Trade Marks Act 1994

1994 CHAPTER 26

An Act to make new provision for registered trade marks, implementing Council Directive No.89/104/EEC of 21st December 1988 to approximate the laws of the Member States relating to trade marks; to make provision in connection with Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community trade mark; to give effect to the Madrid Protocol Relating to the International Registration of Marks of 27th June 1989, and to certain provisions of the Paris Convention for the Protection of Industrial Property of 20th March 1883, as revised and amended; and for connected purposes. [21st July 1994]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Extent Information

E1 Act extends to the United Kingdom and the Isle of Man see s. 108(2).

Modifications etc. (not altering text)

C1 Act applied (with modifications) (I.O.M) (1.4.1996) by S.I. 1996/729, art. 2, **Sch.** (as amended (24.12.2002) by S.I. 2002/3148, **art. 2** and (1.7.2004) by S.I. 2004/1497, art. 2, Sch.)
Act applied (14.8.1996) by S.I. 1996/1908, **reg. 10(2)(3)**

Commencement Information

I1 Act not in force at Royal Assent see s. 109(1); Act partly in force for limited purposes temporarily 29.9.1994 by S.I. 1994/2550, art.3, **Sch.**; Act wholly in force 31.10.1994 by S.I. 1994/2550,art.2.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

PART I

REGISTERED TRADE MARKS

Introductory

1 Trade marks.

(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see section 49) or certification mark (see section 50).

2 Registered trade marks.

(1) A registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.

(2) No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such; but nothing in this Act affects the law relating to passing off.

Grounds for refusal of registration

3 Absolute grounds for refusal of registration.

(1) The following shall not be registered—

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the*bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of—

(a) the shape which results from the nature of the goods themselves,

(b) the shape of goods which is necessary to obtain a technical result, or

(c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is—

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

4 Specially protected emblems.

(1) A trade mark which consists of or contains—

(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,

(b) a representation of the Royal crown or any of the Royal flags,

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,

shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

(2) A trade mark which consists of or contains a representation of—

(a) the national flag of the United Kingdom (commonly known as the Union Jack), or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.

Provision may be made by rules identifying the flags to which paragraph (b) applies.

(3) A trade mark shall not be registered in the cases specified in—

section 57 (national emblems, &c. of Convention countries), or

section 58 (emblems, &c. of certain international organisations).

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains—

(a) arms to which a person is entitled by virtue of a grant of arms by the Crown, or

(b) insignia so nearly resembling such arms as to be likely to be mistaken for them,

unless it appears to the registrar that consent has been given by or on behalf of that person.

Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to the laws of arms.

[[F1](5) A trade mark which consists of or contains a controlled representation within the meaning of the Olympic Symbol etc. (Protection) Act 1995 shall not be registered unless it appears to the registrar—

(a) that the application is made by the person for the time being appointed under section 1(2) of the Olympic Symbol etc. (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics association right), or

(b) that consent has been given by or on behalf of the person mentioned in paragraph (a) above.**]**

Textual Amendments

F1 S. 4(5) inserted (20.9.1995) by 1995 c. 32, **s. 13(2)** (with s. 13(3)); S.I. 1995/2472, **art. 2**

Commencement Information

I2 S. 4 wholly in force at 31.10.1994; S. 4 not in force at Royal Assent see s. 109; s. 4(4) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 4 not already in force by S.I. 1994, arts. 2, 3(1), Sch.

5 Relative grounds for refusal of registration.

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

6 Meaning of "earlier trade mark".

(1) In this Act an "earlier trade mark" means—

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention **[**[F2]or the WTO agreement**]** as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no*bona fide* use of the mark during the two years immediately preceding the expiry.

Textual Amendments

F2 Words in s. 6(1)(c) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(1)**

7 Raising of relative grounds in case of honest concurrent use.

(1) This section applies where on an application for the registration of a trade mark it appears to the registrar—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section "honest concurrent use" means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the [M1]Trade Marks Act 1938.

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(4) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).

(5) This section does not apply when there is an order in force under section 8 below.

Marginal Citations

M1 1938 c. 22.

8 Power to require that relative grounds be raised in opposition proceedings.

(1) The Secretary of State may by order provide that in any case a trade mark shall not be refused registration on a ground mentioned in section 5 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.

(2) The order may make such consequential provision as appears to the Secretary of State appropriate—

(a) with respect to the carrying out by the registrar of searches of earlier trade marks, and

(b) as to the persons by whom an application for a declaration of invalidity may be made on the grounds specified in section 47(2) (relative grounds).

(3) An order making such provision as is mentioned in subsection (2)(a) may direct that so much of section 37 (examination of application) as requires a search to be carried out shall cease to have effect.

(4) An order making such provision as is mentioned in subsection (2)(b) may provide that so much of section 47(3) as provides that any person may make an application for a declaration of invalidity shall have effect subject to the provisions of the order.

(5) An order under this section shall be made by statutory instrument, and no order shall be made unless a draft of it has been laid before and approved by a resolution of each House of Parliament.

No such draft of an order making such provision as is mentioned in subsection (1) shall be laid before Parliament until after the end of the period of ten years beginning with the day on which applications for Community trade marks may first be filed in pursuance of the Community Trade Mark Regulation.

(6) An order under this section may contain such transitional provisions as appear to the Secretary of State to be appropriate.

Effects of registered trade mark

9 Rights conferred by registered trade mark.

(1) The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent.

The acts amounting to infringement, if done without the consent of the proprietor, are specified in section 10.

(2) References in this Act to the infringement of a registered trade mark are to any such infringement of the rights of the proprietor.

(3) The rights of the proprietor have effect from the date of registration (which in accordance with section 40(3) is the date of filing of the application for registration): Provided that—

(a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and

(b) no offence under section 92 (unauthorised use of trade mark, &c. in relation to goods) is committed by anything done before the date of publication of the registration.

10 Infringement of registered trade mark.

(1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because—

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.

(3) A person infringes a registered trade mark if he uses in the course of trade a sign which—

(a) is identical with or similar to the trade mark, and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

(4) For the purposes of this section a person uses a sign if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;

(c) imports or exports goods under the sign; or

(d) uses the sign on business papers or in advertising.

(5) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

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(6) Nothing in the preceding provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee.

But any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

11 Limits on effect of registered trade mark.

(1) A registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered (but see section 47(6) (effect of declaration of invalidity of registration)).

(2) A registered trade mark is not infringed by—

(a) the use by a person of his own name or address,

(b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services, or

(c) the use of 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 the use is in accordance with honest practices in industrial or commercial matters.

(3) A registered trade mark is not infringed by the use in the course of trade in a particular locality of an earlier right which applies only in that locality.

For this purpose an "earlier right" means an unregistered trade mark or other sign continuously used in relation to goods or services by a person or a predecessor in title of his from a date prior to whichever is the earlier of—

(a) the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his, or

(b) the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his;

and an earlier right shall be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by virtue of any rule of law (in particular, the law of passing off).

12 Exhaustion of rights conferred by registered trade mark.

(1) A registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market in the European Economic Area under that trade mark by the proprietor or with his consent.

(2) Subsection (1) does not apply where there exist legitimate reasons for the proprietor to oppose further dealings in the goods (in particular, where the condition of the goods has been changed or impaired after they have been put on the market).

13 Registration subject to disclaimer or limitation.

(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may—

(a) disclaim any right to the exclusive use of any specified element of the trade mark, or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of a disclaimer or limitation.

Commencement Information

I3 S. 13 wholly in force at 31.10.1994; s. 13 not in force at Royal Assent see s. 109; s. 13(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 13 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Infringement proceedings

14 Action for infringement.

(1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.

15 Order for erasure, &c. of offending sign.

(1) Where a person is found to have infringed a registered trade mark, the court may make an order requiring him—

(a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control, or

(b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under subsection (1) is not complied with, or it appears to the court likely that such an order would not be complied with, the court may order that the infringing goods, material or articles be delivered to such person as the court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

Modifications etc. (not altering text)

C2 S. 15: power to apply conferred (20.9.1995) by 1995 c. 32, **s. 7(1)**; S.I. 1995/2472, **art. 2**

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16 Order for delivery up of infringing goods, material or articles.

(1) The proprietor of a registered trade mark may apply to the court for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business.

(2) An application shall not be made after the end of the period specified in section 18 (period after which remedy of delivery up not available); and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 19 (order as to disposal of infringing goods, &c.).

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under section 19 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

(4) Nothing in this section affects any other power of the court.

Modifications etc. (not altering text)

C3 S. 16: power to apply conferred (20.9.1995) by 1995 c. 32, 7(1); S.I. 1995/2472, **art. 2**

17 Meaning of "infringing goods, material or articles".

(1) In this Act the expressions "infringing goods", "infringing material" and "infringing articles" shall be construed as follows.

(2) Goods are "infringing goods", in relation to a registered trade mark, if they or their packaging bear 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, or

(b) the goods are proposed to be imported into the United Kingdom and the application of the sign in the United Kingdom 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.

(3) Nothing in subsection (2) shall be construed as affecting the importation of goods which may lawfully be imported into the United Kingdom by virtue of an enforceable Community right.

(4) Material is "infringing material", in relation to a registered trade mark if it 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.

(5) "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 material.

18 Period after which remedy of delivery up not available.

(1) An application for an order under section 16 (order for delivery up of infringing goods, material or articles) may not be made after the end of the period of six years from—

(a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging,

(b) in the case of infringing material, the date on which the trade mark was applied to the material, or

(c) in the case of infringing articles, the date on which they were made,

except as mentioned in the following provisions.

(2) If during the whole or part of that period the proprietor of the registered trade mark—

(a) is under a disability, or

(b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(3) In subsection (2) "disability"—

(a) in England and Wales, has the same meaning as in the [M2]Limitation Act 1980;

(b) in Scotland, means legal disability within the meaning of the [M3]Prescription and Limitation (Scotland) Act 1973;

(c) in Northern Ireland, has the same meaning as in the [M4]Limitation (Northern Ireland) Order 1989.

Modifications etc. (not altering text)

C4 S. 18: power to apply conferred (20.9.1995) by 1995 c. 32, **s. 7(1)**; S.I. 1995/2472, **art. 2**

Marginal Citations

M2 1980 c. 58.

M3 1973 c. 52.

M4 S.I. 1989/1339 (N.I. 11).

19 Order as to disposal of infringing goods, material or articles.

(1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 16, an application may be made to the court—

(a) for an order that they be destroyed or forfeited to such person as the court may think fit, or

(b) for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the registered trade mark

would be adequate to compensate the proprietor and any licensee and protect their interests.

(3) Provision shall be made by rules of court as to the service of notice on persons having an interest in the goods, material or articles, and any such person is entitled—

(a) to appear in proceedings for an order under this section, whether or not he was served with notice, and

(b) to appeal against any order made, whether or not he appeared;

and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the goods, material or articles, the court shall make such order as it thinks just.

(5) If the court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up is entitled to their return.

(6) References in this section to a person having an interest in goods, material or articles include any person in whose favour an order could be made under this section or under section 114, 204 or 231 of the [M5]Copyright, Designs and Patents Act 1988 (which make similar provision in relation to infringement of copyright, rights in performances and design right).

Modifications etc. (not altering text)

C5 S. 19: power to apply conferred (20.9.1995) by 1995 c. 32, **S.I**. 1995/2472, art. 2

Marginal Citations

M5 1988 c. 48

20 Jurisdiction of sheriff court or county court in Northern Ireland.

Proceedings for an order under section 16 (order for delivery up of infringing goods, material or articles) or section 19 (order as to disposal of infringing goods, &c.) may be brought—

(a) in the sheriff court in Scotland, or

(b) in a county court in Northern Ireland.

This does not affect the jurisdiction of the Court of Session or the High Court in Northern Ireland.

Modifications etc. (not altering text)

C6 S. 20: power to apply conferred (20.9.1995) by 1995 c. 32, **s. 7(1)**; S.I. 1995/2472, **art. 2**

21 Remedy for groundless threats of infringement proceedings.

(1) Where a person threatens another with proceedings for infringement of a registered trade mark other than—

(a) the application of the 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 for relief under this section.

(2) The relief which may be applied for is any of the following—

(a) a declaration that the threats are unjustifiable,

(b) an injunction against the continuance of the threats,

(c) damages in respect of any loss he has sustained by the threats;

and the plaintiff is entitled to such relief unless the defendant shows that the acts in respect of which proceedings were threatened constitute (or if done would constitute) an infringement of the registered trade mark concerned.

(3) If that is shown by the defendant, the plaintiff is nevertheless entitled to relief if he shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.

