



Trade Marks Act 1994

1994 CHAPTER 26

PART I

REGISTERED TRADE MARKS

Introductory

1 Trade marks.

[^{F1}(1) In this Act “trade mark” means any sign which is capable—

- (a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and
- (b) 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, colours, sounds 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).

Textual Amendments

- F1** S. 1(1) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 3 (with Pt. 5)

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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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^[F2], or another characteristic,] which results from the nature of the goods themselves,
- (b) the shape^[F2], or another characteristic,] of goods which is necessary to obtain a technical result, or
- (c) the shape^[F2], or another characteristic,] 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 ^[F3]EU law ^[F4]other than law relating to trade marks].

- ^[F5](4A) A trade mark is not to be registered if its registration is prohibited by or under—

- (a) any enactment or rule of law,
- (b) any provision of EU law, or
- (c) any international agreement to which the United Kingdom or the EU is a party, providing for the protection of designations of origin or geographical indications.

- (4B) A trade mark is not to be registered if its registration is prohibited by or under—

- (a) any provision of EU law, or
- (b) any international agreement to which the EU is a party,

providing for the protection of traditional terms for wine or traditional specialities guaranteed.

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (4C) A trade mark is not to be registered if it—
- (a) consists of, or reproduces in its essential elements, an earlier plant variety denomination registered as mentioned in subsection (4D), and
 - (b) is in respect of plant varieties of the same or closely related species.
- (4D) Subsection (4C)(a) refers to registration in accordance with any—
- (a) enactment or rule of law,
 - (b) provision of EU law, or
 - (c) international agreement to which the United Kingdom or the EU is a party, providing for the protection of plant variety rights.]
- (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.

Textual Amendments

- F2** Words in s. 3(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 4(2) (with Pt. 5)
- F3** Words in Act substituted (22.4.2011) by [The Treaty of Lisbon \(Changes in Terminology\) Order 2011 \(S.I. 2011/1043\)](#), arts. 2, 3, 6 (with arts. 3(2)(3), 4(2), 6(4)(5))
- F4** Words in s. 3(4) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 4(3) (with Pt. 5)
- F5** S. 3(4A)-(4D) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 4(4) (with Pt. 5)

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.

Status: Point in time view as at 14/01/2019.

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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.

- [^{F6}(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

F6 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

II 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—

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (a) is identical with or similar to an earlier trade mark, and
^{F7}(b)

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 [^{F8}European Union] trade mark [^{F9}or international trade mark (EC)], in [^{F10}the European Union]) 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.

[^{F11}(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.]

(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 [^{F12}trade, where the condition in subsection (4A) is met,]
[^{F13}(aa) by virtue of any provision of EU law, or any enactment or rule of law, providing for protection of designations of origin or geographical indications, where the condition in subsection (4B) is met, or]
(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) [^{F14}or (aa)] above, in particular by virtue of the law of copyright [^{F15}or the law relating to industrial property rights].

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.

[^{F16}(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

(4B) The condition mentioned in subsection 4(aa) is that—

- (a) an application for a designation of origin or a geographical indication has been submitted prior to the date of application for registration of the trade mark or the date of the priority claimed for that application, and
(b) the designation of origin or (as the case may be) geographical indication is subsequently registered.]

(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.

[^{F17}(6) Where an agent or representative (“R”) of the proprietor of a trade mark applies, without the proprietor’s consent, for the registration of the trade mark in R’s own name, the application is to be refused unless R justifies that action.]

