Trade Marks Act 1994

CHAPTER 26

TRADE MARKS ACT 1994

PART I
REGISTERED TRADE MARKS

Introductory

1 Trade marks.
2 Registered trade marks.

Grounds for refusal of registration

3 Absolute grounds for refusal of registration.
4 Specially protected emblems.
5 Relative grounds for refusal of registration.
5A Grounds for refusal relating to only some of the goods or services
6 Meaning of “earlier trade mark”.
6A Raising of relative grounds in opposition proceedings in case of non-use
7 Raising of relative grounds in case of honest concurrent use.
8 Power to require that relative grounds be raised in opposition proceedings.

Effects of registered trade mark

9 Rights conferred by registered trade mark.
10 Infringement of registered trade mark.
10A Right to prevent goods entering the UK without being released for free circulation
10B Prohibition on the use of a trade mark registered in the name of an agent or representative
11 Limits on effect of registered trade mark.
11A Non-use as defence in infringement proceedings
12 Exhaustion of rights conferred by registered trade mark.
13 Registration subject to disclaimer or limitation.

Infringement proceedings
14 Action for infringement.
15 Order for erasure, &c. of offending sign.
16 Order for delivery up of infringing goods, material or articles.
17 Meaning of “infringing goods, material or articles”.
18 Period after which remedy of delivery up not available.
19 Order as to disposal of infringing goods, material or articles.
20 Jurisdiction of sheriff court or county court in Northern Ireland.

Unjustified threats
21 Threats of infringement proceedings
21A Actionable threats
21B Permitted communications
21C Remedies and defences
21D Professional advisers
21E Supplementary: pending registration
21F Supplementary: proceedings for delivery up etc.

Registered trade mark as object of property
22 Nature of registered trade mark.
23 Co-ownership of registered trade mark.
24 Assignment, &c. of registered trade mark.
25 Registration of transactions affecting registered trade mark.
26 Trusts and equities.
27 Application for registration of trade mark as an object of property.

Licensing
28 Licensing of registered trade mark.
29 Exclusive licences.
30 General provisions as to rights of licensees in case of infringement.
31 Exclusive licensee having rights and remedies of assignee.

Application for registered trade mark
32 Application for registration.
33 Date of filing.
34 Classification of trade marks.

Priority
35 Claim to priority of Convention application.
36 Claim to priority from other relevant overseas application.

Registration procedure
37 Examination of application.
38 Publication, opposition proceedings and observations.
39 Withdrawal, restriction or amendment of application.
40 Registration.
41 Registration: supplementary provisions.

**Duration, renewal and alteration of registered trade mark**

42 Duration of registration.
43 Renewal of registration.
44 Alteration of registered trade mark.

**Surrender, revocation and invalidity**

45 Surrender of registered trade mark.
46 Revocation of registration.
47 Grounds for invalidity of registration.
48 Effect of acquiescence.

**Collective marks**

49 Collective marks.

**Certification marks**

50 Certification marks.

**PART II**


**European Union trade marks**

51 Meaning of “European Union trade mark”
52 Power to make provision in connection with European Union Trade Mark Regulation.
52A Certain trade marks registered as European Union trade marks to be treated as registered trade marks

**The Madrid Protocol: international registration**

53 The Madrid Protocol.
54 Power to make provision giving effect to Madrid Protocol.
54A Certain international trade marks protected in the European Union to be treated as registered trade marks

**The Paris Convention: supplementary provisions**

55 The Paris Convention.
56 Protection of well-known trade marks: Article 6bis.
57 National emblems, &c. of Convention countries: Article 6ter.
58 Emblems, &c. of certain international organisations: Article 6ter.
59 Notification under Article 6ter of the Convention.
60 Acts of agent or representative: Article 6septies.

**Miscellaneous**

61 Community trade marks and international matters
Nice Classification

60A Similarity of goods and services

PART III

ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

The registrar

62 The registrar.

The register

63 The register.
64 Rectification or correction of the register.
65 Adaptation of entries to new classification.

Powers and duties of the registrar

66 Power to require use of forms.
67 Information about applications and registered trade marks.
68 Costs and security for costs.
69 Evidence before registrar.
70 Exclusion of liability in respect of official acts.
71 Registrar’s annual report.

