

*Status: Point in time view as at 02/04/2007.*

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

## SCHEDULES

### SCHEDULE 1

Section 49.

#### COLLECTIVE MARKS

##### Commencement Information

- II** Sch. 1 wholly in force at 31.10.1994; Sch. 1 not in force at Royal Assent; Sch. 1 para. 6(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 1 not already in force by 1994/2550, arts. 2, 3(1), Sch.

##### *General*

- 1 The provisions of this Act apply to collective marks subject to the following provisions.

##### *Signs of which a collective mark may consist*

- 2 In relation to a collective mark the reference in section 1(1) (signs of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

##### *Indication of geographical origin*

- 3 (1) Notwithstanding section 3(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.
- (2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

##### *Mark not to be misleading as to character or significance*

- 4 (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.
- (2) The registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

Notwithstanding section 39(2), an application may be amended so as to comply with any such requirement.

*Status: Point in time view as at 02/04/2007.*

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

*Regulations governing use of collective mark*

- 5 (1) An applicant for registration of a collective mark must file with the registrar regulations governing the use of the mark.
- (2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse.

Further requirements with which the regulations have to comply may be imposed by rules.

*Approval of regulations by registrar*

- 6 (1) A collective mark shall not be registered unless the regulations governing the use of the mark—
- (a) comply with paragraph 5(2) and any further requirements imposed by rules, and
  - (b) are not contrary to public policy or to accepted principles of morality.
- (2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant must file the regulations with the registrar and pay the prescribed fee.

If he does not do so, the application shall be deemed to be withdrawn.

**Commencement Information**

- I2** [Sch. 1](#) wholly in force at 31.10.1994; [Sch. 1](#) not in force at Royal Assent see [s. 109](#); [Sch. 1 para. 6\(2\)](#) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as [Sch. 1](#) not already in force by [S.I. 1994/2550](#), [arts. 2, 3\(1\)](#), [Sch.](#)

- 7 (1) The registrar shall consider whether the requirements mentioned in paragraph 6(1) are met.
- (2) If it appears to the registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations.
- (3) If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse the application.
- (4) If it appears to the registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 38 (publication, opposition proceedings and observations).
- 8 The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 6(1).

This is in addition to any other grounds on which the application may be opposed or observations made.

---

*Status: Point in time view as at 02/04/2007.*

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

---

*Regulations to be open to inspection*

- 9 The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

*Amendment of regulations*

- 10 (1) An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with the registrar and accepted by him.
- (2) Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published.
- (3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 6(1).

*Infringement: rights of authorised users*

- 11 The following provisions apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark—
- (a) section 10(5) (definition of infringement: unauthorised application of mark to certain material);
  - (b) section 19(2) (order as to disposal of infringing goods, material or articles: adequacy of other remedies);
  - (c) section 89 (prohibition of importation of infringing goods, material or articles: request to Commissioners of Customs and Excise).
- 12 (1) The following provisions (which correspond to the provisions of section 30 (general provisions as to rights of licensees in case of infringement)) have effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.
- (2) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests.
- (3) If the proprietor—
- (a) refuses to do so, or
  - (b) fails to do so within two months after being called upon,
- the authorised user may bring the proceedings in his own name as if he were the proprietor.
- (4) Where infringement proceedings are brought by virtue of this paragraph, the authorised user may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.
- This does not affect the granting of interlocutory relief on an application by an authorised user alone.
- (5) A proprietor who is added as a defendant as mentioned in sub-paragraph (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.
- (6) In infringement proceedings brought by the proprietor of a registered collective mark any loss suffered or likely to be suffered by authorised users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to

*Status: Point in time view as at 02/04/2007.*

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

which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

*Grounds for revocation of registration*

- 13 Apart from the grounds of revocation provided for in section 46, the registration of a collective mark may be revoked on the ground—
- (a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 4(1), or
  - (b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark, or
  - (c) that an amendment of the regulations has been made so that the regulations—
    - (i) no longer comply with paragraph 5(2) and any further conditions imposed by rules, or
    - (ii) are contrary to public policy or to accepted principles of morality.

*Grounds for invalidity of registration*

- 14 Apart from the grounds of invalidity provided for in section 47, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4(1) or 6(1).

SCHEDULE 2

Section 50.