(4) The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

Modifications etc. (not altering text)

C7 S. 21 applied (14.8.1996) by S.I. 1996/1908, **reg. 4**

Registered trade mark as object of property

22 Nature of registered trade mark.

A registered trade mark is personal property (in Scotland, incorporeal moveable property).

Modifications etc. (not altering text)

C8 S. 22 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 5**

23 Co-ownership of registered trade mark.

(1) Where a registered trade mark is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) The following provisions apply where two or more persons are co-proprietors of a registered trade mark, by virtue of subsection (1) or otherwise.

(3) Subj19940929ect to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

(4) One co-proprietor may not without the consent of the other or others—

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(a) grant a licence to use the registered trade mark, or

(b) assign or charge his share in the registered trade mark (or, in Scotland, cause or permit security to be granted over it).

(5) Infringement proceedings may be brought by any co-proprietor, but he may not, without the leave of the court, proceed with the action unless the other, or each of the others, is either joined as a plaintiff or added as a defendant.

A co-proprietor who is thus added as a defendant shall not be made liable for any costs in the action unless he takes part in the proceedings.

Nothing in this subsection affects the granting of interlocutory relief on the application of a single co-proprietor.

(6) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

Modifications etc. (not altering text)

C9 S. 23 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 5**

24 Assignment, &c. of registered trade mark.

(1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

It is so transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply—

(a) in relation to some but not all of the goods or services for which the trade mark is registered, or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

Except in Scotland, this requirement may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(4) The above provisions apply to assignment by way of security as in relation to any other assignment.

(5) A registered trade mark may be the subject of a charge (in Scotland, security) in the same way as other personal or moveable property.

(6) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

Modifications etc. (not altering text)

C10 S. 24 applied (except s. 24(2)(b)) (with modifications) (1.4.1996) by S.I. 1996/714, **art. 5**

25 Registration of transactions affecting registered trade mark.

(1) On application being made to the registrar by—

(a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction, or

(b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions—

(a) an assignment of a registered trade mark or any right in it;

(b) the grant of a licence under a registered trade mark;

(c) the granting of any security interest (whether fixed or floating) over a registered trade mark or any right in or under it;

(d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it;

(e) an order of a court or other competent authority transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for registration of the prescribed particulars of a registrable transaction—

(a) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it, and

(b) a person claiming to be a licensee by virtue of the transaction does not have the protection of section 30 or 31 (rights and remedies of licensee in relation to infringement).

(4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, then unless—

(a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date, or

(b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the prescribed particulars of the transaction are registered.

(5) Provision may be made by rules as to—

(a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence, and

(b) the removal of such particulars from the register—

(i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired, or

(ii) where no such period is indicated and, after such period as may be prescribed, the registrar has notified the parties of his intention to remove the particulars from the register.

(6) Provision may also be made by rules as to the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.

Commencement Information

I4 S. 25 wholly in force 31.10.1994; s. 25 not in force at Royal Assent see s. 109; s. 25(1)(5)(6) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 25 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

26 Trusts and equities.

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

(2) Subject to the provisions of this Act, equities (in Scotland, rights) in respect of a registered trade mark may be enforced in like manner as in respect of other personal or moveable property.

Modifications etc. (not altering text)

C11 S. 26 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 5**

27 Application for registration of trade mark as an object of property.

(1) The provisions of sections 22 to 26 (which relate to a registered trade mark as an object of property) apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark.

(2) In section 23 (co-ownership of registered trade mark) as it applies in relation to an application for registration the reference in subsection (1) to the granting of the registration shall be construed as a reference to the making of the application.

(3) In section 25 (registration of transactions affecting registered trade marks) as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the registrar of those particulars.

Licensing

28 Licensing of registered trade mark.

(1) A licence to use a registered trade mark may be general or limited.

A limited licence may, in particular, apply—

(a) in relation to some but not all of the goods or services for which the trade mark is registered, or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(2) A licence is not effective unless it is in writing signed by or on behalf of the grantor.

Except in Scotland, this requirement may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.

(3) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest.

References in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.

(4) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

29 Exclusive licences.

(1) In this Act an "exclusive licence" means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence.

The expression "exclusive licensee" shall be construed accordingly.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

30 General provisions as to rights of licensees in case of infringement.

(1) This section has effect with respect to the rights of a licensee in relation to infringement of a registered trade mark.

The provisions of this section do not apply where or to the extent that, by virtue of section 31(1) below (exclusive licensee having rights and remedies of assignee), the licensee has a right to bring proceedings in his own name.

(2) A licensee is entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor—

(a) refuses to do so, or

(b) fails to do so within two months after being called upon,

the licensee may bring the proceedings in his own name as if he were the proprietor.

(4) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

This does not affect the granting of interlocutory relief on an application by a licensee alone.

(5) A proprietor who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) In infringement proceedings brought by the proprietor of a registered trade mark any loss suffered or likely to be suffered by licensees shall be taken into account; and the

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court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of licensees.

(7) The provisions of this section apply in relation to an exclusive licensee if or to the extent that he has, by virtue of section 31(1), the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

31 Exclusive licensee having rights and remedies of assignee.

(1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

Where or to the extent that such provision is made, the licensee is entitled, subject to the provisions of the licence and to the following provisions of this section, to bring infringement proceedings, against any person other than the proprietor, in his own name.

(2) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

(4) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

This does not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(5) A person who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action—

(a) the court shall in assessing damages take into account—

(i) the terms of the licence, and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) the court shall if an account of profits is directed apportion the profits between them as the court considers just, subject to any agreement between them.

The provisions of this subsection apply whether or not the proprietor and the exclusive licensee are both parties to the action; and if they are not both parties the court may

give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(7) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 16 (order for delivery up); and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(8) The provisions of subsections (4) to (7) above have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

Application for registered trade mark

32 Application for registration.

(1) An application for registration of a trade mark shall be made to the registrar.

(2) The application shall contain—
- (a) a request for registration of a trade mark,
- (b) the name and address of the applicant,
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- (d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a*bona fide* intention that it should be so used.

(4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.

33 Date of filing.

(1) The date of filing of an application for registration of a trade mark is the date on which documents containing everything required by section 32(2) are furnished to the registrar by the applicant.

If the documents are furnished on different days, the date of filing is the last of those days.

(2) References in this Act to the date of application for registration are to the date of filing of the application.

34 Classification of trade marks.

(1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final.

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Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Commencement Information

I5 S. 34 wholly in force at 31.10.1994; s. 34 not in force at Royal Assent see s. 109; s. 34(1) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 34 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Priority

35 Claim to priority of Convention application.

(1) A person who has duly filed an application for protection of a trade mark in a Convention country (a "Convention application"), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within that six-month period—

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

(3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

A "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

(4) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application—

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and

(b) it has not yet served as a basis for claiming a right of priority.

The previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a Convention application.

(6) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently.

The reference in subsection (1) to the applicant's "successor in title" shall be construed accordingly.

Commencement Information

I6 S. 35 wholly in force at 31.10.1994; s. 35 not in force at Royal Assent see s. 109; s. 35(5) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 35 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

36 Claim to priority from other relevant overseas application.

(1) Her Majesty may by Order in Council make provision for conferring on a person who has duly filed an application for protection of a trade mark in—

(a) any of the Channel Islands or a colony, or

(b) a country or territory in relation to which Her Majesty's Government in the United Kingdom have entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks,

a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

(2) An Order in Council under this section may make provision corresponding to that made by section 35 in relation to Convention countries or such other provision as appears to Her Majesty to be appropriate.

(3) A statutory instrument containing an Order in Council under this section shall be subject to annulment in pursuance of a resolution of either House of Parliament.

Registration procedure

37 Examination of application.

(1) The registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act (including any requirements imposed by rules).

(2) For that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) If it appears to the registrar that the requirements for registration are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to amend the application.

(4) If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.

(5) If it appears to the registrar that the requirements for registration are met, he shall accept the application.

38 Publication, opposition proceedings and observations.

(1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

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(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) Where an application has been published, any person may, at any time before the registration of the trade mark, make observations in writing to the registrar as to whether the trade mark should be registered; and the registrar shall inform the applicant of any such observations.

A person who makes observations does not thereby become a party to the proceedings on the application.

Commencement Information

I7 S. 38 wholly in force at 31.10.1994; s. 38 not in force at Royal Assent see s. 109; s. 38(1)(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 38 not already in force by S.I. 1994/2550, art. 2, 3(1), **Sch.**

39 Withdrawal, restriction or amendment of application.

(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects, an application may be amended, at the request of the applicant, only by correcting—

(a) the name or address of the applicant,

(b) errors of wording or of copying, or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(3) Provision shall be made by rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it.

Commencement Information

I8 S. 39 wholly in force at 31.10.1994; s. 39 not in force at Royal Assent see s. 109; s. 39(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 39 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

40 Registration.

(1) Where an application has been accepted and—

(a) no notice of opposition is given within the period referred to in section 38(2), or

(b) all opposition proceedings are withdrawn or decided in favour of the applicant,

the registrar shall register the trade mark, unless it appears to him having regard to matters coming to his notice since he accepted the application that it was accepted in error.

(2) A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period.

If the fee is not paid within that period, the application shall be deemed to be withdrawn.

(3) A trade mark when registered shall be registered as of the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.

(4) On the registration of a trade mark the registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.

Commencement Information

I9 S. 40 wholly in force at 31.10.1994; s. 40 not in force at Royal Assent see s. 109; s. 40(4) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 40 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

41 Registration: supplementary provisions.

(1) Provision may be made by rules as to—

(a) the division of an application for the registration of a trade mark into several applications;

(b) the merging of separate applications or registrations;

(c) the registration of a series of trade marks.

(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) Rules under this section may include provision as to—

(a) the circumstances in which, and conditions subject to which, division, merger or registration of a series is permitted, and

(b) the purposes for which an application to which the rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.

Commencement Information

I10 S. 41 wholly in force at 31.10.1994; s. 41 not in force at Royal Assent see s. 109; s. 41(1)(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 41 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
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Duration, renewal and alteration of registered trade mark

42 Duration of registration.

(1) A trade mark shall be registered for a period of ten years from the date of registration.

(2) Registration may be renewed in accordance with section 43 for further periods of ten years.

43 Renewal of registration.

(1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of a renewal fee.

(2) Provision shall be made by rules for the registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal must be made, and the renewal fee paid, before the expiry of the registration.

Failing this, the request may be made and the fee paid within such further period (of not less than six months) as may be prescribed, in which case an additional renewal fee must also be paid within that period.

(4) Renewal shall take effect from the expiry of the previous registration.

(5) If the registration is not renewed in accordance with the above provisions, the registrar shall remove the trade mark from the register.

Provision may be made by rules for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions (if any) as may be prescribed.

(6) The renewal or restoration of the registration of a trade mark shall be published in the prescribed manner.

Commencement Information

I11 S. 43 wholly in force at 31.10.1994; s. 43 not in force at Royal Assent see s. 109; s.43(2)(3)(5)(6) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 43 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

44 Alteration of registered trade mark.

(1) A registered trade mark shall not be altered in the register, during the period of registration or on renewal.

(2) Nevertheless, the registrar may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark.

(3) Provision shall be made by rules for the publication of any such alteration and the making of objections by any person claiming to be affected by it.

Commencement Information

I12 S. 44 wholly in force at 31.10.1994; s. 44 not in force at Royal Assent see s. 109; s. 44(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s.44 not already in force by S.I. 1994/2550, art. 2, 3(1), **Sch.**

Surrender, revocation and invalidity

45 Surrender of registered trade mark.

(1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

(2) Provision may be made by rules—

(a) as to the manner and effect of a surrender, and

(b) for protecting the interests of other persons having a right in the registered trade mark.

Commencement Information

I13 S. 45 wholly in force at31.10.1994; s. 45 not in force at Royal Assent see s. 109; s. 45(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 45 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

46 Revocation of registration.

(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

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Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.

Modifications etc. (not altering text)

C12 S. 46 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 13**
S. 46 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 3(3)**

47 Grounds for invalidity of registration.

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:
Provided that this shall not affect transactions past and closed.

Modifications etc. (not altering text)
C13 S. 47 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 13**
S. 47 applied (with modifications) (14.8.1996) by S.I. 1908, reg. 3(3)

48 Effect of acquiescence.

(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right—

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

Modifications etc. (not altering text)
C14 S. 48 applied (1.4.1996) by S.I. 1996/714, **art. 14**

Collective marks

49 Collective marks.

(1) A collective mark is a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

(2) The provisions of this Act apply to collective marks subject to the provisions of Schedule 1.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Certification marks

50 Certification marks.

(1) A certification mark is 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 manufacture of goods or performance of services, quality, accuracy or other characteristics.