Legal proceedings and appeals

72 Registration to be prima facie evidence of validity.
73 Certificate of validity of contested registration.
74 Registrar’s appearance in proceedings involving the register.
75 The court.
76 Appeals from the registrar.
77 Persons appointed to hear and determine appeals.

Rules, fees, hours of business, &c.

78 Power of Secretary of State to make rules.
79 Fees.
80 Hours of business and business days.
81 The trade marks journal.

Trade mark agents

82 Recognition of agents.
83 The register of trade mark attorneys
83A Regulation of trade mark attorneys
84 Unregistered persons not to be described as registered trade mark agents.
85 Power to prescribe conditions, &c. for mixed partnerships and bodies corporate.
86 Use of the term “trade mark attorney”.
87 Privilege for communications with registered trade mark agents.
88 Power of registrar to refuse to deal with certain agents.
Importation of infringing goods, material or articles

89 Infringing goods, material or articles may be treated as prohibited goods.
90 Power of Commissioners of Customs and Excise to make regulations.
91 Power of Commissioners for Revenue and Customs to disclose information.

Offences

92 Unauthorised use of trade mark, &c. in relation to goods.
92A Search warrants
93 Enforcement function of local weights and measures authority.
94 Falsification of register, &c.
95 Falsey representing trade mark as registered.
96 Supplementary provisions as to summary proceedings in Scotland.

Forfeiture of counterfeit goods, &c.

97 Forfeiture: England and Wales or Northern Ireland.
98 Forfeiture: Scotland.

PART IV
MISCELLANEOUS AND GENERAL PROVISIONS

Miscellaneous

99 Unauthorised use of Royal arms, &c.
99A Reproduction of trade marks in dictionaries, encyclopaedias etc.
100 Burden of proving use of trade mark.
101 Offences committed by partnerships and bodies corporate.

Interpretation

102 Adaptation of expressions for Scotland.
103 Minor definitions.
104 Index of defined expressions.

Other general provisions

105 Transitional provisions.
106 Consequential amendments and repeals.
107 Territorial waters and the continental shelf.
108 Extent.
109 Commencement.
110 Short title.

SCHEDULES
SCHEDULE 1 — Collective marks

General

1 The provisions of this Act apply to collective marks subject...
Signs of which a collective mark may consist

2 In relation to a collective mark the reference in section...

Indication of geographical origin

3 (1) Notwithstanding section 3(1)(c), a collective mark may be registered...

Mark not to be misleading as to character or significance

4 (1) A collective mark shall not be registered if the...

Regulations governing use of collective mark

5 (1) An applicant for registration of a collective mark must...

Approval of regulations by registrar

6 (1) A collective mark shall not be registered unless the...

7 (1) The registrar shall consider whether the requirements mentioned in...

8 The regulations shall be published and notice of opposition may...

Regulations to be open to inspection

9 The regulations governing the use of a registered collective mark...

Amendment of regulations

10 (1) An amendment of the regulations governing the use of...

Infringement: rights of authorised users

11 The following provisions apply in relation to an authorised user...

12 (1) The following provisions (which correspond to the provisions of...

Grounds for revocation of registration

13 Apart from the grounds of revocation provided for in section...

Grounds for invalidity of registration

14 Apart from the grounds of invalidity provided for in section...

SCHEDULE 2 — Certification marks

General

1 The provisions of this Act apply to certification marks subject...

Signs of which a certification mark may consist

2 In relation to a certification mark the reference in section...

Indication of geographical origin

3 (1) Notwithstanding section 3(1)(c), a certification mark may be registered...
Nature of proprietor’s business

4 A certification mark shall not be registered if the proprietor...

Mark not to be misleading as to character or significance

5 (1) A certification mark shall not be registered if the...

Regulations governing use of certification mark

6 (1) An applicant for registration of a certification mark must...

Approval of regulations, &c.

7 (1) A certification mark shall not be registered unless—
8 (1) The registrar shall consider whether the requirements mentioned in...
9 The regulations shall be published and notice of opposition may...

Regulations to be open to inspection

10 The regulations governing the use of a registered certification mark...

Amendment of regulations

11 (1) An amendment of the regulations governing the use of...