Textual Amendments

- F7** S. 5(3)(b) and preceding word omitted (5.5.2004) by virtue of [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, 7(1)
F8 Words in s. 5(3) substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), reg. 1(1), [Sch. para. 1](#) (with reg. 13)
F9 Words in s. 5(3) inserted (1.10.2004) by [Trade Marks \(International Registrations Designating the European Community, etc.\) Regulations 2004 \(S.I. 2004/2332\)](#), regs. 1(2), 3

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- F10** Words in Act substituted (22.4.2011) by [The Treaty of Lisbon \(Changes in Terminology\) Order 2011 \(S.I. 2011/1043\)](#), arts. 2, 3, 4 (with arts. 3(2)(3), 4(2), 6(4)(5))
- F11** S. 5(3A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(2)** (with Pt. 5)
- F12** Words in s. 5(4)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(3)** (with Pt. 5)
- F13** S. 5(4)(aa) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(4)** (with Pt. 5)
- F14** Words in s. 5(4)(b) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(5)(a)** (with Pt. 5)
- F15** Words in s. 5(4)(b) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(5)(b)** (with Pt. 5)
- F16** S. 5(4A)(4B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(6)** (with Pt. 5)
- F17** S. 5(6) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(7)** (with Pt. 5)

[^{F18}5A] Grounds for refusal relating to only some of the goods or services

Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.]

Textual Amendments

- F18** S. 5A inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **6** (with Pt. 5)

6 Meaning of “earlier trade mark”.

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

- (a) a registered trade mark, international trade mark (UK) [^{F19}[^{F20}European Union] trade mark or international trade mark (EC)] 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,
- [^{F21}(b) a [^{F20}European Union] trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK)] [^{F22}even where the earlier trade mark has been surrendered or its registration has expired],
- (ba) a registered trade mark or international trade mark (UK) which—
- (i) has been converted from a [^{F20}European Union] trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and
- (ii) accordingly has the same claim to seniority, 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 [^{F23}or the WTO agreement] as a well known trade mark.

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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.

^{F24}(3)

Textual Amendments

- F19** Words in s. 6(1)(a) substituted (1.10.2004) by Trade Marks (International Registrations Designating the European Community, etc.) Regulations 2004 (S.I. 2004/2332), regs. 1(2), **4(a)**
- F20** Words in s. 6(1) substituted (6.4.2016) by The European Union Trade Mark Regulations 2016 (S.I. 2016/299), reg. 1(1), **Sch. para. 1** (with reg. 13)
- F21** S. 6(1)(b)(ba) substituted for s. 6(1)(b) (1.10.2004) by Trade Marks (International Registrations Designating the European Community, etc.) Regulations 2004 (S.I. 2004/2332), regs. 1(2), **4(b)**
- F22** Words in s. 6(1)(b) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **7(2)** (with Pt. 5)
- F23** Words in s. 6(1)(c) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(1)**
- F24** S. 6(3) omitted (14.1.2019) by virtue of The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **7(3)** (with Pt. 5)

Modifications etc. (not altering text)

- C1** S. 6(3) modified (20.5.2016) by The Standardised Packaging of Tobacco Products Regulations 2015 (S.I. 2015/829), regs. 1(2), **13(3)(4)** (with regs. 13(9), 14(5), 20)

^{F25}6A Raising of relative grounds in opposition proceedings in case of non-use

- (1) This section applies where—
- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark [^{F26}of a kind falling within section 6(1)(a), (b) or (ba)] in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the [^{F27}relevant period].

[In this section “the relevant period” means the period of 5 years ending with the date ^{F28}(1A) of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.]

- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

- (3) The use conditions are met if—
- (a) within the [^{F29}relevant period] the earlier trade mark has 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, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form [^{F30}(the “variant form”)] differing in elements which do not alter the distinctive character of the mark in the form

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- in which it was registered [^{F31}(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)], and
- (b) 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.
- (5) In relation to a [^{F32}European Union] trade mark [^{F33}or international trade mark (EC)], any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to [^{F10}the European Union].
- [In relation to an international trade mark (EC) the reference in subsection (1)(c) to
- ^{F34}(5A) the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.]
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), 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).]