CERTIFICATION MARKS

**Commencement Information**

- I3** [Sch. 2](#) wholly in force; [Sch. 2](#) not in force at Royal Assent see [s. 109](#); [Sch. 2 para. 7\(2\)](#) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as [Sch. 2](#) not already in force by [S.I. 1994/2550](#), [arts. 2, 3\(1\)](#), [Sch.](#)

*General*

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

*Signs of which a certification mark may consist*

- 2 In relation to a certification mark the reference in section 1(1) (signs of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

---

*Status: Point in time view as at 02/04/2007.*

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

---

*Indication of geographical origin*

- 3 (1) Notwithstanding section 3(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.
- (2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

*Nature of proprietor's business*

- 4 A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

*Mark not to be misleading as to character or significance*

- 5 (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.
- (2) The registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

Notwithstanding section 39(2), an application may be amended so as to comply with any such requirement.

*Regulations governing use of certification mark*

- 6 (1) An applicant for registration of a certification mark must file with the registrar regulations governing the use of the mark.
- (2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

Further requirements with which the regulations have to comply may be imposed by rules.

*Approval of regulations, &c.*

- 7 (1) A certification mark shall not be registered unless—
- (a) the regulations governing the use of the mark—
    - (i) comply with paragraph 6(2) and any further requirements imposed by rules, and
    - (ii) are not contrary to public policy or to accepted principles of morality, and
  - (b) the applicant is competent to certify the goods or services for which the mark is to be registered.
- (2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the registrar and pay the prescribed fee.

*Status: Point in time view as at 02/04/2007.*

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

If he does not do so, the application shall be deemed to be withdrawn.

#### **Commencement Information**

**I4** Sch. 2 wholly in force; Sch. 2 not in force at Royal Assent see s. 109; Sch. 2 para. 7(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 2 not already in force by S.I. 1994/2550, arts. 2, 3(1), Sch.

- 8 (1) The registrar shall consider whether the requirements mentioned in paragraph 7(1) are met.
- (2) If it appears to the registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations.
- (3) If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse the application.
- (4) If it appears to the registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 38 (publication, opposition proceedings and observations).

- 9 The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).
- This is in addition to any other grounds on which the application may be opposed or observations made.

#### *Regulations to be open to inspection*

- 10 The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

#### *Amendment of regulations*

- 11 (1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the registrar and accepted by him.
- (2) Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published.
- (3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

#### *Consent to assignment of registered certification mark*

- 12 The assignment or other transmission of a registered certification mark is not effective without the consent of the registrar.

---

*Status: Point in time view as at 02/04/2007.*

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

---

*Infringement: rights of authorised users*

- 13 The following provisions apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark—
- (a) section 10(5) (definition of infringement: unauthorised application of mark to certain material);
  - (b) section 19(2) (order as to disposal of infringing goods, material or articles: adequacy of other remedies);
  - (c) section 89 (prohibition of importation of infringing goods, material or articles: request to Commissioners of Customs and Excise).
- 14 In infringement proceedings brought by the proprietor of a registered certification mark any loss suffered or likely to be suffered by authorised users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

*Grounds for revocation of registration*

- 15 Apart from the grounds of revocation provided for in section 46, the registration of a certification mark may be revoked on the ground—
- (a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4,
  - (b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1),
  - (c) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark,
  - (d) that an amendment of the regulations has been made so that the regulations—
    - (i) no longer comply with paragraph 6(2) and any further conditions imposed by rules, or
    - (ii) are contrary to public policy or to accepted principles of morality, or
  - (e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

*Grounds for invalidity of registration*

- 16 Apart from the grounds of invalidity provided for in section 47, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4, 5(1) or 7(1).

*Status: Point in time view as at 02/04/2007.*

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

## SCHEDULE 3

Section 105.

## TRANSITIONAL PROVISIONS

**Commencement Information**

- I5** Sch. 3 wholly in force at 31.10.1994; Sch. 3 not in force at Royal Assent see s. 109; Sch. 3 paras. 10(2), 11(2), 12, 14(5) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 3 not already in force by S.I. 1994/2550, arts. 2, 3(1), Sch.