(2) The provisions of this Act apply to certification marks subject to the provisions of Schedule 2.

PART II

COMMUNITY TRADE MARKS AND INTERNATIONAL MATTERS

Community trade marks

51 Meaning of "Community trade mark".

In this Act—

"Community trade mark" has the meaning given by Article 1(1) of the Community Trade Mark Regulation; and

"the Community Trade Mark Regulation" means [M6]Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community trade mark.

Marginal Citations

M6 O.J. No. L11, 14.1.94, p.1.

52 Power to make provision in connection with Community Trade Mark Regulation.

(1) The Secretary of State may by regulations make such provision as he considers appropriate in connection with the operation of the Community Trade Mark Regulation.

(2) Provision may, in particular, be made with respect to—

(a) the making of applications for Community trade marks by way of the Patent Office;

(b) the procedures for determining*a posteriori* the invalidity, or liability to revocation, of the registration of a trade mark from which a Community trade mark claims seniority;

(c) the conversion of a Community trade mark, or an application for a Community trade mark, into an application for registration under this Act;

(d) the designation of courts in the United Kingdom having jurisdiction over proceedings arising out of the Community Trade Mark Regulation.

(3) Without prejudice to the generality of subsection (1), provision may be made by regulations under this section—

(a) applying in relation to a Community trade mark the provisions of—

(i) section 21 (remedy for groundless threats of infringement proceedings);

(ii) sections 89 to 91 (importation of infringing goods, material or articles); and

(iii) sections 92, 93, 95 and 96 (offences); and

(b) making in relation to the list of professional representatives maintained in pursuance of Article 89 of the Community Trade Mark Regulation, and persons on that list, provision corresponding to that made by, or capable of being made under, sections 84 to 88 in relation to the register of trade mark agents and registered trade mark agents.

(4) Regulations under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

Subordinate Legislation Made

P1 S. 52 power fully exercised (23.7.1996): 14.8.1996 appointed day by S.I. 1996/1908

The Madrid Protocol: international registration

53 The Madrid Protocol.

In this Act—

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

"the International Bureau" has the meaning given by Article 2(1) of that Protocol; and

"international trade mark (UK)" means a trade mark which is entitled to protection in the United Kingdom under that Protocol.

54 Power to make provision giving effect to Madrid Protocol.

(1) The Secretary of State may by order make such provision as he thinks fit for giving effect in the United Kingdom to the provisions of the Madrid Protocol.

(2) Provision may, in particular, be made with respect to—

(a) the making of applications for international registrations by way of the Patent Office as office of origin;

(b) the procedures to be followed where the basic United Kingdom application or registration fails or ceases to be in force;

(c) the procedures to be followed where the Patent Office receives from the International Bureau a request for extension of protection to the United Kingdom;

(d) the effects of a successful request for extension of protection to the United Kingdom;

(e) the transformation of an application for an international registration, or an international registration, into a national application for registration;

(f) the communication of information to the International Bureau;

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Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

(g) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.

(3) Without prejudice to the generality of subsection (1), provision may be made by regulations under this section applying in relation to an international trade mark (UK) the provisions of—

(a) section 21 (remedy for groundless threats of infringement proceedings);

(b) sections 89 to 91 (importation of infringing goods, material or articles); and

(c) sections 92, 93, 95 and 96 (offences).

(4) An order under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

The Paris Convention: supplementary provisions

55 The Paris Convention.

(1) In this Act—

(a) "the Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time, [F3]. . .

[[F4](aa) "the WTO agreement" means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994 [F5], and**]**

(b) a "Convention country" means a country, other than the United Kingdom, which is a party to that Convention.

(2) The Secretary of State may by order make such amendments of this Act, and rules made under this Act, as appear to him appropriate in consequence of any revision or amendment of the Paris Convention **[**[F6]or the WTO agreement**]** after the passing of this Act.

(3) Any such order shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

Textual Amendments

F3 Word in s. 55(1) omitted (29.7.1999) by virtue of S.I. 1999/1899, **reg. 13(2)**

F4 S. 55(1)(aa) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(2)**

F5 Cm. 2556–59, 2561–2, 2564–69, 2571–74. The Agreement Establishing the World Trade Organisation was declared a Community Treaty as defined in section 1(2) of the European Communities Act 1972 by S.I. 1995/265.

F6 Words in s. 55(2) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(3)**

56 Protection of well-known trade marks: Article 6bis.

(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention **[**[F7]or the WTO agreement**]** as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who—

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention **[**[F7]or the WTO agreement**]** as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any*bona fide* use of a trade mark begun before the commencement of this section.

Textual Amendments

F7 Words in s. 56(1)(2) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(4)** (with reg. 14(1))

57 National emblems, &c. of Convention countries: Article 6ter.

(1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention **[**[F8]or the WTO agreement**]** shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention **[**[F8]or the WTO agreement**]**, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use of the mark in the United Kingdom without their authorisation.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Textual Amendments

F8 Words in s. 57(2)(3) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(5)**

58 Emblems, &c. of certain international organisations: Article 6ter.

(1) This section applies to—

(a) the armorial bearings, flags or other emblems, and

(b) the abbreviations and names,

of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention **[**[F9]or the WTO agreement**]**shall not be registered without the authorisation of the international organisation concerned, unless it appears to the registrar that the use of the emblem, abbreviation or name in the manner proposed—

(a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark, or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an international organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use of the mark in the United Kingdom without its authorisation.

(5) Nothing in this section affects the rights of a person whose*bona fide* use of the trade mark in question began before 4th January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom).

Textual Amendments

F9 Words in s. 58(2) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(6)** (with art. 14(2))

59 Notification under Article 6ter of the Convention.

(1) For the purposes of section 57 state emblems of a Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that—

(a) the country in question has notified the United Kingdom in accordance with Article 6*ter*(3) of the Convention that it desires to protect that emblem, sign or hallmark,

(b) the notification remains in force, and

(c) the United Kingdom has not objected to it in accordance with Article 6*ter*(4) or any such objection has been withdrawn.

(2) For the purposes of section 58 the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—
  (a) the organisation in question has notified the United Kingdom in accordance with Article 6*ter*(3) of the Convention that it desires to protect that emblem, abbreviation or name,
  (b) the notification remains in force, and
  (c) the United Kingdom has not objected to it in accordance with Article 6*ter*(4) or any such objection has been withdrawn.

(3) Notification under Article 6*ter*(3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

(4) The registrar shall keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of—
  (a) the state emblems and official signs or hallmarks, and
  (b) the emblems, abbreviations and names of international organisations,

which are for the time being protected under the Paris Convention by virtue of notification under Article 6*ter*(3).

[[F10](5) Any reference in this section to Article 6ter of the Paris Convention shall be construed as including a reference to that Article as applied by the WTO agreement**]**

Textual Amendments
F10 S. 59(5) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(7)**

60 Acts of agent or representative: Article 6septies.

(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3) If the application (not being so opposed) is granted, the proprietor may—
  (a) apply for a declaration of the invalidity of the registration, or
  (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in the United Kingdom which is not authorised by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.

(6) An application under subsection (3)(a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Miscellaneous

61 Stamp duty.

Stamp duty shall not be chargeable on an instrument relating to a Community trade mark or an international trade mark (UK), or an application for any such mark, by reason only of the fact that such a mark has legal effect in the United Kingdom.

PART III

ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

The registrar

PROSPECTIVE

62 The registrar.

In this Act "the registrar" means the Comptroller-General of Patents, Designs and Trade Marks.

The register

63 The register.

(1) The registrar shall maintain a register of trade marks.

References in this Act to "the register" are to that register; and references to registration (in particular, in the expression "registered trade mark") are, unless the context otherwise requires, to registration in that register.

(2) There shall be entered in the register in accordance with this Act—
- (a) registered trade marks,
- (b) such particulars as may be prescribed of registrable transactions affecting a registered trade mark, and
- (c) such other matters relating to registered trade marks as may be prescribed.

(3) The register shall be kept in such manner as may be prescribed, and provision shall in particular be made for—
- (a) public inspection of the register, and
- (b) the supply of certified or uncertified copies, or extracts, of entries in the register.

Commencement Information

I14 S. 63 wholly in force at 31.10.1994; s. 63 not in force at Royal Assent see s. 109; s. 63(2)(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 63 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

64 Rectification or correction of the register.

(1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:
Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) An application for rectification may be made either to the registrar or to the court, except that—
  (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
  (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The registrar may remove from the register matter appearing to him to have ceased to have effect.

Commencement Information

I15 S. 64 wholly in force at 31.10.1994; s. 64 not in force at Royal Assent see s. 109; s. 64(4) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 64 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

65 Adaptation of entries to new classification.

(1) Provision may be made by rules empowering the registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.

(2) Provision may in particular be made for the amendment of existing entries on the register so as to accord with the new classification.

(3) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

(4) The rules may empower the registrar—
  (a) to require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the register, and
  (b) to cancel or refuse to renew the registration of the trade mark in the event of his failing to do so.

(5) Any such proposal shall be advertised, and may be opposed, in such manner as may be prescribed.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Commencement Information

I16 S. 65 wholly in force at 31.10.1994; s. 65 not in force at Royal Assent see s. 109; s. 65(1)(3)(4)(5) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 65 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Powers and duties of the registrar

66 Power to require use of forms.

(1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner.

Commencement Information

I17 S. 66 wholly in force at 31.10.1994; s. 66 not in force at Royal Assent see s. 109; s. 66 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3, **Sch.**

67 Information about applications and registered trade marks.

(1) After publication of an application for registration of a trade mark, the registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject, however, to any prescribed restrictions.

Any request must be made in the prescribed manner and be accompanied by the appropriate fee (if any).

(2) Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application shall not be published by the registrar or communicated by him to any person except—

(a) in such cases and to such extent as may be prescribed, or

(b) with the consent of the applicant;

but subject as follows.

(3) Where a person has been notified that an application for registration of a trade mark has been made, and that the applicant will if the application is granted bring proceedings against him in respect of acts done after publication of the application, he may make a request under subsection (1) notwithstanding that the application has not been published and that subsection shall apply accordingly.

Commencement Information

I18 S. 67(1)(2) wholly in force at 31.10.1994; s. 67 not in force at Royal Assent see s. 109; s. 67(1)(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 67 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

68 Costs and security for costs.

(1) Provision may be made by rules empowering the registrar, in any proceedings before him under this Act—

(a) to award any party such costs as he may consider reasonable, and

(b) to direct how and by what parties they are to be paid.

(2) Any such order of the registrar may be enforced—

(a) in England and Wales or Northern Ireland, in the same way as an order of the High Court;

(b) in Scotland, in the same way as a decree for expenses granted by the Court of Session.

(3) Provision may be made by rules empowering the registrar, in such cases as may be prescribed, to require a party to proceedings before him to give security for costs, in relation to those proceedings or to proceedings on appeal, and as to the consequences if security is not given.

Commencement Information

I19 S. 68 wholly in force at 31.10.1994; s. 68 not in force at Royal Assent see s. 109; s. 68(1)(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 68 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

69 Evidence before registrar.

Provision may be made by rules—

(a) as to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration;

(b) conferring on the registrar the powers of an official referee of the Supreme Court as regards the examination of witnesses on oath and the discovery and production of documents; and

(c) applying in relation to the attendance of witnesses in proceedings before the registrar the rules applicable to the attendance of witnesses before such a referee.

Commencement Information

I20 S. 69 wholly in force at 31.10.1994; s. 69 not in force at Royal Assent see s. 109; s. 69 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
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70 Exclusion of liability in respect of official acts.

(1) The registrar shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention, arrangement or engagement to which the United Kingdom is a party.

(2) The registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.

(3) No proceedings lie against an officer of the registrar in respect of any matter for which, by virtue of this section, the registrar is not liable.

PROSPECTIVE

71 Registrar's annual report.

(1) The Comptroller-General of Patents, Designs and Trade Marks shall in his annual report under section 121 of the [M7]Patents Act 1977, include a report on the execution of this Act, including the discharge of his functions under the Madrid Protocol.

(2) The report shall include an account of all money received and paid by him under or by virtue of this Act.

Marginal Citations
M7 1977 c. 37.

Legal proceedings and appeals

72 Registration to be prima facie evidence of validity.

In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

Modifications etc. (not altering text)
C15 S. 72 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 3(3)**

73 Certificate of validity of contested registration.

(1) If in proceedings before the court the validity of the registration of a trade mark is contested and it is found by the court that the trade mark is validly registered, the court may give a certificate to that effect.

(2) If the court gives such a certificate and in subsequent proceedings—
(a) the validity of the registration is again questioned, and

(b) the proprietor obtains a final order or judgment in his favour,

he is entitled to his costs as between solicitor and client unless the court directs otherwise.