Textual Amendments

- F10** Words in Act substituted (22.4.2011) by [The Treaty of Lisbon \(Changes in Terminology\) Order 2011 \(S.I. 2011/1043\)](#), arts. 2, 3, 4 (with arts. 3(2)(3), 4(2), 6(4)(5))
- F25** S. 6A inserted (5.5.2004) by [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, 4 (with reg. 8)
- F26** Words in s. 6A(1)(b) inserted (10.5.2008) by [Trade Marks \(Earlier Trade Marks\) Regulations 2008 \(S.I. 2008/1067\)](#), regs. 1, **art. 4(2)** (with reg. 6)
- F27** Words in s. 6A(1)(c) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **8(2)** (with Pt. 5)
- F28** S. 6A(1A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **8(3)** (with Pt. 5)
- F29** Words in s. 6A(3)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **8(4)** (with Pt. 5)
- F30** Words in s. 6A(4)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **8(5)(a)** (with Pt. 5)
- F31** Words in s. 6A(4)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **8(5)(b)** (with Pt. 5)
- F32** Words in s. 6A(5) substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), reg. 1(1), **Sch. para. 1** (with reg. 13)
- F33** Words in s. 6A(5) inserted (10.5.2008) by [Trade Marks \(Earlier Trade Marks\) Regulations 2008 \(S.I. 2008/1067\)](#), regs. 1, **4(3)**
- F34** S. 6A(5A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **8(6)** (with Pt. 5)

Modifications etc. (not altering text)

- C2** S. 6A applied (with modifications) by SI 1996/714, art. 10C(2) (as substituted (5.5.2004) by [Trade Marks \(International Registration\) \(Amendment\) Order 2004 \(S.I. 2004/948\)](#), arts. 1(2), **5** (with art. 8))

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

C3 S. 6A(3) modified (20.5.2016) by [The Standardised Packaging of Tobacco Products Regulations 2015 \(S.I. 2015/829\)](#), regs. 1(2), **13(5)(a)(6)** (with regs. 13(9), 14(5), 20)

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.
- (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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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 [^{F35}Council Regulation (EC) No 40/94 of 20th December 1993 on the Community trade mark].

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

Textual Amendments

F35 Words in s. 8(5) substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), reg. 1(1), [Sch. para. 2](#) (with reg. 13)

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 [^{F36}subsections (1) to (3) of] section 10.

[^{F37}(1A) See subsection (3B) of section 10 for provision about certain other acts amounting to infringement of a registered trade mark.

- (1B) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of filing of the application for registration or (where applicable) the date of the priority claimed in respect of that application.]

- (2) References in this Act to the infringement of a registered trade mark are to any ^{F38}... infringement of the rights of the proprietor [^{F39}such as is mentioned in subsection (1) or (1A)].

- (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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

Textual Amendments

- F36** Words in s. 9(1) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(2)** (with Pt. 5)
- F37** S. 9(1A)(1B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(3)** (with Pt. 5)
- F38** Word in s. 9(2) omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(4)(a)** (with Pt. 5)
- F39** Words in s. 9(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(4)(b)** (with Pt. 5)

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^{F40}, in relation to goods or services,] a sign which—
- (a) is identical with or similar to the trade mark, ^{F41} ...
 - ^{F41}(b)
- 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.

^{F42}(3A) Subsection (3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered.

- (3B) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of the trade mark, a person infringes a registered trade mark if the person carries out in the course of trade any of the following acts—
- (a) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed; or
 - (b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.]

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

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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;^{F43} ...
- [^{F44}(ca) uses the sign as a trade or company name or part of a trade or company name;]
- (d) uses the sign on business papers [^{F45}and] in advertising[^{F46}; or]
- [^{F47}(e) uses the sign in comparative advertising in a manner that is contrary to the Business Protection from Misleading Marketing Regulations 2008.]