*Introductory*

- 1 (1) In this Schedule—

“existing registered mark” means a trade mark, certification trade mark or service mark registered under the 1938 Act immediately before the commencement of this Act;

“the 1938 Act” means the <sup>M1</sup>Trade Marks Act 1938; and

“the old law” means that Act and any other enactment or rule of law applying to existing registered marks immediately before the commencement of this Act.

- (2) For the purposes of this Schedule—

- (a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before commencement, and
- (b) the date on which it was made shall be taken to be the date of filing under the 1938 Act.

**Marginal Citations**

- M1** 1938 c. 22.

*Existing registered marks*

- 2 (1) Existing registered marks (whether registered in Part A or B of the register kept under the 1938 Act) shall be transferred on the commencement of this Act to the register kept under this Act and have effect, subject to the provisions of this Schedule, as if registered under this Act.
- (2) Existing registered marks registered as a series under section 21(2) of the 1938 Act shall be similarly registered in the new register.
- Provision may be made by rules for putting such entries in the same form as is required for entries under this Act.
- (3) In any other case notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement of this Act.



*Status: Point in time view as at 02/04/2007.*

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

PROSPECTIVE

- 3 (1) A condition entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall cease to have effect on commencement.

Proceedings under section 33 of the 1938 Act (application to expunge or vary registration for breach of condition) which are pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

- (2) A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of section 13 of this Act.

*Effects of registration: infringement*

- 4 (1) Sections 9 to 12 of this Act (effects of registration) apply in relation to an existing registered mark as from the commencement of this Act and section 14 of this Act (action for infringement) applies in relation to infringement of an existing registered mark committed after the commencement of this Act, subject to sub-paragraph (2) below.

The old law continues to apply in relation to infringements committed before commencement.

- (2) It is not an infringement of—  
(a) an existing registered mark, or  
(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue after commencement any use which did not amount to infringement of the existing registered mark under the old law.

*Infringing goods, material or articles*

- 5 Section 16 of this Act (order for delivery up of infringing goods, material or articles) applies to infringing goods, material or articles whether made before or after the commencement of this Act.

*Rights and remedies of licensee or authorised user*

- 6 (1) Section 30 (general provisions as to rights of licensees in case of infringement) of this Act applies to licences granted before the commencement of this Act, but only in relation to infringements committed after commencement.
- (2) Paragraph 14 of Schedule 2 of this Act (court to take into account loss suffered by authorised users, &c.) applies only in relation to infringements committed after commencement.

---

*Status: Point in time view as at 02/04/2007.*

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

---

*Co-ownership of registered mark*

- 7 The provisions of section 23 of this Act (co-ownership of registered mark) apply as from the commencement of this Act to an existing registered mark of which two or more persons were immediately before commencement registered as joint proprietors.

But so long as the relations between the joint proprietors remain such as are described in section 63 of the 1938 Act (joint ownership) there shall be taken to be an agreement to exclude the operation of subsections (1) and (3) of section 23 of this Act (ownership in undivided shares and right of co-proprietor to make separate use of the mark).

*Assignment, &c. of registered mark*

- 8 (1) Section 24 of this Act (assignment or other transmission of registered mark) applies to transactions and events occurring after the commencement of this Act in relation to an existing registered mark; and the old law continues to apply in relation to transactions and events occurring before commencement.

- (2) Existing entries under section 25 of the 1938 Act (registration of assignments and transmissions) shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 25 of this Act.

Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

- (3) An application for registration under section 25 of the 1938 Act which is pending before the registrar on the commencement of this Act shall be treated as an application for registration under section 25 of this Act and shall proceed accordingly.

The registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

- (4) An application for registration under section 25 of the 1938 Act which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

- (5) Where before the commencement of this Act a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after commencement shall be made under section 25 of this Act.

- (6) In cases to which sub-paragraph (3) or (5) applies section 25(3) of the 1938 Act continues to apply (and section 25(3) and (4) of this Act do not apply) as regards the consequences of failing to register.

*Licensing of registered mark*

- 9 (1) Sections 28 and 29(2) of this Act (licensing of registered trade mark; rights of exclusive licensee against grantor's successor in title) apply only in relation to licences granted after the commencement of this Act; and the old law continues to apply in relation to licences granted before commencement.

*Status: Point in time view as at 02/04/2007.*

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

- (2) Existing entries under section 28 of the 1938 Act (registered users) shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 25 of this Act.

Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

- (3) An application for registration as a registered user which is pending before the registrar on the commencement of this Act shall be treated as an application for registration of a licence under section 25(1) of this Act and shall proceed accordingly.

The registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

- (4) An application for registration as a registered user which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

- (5) Any proceedings pending on the commencement of this Act under section 28(8) or (10) of the 1938 Act (variation or cancellation of registration of registered user) shall be dealt with under the old law and any necessary alteration made to the new register.

#### *Pending applications for registration*

- 10 (1) An application for registration of a mark under the 1938 Act which is pending on the commencement of this Act shall be dealt with under the old law, subject as mentioned below, and if registered the mark shall be treated for the purposes of this Schedule as an existing registered mark.
- (2) The power of the Secretary of State under section 78 of this Act to make rules regulating practice and procedure, and as to the matters mentioned in subsection (2) of that section, is exercisable in relation to such an application; and different provision may be made for such applications from that made for other applications.
- (3) Section 23 of the 1938 Act (provisions as to associated trade marks) shall be disregarded in dealing after the commencement of this Act with an application for registration.

#### **Commencement Information**

- I6** Sch. 3 para. 10 wholly in force; Sch. 3 para. 10 not in force at Royal Assent see s. 109; Sch. 3 para. 10(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), Sch.

#### *Conversion of pending application*

- 11 (1) In the case of a pending application for registration which has not been advertised under section 18 of the 1938 Act before the commencement of this Act, the applicant may give notice to the registrar claiming to have the registrability of the mark determined in accordance with the provisions of this Act.
- (2) The notice must be in the prescribed form, be accompanied by the appropriate fee and be given no later than six months after the commencement of this Act.

*Status: Point in time view as at 02/04/2007.*

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

- (3) Notice duly given is irrevocable and has the effect that the application shall be treated as if made immediately after the commencement of this Act.

#### Commencement Information

- I7** Sch. 3 para. 11 wholly in force; Sch. 3 para. 11 not in force at Royal Assent see s. 109; Sch. 3 para. 11 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), Sch.

#### *Trade marks registered according to old classification*

- 12 The registrar may exercise the powers conferred by rules under section 65 of this Act (adaptation of entries to new classification) to secure that any existing registered marks which do not conform to the system of classification prescribed under section 34 of this Act are brought into conformity with that system.

This applies, in particular, to existing registered marks classified according to the pre-1938 classification set out in Schedule 3 to the <sup>M2</sup>Trade Marks Rules 1986.

#### Commencement Information

- I8** Sch. 3 para. 12 wholly in force; Sch. 3 para. 12 not in force at Royal Assent see s. 109; Sch. 3 para. 12 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), Sch.

#### Marginal Citations

- M2** S.I. 1986/1319.

#### *Claim to priority from overseas application*

- 13 Section 35 of this Act (claim to priority of Convention application) applies to an application for registration under this Act made after the commencement of this Act notwithstanding that the Convention application was made before commencement.
- 14 (1) Where before the commencement of this Act a person has duly filed an application for protection of a trade mark in a relevant country within the meaning of section 39A of the 1938 Act which is not a Convention country (a “relevant overseas application”), he, or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the relevant overseas application.
- (2) If the application for registration under this Act is made within that six-month period—
- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the relevant overseas application, and
  - (b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

*Status: Point in time view as at 02/04/2007.*

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

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

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

- (4) A subsequent application concerning the same subject as the relevant overseas application, filed in the same country, shall be considered the relevant overseas application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application—
- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and
  - (b) it has not yet served as a basis for claiming a right of priority.

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

- (5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a relevant overseas application.
- (6) A right to priority arising as a result of a relevant overseas application may be assigned or otherwise transmitted, either with the application or independently.

The reference in sub-paragraph (1) to the applicant’s “successor in title” shall be construed accordingly.

- (7) Nothing in this paragraph affects proceedings on an application for registration under the 1938 Act made before the commencement of this Act (see paragraph 10 above).

