



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

##### *Grounds for refusal of registration*

### 3 Absolute grounds for refusal of registration.

(1) The following shall not be registered—

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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

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

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods.

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

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

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- (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 [F1EU] law.
- (5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).
- (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

**Annotations:**

**Amendments (Textual)**

- F1** 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))

**4 Specially protected emblems.**

- (1) A trade mark which consists of or contains—
- (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,
  - (b) a representation of the Royal crown or any of the Royal flags,
  - (c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or
  - (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,
- shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.
- (2) A trade mark which consists of or contains a representation of—
- (a) the national flag of the United Kingdom (commonly known as the Union Jack), or
  - (b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,
- shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.
- Provision may be made by rules identifying the flags to which paragraph (b) applies.
- (3) A trade mark shall not be registered in the cases specified in—
- section 57 (national emblems, &c. of Convention countries), or
  - section 58 (emblems, &c. of certain international organisations).
- (4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains—
- (a) arms to which a person is entitled by virtue of a grant of arms by the Crown, or
  - (b) insignia so nearly resembling such arms as to be likely to be mistaken for them,
- unless it appears to the registrar that consent has been given by or on behalf of that person.

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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.

[<sup>F2</sup>(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.]

**Annotations:**

**Amendments (Textual)**

**F2** 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—

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

<sup>F3</sup>(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 [<sup>F4</sup>European Union] trade mark [<sup>F5</sup>or international trade mark (EC)], in [<sup>F6</sup>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.

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

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

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

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

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

#### Annotations:

##### Amendments (Textual)

- F3** 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)
- F4** 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)
- F5** 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
- F6** 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))

## 6 Meaning of “earlier trade mark”.

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

- (a) a registered trade mark, international trade mark (UK) [<sup>F7</sup>[<sup>F8</sup>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,
- [<sup>F9</sup>(b) a [<sup>F8</sup>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 ), ]
- (ba) a registered trade mark or international trade mark (UK) which—
- (i) has been converted from a [<sup>F8</sup>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 [<sup>F10</sup>or the WTO agreement] as a well known trade mark.

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

- (3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was *nobona fide* use of the mark during the two years immediately preceding the expiry.

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#### Annotations:

#### Amendments (Textual)

- F7** 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)**
- F8** 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)
- F9** 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)**
- F10** Words in s. 6(1)(c) inserted (29.7.1999) by [S.I. 1999/1899](#), **reg. 13(1)**

#### 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)

### [<sup>F11</sup>6A Raising of relative grounds in opposition proceedings in case of non-use

- (1) This section applies where—
- an application for registration of a trade mark has been published,
  - there is an earlier trade mark [<sup>F12</sup>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
  - the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (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—
- within the period of five years ending with the date of publication of the application 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
  - the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
  - use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a [<sup>F13</sup>European Union] trade mark [<sup>F14</sup>or international trade mark (EC)], any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to [<sup>F6</sup>the European Union].
- (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—

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- (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).]

#### Annotations:

##### Amendments (Textual)

- F6** 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. 6A inserted (5.5.2004) by [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, 4 (with reg. 8)
- F12** 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)
- F13** 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)
- F14** 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)**

##### 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))
- 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 <sup>MI</sup>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.

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

**Annotations:**

**Marginal Citations**

**M1** 1938 c. 22.

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

- (1) The Secretary of State may by order provide that in any case a trade mark shall not be refused registration on a ground mentioned in section 5 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.
- (2) The order may make such consequential provision as appears to the Secretary of State appropriate—
  - (a) with respect to the carrying out by the registrar of searches of earlier trade marks, and
  - (b) as to the persons by whom an application for a declaration of invalidity may be made on the grounds specified in section 47(2) (relative grounds).
- (3) An order making such provision as is mentioned in subsection (2)(a) may direct that so much of section 37 (examination of application) as requires a search to be carried out shall cease to have effect.
- (4) An order making such provision as is mentioned in subsection (2)(b) may provide that so much of section 47(3) as provides that any person may make an application for a declaration of invalidity shall have effect subject to the provisions of the order.
- (5) An order under this section shall be made by statutory instrument, and no order shall be made unless a draft of it has been laid before and approved by a resolution of each House of Parliament.

No such draft of an order making such provision as is mentioned in subsection (1) shall be laid before Parliament until after the end of the period of ten years beginning with the day on which applications for Community trade marks may first be filed in pursuance of [<sup>F15</sup>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.

**Annotations:**

**Amendments (Textual)**

**F15** 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)

**Changes to legislation:**

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Grounds for refusal of registration.