Consent to assignment of registered certification mark

12 The assignment or other transmission of a registered certification mark...

Infringement: rights of authorised users

13 The following provisions apply in relation to an authorised user...
14 In infringement proceedings brought by the proprietor of a registered...

Grounds for revocation of registration

15 Apart from the grounds of revocation provided for in section...

Grounds for invalidity of registration

16 Apart from the grounds of invalidity provided for in section...

SCHEDULE 2A — EUROPEAN UNION TRADE MARKS

PART 1 — EXISTING EUROPEAN UNION TRADE MARKS

1 A trade mark registered as an existing EUTM to be treated as registered under this Act
2 Opt out
3 Entries to be made in the register in relation to a comparable trade mark (EU)
4 Comparable trade mark (EU) which derives from an EU Collective Mark or EU Certification Mark
5 Renewal of a comparable trade mark (EU) which expires within six months after IP completion day
6 Restoration of a comparable trade mark (EU)
7 Raising of relative grounds in opposition proceedings in case of non-use
8 Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)
9 Grounds for invalidity of registration of a trade mark based upon an earlier comparable trade mark (EU)
10 Reputation of a comparable trade mark (EU)
11 Rights conferred by registered trade mark
12 Effect of claim of priority
13 Effect of seniority claim
14 Determination of invalidity and liability to revocation in relation to claims of seniority
15 Procedure for declaration that trade mark would have been liable to be revoked or declared invalid
16 Assignment of an existing EUTM not registered on IP completion day
17 Effect of a licence of an existing EUTM
18 Effect of a security interest in an existing EUTM
19 Continuity of rights in relation to a comparable trade mark (EU)
20 Existing EUTM: pending proceedings
21 Existing EUTM: effect of injunction
21A Existing EUTM: effect of invalidity or revocation

PART 2 — TREATMENT OF EUROPEAN UNION TRADE MARKS WHICH EXPIRE DURING THE PERIOD OF SIX MONTHS ENDING ON IP COMPLETION DAY

22 Registration of certain expired European Union trade marks
23 Renewal of an expired EUTM

PART 3 — APPLICATIONS FOR EUROPEAN UNION TRADE MARKS WHICH ARE PENDING ON IP COMPLETION DAY

24 Application of Part
25 Application for registration under this Act based upon an existing EUTM application
26 Right to claim seniority where seniority has been claimed by an existing EUTM application
27 Determination of invalidity and liability to revocation in relation to claim of seniority under paragraph 26

PART 4 — RESTORATION OF EUROPEAN UNION TRADE MARK REGISTRATIONS AND APPLICATIONS

28 Restoration of a European Union trade mark to the EUTM Register
29 Restoration of an application for a European Union trade mark

PART 5 — INTERPRETATION

30 Interpretation

SCHEDULE 2B — INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION

PART 1 — EXISTING INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION

1 An international trade mark protected in the European Union to be treated as registered under this Act
2 Opt out
3 Entries to be made in the register in relation to a comparable trade mark (IR)
4 Comparable trade mark (IR) which derives from a mark treated as an EU Collective Mark or EU Certification Mark
5 Renewal of a comparable trade mark (IR) which expires within six months after IP completion day
6 Restoration of a comparable trade mark (IR)
7 Raising of relative grounds in opposition proceedings in case of non-use
8 Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (IR)
9 Grounds for invalidity of registration of a trade mark based upon an earlier comparable trade mark (IR)
10 Reputation of a comparable trade mark (IR)
11 Rights conferred by registered trade mark
12 Effect of disclaimer
13 Effect of claim of priority
14 Effect of seniority claim
15 Determination of invalidity and liability to revocation in relation to claims of seniority
16 Procedure for declaration that trade mark would have been liable to be revoked or declared invalid
17 Assignment of an existing IR(EU) not registered on IP completion day
18 Effect of a licence of an existing IR(EU)
19 Effect of a security interest in an existing IR(EU)
20 Continuity of rights in relation to a comparable trade mark (IR)
21 Existing IR(EU): pending proceedings
22 Existing IR(EU): effect of injunction

PART 2 — TREATMENT OF INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION WHICH EXPIRE DURING THE PERIOD OF SIX MONTHS ENDING ON IP COMPLETION DAY