#### **Commencement Information**

- 19** [Sch. 3](#) wholly in force; [Sch. 3](#) not in force at Royal Assent see [s. 109](#); [Sch. 3 para. 14\(5\)](#) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by [S.I. 1994/2550](#), [arts. 2, 3\(1\)](#), [Sch.](#)

#### *Duration and renewal of registration*

- 15 (1) Section 42(1) of this Act (duration of original period of registration) applies in relation to the registration of a mark in pursuance of an application made after the commencement of this Act; and the old law applies in any other case.
- (2) Sections 42(2) and 43 of this Act (renewal) apply where the renewal falls due on or after the commencement of this Act; and the old law continues to apply in any other case.
- (3) In either case it is immaterial when the fee is paid.

*Status: Point in time view as at 02/04/2007.*

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

*Pending application for alteration of registered mark*

PROSPECTIVE

- 16 An application under section 35 of the 1938 Act (alteration of registered trade mark) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

*Revocation for non-use*

- 17 (1) An application under section 26 of the 1938 Act (removal from register or imposition of limitation on ground of non-use) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.
- (2) An application under section 46(1)(a) or (b) of this Act (revocation for non-use) may be made in relation to an existing registered mark at any time after the commencement of this Act.  
Provided that no such application for the revocation of the registration of an existing registered mark registered by virtue of section 27 of the 1938 Act (defensive registration of well-known trade marks) may be made until more than five years after the commencement of this Act.

*Application for rectification, &c.*

- 18 (1) An application under section 32 or 34 of the 1938 Act (rectification or correction of the register) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.
- (2) For the purposes of proceedings under section 47 of this Act (grounds for invalidity of registration) as it applies in relation to an existing registered mark, the provisions of this Act shall be deemed to have been in force at all material times.  
Provided that no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection (3) of section 5 of this Act (relative grounds for refusal of registration: conflict with earlier mark registered for different goods or services).

*Regulations as to use of certification mark*

- 19 (1) Regulations governing the use of an existing registered certification mark deposited at the Patent Office in pursuance of section 37 of the 1938 Act shall be treated after the commencement of this Act as if filed under paragraph 6 of Schedule 2 to this Act.
- (2) Any request for amendment of the regulations which was pending on the commencement of this Act shall be dealt with under the old law.

*Sheffield marks*

- 20 (1) For the purposes of this Schedule the Sheffield register kept under Schedule 2 to the 1938 Act shall be treated as part of the register of trade marks kept under that Act.

*Status: Point in time view as at 02/04/2007.*

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

- (2) Applications made to the Cutlers' Company in accordance with that Schedule which are pending on the commencement of this Act shall proceed after commencement as if they had been made to the registrar.

*Certificate of validity of contested registration*

- 21 A certificate given before the commencement of this Act under section 47 of the 1938 Act (certificate of validity of contested registration) shall have effect as if given under section 73(1) of this Act.

*Trade mark agents*

- 22 (1) Rules in force immediately before the commencement of this Act under section 282 or 283 of the <sup>M3</sup>Copyright, Designs and Patents Act 1988 (register of trade mark agents; persons entitled to described themselves as registered) shall continue in force and have effect as if made under section 83 or 85 of this Act.
- (2) Rules in force immediately before the commencement of this Act under section 40 of the 1938 Act as to the persons whom the registrar may refuse to recognise as agents for the purposes of business under that Act shall continue in force and have effect as if made under section 88 of this Act.
- (3) Rules continued in force under this paragraph may be varied or revoked by further rules made under the relevant provisions of this Act.

**Marginal Citations**

**M3** 1988 c. 48.

SCHEDULE 4

Section 106(1).

CONSEQUENTIAL AMENDMENTS

*General adaptation of existing references*

- 1 (1) References in statutory provisions passed or made before the commencement of this Act to trade marks or registered trade marks within the meaning of the <sup>M4</sup>Trade Marks Act 1938 shall, unless the context otherwise requires, be construed after the commencement of this Act as references to trade marks or registered trade marks within the meaning of this Act.
- (2) Sub-paragraph (1) applies, in particular, to the references in the following provisions—

---

<b>M5</b>	Schedule 1, paragraph 7
Industrial Organisation and Development Act 1947	
<b>M6</b>	section 3(1)(b)
Crown Proceedings Act 1947	