This subsection does not extend to the costs of an appeal in any such proceedings.

Modifications etc. (not altering text)
C16 S. 73 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 15(1)**

74 Registrar's appearance in proceedings involving the register.

(1) In proceedings before the court involving an application for—
(a) the revocation of the registration of a trade mark,
(b) a declaration of the invalidity of the registration of a trade mark, or
(c) the rectification of the register,

the registrar is entitled to appear and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of—
(a) any proceedings before him in relation to the matter in issue,
(b) the grounds of any decision given by him affecting it,
(c) the practice of the Patent Office in like cases, or
(d) such matters relevant to the issues and within his knowledge as registrar as he thinks fit;

and the statement shall be deemed to form part of the evidence in the proceedings.

(3) Anything which the registrar is or may be authorised or required to do under this section may be done on his behalf by a duly authorised officer.

Modifications etc. (not altering text)
C17 S. 74 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 15(2)**
S. 74 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 3(3)**

75 The court.

In this Act, unless the context otherwise requires, "the court" means—
(a) in England and Wales and Northern Ireland, the High Court, and
(b) in Scotland, the Court of Session.

76 Appeals from the registrar.

(1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules.

For this purpose "decision" includes any act of the registrar in exercise of a discretion vested in him by or under this Act.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

(2) Any such appeal may be brought either to an appointed person or to the court.

(3) Where an appeal is made to an appointed person, he may refer the appeal to the court if—

(a) it appears to him that a point of general legal importance is involved,

(b) the registrar requests that it be so referred, or

(c) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.

Before doing so the appointed person shall give the appellant and any other party to the appeal an opportunity to make representations as to whether the appeal should be referred to the court.

(4) Where an appeal is made to an appointed person and he does not refer it to the court, he shall hear and determine the appeal and his decision shall be final.

(5) The provisions of sections 68 and 69 (costs and security for costs; evidence) apply in relation to proceedings before an appointed person as in relation to proceedings before the registrar.

Modifications etc. (not altering text)

C18 S. 76 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 3(3)**

Commencement Information

I21 S. 76 wholly in force at 31.10.1994; s. 76 not in force at Royal Assent see s. 109; s. 76(1) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 76 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

77 Persons appointed to hear and determine appeals.

(1) For the purposes of section 76 an "appointed person" means a person appointed by the Lord Chancellor to hear and decide appeals under this Act.

(2) A person is not eligible for such appointment unless—

(a) he has a 7 year general qualification, within the meaning of section 71 of the [M8]Courts and Legal Services Act 1990;

(b) he is an advocate or solicitor in Scotland of at least 7 years' standing;

(c) he is a member of the Bar of Northern Ireland or solicitor of the Supreme Court of Northern Ireland of at least 7 years' standing; or

(d) he has held judicial office.

(3) An appointed person shall hold and vacate office in accordance with his terms of appointment, subject to the following provisions—

(a) there shall be paid to him such remuneration (whether by way of salary or fees), and such allowances, as the Secretary of State with the approval of the Treasury may determine;

(b) he may resign his office by notice in writing to the Lord Chancellor;

(c) the Lord Chancellor may by notice in writing remove him from office if—

(i) he has become bankrupt or made an arrangement with his creditors or, in Scotland, his estate has been sequestrated or he has executed a trust deed for his creditors or entered into a composition contract, or

(ii) he is incapacitated by physical or mental illness,

or if he is in the opinion of the Lord Chancellor otherwise unable or unfit to perform his duties as an appointed person.

(4) The Lord Chancellor shall consult the Lord Advocate before exercising his powers under this section.

Modifications etc. (not altering text)

C19 S. 77: Functions of the Lord Advocate transferred to the Secretary of State, and all property, rights and liabilities to which the Lord Advocate is entitled or subject in connection with any such function transferred to the Secretary of State for Scotland (19.5.1999) by S.I. 1999/678, arts. 2, 3, **Sch.** (with art. 7)

S. 77 modified (30.6.1999) by S.I. 1999/1748, art. 3, **Sch. 1 para. 17**

S. 77: transfer of certain functions (1.7.1999) by S.I. 1999/1750, arts. 1, 2, **Sch. 1** (with art. 7); S.I. 1998/3178.art. 2(1)

Marginal Citations

M8 1990 c. 41.

Rules, fees, hours of business, &c.

78 Power of Secretary of State to make rules.

(1) The Secretary of State may make rules—

(a) for the purposes of any provision of this Act authorising the making of rules with respect to any matter, and

(b) for prescribing anything authorised or required by any provision of this Act to be prescribed,

and generally for regulating practice and procedure under this Act.

(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) authorising the rectification of irregularities of procedure;

(e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;

(f) providing for the extension of any time limit so prescribed, or specified by the registrar, whether or not it has already expired.

(3) Rules under this Act shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Commencement Information

I22 S. 78 wholly in force at 31.10.1994; s. 78 not in force at Royal Assent see s. 109; s. 78 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

79 Fees.

(1) There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed.

(2) Provision may be made by rules as to—

(a) the payment of a single fee in respect of two or more matters, and

(b) the circumstances (if any) in which a fee may be repaid or remitted.

Commencement Information

I23 S. 79 wholly in force at 31.10.1994; s. 79 not in force at Royal Assent see s. 109; s. 79 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

80 Hours of business and business days.

(1) The registrar may give directions specifying the hours of business of the Patent Office for the purpose of the transaction by the public of business under this Act, and the days which are business days for that purpose.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

(3) Directions under this section may make different provision for different classes of business and shall be published in the prescribed manner.

Commencement Information

I24 S. 80 wholly in force at 31.10.1994; s. 80 not in force at Royal Assent see s. 109; s. 80(1)(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 80 not already in force by S.I. 1994/2550, arts. 2, 3, **Sch.**

81 The trade marks journal.

Provision shall be made by rules for the publication by the registrar of a journal containing particulars of any application for the registration of a trade mark (including a representation of the mark) and such other information relating to trade marks as the registrar thinks fit.

Commencement Information

I25 S. 81 wholly in force at 31.10.1994; s. 81 not in force at Royal Assent see s. 109; s. 81 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Trade mark agents

82 Recognition of agents.

Except as otherwise provided by rules, any act required or authorised by this Act to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or to an agent authorised by that person orally or in writing.

Commencement Information

I26 S. 82 wholly in force at 31.10.1994; s. 82 not in force at Royal Assent see s. 109; s. 82 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

83 The register of trade mark agents.

(1) The Secretary of State may make rules requiring the keeping of a register of persons who act as agent for others for the purpose of applying for or obtaining the registration of trade marks; and in this Act a "registered trade mark agent" means a person whose name is entered in the register kept under this section.

(2) The rules may contain such provision as the Secretary of State thinks fit regulating the registration of persons, and may in particular—

(a) require the payment of such fees as may be prescribed, and

(b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person's registration.

(3) The rules may delegate the keeping of the register to another person, and may confer on that person—

(a) power to make regulations—

(i) with respect to the payment of fees, in the cases and subject to the limits prescribed by the rules, and

(ii) with respect to any other matter which could be regulated by the rules, and

(b) such other functions, including disciplinary functions, as may be prescribed by the rules.

84 Unregistered persons not to be described as registered trade mark agents.

(1) An individual who is not a registered trade mark agent shall not—

(a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "registered trade mark agent"; or

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(b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent.

(2) A partnership shall not—

(a) carry on a business under any name or other description which contains the words "registered trade mark agent"; or

(b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a firm of registered trade mark agents,

unless all the partners are registered trade mark agents or the partnership satisfies such conditions as may be prescribed for the purposes of this section.

(3) A body corporate shall not—

(a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "registered trade mark agent"; or

(b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trade mark agent,

unless all the directors of the body corporate are registered trade mark agents or the body satisfies such conditions as may be prescribed for the purposes of this section.

(4) A person who contravenes this section commits an offence and is liable on summary conviction to a fine not exceeding level 5 on the standard scale; and proceedings for such an offence may be begun at any time within a year from the date of the offence.

85 Power to prescribe conditions, &c. for mixed partnerships and bodies corporate.

(1) The Secretary of State may make rules prescribing the conditions to be satisfied for the purposes of section 84 (persons entitled to be described as registered trade mark agents)—

(a) in relation to a partnership where not all the partners are qualified persons, or

(b) in relation to a body corporate where not all the directors are qualified persons,

and imposing requirements to be complied with by such partnerships or bodies corporate.

(2) The rules may, in particular—

(a) prescribe conditions as to the number or proportion of partners or directors who must be qualified persons;

(b) impose requirements as to—

(i) the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to its business, and

(ii) the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a sufficient degree of control over the activities of unqualified persons.

(3) Contravention of a requirement imposed by the rules is an offence for which a person is liable on summary conviction to a fine not exceeding level 5 on the standard scale.

(4) In this section "qualified person" means a registered trade mark agent.

86 Use of the term "trade mark attorney".

(1) No offence is committed under the enactments restricting the use of certain expressions in reference to persons not qualified to act as solicitors by the use of the term "trade mark attorney" in reference to a registered trade mark agent.

(2) The enactments referred to in subsection (1) are section 21 of the [M9]Solicitors Act 1974, section 31 of the [M10]Solicitors (Scotland) Act 1980 and Article 22 of the Solicitors (Northern Ireland) Order 1976.

Marginal Citations

M9 1974 c. 47. S.I. 1976/582 (N.I. 12)

M10 1980 c. 46.

87 Privilege for communications with registered trade mark agents.

(1) This section applies to communications as to any matter relating to the protection of any design or trade mark, or as to any matter involving passing off.

(2) Any such communication—

(a) between a person and his trade mark agent, or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his trade mark agent,

is privileged from, or in Scotland protected against, disclosure in legal proceedings in the same way as a communication between a person and his solicitor or, as the case may be, 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 solicitor.

(3) In subsection (2) "trade mark agent" means—

(a) a registered trade mark agent, or

(b) a partnership entitled to describe itself as a firm of registered trade mark agents, or

(c) a body corporate entitled to describe itself as a registered trade mark agent.

Modifications etc. (not altering text)

C20 S. 87 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 5**

88 Power of registrar to refuse to deal with certain agents.

(1) The Secretary of State may make rules authorising the registrar to refuse to recognise as agent in respect of any business under this Act—

(a) a person who has been convicted of an offence under section 84 (unregistered persons describing themselves as registered trade mark agents);

(b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents on the ground of misconduct;

(c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of trade

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mark agents, render him liable to have his name erased from the register on the ground of misconduct;

(d) a partnership or body corporate of which one of the partners or directors is a person whom the registrar could refuse to recognise under paragraph (a), (b) or (c) above.

(2) The rules may contain such incidental and supplementary provisions as appear to the Secretary of State to be appropriate and may, in particular, prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct.

Commencement Information

I27 S. 88 wholly in force at 31.10.1994; s. 88 not in force at Royal Assent see s. 109; s. 88 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Importation of infringing goods, material or articles

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

(1) The proprietor of a registered trade mark, or a licensee, may give notice in writing to the Commissioners of Customs and Excise—

(a) that he is the proprietor or, as the case may be, a licensee of the registered trade mark,

(b) that, at a time and place specified in the notice, goods which are, in relation to that registered trade mark, infringing goods, material or articles are expected to arrive in the United Kingdom—

(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 Commissioners to treat them as prohibited goods.

(2) When a notice is in force under this section the importation of the goods to which the notice relates, otherwise than by a person for his private and domestic use, is prohibited; but a person is not by reason of the prohibition liable to any penalty other than forfeiture of the goods.

[[F11](3) This section 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[F12] laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods.**]**

Textual Amendments

F11 S. 89(3) substituted (1.7.1995) by S.I. 1995/1444,reg. 2

F12 O.J.No.L341,30.12.94, p.8.

Modifications etc. (not altering text)

C21 S. 89 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 16**

S. 89 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 6**

90 Power of Commissioners of Customs and Excise to make regulations.

(1) The Commissioners of Customs and Excise may make regulations prescribing the form in which notice is to be given under section 89 and requiring a person giving notice—

(a) to furnish the Commissioners with such evidence as may be specified in the regulations, either on giving notice or when the goods are imported, or at both those times, and

(b) to comply with such other conditions as may be specified in the regulations.

(2) The regulations may, in particular, require a person giving such a notice—

(a) to pay such fees in respect of the notice as may be specified by the regulations;

(b) to give such security as may be so specified in respect of any liability or expense which the Commissioners may incur in consequence of the notice by reason of the detention of any goods or anything done to goods detained;

(c) to indemnify the Commissioners against any such liability or expense, whether security has been given or not.