23 Registration of certain expired international trade marks
24 Renewal of an expired IR(EU)
25 Renewal of an expired IR(EU): territorial extension under Article 3ter(1)
26 Renewal of an expired IR(EU): territorial extension under Article 3ter(2)

PART 3 — APPLICATIONS FOR THE EXTENSION OF PROTECTION OF INTERNATIONAL REGISTRATIONS TO THE EUROPEAN UNION WHICH ARE PENDING ON IP COMPLETION DAY

27 Interpretation
28 Application for registration under this Act based upon an existing ITM application or an existing request for EU extension recorded in the International Register prior to IP completion day
29 Application for registration under this Act based upon an existing ITM application or an existing request for EU extension recorded in the International Register on or after IP completion day
30 Right to claim seniority where seniority has been claimed by an existing ITM application or an existing request for EU extension
31 Determination of invalidity and liability to revocation in relation to claim of seniority under paragraph 30

PART 4 — TRANSFORMATION APPLICATIONS WHICH ARE PENDING ON IP COMPLETION DAY

32 Transformation applications
33 Application for registration based upon a cancelled international registration

PART 5 — INTERPRETATION

SCHEDULE 3 — Transitional provisions
Introductory

1. (1) In this Schedule—“existing registered mark” means a trade...

Existing registered marks

2. (1) Existing registered marks (whether registered in Part A or...
3. (1) A condition entered on the former register in relation...

Effects of registration: infringement

4. (1) Sections 9 to 12 of this Act (effects of...

Infringing goods, material or articles

5. Section 16 of this Act (order for delivery up of...

Rights and remedies of licensee or authorised user

6. (1) Section 30 (general provisions as to rights of licensees...

Co-ownership of registered mark

7. The provisions of section 23 of this Act (co-ownership of...

Assignment, &c. of registered mark

8. (1) Section 24 of this Act (assignment or other transmission...

Licensing of registered mark

9. (1) Sections 28 and 29(2) of this Act (licensing of...

Pending applications for registration

10. (1) An application for registration of a mark under the...

Conversion of pending application

11. (1) In the case of a pending application for registration...

Trade marks registered according to old classification

12. The registrar may exercise the powers conferred by rules under...

Claim to priority from overseas application

13. Section 35 of this Act (claim to priority of Convention...
14. (1) Where before the commencement of this Act a person...

Duration and renewal of registration

15. (1) Section 42(1) of this Act (duration of original period...

Pending application for alteration of registered mark

16. An application under section 35 of the 1938 Act (alteration...
Revocation for non-use

17 (1) An application under section 26 of the 1938 Act...

Application for rectification, &c.

18 (1) An application under section 32 or 34 of the...

Regulations as to use of certification mark

19 (1) Regulations governing the use of an existing registered certification...

Sheffield marks

20 (1) For the purposes of this Schedule the Sheffield register...

Certificate of validity of contested registration

21 A certificate given before the commencement of this Act under...

Trade mark agents

22 (1) Rules in force immediately before the commencement of this...

SCHEDULE 4 — Consequential amendments

General adaptation of existing references

1 (1) References in statutory provisions passed or made before the...

Patents and Designs Act 1907 (c.29)

2 (1) The Patents and Designs Act 1907 is amended as...

Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939(c.107)

3 (1) The Patents, Designs, Copyright and Trade Marks (Emergency) Act...

Trade Descriptions Act 1968 (c.29)

4 In the Trade Descriptions Act 1968, in section 34 (exemption...

Solicitors Act 1974 (c.47)

5 (1) Section 22 of the Solicitors Act 1974 (preparation of...

House of Commons Disqualification Act 1975 (c.24)

6 In Part III of Schedule 1 to the House of...

Restrictive Trade Practices Act 1976 (c.34)

7 In Schedule 3 to the Restrictive Trade Practices Act 1976...

Copyright, Designs and Patents Act 1988 (c.48)

8 (1) The Copyright, Designs and Patents Act 1988 is amended...
Tribunals and Inquiries Act 1992 (c.53)

9 In Part I of Schedule 1 to the Tribunals and...

SCHEDULE 5 — Repeals and revocations
Changes to legislation:
There are currently no known outstanding effects for the Trade Marks Act 1994.