---

*Status: Point in time view as at 02/04/2007.*

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

---

F1	F1
. . .	. . .
M7	section 1(1)(b)
Printer's Imprint Act 1961	
F2	F2
. . .	. . .
F3	F3
. . .	. . .
M8	section 19(2)section 27(4)section 123(7)
Patents Act 1977	
M9	Schedule 1, paragraph 1(c)
Unfair Contract Terms Act 1977	
M10	section 94A(5)
Judicature (Northern Ireland) Act 1978	
M11	section 7(a) and (b)
State Immunity Act 1978	
M12	section 72(5)Schedule 1, paragraph 1(i)
Supreme Court Act 1981	
M13	Schedule 5, paragraph 2Schedule 8, paragraph 2(14) and 4(2)
Civil Jurisdiction and Judgments Act 1982	
M14	Schedule 3, paragraph 1
Value Added Tax Act 1983	
M15	section 396(3A)(a) or (as substituted by the
Companies Act 1985	M16 Companies Act 1989) section 396(2)(d) (i)section 410(4)(c)(v)Schedule 4, Part I, Balance Sheet Formats 1 and 2 and Note (2)Schedule 9, Part I, paragraphs 5(2)(d) and 10(2)
M17	section 15(5)
Law Reform (Miscellaneous Provisions) (Scotland) Act 1985	
M18	section 8(2)
Atomic Energy Authority Act 1986	
M19	article 403(3A)(a) or (as substituted by the
Companies (Northern Ireland) Order 1986	M20 Companies (No.2) (Northern Ireland) Order 1990) article 403(2)(d) (i)Schedule 4, Part I, Balance Sheet



*Status: Point in time view as at 02/04/2007.*

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

	Formats 1 and 2 and Note (2)Schedule 9, Part I, paragraphs 5(2)(d) and 10(2)
M21	section 2(2)(b)
Consumer Protection Act 1987	
M22	article 5(2)(b)
Consumer Protection (Northern Ireland) Order 1987	
M23	section 83(a)
Income and Corporation Taxes Act 1988	
M24	section 275(h)
Taxation of Chargeable Gains Act 1992	
M25	Schedule 1, paragraph 34.
Tribunals and Inquiries Act 1992	

#### Textual Amendments

- F1** Words in Sch. 4 para. 1(2) repealed (22.7.2004) by [Statute Law \(Repeals\) Act 2004 \(c. 14\)](#), [Sch. 1 Pt. 2](#) Group 1
- F2** Entry relating to “Plant Variety and Seeds Act” in Sch. 4 para. 1(2) repealed (8.5.1998) by [1997 c. 66](#), [s. 52](#), [Sch. 4](#); [S.I. 1998/1028](#), [art. 2](#)
- F3** Entry relating to “Northern Ireland Constitution Act 1973” repealed (2.12.1999) by [1998 c. 47](#), [s. 100\(2\)](#), [Sch. 15](#) (with [s. 95](#))

#### Marginal Citations

- M4** 1938 c. 22.  
**M5** 1947 c. 40.  
**M6** 1947 c. 44.  
**M7** 1961 c. 31.  
**M8** 1977 c. 37.  
**M9** 1977 c. 50.  
**M10** 1978 c. 23.  
**M11** 1978 c. 33.  
**M12** 1981 c. 54.  
**M13** 1982 c. 27.  
**M14** 1983 c. 55.  
**M15** 1985 c. 6.  
**M16** 1989 c. 40.  
**M17** 1985 c. 73.  
**M18** 1986 c. 3.  
**M19** [S.I. 1986/1032 \(N.I. 6\)](#).  
**M20** [S.I. 1990/1504 \(N.I. 10\)](#).  
**M21** 1987 c. 43.  
**M22** [S.I. 1987/2049 \(N.I. 20\)](#).  
**M23** 1988 c. 1.  
**M24** 1992 c. 12.  
**M25** 1992 c. 53.

*Status: Point in time view as at 02/04/2007.*

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

*Patents and Designs Act 1907 (c.29)*

- 2 (1) The Patents and Designs Act 1907 is amended as follows.
- (2) In section 62 (the Patent Office)—
- (a) in subsection (1) for “this Act and the Trade Marks Act 1905” substitute “the Patents Act 1977, the Registered Designs Act 1949 and the Trade Marks Act 1994 ”; and
- (b) in subsections (2) and (3) for “the Board of Trade” substitute “ the Secretary of State ”.
- (3) In section 63 (officers and clerks of the Patent Office)—
- (a) for “the Board of Trade” in each place where it occurs substitute “ the Secretary of State ”; and
- (b) in subsection (2) omit the words from “and those salaries” to the end.
- (4) The repeal by the <sup>M26</sup>Patents Act 1949 and the <sup>M27</sup>Registered Designs Act 1949 of the whole of the 1907 Act, except certain provisions, shall be deemed not to have extended to the long title, date of enactment or enacting words or to so much of section 99 as provides the Act with its short title.