(3) The regulations may make different provision as respects different classes of case to which they apply and may include such incidental and supplementary provisions as the Commissioners consider expedient.

(4) Regulations under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

(5) Section 17 of the [M11]Customs and Excise Management Act 1979 (general provisions as to Commissioners' receipts) applies to fees paid in pursuance of regulations under this section as to receipts under the enactments relating to customs and excise.

Modifications etc. (not altering text)

C22 S. 90 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 16**
S. 90 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 6**

Marginal Citations

M11 1979 c. 2.

91 Power of Commissioners of Customs and Excise to disclose information.

Where information relating to infringing goods, material or articles has been obtained by the Commissioners of Customs and Excise for the purposes of, or in connection with, the exercise of their functions in relation to imported goods, the Commissioners may authorise 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 section 92 below (unauthorised use of trade mark, &c. in relation to goods) or under the [M12]Trade Descriptions Act 1968.

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Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Modifications etc. (not altering text)

C23 S. 91 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 16**
S. 91 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 6**

Marginal Citations

M12 1968 c. 29

Offences

92 Unauthorised use of trade mark, &c. 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, or

(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 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—

(a) applies a sign identical to, or likely to be mistaken for, a registered 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, or

(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 doing of anything, by himself or another, which would be an offence under 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, 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 section unless—

(a) the goods are goods in respect of which the trade mark is registered, or

(b) the trade mark has a reputation in the United Kingdom 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 section 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 registered trade mark.

(6) A person guilty of an offence under this section is liable—

(a) on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both;

(b) on conviction on indictment to a fine or imprisonment for a term not exceeding ten years, or both.

Modifications etc. (not altering text)

C24 S. 92 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 17**
S. 92 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 7**

VALID FROM 20/11/2002

[F13 92A Search warrants

(1) Where a justice of the peace (in Scotland, a sheriff or justice of the peace) is satisfied by information on oath given by a constable (in Scotland, by evidence on oath) that there are reasonable grounds for believing—

(a) that an offence under section 92 (unauthorised use of trade mark, etc. in relation to goods) has been or is about to be committed in any premises, and

(b) that evidence that such an offence has been or is about to be committed is in those premises,

he may issue a warrant authorising a constable to enter and search the premises, using such reasonable force as is necessary.

(2) The power conferred by subsection (1) does not, in England and Wales, extend to authorising a search for material of the kinds mentioned in section 9(2) of the Police and Criminal Evidence Act 1984 (c. 60) (certain classes of personal or confidential material).

(3) A warrant under subsection (1)—

(a) may authorise persons to accompany any constable executing the warrant, and

(b) remains in force for 28 days from the date of its issue.

(4) In executing a warrant issued under subsection (1) a constable may seize an article if he reasonably believes that it is evidence that any offence under section 92 has been or is about to be committed.

(5) In this section "premises" includes land, buildings, fixed or moveable structures, vehicles, vessels, aircraft and hovercraft.]

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Textual Amendments

F13 S. 92A inserted (20.11.2002) by 2002 c. 24, **s. 6**; S.I. 2002/2749, **art. 2**

93 Enforcement function of local weights and measures authority.

(1) It is the duty of every local weights and measures authority to enforce within their area the provisions of section 92 (unauthorised use of trade mark, &c. in relation to goods).

(2) The following provisions of the [M13]Trade Descriptions Act 1968 apply in relation to the enforcement of that section as in relation to the enforcement of that Act—

section 27 (power to make test purchases),

section 28 (power to enter premises and inspect and seize goods and documents),

section 29 (obstruction of authorised officers), and

section 33 (compensation for loss, &c. of goods seized).

(3) Subsection (1) above does not apply in relation to the enforcement of section 92 in Northern Ireland, but it is the duty of the Department of Economic Development to enforce that section in Northern Ireland.

For that purpose the provisions of the [M14]Trade Descriptions Act 1968 specified in subsection (2) apply as if for the references to a local weights and measures authority and any officer of such an authority there were substituted references to that Department and any of its officers.

(4) Any enactment which authorises the disclosure of information for the purpose of facilitating the enforcement of the Trade Descriptions Act 1968 shall apply as if section 92 above were contained in that Act and as if the functions of any person in relation to the enforcement of that section were functions under that Act.

(5) Nothing in this section shall be construed as authorising a local weights and measures authority to bring proceedings in Scotland for an offence.

Modifications etc. (not altering text)

C25 S. 93 applied (with modifications) (1.4.1996) by S.I. 1996/704, **art. 17**
S. 93 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 7**

Marginal Citations

M13 1968 c. 29.
M14 1968 c. 29.

94 Falsification of register, &c.

(1) It is an offence for a person to make, or cause to be made, a false entry in the register of trade marks, knowing or having reason to believe that it is false.

(2) It is an offence for a person—

(a) to make or cause to be made anything falsely purporting to be a copy of an entry in the register, or

(b) to produce or tender or cause to be produced or tendered in evidence any such thing,

knowing or having reason to believe that it is false.

(3) A person guilty of an offence under this section is liable—

(a) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both;

(b) on summary conviction, to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both.

95 Falsely representing trade mark as registered.

(1) It is an offence for a person—

(a) falsely to represent that a mark is a registered trade mark, or

(b) to make a false representation as to the goods or services for which a trade mark is registered

knowing or having reason to believe that the representation is false.

(2) For the purposes of this section, the use in the United Kingdom in relation to a trade mark—

(a) of the word "registered", or

(b) of any other word or symbol importing a reference (express or implied) to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the United Kingdom and that the trade mark is in fact so registered for the goods or services in question.

(3) A person guilty of an offence under this section is liable on summary conviction to a fine not exceeding level 3 on the standard scale.

96 Supplementary provisions as to summary proceedings in Scotland.

(1) Notwithstanding anything in **[**[F14]section 136 of the Criminal Procedure (Scotland) Act 1995**]**, summary proceedings in Scotland for an offence under this Act may be begun at any time within six months after the date on which evidence sufficient in the Lord Advocate's opinion to justify the proceedings came to his knowledge.

For this purpose a certificate of the Lord Advocate as to the date on which such evidence came to his knowledge is conclusive evidence.

(2) For the purposes of subsection (1) and of any other provision of this Act as to the time within which summary proceedings for an offence may be brought, proceedings in Scotland shall be deemed to be begun on the date on which a warrant to apprehend or to cite the accused is granted, if such warrant is executed without undue delay.

Textual Amendments

F14 Words in s. 96(1) substituted (1.4.1996) by 1995 c. 40, ss. 5, 7(2), **Sch. 4 para. 92(1)(2)**

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
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Forfeiture of counterfeit goods, &c.

97 Forfeiture: England and Wales or Northern Ireland.

(1) In England and Wales or Northern Ireland where there has come into the possession of any person 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,
   (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
   (c) articles specifically designed or adapted for making copies of such a sign,

   that person may apply under this section for an order for the forfeiture of the goods, material or articles.

(2) An application under this section may be made—
   (a) where proceedings have been brought in any court for a relevant offence relating to some or all of the goods, material or articles, to that court;
   (b) where no application for the forfeiture of the goods, material or articles has been made under paragraph (a), by way of complaint to a magistrates' court.

(3) On an application under this section the court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that a relevant offence has been committed in relation to the goods, material or articles.

(4) A court may infer for the purposes of this section that such an offence has been committed in relation to any 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).

(5) Any person aggrieved by an order made under this section by a magistrates' court, or by a decision of such a court not to make such an order, may appeal against that order or decision—
   (a) in England and Wales, to the Crown Court;
   (b) in Northern Ireland, to the county court;

   and an order so made may contain such provision as appears to the court to be appropriate for delaying the coming into force of the order pending the making and determination of any appeal (including any application under section 111 of the [M15]Magistrates' Courts Act 1980 or Article 146 of the [M16]Magistrates' Courts (Northern Ireland) Order 1981 (statement of case)).

(6) Subject to subsection (7), where any goods, material or articles are forfeited under this section they shall be destroyed in accordance with such directions as the court may give.

(7) On making an order under this section the court may, if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall (instead of being destroyed) be released, to such person as the court may specify, on condition that that person—
   (a) causes the offending sign to be erased, removed or obliterated, and
   (b) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

(8) For the purposes of this section a "relevant offence" means an offence under section 92 above (unauthorised use of trade mark, &c. in relation to goods) or under the [M17]Trade Descriptions Act 1968 or any offence involving dishonesty or deception.

Modifications etc. (not altering text)

C26 S. 97 applied (with modifications) (20.9.1995) by 1995 c. 32, **s. 11**; S.I. 1995/2472, **art. 2**
S. 97 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 17**
S. 97 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 7**

Marginal Citations

M15 1980 c. 43.
M16 S.I. 1981/1675 (N.I. 26).
M17 1968 c. 29.

98 Forfeiture: Scotland.

(1) In Scotland the court may make an order for the forfeiture of any—
- (a) goods which bear, or the packaging of which bears, a sign identical to or likely to be mistaken for a registered 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
- (c) articles specifically designed or adapted for making copies of such a sign.

(2) An order under this section may be made—
- (a) on an application by the procurator-fiscal made in the manner specified in **[**[F15]section 134 of the Criminal Procedure (Scotland) Act 1995**]**, or
- (b) where a person is convicted of a relevant offence, in addition to any other penalty which the court may impose.

(3) On an application under subsection (2)(a), the court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that a relevant offence has been committed in relation to the goods, material or articles.

(4) The court may infer for the purposes of this section that such an offence has been committed in relation to any 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).

(5) The procurator-fiscal making the application under subsection (2)(a) shall serve on any person appearing to him to be the owner of, or otherwise to have an interest in, the goods, material or articles to which the application relates a copy of the application, together with a notice giving him the opportunity to appear at the hearing of the application to show cause why the goods, material or articles should not be forfeited.

(6) Service under subsection (5) shall be carried out, and such service may be proved, in the manner specified for citation of an accused in summary proceedings under the **[**[F16]Criminal Procedure (Scotland) Act 1995**]**.

(7) Any person upon whom notice is served under subsection (5) and any other person claiming to be the owner of, or otherwise to have an interest in, goods, material or

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articles to which an application under this section relates shall be entitled to appear at the hearing of the application to show cause why the goods, material or articles should not be forfeited.

(8) The court shall not make an order following an application under subsection (2)(a)—
- (a) if any person on whom notice is served under subsection (5) does not appear, unless service of the notice on that person is proved; or
- (b) if no notice under subsection (5) has been served, unless the court is satisfied that in the circumstances it was reasonable not to serve such notice.

(9) Where an order for the forfeiture of any goods, material or articles is made following an application under subsection (2)(a), any person who appeared, or was entitled to appear, to show cause why goods, material or articles should not be forfeited may, within 21 days of the making of the order, appeal to the High Court by Bill of Suspension; and **[**[F17]section 182(5)(a) to (e) of the Criminal Procedure (Scotland) Act 1995**]** shall apply to an appeal under this subsection as it applies to a stated case under Part II of that Act.

(10) An order following an application under subsection (2)(a) shall not take effect—
- (a) until the end of the period of 21 days beginning with the day after the day on which the order is made; or
- (b) if an appeal is made under subsection (9) above within that period, until the appeal is determined or abandoned.

(11) An order under subsection (2)(b) shall not take effect—
- (a) until the end of the period within which an appeal against the order could be brought under the **[**[F18]Criminal Procedure (Scotland) Act 1995**]**; or
- (b) if an appeal is made within that period, until the appeal is determined or abandoned.

(12) Subject to subsection (13), goods, material or articles forfeited under this section shall be destroyed in accordance with such directions as the court may give.

(13) On making an order under this section the court may if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall (instead of being destroyed) be released, to such person as the court may specify, on condition that that person causes the offending sign to be erased, removed or obliterated.

(14) For the purposes of this section—

"relevant offence" means an offence under section 92 (unauthorised use of trade mark, &c. in relation to goods) or under the [M18]Trade Descriptions Act 1968 or any offence involving dishonesty or deception,

"the court" means—
- (a) in relation to an order made on an application under subsection (2)(a), the sheriff, and
- (b) in relation to an order made under subsection (2)(b), the court which imposed the penalty.

Textual Amendments

F15 Words in s. 98(2)(a) substituted (1.4.1996) by 1995 c. 40, s. 5, **Sch. 4 para. 92(1)(3)(a)**

F16 Words in s. 98(6) substituted (1.4.1996) by 1995 c. 40, s. 5, **Sch. 4 para. 92(1)(3)(b)**

F17 Words in s. 98(9) substituted (1.4.1996) by 1995 c. 40, s. 5, **Sch. 4 para. 92(1)(3)(c)**

F18 Words in s. 98(11) substituted (1.4.1996) by 1995 c. 40, s. 5, **Sch. 4 para. 92(1)(3)(d)**

Modifications etc. (not altering text)

C27 S. 98 applied (with modifications) (20.9.1995) by 1995 c. 32, **s. 12**; S.I. 1995/2472, **art. 2**
S. 98 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 17**
S. 98 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 7**

Marginal Citations

M18 1968 c. 29.