^{F48}(5)

^{F48}(6)

Textual Amendments

- F40** Words in s. 10(3) inserted (5.5.2004) by Trade Marks (Proof of Use, etc.) Regulations 2004 (S.I. 2004/946), regs. 1, **7(2)(a)**
- F41** S. 10(3)(b) and preceding word omitted (5.5.2004) by virtue of Trade Marks (Proof of Use, etc.) Regulations 2004 (S.I. 2004/946), regs. 1, **7(2)(b)**
- F42** S. 10(3A)(3B) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(2)** (with Pt. 5)
- F43** Word in s. 10(4)(c) omitted (14.1.2019) by virtue of The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(3)** (with Pt. 5)
- F44** S. 10(4)(ca) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(4)** (with Pt. 5)
- F45** Word in s. 10(4)(d) substituted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(5)(a)** (with Pt. 5)
- F46** Word in s. 10(4)(d) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(5)(b)** (with Pt. 5)
- F47** S. 10(4)(e) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(6)** (with Pt. 5)
- F48** S. 10(5)(6) omitted (14.1.2019) by virtue of The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(7)** (with Pt. 5)

[^{F49}10A Right to prevent goods entering the UK without being released for free circulation

- (1) The proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into the United Kingdom in the course of trade without being released for free circulation if they are goods for which the trade mark is registered which—
 - (a) come from outside the customs territory of the EU; and
 - (b) bear without authorisation a sign which is identical with the trade mark or cannot be distinguished in its essential aspects from the trade mark.
- (2) In subsection (1) the reference to goods for which the trade mark is registered includes a reference to the packaging of goods for which the trade mark is registered.
- (3) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of application for registration of the trade mark, or (where applicable) the date of the priority claimed in respect of that application.
- (4) The entitlement of the proprietor under subsection (1) is to lapse if—

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (a) proceedings are initiated in accordance with the European Customs Enforcement Regulation to determine whether the trade mark has been infringed; and
 - (b) during those proceedings evidence is provided by the declarant or the holder of the goods that the proprietor of the trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.
- (5) References in this Act to the “European Customs Enforcement Regulation” are references to Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights.

Textual Amendments

F49 Ss. 10A, 10B inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 11 (with Pt. 5)

10B Prohibition on the use of a trade mark registered in the name of an agent or representative

- (1) Subsection (2) applies where a trade mark is registered in the name of an agent or representative of a person (“P”) who is the proprietor of the trade mark, without P’s consent.
- (2) Unless the agent or representative justifies the action mentioned in subsection (1), P may do either or both of the following—
- (a) prevent the use of the trade mark by the agent or representative (notwithstanding the rights conferred by this Act in relation to a registered trade mark);
 - (b) apply for the rectification of the register so as to substitute P’s name as the proprietor of the registered trade mark.]

Textual Amendments

F49 Ss. 10A, 10B inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 11 (with Pt. 5)

11 Limits on effect of registered trade mark.

- (1) A registered trade mark is not infringed by the use of [^{F50}a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1)].

[^{F51}(1A) A registered trade mark is not infringed by the use of a later registered European Union trade mark where that later European Union trade mark would not be declared invalid as a result of Article 60(1), (3), (4), 61(1), (2) or 64(2) of the European Union Trade Mark Regulation.

- (1B) Where subsection (1) or (1A) applies, the later registered trade mark is not infringed by the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later registered trade mark.]

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (2) A registered trade mark is not infringed by—
- (a) the use by ^{F52}[an individual] of his own name or address,
 - (b) the use of ^{F53}[signs or indications which are not distinctive or which concern] 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 ^{F54}[for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use] 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).

Textual Amendments

- F50** Words in s. 11(1) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(2)** (with Pt. 5)
- F51** S. 11(1A)(1B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(3)** (with Pt. 5)
- F52** Words in s. 11(2)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(4)** (with Pt. 5)
- F53** Words in s. 11(2)(b) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(5)** (with Pt. 5)
- F54** Words in s. 11(2)(c) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(6)** (with Pt. 5)

^{F55}11A Non-use as defence in infringement proceedings

- (1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1)(a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.
- (2) Subsection (3) applies in relation to an action for infringement of a registered trade mark where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (3) If the defendant so requests, the proprietor of the trade mark must furnish proof—
- (a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in the United Kingdom by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action, or
 - (b) that there are proper reasons for non-use.
- (4) Nothing in subsections (2) and (3) overrides any provision of section 46, as applied by subsection (1) (including the words from “Provided that” to the end of subsection (3)).]