**Marginal Citations**

**M26** 1949 c. 87.

**M27** 1949 c. 88.

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

- 3 (1) The Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 is amended as follows.
- (2) For section 3 (power of comptroller to suspend rights of enemy or enemy subject) substitute—

**“3 Power of comptroller to suspend trade mark rights of enemy or enemy subject.**

- (1) Where on application made by a person proposing to supply goods or services of any description it is made to appear to the comptroller—
- (a) that it is difficult or impracticable to describe or refer to the goods or services without the use of a registered trade mark, and
- (b) that the proprietor of the registered trade mark (whether alone or jointly with another) is an enemy or an enemy subject,
- the comptroller may make an order suspending the rights given by the registered trade mark.
- (2) An order under this section shall suspend those rights as regards the use of the trade mark—
- (a) by the applicant, and
- (b) by any person authorised by the applicant to do, for the purposes of or in connection with the supply by the applicant of the goods or

---

*Status: Point in time view as at 02/04/2007.*

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

---

services, things which would otherwise infringe the registered trade mark,

to such extent and for such period as the comptroller considers necessary to enable the applicant to render well-known and established some other means of describing or referring to the goods or services in question which does not involve the use of the trade mark.

(3) Where an order has been made under this section, no action for passing off lies on the part of any person interested in the registered trade mark in respect of any use of it which by virtue of the order is not an infringement of the right conferred by it.

(4) An order under this section may be varied or revoked by a subsequent order made by the comptroller.”

(3) In each of the following provisions—

- (a) section 4(1)(c) (effect of war on registration of trade marks),
- (b) section 6(1) (power of comptroller to extend time limits),
- (c) section 7(1)(a) (evidence as to nationality, &c.), and
- (d) the definition of “the comptroller” in section 10(1) (interpretation),

for “the Trade Marks Act 1938” substitute “ the Trade Marks Act 1994 ”.

#### *Trade Descriptions Act 1968 (c.29)*

4 In the Trade Descriptions Act 1968, in section 34 (exemption of trade description contained in pre-1968 trade mark)—

- (a) in the opening words, omit “within the meaning of the Trade Marks Act 1938”; and
- (b) in paragraph (c), for “a person registered under section 28 of the Trade Marks Act 1938 as a registered user of the trade mark” substitute “, in the case of a registered trade mark, a person licensed to use it ”.

#### *Solicitors Act 1974 (c.47)*

5 (1) Section 22 of the Solicitors Act 1974 (preparation of instruments by unqualified persons) is amended as follows.

(2) In subsection (2)(aa) and (ab) (instruments which may be prepared by registered trade mark agent or registered patent agent) for “, trade mark or service mark” substitute “ or trade mark ”.

(3) In subsection (3A) (interpretation)—

- (a) in the definition of “registered trade mark agent” for “section 282(1) of the Copyright, Designs and Patents Act 1988” substitute “ the Trade Marks Act 1994 ”; and
- (b) in the definition of “registered patent agent” for “of that Act” substitute “ of the Copyright, Designs and Patents Act 1988 ”.

*Status: Point in time view as at 02/04/2007.*

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

*House of Commons Disqualification Act 1975 (c.24)*

PROSPECTIVE

- 6 In Part III of Schedule 1 to the House of Commons Disqualification Act 1975 (other disqualifying offices), for the entry relating to persons appointed to hear and determine appeals under the Trade Marks Act 1938 substitute— “ Person appointed to hear and determine appeals under the Trade Marks Act 1994. ”