PART IV

MISCELLANEOUS AND GENERAL PROVISIONS

Miscellaneous

99 Unauthorised use of Royal arms, &c.

(1) A person shall not without the authority of Her Majesty use in connection with any business the Royal arms (or arms so closely resembling the Royal arms as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal arms.

(2) A person shall not without the authority of Her Majesty or of a member of the Royal family use in connection with any business any device, emblem or title in such a manner as to be calculated to lead to the belief that he is employed by, or supplies goods or services to, Her Majesty or that member of the Royal family.

(3) A person who contravenes subsection (1) commits an offence and is liable on summary conviction to a fine not exceeding level 2 on the standard scale.

(4) Contravention of subsection (1) or (2) may be restrained by injunction in proceedings brought by—
   (a) any person who is authorised to use the arms, device, emblem or title in question, or
   (b) any person authorised by the Lord Chamberlain to take such proceedings.

(5) Nothing in this section affects any right of the proprietor of a trade mark containing any such arms, device, emblem or title to use that trade mark.

100 Burden of proving use of trade mark.

If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

101 Offences committed by partnerships and bodies corporate.

(1) Proceedings for an offence under this Act alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not

in that of the partners; but without prejudice to any liability of the partners under subsection (4) below.

(2) The following provisions apply for the purposes of such proceedings as in relation to a body corporate—

(a) any rules of court relating to the service of documents;

(b) in England and Wales or Northern Ireland, Schedule 3 to the [M19]Magistrates' Courts Act 1980 or Schedule 4 to the [M20]Magistrates' Courts (Northern Ireland) Order 1981 (procedure on charge of offence).

(3) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(4) Where a partnership is guilty of an offence under this Act, 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 also guilty of the offence and liable to be proceeded against and punished accordingly.

(5) Where an offence under this Act 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, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.

Modifications etc. (not altering text)

C28 S. 101 applied (20.9.1995) by 1995 c. 32, **s. 10**; S.I. 1995/2472, **art. 2**

Marginal Citations

M19 1980 c. 43.

M20 S.I. 1981/1675 (N.I. 26).

Interpretation

102 Adaptation of expressions for Scotland.

In the application of this Act to Scotland—

"account of profits" means accounting and payment of profits;

"accounts" means count, reckoning and payment;

"assignment" means assignation;

"costs" means expenses;

"declaration" means declarator;

"defendant" means defender;

"delivery up" means delivery;

"injunction" means interdict;

"interlocutory relief" means interim remedy; and

"plaintiff" means pursuer.

103 Minor definitions.

(1) In this Act—

"business" includes a trade or profession;

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

"infringement proceedings", in relation to a registered trade mark, includes proceedings under section 16 (order for delivery up of infringing goods, &c.);

"publish" means make available to the public, and references to publication—

(a) in relation to an application for registration, are to publication under section 38(1), and

(b) in relation to registration, are to publication under section 40(4);

"statutory provisions" includes provisions of subordinate legislation within the meaning of the [M21]Interpretation Act 1978;

"trade" includes any business or profession.

(2) References in this Act to use (or 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) References in this Act to a Community instrument include references to any instrument amending or replacing that instrument.

Marginal Citations

M21 1978 c. 30.

104 Index of defined expressions.

In this Act the expressions listed below are defined by or otherwise fall to be construed in accordance with the provisions indicated—

account of profits and accounts (in Scotland)	section 102
appointed person (for purposes of section 76)	section 77
assignment (in Scotland)	section 102
business	section 103(1)
certification mark	section 50(1)
collective mark	section 49(1)
commencement (of this Act)	section 109(2)
Community trade mark	section 51
Community Trade Mark Regulation	section 51
Convention country	section 55(1)(b)
costs (in Scotland)	section 102

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the court	section 75
date of application	section 33(2)
date of filing	section 33(1)
date of registration	section 40(3)
defendant (in Scotland)	section 102
delivery up (in Scotland)	section 102
director	section 103(1)
earlier right	section 5(4)
earlier trade mark	section 6
exclusive licence and licensee	section 29(1)
infringement (of registered trade mark)	sections 9(1) and (2) and 10
infringement proceedings	section 103(1)
infringing articles	section 17
infringing goods	section 17
infringing material	section 17
injunction (in Scotland)	section 102
interlocutory relief (in Scotland)	section 102
the International Bureau	section 53
international trade mark (UK)	section 53
Madrid Protocol	section 53
Paris Convention	section 55(1)(a)
plaintiff (in Scotland)	section 102
prescribed	section 78(1)(b)
protected under the Paris Convention	
—well-known trade marks	section 56(1)
—state emblems and official signs or hallmarks	section 57(1)
—emblems, &c. of international organisations	section 58(2)
publish and references to publication	section 103(1)
register, registered (and related expressions)	section 63(1)
registered trade mark agent	section 83(1)
registrable transaction	section 25(2)
the registrar	section 62
rules	section 78

statutory provisions	section 103(1)
trade	section 103(1)
trade mark	
—generally	section 1(1)
—includes collective mark or certification mark	section 1(2)
United Kingdom (references include Isle of Man)	section 108(2)
use (of trade mark or sign)	section 103(2)
well-known trade mark (under Paris Convention)	section 56(1)

Other general provisions

105 Transitional provisions.

The provisions of Schedule 3 have effect with respect to transitional matters, including the treatment of marks registered under the [M22]Trade Marks Act 1938, and applications for registration and other proceedings pending under that Act, on the commencement of this Act.

Marginal Citations
M22 1938 c. 22.

106 Consequential amendments and repeals.

(1) The enactments specified in Schedule 4 are amended in accordance with that Schedule, the amendments being consequential on the provisions of this Act.

(2) The enactments specified in Schedule 5 are repealed to the extent specified.

107 Territorial waters and the continental shelf.

(1) For the purposes of this Act the territorial waters of the United Kingdom shall be treated as part of the United Kingdom.

(2) This Act applies to things done in the United Kingdom sector of the continental shelf on a structure or vessel which is present there for purposes directly connected with the exploration of the sea bed or subsoil or the exploitation of their natural resources as it applies to things done in the United Kingdom.

(3) The United Kingdom sector of the continental shelf means the areas designated by order under section 1(7) of the [M23]Continental Shelf Act 1964.

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Marginal Citations

M23 1964 c. 29.

108 Extent.

(1) This Act extends to England and Wales, Scotland and Northern Ireland.

(2) This Act also extends to the Isle of Man, subject to such exceptions and modifications as Her Majesty may specify by Order in Council; and subject to any such Order references in this Act to the United Kingdom shall be construed as including the Isle of Man.

Subordinate Legislation Made

P2 S. 108(2) power fully exercised (13.3.1996): 1.4.1996 appointed day by S.I. 1996/729

109 Commencement.

(1) The provisions of this Act come into force on such day as the Secretary of State may appoint by order made by statutory instrument.

Different days may be appointed for different provisions and different purposes.

(2) The references to the commencement of this Act in Schedules 3 and 4 (transitional provisions and consequential amendments) are to the commencement of the main substantive provisions of Parts I and III of this Act and the consequential repeal of the Trade Marks Act 1938.

Provision may be made by order under this section identifying the date of that commencement.

Subordinate Legislation Made

P3 S. 109 power fully exercised (29.9.1994): 29.9.1994 appointed for specified provisions and 31.10.1994 appointed by S.I. 1994/2550, **arts. 2**, 3

110 Short title.

This Act may be cited as the Trade Marks Act 1994.

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SCHEDULES

SCHEDULE 1

Section 49.

COLLECTIVE MARKS

Commencement Information

I28 Sch. 1 wholly in force at 31.10.1994; Sch. 1 not in force at Royal Assent; Sch. 1 para. 6(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 1 not alredy in force by 1994/2550, arts. 2, 3(1), Sch.

General

1 The provisions of this Act apply to collective marks subject to the following provisions.

Signs of which a collective mark may consist

2 In relation to a collective mark the reference in section 1(1) (signs of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Indication of geographical origin

3 (1) Notwithstanding section 3(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Mark not to be misleading as to character or significance

4 (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(2) The registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

Notwithstanding section 39(2), an application may be amended so as to comply with any such requirement.

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Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Regulations governing use of collective mark

5 (1) An applicant for registration of a collective mark must file with the registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse.

Further requirements with which the regulations have to comply may be imposed by rules.

Approval of regulations by registrar

6 (1) A collective mark shall not be registered unless the regulations governing the use of the mark—

(a) comply with paragraph 5(2) and any further requirements imposed by rules, and

(b) are not contrary to public policy or to accepted principles of morality.

(2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant must file the regulations with the registrar and pay the prescribed fee.

If he does not do so, the application shall be deemed to be withdrawn.

Commencement Information

I29 Sch. 1 wholly in force at 31.10.1994; Sch. 1 not in force at Royal Assent see s. 109; Sch. 1 para. 6(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 1 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

7 (1) The registrar shall consider whether the requirements mentioned in paragraph 6(1) are met.

(2) If it appears to the registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations.

(3) If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse the application.

(4) If it appears to the registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 38 (publication, opposition proceedings and observations).

8 The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 6(1).

This is in addition to any other grounds on which the application may be opposed or observations made.

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Regulations to be open to inspection

9 The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

Amendment of regulations

10 (1) An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with the registrar and accepted by him.

(2) Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published.

(3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 6(1).

Infringement: rights of authorised users

11 The following provisions apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark—

(a) section 10(5) (definition of infringement: unauthorised application of mark to certain material);

(b) section 19(2) (order as to disposal of infringing goods, material or articles: adequacy of other remedies);

(c) section 89 (prohibition of importation of infringing goods, material or articles: request to Commissioners of Customs and Excise).

12 (1) The following provisions (which correspond to the provisions of section 30 (general provisions as to rights of licensees in case of infringement)) have effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.

(2) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor—

(a) refuses to do so, or

(b) fails to do so within two months after being called upon,

the authorised user may bring the proceedings in his own name as if he were the proprietor.

(4) Where infringement proceedings are brought by virtue of this paragraph, the authorised user may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

This does not affect the granting of interlocutory relief on an application by an authorised user alone.

(5) A proprietor who is added as a defendant as mentioned in sub-paragraph (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) In infringement proceedings brought by the proprietor of a registered collective mark any loss suffered or likely to be suffered by authorised users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to

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which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

13 Apart from the grounds of revocation provided for in section 46, the registration of a collective mark may be revoked on the ground—

(a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 4(1), or

(b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark, or

(c) that an amendment of the regulations has been made so that the regulations—

(i) no longer comply with paragraph 5(2) and any further conditions imposed by rules, or

(ii) are contrary to public policy or to accepted principles of morality.

Grounds for invalidity of registration

14 Apart from the grounds of invalidity provided for in section 47, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4(1) or 6(1).

SCHEDULE 2

Section 50.

CERTIFICATION MARKS

Commencement Information

I30 Sch. 2 wholly in force; Sch. 2 not in force at Royal Assent see s. 109; Sch. 2 para. 7(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 2 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

General

1 The provisions of this Act apply to certification marks subject to the following provisions.

Signs of which a certification mark may consist

2 In relation to a certification mark the reference in section 1(1) (signs of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

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Indication of geographical origin

3 (1) Notwithstanding section 3(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Nature of proprietor's business

4 A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

5 (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

Notwithstanding section 39(2), an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

6 (1) An applicant for registration of a certification mark must file with the registrar regulations governing the use of the mark.

(2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

Further requirements with which the regulations have to comply may be imposed by rules.

Approval of regulations, &c.

7 (1) A certification mark shall not be registered unless—

(a) the regulations governing the use of the mark—

(i) comply with paragraph 6(2) and any further requirements imposed by rules, and

(ii) are not contrary to public policy or to accepted principles of morality, and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the registrar and pay the prescribed fee.

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If he does not do so, the application shall be deemed to be withdrawn.

Commencement Information

I31 Sch. 2 wholly in force; Sch. 2 not in force at Royal Assent see s. 109; Sch. 2 para. 7(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 2 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

8 (1) The registrar shall consider whether the requirements mentioned in paragraph 7(1) are met.

(2) If it appears to the registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations.

(3) If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse the application.

(4) If it appears to the registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 38 (publication, opposition proceedings and observations).