Textual Amendments

F55 S. 11A inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **13** (with Pt. 5)

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

I2 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.](#)

Status: Point in time view as at 14/01/2019.

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

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)

C4 S. 15: power to apply conferred (20.9.1995) by [1995 c. 32, s. 7\(1\)](#); [S.I. 1995/2472, art. 2](#)

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)

C5 S. 16: power to apply conferred (20.9.1995) by [1995 c. 32, 7\(1\)](#); [S.I. 1995/2472, art. 2](#)

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

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 [F3EU] 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.

Textual Amendments

- F3** Words in Act substituted (22.4.2011) by [The Treaty of Lisbon \(Changes in Terminology\) Order 2011 \(S.I. 2011/1043\)](#), arts. 2, 3, 6 (with arts. 3(2)(3), 4(2), 6(4)(5))

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

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

(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)

C6 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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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
- [^{F56}(a) under this section (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027));
- (b) under section 24D of the Registered Designs Act 1949;
- (c) under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988; or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).]

Textual Amendments

F56 S. 19(6)(a)-(d) substituted for words in s 19(6) (29.4.2006) by [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), art. 1, [Sch. 2 para. 16](#)

Modifications etc. (not altering text)

C7 S. 19: power to apply conferred (20.9.1995) by [1995 c. 32, S.I. 1995/2472](#), art. 2

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)

C8 S. 20: power to apply conferred (20.9.1995) by [1995 c. 32, s. 7\(1\)](#); [S.I. 1995/2472, art. 2](#)

[^{F57}Unjustified threats

Textual Amendments

F57 Ss. 21-21F and cross-heading substituted for s. 21 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017 \(c. 14\)](#), [ss. 2\(2\), 8](#); [S.I. 2017/771, reg. 2\(1\)\(b\)](#) (with [reg. 3](#))

21 Threats of infringement proceedings

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that—
- (a) a registered trade mark exists, and
- (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the registered trade mark by—

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (i) an act done in the United Kingdom, or
- (ii) an act which, if done, would be done in the United Kingdom.

- (2) References in this section and in section 21C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

21A Actionable threats

- (1) Subject to subsections (2) to (6), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.
- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
- (a) applying, or causing another person to apply, a sign to goods or their packaging,
 - (b) importing, for disposal, goods to which, or to the packaging of which, a sign has been applied, or
 - (c) supplying services under a sign.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a), (b) or (c).
- (4) A threat of infringement proceedings is not actionable if the threat—
- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to goods or their packaging, and
 - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to those goods or their packaging.
- (5) A threat of infringement proceedings is not actionable if the threat—
- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(c) in relation to services, and
 - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to those services.
- (6) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (7) In sections 21C and 21D “an actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

21B Permitted communications

- (1) For the purposes of section 21A(6), a communication containing a threat of infringement proceedings is a “permitted communication” if—
- (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
 - (b) all of the information that relates to the threat is information that—
 - (i) is necessary for that purpose (see subsection (5)(a) to (c) for some examples of necessary information), and
 - (ii) the person making the communication reasonably believes is true.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (2) Each of the following is a “permitted purpose”—
 - (a) giving notice that a registered trade mark exists;
 - (b) discovering whether, or by whom, a registered trade mark has been infringed by an act mentioned in section 21A(2)(a), (b) or (c);
 - (c) giving notice that a person has a right in or under a registered trade mark, where another person's awareness of the right is relevant to any proceedings that may be brought in respect of the registered trade mark.
- (3) The court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.
- (4) But the following may not be treated as a “permitted purpose”—
 - (a) requesting a person to cease using, in the course of trade, a sign in relation to goods or services,
 - (b) requesting a person to deliver up or destroy goods, or
 - (c) requesting a person to give an undertaking relating to the use of a sign in relation to goods or services.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see subsection (1)(b)(i))—
 - (a) a statement that a registered trade mark exists and is in force or that an application for the registration of a trade mark has been made;
 - (b) details of the registered trade mark, or of a right in or under the registered trade mark, which—
 - (i) are accurate in all material respects, and
 - (ii) are not misleading in any material respect; and
 - (c) information enabling the identification of the goods or their packaging, or the services, in relation to which it is alleged that the use of a sign constitutes an infringement of the registered trade mark.