9 The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

This is in addition to any other grounds on which the application may be opposed or observations made.

Regulations to be open to inspection

10 The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

Amendment of regulations

11 (1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the registrar and accepted by him.

(2) Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published.

(3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

Consent to assignment of registered certification mark

12 The assignment or other transmission of a registered certification mark is not effective without the consent of the registrar.

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Infringement: rights of authorised users

13 The following provisions apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark—

(a) section 10(5) (definition of infringement: unauthorised application of mark to certain material);

(b) section 19(2) (order as to disposal of infringing goods, material or articles: adequacy of other remedies);

(c) section 89 (prohibition of importation of infringing goods, material or articles: request to Commissioners of Customs and Excise).

14 In infringement proceedings brought by the proprietor of a registered certification mark any loss suffered or likely to be suffered by authorised users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

15 Apart from the grounds of revocation provided for in section 46, the registration of a certification mark may be revoked on the ground—

(a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4,

(b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1),

(c) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark,

(d) that an amendment of the regulations has been made so that the regulations—

(i) no longer comply with paragraph 6(2) and any further conditions imposed by rules, or

(ii) are contrary to public policy or to accepted principles of morality, or

(e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

Grounds for invalidity of registration

16 Apart from the grounds of invalidity provided for in section 47, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4, 5(1) or 7(1).

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

SCHEDULE 3

Section 105.

TRANSITIONAL PROVISIONS

Commencement Information

I32 Sch. 3 wholly in force at 31.10.1994; Sch. 3 not in force at Royal Assent see s. 109; Sch. 3 paras. 10(2), 11(2), 12, 14(5) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 3 not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Introductory

1 (1) In this Schedule—

"existing registered mark" means a trade mark, certification trade mark or service mark registered under the 1938 Act immediately before the commencement of this Act;

"the 1938 Act" means the [M24]Trade Marks Act 1938; and

"the old law" means that Act and any other enactment or rule of law applying to existing registered marks immediately before the commencement of this Act.

(2) For the purposes of this Schedule—

(a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before commencement, and

(b) the date on which it was made shall be taken to be the date of filing under the 1938 Act.

Marginal Citations

M24 1938 c. 22.

Existing registered marks

2 (1) Existing registered marks (whether registered in Part A or B of the register kept under the 1938 Act) shall be transferred on the commencement of this Act to the register kept under this Act and have effect, subject to the provisions of this Schedule, as if registered under this Act.

(2) Existing registered marks registered as a series under section 21(2) of the 1938 Act shall be similarly registered in the new register.

Provision may be made by rules for putting such entries in the same form as is required for entries under this Act.

(3) In any other case notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement of this Act.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

PROSPECTIVE

3 (1) A condition entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall cease to have effect on commencement.

Proceedings under section 33 of the 1938 Act (application to expunge or vary registration for breach of condition) which are pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

(2) A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of section 13 of this Act.

Effects of registration: infringement

4 (1) Sections 9 to 12 of this Act (effects of registration) apply in relation to an existing registered mark as from the commencement of this Act and section 14 of this Act (action for infringement) applies in relation to infringement of an existing registered mark committed after the commencement of this Act, subject to sub-paragraph (2) below.

The old law continues to apply in relation to infringements committed before commencement.

(2) It is not an infringement of—

(a) an existing registered mark, or

(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue after commencement any use which did not amount to infringement of the existing registered mark under the old law.

Infringing goods, material or articles

5 Section 16 of this Act (order for delivery up of infringing goods, material or articles) applies to infringing goods, material or articles whether made before or after the commencement of this Act.

Rights and remedies of licensee or authorised user

6 (1) Section 30 (general provisions as to rights of licensees in case of infringement) of this Act applies to licences granted before the commencement of this Act, but only in relation to infringements committed after commencement.

(2) Paragraph 14 of Schedule 2 of this Act (court to take into account loss suffered by authorised users, &c.) applies only in relation to infringements committed after commencement.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Co-ownership of registered mark

7 The provisions of section 23 of this Act (co-ownership of registered mark) apply as from the commencement of this Act to an existing registered mark of which two or more persons were immediately before commencement registered as joint proprietors.

But so long as the relations between the joint proprietors remain such as are described in section 63 of the 1938 Act (joint ownership) there shall be taken to be an agreement to exclude the operation of subsections (1) and (3) of section 23 of this Act (ownership in undivided shares and right of co-proprietor to make separate use of the mark).

Assignment, &c. of registered mark

8 (1) Section 24 of this Act (assignment or other transmission of registered mark) applies to transactions and events occurring after the commencement of this Act in relation to an existing registered mark; and the old law continues to apply in relation to transactions and events occurring before commencement.

(2) Existing entries under section 25 of the 1938 Act (registration of assignments and transmissions) shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 25 of this Act.

Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

(3) An application for registration under section 25 of the 1938 Act which is pending before the registrar on the commencement of this Act shall be treated as an application for registration under section 25 of this Act and shall proceed accordingly.

The registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

(4) An application for registration under section 25 of the 1938 Act which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

(5) Where before the commencement of this Act a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after commencement shall be made under section 25 of this Act.

(6) In cases to which sub-paragraph (3) or (5) applies section 25(3) of the 1938 Act continues to apply (and section 25(3) and (4) of this Act do not apply) as regards the consequences of failing to register.

Licensing of registered mark

9 (1) Sections 28 and 29(2) of this Act (licensing of registered trade mark; rights of exclusive licensee against grantor's successor in title) apply only in relation to licences granted after the commencement of this Act; and the old law continues to apply in relation to licences granted before commencement.

(2) Existing entries under section 28 of the 1938 Act (registered users) shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 25 of this Act.

Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

(3) An application for registration as a registered user which is pending before the registrar on the commencement of this Act shall be treated as an application for registration of a licence under section 25(1) of this Act and shall proceed accordingly.

The registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

(4) An application for registration as a registered user which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

(5) Any proceedings pending on the commencement of this Act under section 28(8) or (10) of the 1938 Act (variation or cancellation of registration of registered user) shall be dealt with under the old law and any necessary alteration made to the new register.

Pending applications for registration

10 (1) An application for registration of a mark under the 1938 Act which is pending on the commencement of this Act shall be dealt with under the old law, subject as mentioned below, and if registered the mark shall be treated for the purposes of this Schedule as an existing registered mark.

(2) The power of the Secretary of State under section 78 of this Act to make rules regulating practice and procedure, and as to the matters mentioned in subsection (2) of that section, is exercisable in relation to such an application; and different provision may be made for such applications from that made for other applications.

(3) Section 23 of the 1938 Act (provisions as to associated trade marks) shall be disregarded in dealing after the commencement of this Act with an application for registration.

Commencement Information

I33 Sch. 3 para. 10 wholly in force; Sch. 3 para. 10 not in force at Royal Assent see s. 109; Sch. 3 para. 10(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Conversion of pending application

11 (1) In the case of a pending application for registration which has not been advertised under section 18 of the 1938 Act before the commencement of this Act, the applicant may give notice to the registrar claiming to have the registrability of the mark determined in accordance with the provisions of this Act.

(2) The notice must be in the prescribed form, be accompanied by the appropriate fee and be given no later than six months after the commencement of this Act.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

(3) Notice duly given is irrevocable and has the effect that the application shall be treated as if made immediately after the commencement of this Act.

Commencement Information

I34 Sch. 3 para. 11 wholly in force; Sch. 3 para. 11 not in force at Royal Assent see s. 109; Sch. 3 para. 11 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Trade marks registered according to old classification

12 The registrar may exercise the powers conferred by rules under section 65 of this Act (adaptation of entries to new classification) to secure that any existing registered marks which do not conform to the system of classification prescribed under section 34 of this Act are brought into conformity with that system.

This applies, in particular, to existing registered marks classified according to the pre-1938 classification set out in Schedule 3 to the [M25]Trade Marks Rules 1986.

Commencement Information

I35 Sch. 3 para. 12 wholly in force; Sch. 3 para. 12 not in force at Royal Assent see s. 109; Sch. 3 para. 12 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Marginal Citations

M25 S.I. 1986/1319.

Claim to priority from overseas application

13 Section 35 of this Act (claim to priority of Convention application) applies to an application for registration under this Act made after the commencement of this Act notwithstanding that the Convention application was made before commencement.

14 (1) Where before the commencement of this Act a person has duly filed an application for protection of a trade mark in a relevant country within the meaning of section 39A of the 1938 Act which is not a Convention country (a "relevant overseas application"), he, or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the relevant overseas application.

(2) If the application for registration under this Act is made within that six-month period—

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the relevant overseas application, and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

(3) Any filing which in a relevant country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

A "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

(4) A subsequent application concerning the same subject as the relevant overseas application, filed in the same country, shall be considered the relevant overseas application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application—

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and

(b) it has not yet served as a basis for claiming a right of priority.

The previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a relevant overseas application.

(6) A right to priority arising as a result of a relevant overseas application may be assigned or otherwise transmitted, either with the application or independently.

The reference in sub-paragraph (1) to the applicant's "successor in title" shall be construed accordingly.

(7) Nothing in this paragraph affects proceedings on an application for registration under the 1938 Act made before the commencement of this Act (see paragraph 10 above).

Commencement Information

I36 Sch. 3 wholly in force; Sch. 3 not in force at Royal Assent see s. 109; Sch. 3 para. 14(5) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), **Sch.**

Duration and renewal of registration

15 (1) Section 42(1) of this Act (duration of original period of registration) applies in relation to the registration of a mark in pursuance of an application made after the commencement of this Act; and the old law applies in any other case.

(2) Sections 42(2) and 43 of this Act (renewal) apply where the renewal falls due on or after the commencement of this Act; and the old law continues to apply in any other case.

(3) In either case it is immaterial when the fee is paid.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Pending application for alteration of registered mark

PROSPECTIVE

16 An application under section 35 of the 1938 Act (alteration of registered trade mark) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

Revocation for non-use

17 (1) An application under section 26 of the 1938 Act (removal from register or imposition of limitation on ground of non-use) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

(2) An application under section 46(1)(a) or (b) of this Act (revocation for non-use) may be made in relation to an existing registered mark at any time after the commencement of this Act.
Provided that no such application for the revocation of the registration of an existing registered mark registered by virtue of section 27 of the 1938 Act (defensive registration of well-known trade marks) may be made until more than five years after the commencement of this Act.

Application for rectification, &c.

18 (1) An application under section 32 or 34 of the 1938 Act (rectification or correction of the register) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

(2) For the purposes of proceedings under section 47 of this Act (grounds for invalidity of registration) as it applies in relation to an existing registered mark, the provisions of this Act shall be deemed to have been in force at all material times.
Provided that no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection (3) of section 5 of this Act (relative grounds for refusal of registration: conflict with earlier mark registered for different goods or services).

Regulations as to use of certification mark

19 (1) Regulations governing the use of an existing registered certification mark deposited at the Patent Office in pursuance of section 37 of the 1938 Act shall be treated after the commencement of this Act as if filed under paragraph 6 of Schedule 2 to this Act.

(2) Any request for amendment of the regulations which was pending on the commencement of this Act shall be dealt with under the old law.

Sheffield marks

20 (1) For the purposes of this Schedule the Sheffield register kept under Schedule 2 to the 1938 Act shall be treated as part of the register of trade marks kept under that Act.

(2) Applications made to the Cutlers' Company in accordance with that Schedule which are pending on the commencement of this Act shall proceed after commencement as if they had been made to the registrar.

Certificate of validity of contested registration

21 A certificate given before the commencement of this Act under section 47 of the 1938 Act (certificate of validity of contested registration) shall have effect as if given under section 73(1) of this Act.

Trade mark agents

22 (1) Rules in force immediately before the commencement of this Act under section 282 or 283 of the [M26]Copyright, Designs and Patents Act 1988 (register of trade mark agents; persons entitled to described themselves as registered) shall continue in force and have effect as if made under section 83 or 85 of this Act.

(2) Rules in force immediately before the commencement of this Act under section 40 of the 1938 Act as to the persons whom the registrar may refuse to recognise as agents for the purposes of business under that Act shall continue in force and have effect as if made under section 88 of this Act.

(3) Rules continued in force under this paragraph may be varied or revoked by further rules made under the relevant provisions of this Act.

Marginal Citations

M26 1988 c. 48.

SCHEDULE 4

Section 106(1).

CONSEQUENTIAL AMENDMENTS

General adaptation of existing references

1 (1) References in statutory provisions passed or made before the commencement of this Act to trade marks or registered trade marks within the meaning of the [M27]Trade Marks Act 1938 shall, unless the context otherwise requires, be construed after the commencement of this Act as references to trade marks or registered trade marks within the meaning of this Act.