21C Remedies and defences

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
 - (a) a declaration that the threat is unjustified;
 - (b) an injunction against the continuance of the threat;
 - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.
- (2) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the registered trade mark.
- (3) It is a defence for the person who made the threat to show—
 - (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 21A(2)(a), (b) or (c) in relation to the goods or their packaging or the services which are the subject of the threat, and

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

21D Professional advisers

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in subsection (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—
 - (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and
 - (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
 - (a) in making the communication the professional adviser is acting on the instructions of another person, and
 - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that subsection (1) applies to prove (if required) that at the material time—
 - (a) the person concerned was acting as a professional adviser, and
 - (b) the conditions in subsection (3) were met.

21E Supplementary: pending registration

- (1) In sections 21 and 21B references to a registered trade mark include references to a trade mark in respect of which an application for registration has been published under section 38.
- (2) Where the threat of infringement proceedings is made after an application for registration has been published (but before registration) the reference in section 21C(2) to “the registered trade mark” is to be treated as a reference to the trade mark registered in pursuance of that application.

21F Supplementary: proceedings for delivery up etc.

In section 21(1)(b) the reference to proceedings for infringement of a registered trade mark includes a reference to—

- (a) proceedings for an order under section 16 (order for delivery up of infringing goods, material or articles), and
- (b) proceedings for an order under section 19 (order as to disposal of infringing goods, material or articles).]

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

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)

C9 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) Subject 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—
 - (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)

C10 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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

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

[^{F58}(1A) A contractual obligation to transfer a business is to be taken to include an obligation to transfer any registered trade mark, except where there is agreement to the contrary or it is clear in all the circumstances that this presumption should not apply.]

- (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.

Textual Amendments

F58 S. 24(1A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **14** (with Pt. 5)

Modifications etc. (not altering text)

C11 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;

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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 [^{F59}and the mark is infringed before the prescribed particulars of the transaction are registered, in proceedings for such an infringement, the court shall not award him costs 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.]
- (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.

Textual Amendments

F59 Words in s. 25(4) substituted (29.4.2006) by [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), art. 1, [Sch. 2 para. 17](#)

Commencement Information

I3 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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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)

C12 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) [^{F60}and sections 28 to 31 (which relate to licensing)] 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.

Textual Amendments

F60 Words in s. 27(1) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), [regs. 1\(1\), 15](#) (with [Pt. 5](#))

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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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.
- [^{F61}(5) The proprietor of a registered trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in the licence with regard to—
- (a) its duration,
 - (b) the form covered by the registration in which the trade mark may be used,
 - (c) the scope of the goods or services for which the licence is granted,
 - (d) the territory in which the trade mark may be affixed, or
 - (e) the quality of the goods manufactured or of the services provided by the licensee.]

Textual Amendments

F61 S. 28(5) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 16 (with Pt. 5)

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.

- [^{F62}(1A) Except so far as the licence provides otherwise a licensee may only bring proceedings for infringement of the registered trade mark with the consent of the proprietor (but see subsections (2) and (3)).]
- (2) [^{F63}An exclusive licensee may] 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 [^{F64}mentioned in subsection (2)]—
- (a) refuses to do so, or
 - (b) fails to do so within two months after being called upon,
- the [^{F64}exclusive] licensee may bring the proceedings in his own name as if he were the proprietor.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (4) Where infringement proceedings are brought by a licensee by virtue of this section [^{F65}or with the consent of the proprietor or pursuant to the licence], 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 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.

[^{F66}(6A) Where the proprietor of a registered trade mark brings infringement proceedings, a licensee who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.]

- (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.

Textual Amendments

- F62** S. 30(1A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **17(2)** (with Pt. 5)
- F63** Words in s. 30(2) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **17(3)** (with Pt. 5)
- F64** Words in s. 30(3) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **17(4)** (with Pt. 5)
- F65** Words in s. 30(4) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **17(5)** (with Pt. 5)
- F66** S. 30(6A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **17(6)** (with Pt. 5)

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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (d) a representation of the trade mark^{F67}, which is capable of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor].
- (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 *abona 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.

Textual Amendments

F67 Words in s. 32(2)(d) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 18 (with Pt. 5)

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.

Commencement Information

I4 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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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

- I5** 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,

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

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) [^{F68}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.

Textual Amendments

F68 S. 37(2) ceases to have effect (1.10.2007) by virtue of [Trade Marks \(Relative Grounds\) Order 2007 \(S.I. 2007/1976\)](#), arts. 1, 3 (with art. 6)

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.
- (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.

- [^{F69}(2A) Where a notice of opposition is filed on the basis of one or more earlier trade marks or other earlier rights—
- (a) the rights (if plural) must all belong to the same proprietor;
 - (b) the notice may be filed on the basis of part, or the totality, of the goods or services in respect of which the earlier right is protected or applied for.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

(2B) A notice of opposition may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.]

(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.

Textual Amendments

F69 S. 38(2A)(2B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 19(2) (with Pt. 5)

Commencement Information

I6 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

I7 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—

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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 [^{F70}since the application was accepted that the registration requirements (other than those mentioned in section 5(1), (2) or (3)) were not met at that time.]
- (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.

Textual Amendments

F70 Words in s. 40(1) substituted (5.5.2004) by [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, 5 (with reg. 8)

Commencement Information

I8 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;
 - [^{F71}(aa) the division of a registration of a trade mark into several registrations;]
 - (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 [^{F72}or registration] to which the rules apply is to be treated as a single application [^{F72}or registration] and those for which it is to be treated as a number of separate applications [^{F72}or registrations].

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

Textual Amendments

- F71** S. 41(1)(aa) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **20(2)** (with Pt. 5)
- F72** Words in s. 41(3)(b) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **20(3)** (with Pt. 5)

Commencement Information

- I9** 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.](#)

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.

[^{F73}(3A) If a request for renewal is made or the renewal fee is paid in respect of only some of the goods or services for which the trade mark is registered, the registration is to be renewed for those goods or services only.]

- (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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

Textual Amendments

F73 S. 43(3A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **21** (with Pt. 5)

Commencement Information

I10 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

I11 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

I12 S. 45 wholly in force at 31.10.1994; 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—

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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 [F74(the “variant form”)] differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [F75(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)], 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:
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.

Textual Amendments

F74 Words in s. 46(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **22(a)** (with Pt. 5)

F75 Words in s. 46(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **22(b)** (with Pt. 5)

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

Modifications etc. (not altering text)

- C13** 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\(3\)](#)
- C14** S. 46(1)(a)(b) modified (20.5.2016) by [The Standardised Packaging of Tobacco Products Regulations 2015 \(S.I. 2015/829\), regs. 1\(2\), 13\(7\)\(8\)](#) (with [regs. 13\(9\), 14\(5\), 20](#))

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) [^{F76}Subject to subsections (2A) and (2G),] 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.

- [^{F77}(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).]

- [^{F78}(2A) ^{F79}... The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

- (2B) The use conditions are met if—

- [^{F80}(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—

- (i) within the period of 5 years ending with the date of application for the declaration, and
- (ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or]

- (b) it has not been so used, but there are proper reasons for non-use.