(2) Sub-paragraph (1) applies, in particular, to the references in the following provisions—

M28 Industrial Organisation and Development Act 1947	Schedule 1, paragraph 7
M29 Crown Proceedings Act 1947	section 3(1)(b)

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

M30 Horticulture Act 1960	section 15(1)(b)
M31 Printer's Imprint Act 1961	section 1(1)(b)
F19 . . .	**F19** . . .
F20 . . .	**F20** . . .
M32 Patents Act 1977	section 19(2)section 27(4)section 123(7)
M33 Unfair Contract Terms Act 1977	Schedule 1, paragraph 1(c)
M34 Judicature (Northern Ireland) Act 1978	section 94A(5)
M35 State Immunity Act 1978	section 7(a) and (b)
M36 Supreme Court Act 1981	section 72(5)Schedule 1, paragraph 1(i)
M37 Civil Jurisdiction and Judgments Act 1982	Schedule 5, paragraph 2Schedule 8, paragraph 2(14) and 4(2)
M38 Value Added Tax Act 1983	Schedule 3, paragraph 1
M39 Companies Act 1985	section 396(3A)(a) or (as substituted by the **M40** Companies Act 1989) section 396(2)(d)(i)section 410(4)(c)(v)Schedule 4, Part I, Balance Sheet Formats 1 and 2 and Note (2)Schedule 9, Part I, paragraphs 5(2)(d) and 10(2)
M41 Law Reform (Miscellaneous Provisions) (Scotland) Act 1985	section 15(5)
M42 Atomic Energy Authority Act 1986	section 8(2)
M43 Companies (Northern Ireland) Order 1986	article 403(3A)(a) or (as substituted by the **M44** Companies (No.2) (Northern Ireland) Order 1990) article 403(2)(d)(i)Schedule 4, Part I, Balance Sheet

	Formats 1 and 2 and Note (2)Schedule 9, Part I, paragraphs 5(2)(d) and 10(2)
M45 Consumer Protection Act 1987	section 2(2)(b)
M46 Consumer Protection (Northern Ireland) Order 1987	article 5(2)(b)
M47 Income and Corporation Taxes Act 1988	section 83(a)
M48 Taxation of Chargeable Gains Act 1992	section 275(h)
M49 Tribunals and Inquiries Act 1992	Schedule 1, paragraph 34.

Textual Amendments

F19 Entry relating to "Plant Variety and Seeds Act"in Sch. 4 para. 1(2) repealed (8.5.1998) by 1997 c. 66, s. 52, **Sch. 4**; S.I. 1998/1028, **art. 2**

F20 Entry relating to "Northern Ireland Constitution Act 1973" repealed (2.12.1999) by 1998 c. 47, s. 100(2), **Sch. 15** (with s. 95)

Marginal Citations

M27 1938 c. 22.
M28 1947 c. 40.
M29 1947 c. 44.
M30 1960 c. 22.
M31 1961 c. 31.
M32 1977 c. 37.
M33 1977 c. 50.
M34 1978 c. 23.
M35 1978 c. 33.
M36 1981 c. 54.
M37 1982 c. 27.
M38 1983 c. 55.
M39 1985 c. 6.
M40 1989 c. 40.
M41 1985 c. 73.
M42 1986 c. 3.
M43 S.I. 1986/1032 (N.I. 6).
M44 S.I. 1990/1504 (N.I. 10).
M45 1987 c. 43.
M46 S.I. 1987/2049 (N.I. 20).
M47 1988 c. 1.
M48 1992 c. 12.
M49 1992 c. 53.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

Patents and Designs Act 1907 (c.29)

2 (1) The Patents and Designs Act 1907 is amended as follows.

(2) In section 62 (the Patent Office)—

(a) in subsection (1) for "this Act and the Trade Marks Act 1905" substitute " the Patents Act 1977, the Registered Designs Act 1949 and the Trade Marks Act 1994 "; and

(b) in subsections (2) and (3) for "the Board of Trade" substitute " the Secretary of State ".

(3) In section 63 (officers and clerks of the Patent Office)—

(a) for "the Board of Trade" in each place where it occurs substitute " the Secretary of State "; and

(b) in subsection (2) omit the words from "and those salaries" to the end.

(4) The repeal by the [M50]Patents Act 1949 and the [M51]Registered Designs Act 1949 of the whole of the 1907 Act, except certain provisions, shall be deemed not to have extended to the long title, date of enactment or enacting words or to so much of section 99 as provides the Act with its short title.

Marginal Citations

M50 1949 c. 87.

M51 1949 c. 88.

Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939(c.107)

3 (1) The Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 is amended as follows.

(2) For section 3 (power of comptroller to suspend rights of enemy or enemy subject) substitute—

"**3 Power of comptroller to suspend trade mark rights of enemy or enemy subject.**

(1) Where on application made by a person proposing to supply goods or services of any description it is made to appear to the comptroller—

(a) that it is difficult or impracticable to describe or refer to the goods or services without the use of a registered trade mark, and

(b) that the proprietor of the registered trade mark (whether alone or jointly with another) is an enemy or an enemy subject,

the comptroller may make an order suspending the rights given by the registered trade mark.

(2) An order under this section shall suspend those rights as regards the use of the trade mark—

(a) by the applicant, and

(b) by any person authorised by the applicant to do, for the purposes of or in connection with the supply by the applicant of the goods or

services, things which would otherwise infringe the registered trade mark,

to such extent and for such period as the comptroller considers necessary to enable the applicant to render well-known and established some other means of describing or referring to the goods or services in question which does not involve the use of the trade mark.

(3) Where an order has been made under this section, no action for passing off lies on the part of any person interested in the registered trade mark in respect of any use of it which by virtue of the order is not an infringement of the right conferred by it.

(4) An order under this section may be varied or revoked by a subsequent order made by the comptroller.".

(3) In each of the following provisions—

(a) section 4(1)(c) (effect of war on registration of trade marks),

(b) section 6(1) (power of comptroller to extend time limits),

(c) section 7(1)(a) (evidence as to nationality, &c.), and

(d) the definition of "the comptroller" in section 10(1) (interpretation),

for "the Trade Marks Act 1938" substitute " the Trade Marks Act 1994 ".

Trade Descriptions Act 1968 (c.29)

4 In the Trade Descriptions Act 1968, in section 34 (exemption of trade description contained in pre-1968 trade mark)—

(a) in the opening words, omit "within the meaning of the Trade Marks Act 1938"; and

(b) in paragraph (c), for "a person registered under section 28 of the Trade Marks Act 1938 as a registered user of the trade mark" substitute " , in the case of a registered trade mark, a person licensed to use it ".

Solicitors Act 1974 (c.47)

5 (1) Section 22 of the Solicitors Act 1974 (preparation of instruments by unqualified persons) is amended as follows.

(2) In subsection (2)(aa) and (ab) (instruments which may be prepared by registered trade mark agent or registered patent agent) for ", trade mark or service mark" substitute " or trade mark ".

(3) In subsection (3A) (interpretation)—

(a) in the definition of "registered trade mark agent" for "section 282(1) of the Copyright, Designs and Patents Act 1988" substitute " the Trade Marks Act 1994 "; and

(b) in the definition of "registered patent agent" for "of that Act" substitute " of the Copyright, Designs and Patents Act 1988 ".

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

House of Commons Disqualification Act 1975 (c.24)

PROSPECTIVE

6 In Part III of Schedule 1 to the House of Commons Disqualification Act 1975 (other disqualifying offices), for the entry relating to persons appointed to hear and determine appeals under the Trade Marks Act 1938 substitute— " Person appointed to hear and determine appeals under the Trade Marks Act 1994. "

Restrictive Trade Practices Act 1976 (c.34)

7 In Schedule 3 to the Restrictive Trade Practices Act 1976 (excepted agreements), for paragraph 4 (agreements relating to trade marks) substitute—

"4 (1) This Act does not apply to an agreement authorising the use of a registered trade mark (other than a collective mark or certification mark) if no such restrictions as are described in section 6(1) or 11(2) above are accepted, and no such information provisions as are described in section 7(1) or 12(2) above are made, except in respect of—

(a) the descriptions of goods bearing the mark which are to be produced or supplied, or the processes of manufacture to be applied to such goods or to goods to which the mark is to be applied, or

(b) the kinds of services in relation to which the mark is to be used which are to be made available or supplied, or the form or manner in which such services are to be made available or supplied, or

(c) the descriptions of goods which are to be produced or supplied in connection with the supply of services in relation to which the mark is to be used, or the process of manufacture to be applied to such goods.

(2) This Act does not apply to an agreement authorising the use of a registered collective mark or certification mark if—

(a) the agreement is made in accordance with regulations approved by the registrar under Schedule 1 or 2 to the Trade Marks Act 1994, and

(b) no such restrictions as are described in section 6(1) or 11(2) above are accepted, and no such information provisions as are described in section 7(1) or 12(2) above are made, except as permitted by those regulations.".

Copyright, Designs and Patents Act 1988 (c.48)

8 (1) The Copyright, Designs and Patents Act 1988 is amended as follows.

(2) In sections 114(6), 204(6) and 231(6) (persons regarded as having an interest in infringing copies, &c.), for "section 58C of the Trade Marks Act 1938" substitute " section 19 of the Trade Marks Act 1994 ".

(3) In section 280(1) (privilege for communications with patent agents), for "trade mark or service mark" substitute " or trade mark ".

Tribunals and Inquiries Act 1992 (c.53)

9 In Part I of Schedule 1 to the Tribunals and Inquiries Act 1992 (tribunals under direct supervision of Council on Tribunals), for "Patents, designs, trade marks and service marks" substitute " Patents, designs and trade marks ".

SCHEDULE 5

Section 106(2).

REPEALS AND REVOCATIONS

Chapter or number	Short title	Extent of repeal or revocation
1891 c. 50.	Commissioners for Oaths Act 1891.	In section 1, the words "or the Patents, Designs and Trade Marks Acts, 1883 to 1888,".
1907 c. 29.	Patents and Designs Act 1907.	In section 63(2), the words from "and those salaries" to the end.
1938 c. 22.	Trade Marks Act 1938.	The whole Act.
1947 c. 44.	Crown Proceedings Act 1947.	In section 3(1)(b), the words "or registered service mark".
1949 c. 87.	Patents Act 1949.	Section 92(2).
1964 c. 14.	Plant Varieties and Seeds Act 1964.	In section 5A(4), the words "under the Trade Marks Act 1938".
1967 c. 80.	Criminal Justice Act 1967.	In Schedule 3, in Parts I and IV, the entries relating to the Trade Marks Act 1938.
1978 c. 23.	Judicature (Northern Ireland) Act 1978.	In Schedule 5, in Part II, the paragraphs amending the Trade Marks Act 1938.
1984 c. 19.	Trade Marks (Amendment) Act 1984.	The whole Act.
1985 c. 6.	Companies Act 1985.	In section 396— (a) in subsection (3A)(a), and (b) in subsection (2)(d)(i) as inserted by the Companies Act 1989, the words "service mark,".
1986 c. 12.	Statute Law (Repeals) Act 1986.	In Schedule 2, paragraph 2.

Status: *Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.*
Changes to legislation: *There are currently no known outstanding effects for the Trade Marks Act 1994. (See end of Document for details)*

1986 c. 39.	Patents, Designs and Marks Act 1986.	Section 2.
		Section 4(4).
		In Schedule 1, paragraphs 1 and 2.
		Schedule 2.
S.I. 1986/1032 (N.I. 6).	Companies (Northern Ireland) Order 1986.	In article 403—
		(a) in paragraph (3A)(a), and
		(b) in paragraph (2)(d)(i) as inserted by the Companies (No.2) (Northern Ireland) Order 1990,the words “service mark,”.
1987 c. 43.	Consumer Protection Act 1987.	In section 45—
		(a) in subsection (1), the definition of “mark” and “trade mark”;
		(b) subsection (4).
S.I. 1987/2049.	Consumer Protection (Northern Ireland) Order 1987.	In article 2—
		(a) in paragraph (2), the definitions of “mark” and “trade mark”;
		(b) paragraph (3).
1988 c. 1.	Income and Corporation Taxes Act 1988.	In section 83, the words from “References in this section” to the end.
1988 c. 48.	Copyright, Designs and Patents Act 1988.	Sections 282 to 284.
		In section 286, the definition of “registered trade mark agent”.
		Section 300.
1992 c. 12.	Taxation of Chargeable Gains Act 1992.	In section 275(h), the words “service marks” and “service mark”.

Status:
Point in time view as at 02/12/1999. This version of this Act contains provisions that are not valid for this point in time.

Changes to legislation:
There are currently no known outstanding effects for the Trade Marks Act 1994.