- (2C) For these purposes—

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (a) use of a trade mark includes use in a form [^{F81}(the “variant form”)] differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [^{F82}(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)], and
 - (b) 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.
- (2D) In relation to a [^{F83}European Union] trade mark [^{F84}or international trade mark (EC)], any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to [^{F10}the European Union].
- [In relation to an international trade mark (EC), the reference in subsection (2A)(a) ^{F85}(2DA) the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.]
- (2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.]
- [^{F86}(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).]
- [^{F87}(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.
- (2H) The reasons referred to in subsection (2G) are—
- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));
 - (b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);
 - (c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).]
- (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.

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

[^{F88}(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.]

- (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.

Textual Amendments

- F10** Words in Act substituted (22.4.2011) by [The Treaty of Lisbon \(Changes in Terminology\) Order 2011 \(S.I. 2011/1043\)](#), arts. 2, 3, 4 (with arts. 3(2)(3), 4(2), 6(4)(5))
- F76** Words in s. 47(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(2)** (with Pt. 5)
- F77** S. 47(2ZA) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(3)** (with Pt. 5)
- F78** S. 47(2A)-(2E) inserted (5.5.2004) by [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, **6** (with reg. 9)
- F79** Word in s. 47(2A) omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(4)** (with Pt. 5)
- F80** S. 47(2B)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(5)** (with Pt. 5)
- F81** Words in s. 47(2C)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(6)(a)** (with Pt. 5)
- F82** Words in s. 47(2C)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(6)(b)** (with Pt. 5)
- F83** Words in s. 47(2D) substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), reg. 1(1), **Sch. para. 1** (with reg. 13)
- F84** Words in s. 47(2D) inserted (10.5.2008) by [Trade Marks \(Earlier Trade Marks\) Regulations 2008 \(S.I. 2008/1067\)](#), regs. 1, **5(2)**
- F85** S. 47(2DA) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(7)** (with Pt. 5)
- F86** S. 47(2F) inserted (10.5.2008) by [Trade Marks \(Earlier Trade Marks\) Regulations 2008 \(S.I. 2008/1067\)](#), regs. 1, **5(3)** (with regs. 7, 8)
- F87** S. 47(2G)(2H) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(8)** (with Pt. 5)
- F88** S. 47(5A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(9)** (with Pt. 5)

Modifications etc. (not altering text)

- C15** 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)
- C16** S. 47(2B) modified (20.5.2016) by [The Standardised Packaging of Tobacco Products Regulations 2015 \(S.I. 2015/829\)](#), regs. 1(2), **13(5)(b)(6)** (with regs. 13(9), 14(5), 20)

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—

Status: Point in time view as at 14/01/2019.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Part 1. (See end of Document for details)

- (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)

C17 S. 48 applied (1.4.1996) by [S.I. 1996/714](#), [art. 14](#)

Collective marks

49 Collective marks.

^{F89}(1) A collective mark is a mark which is described as such when it is applied for and is capable of distinguishing the goods and services of members of the association which is the proprietor of the mark from those of other undertakings.

(1A) The following may be registered as the proprietor of a collective mark—

- (a) an association of manufacturers, producers, suppliers of services or traders which has the capacity in its own name to enter into contracts and to sue or be sued; and
 - (b) a legal person governed by public law.]
- (2) The provisions of this Act apply to collective marks subject to the provisions of Schedule 1.

Textual Amendments

F89 S. 49(1)(1A) substituted for s. 49(1) (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), [regs. 1\(1\), 24](#) (with [Pt. 5](#))

Certification marks

50 Certification marks.

- (1) A certification mark is a mark ^{F90}which is described as such when the mark is applied for and indicates] 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.

Status: Point in time view as at 14/01/2019.

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

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Textual Amendments

F90 Words in s. 50(1) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **25** (with Pt. 5)

Status:

Point in time view as at 14/01/2019.

Changes to legislation:

There are currently no known outstanding effects for the Trade Marks Act 1994, Part I.