*Restrictive Trade Practices Act 1976 (c.34)*

- 7 In Schedule 3 to the Restrictive Trade Practices Act 1976 (excepted agreements), for paragraph 4 (agreements relating to trade marks) substitute—
- “4 (1) This Act does not apply to an agreement authorising the use of a registered trade mark (other than a collective mark or certification mark) if no such restrictions as are described in section 6(1) or 11(2) above are accepted, and no such information provisions as are described in section 7(1) or 12(2) above are made, except in respect of—
- (a) the descriptions of goods bearing the mark which are to be produced or supplied, or the processes of manufacture to be applied to such goods or to goods to which the mark is to be applied, or
  - (b) the kinds of services in relation to which the mark is to be used which are to be made available or supplied, or the form or manner in which such services are to be made available or supplied, or
  - (c) the descriptions of goods which are to be produced or supplied in connection with the supply of services in relation to which the mark is to be used, or the process of manufacture to be applied to such goods.
- (2) This Act does not apply to an agreement authorising the use of a registered collective mark or certification mark if—
- (a) the agreement is made in accordance with regulations approved by the registrar under Schedule 1 or 2 to the Trade Marks Act 1994, and
  - (b) no such restrictions as are described in section 6(1) or 11(2) above are accepted, and no such information provisions as are described in section 7(1) or 12(2) above are made, except as permitted by those regulations.”.

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

- 8 (1) The Copyright, Designs and Patents Act 1988 is amended as follows.
- (2) In sections 114(6), 204(6) and 231(6) (persons regarded as having an interest in infringing copies, &c.), for “section 58C of the Trade Marks Act 1938” substitute “ section 19 of the Trade Marks Act 1994 ”.
- (3) In section 280(1) (privilege for communications with patent agents), for “trade mark or service mark” substitute “ or trade mark ”.

*Status: Point in time view as at 02/04/2007.*

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

*Tribunals and Inquiries Act 1992 (c.53)*

- 9 In Part I of Schedule 1 to the Tribunals and Inquiries Act 1992 (tribunals under direct supervision of Council on Tribunals), for “Patents, designs, trade marks and service marks” substitute “ Patents, designs and trade marks ”.

SCHEDULE 5

Section 106(2).

REPEALS AND REVOCATIONS

<b>Chapter or number</b>	<b>Short title</b>	<b>Extent of repeal or revocation</b>
1891 c. 50.	Commissioners for Oaths Act 1891.	In section 1, the words “or the Patents, Designs and Trade Marks Acts, 1883 to 1888,”.
1907 c. 29.	Patents and Designs Act 1907.	In section 63(2), the words from “and those salaries” to the end.
1938 c. 22.	Trade Marks Act 1938.	The whole Act.
1947 c. 44.	Crown Proceedings Act 1947.	In section 3(1)(b), the words “or registered service mark”.
1949 c. 87.	Patents Act 1949.	Section 92(2).
1964 c. 14.	Plant Varieties and Seeds Act 1964.	In section 5A(4), the words “under the Trade Marks Act 1938”.
1967 c. 80.	Criminal Justice Act 1967.	In Schedule 3, in Parts I and IV, the entries relating to the Trade Marks Act 1938.
1978 c. 23.	Judicature (Northern Ireland) Act 1978.	In Schedule 5, in Part II, the paragraphs amending the Trade Marks Act 1938.
1984 c. 19.	Trade Marks (Amendment) Act 1984.	The whole Act.
1985 c. 6.	Companies Act 1985.	In section 396— (a) in subsection (3A)(a), and (b) in subsection (2)(d)(i) as inserted by the Companies Act 1989, the words “service mark,”.
1986 c. 12.	Statute Law (Repeals) Act 1986.	In Schedule 2, paragraph 2.

---

*Status: Point in time view as at 02/04/2007.*

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

---

1986 c. 39.	Patents, Designs and Marks Act 1986.	Section 2.
		Section 4(4). In Schedule 1, paragraphs 1 and 2. Schedule 2.
S.I. 1986/1032 (N.I. 6).	Companies (Northern Ireland) Order 1986.	In article 403—  (a) in paragraph (3A)(a), and (b) in paragraph (2)(d)(i) as inserted by the Companies (No.2) (Northern Ireland) Order 1990, the words “service mark”.
1987 c. 43.	Consumer Protection Act 1987.	In section 45—  (a) in subsection (1), the definition of “mark” and “trade mark”; (b) subsection (4).
S.I. 1987/2049.	Consumer Protection (Northern Ireland) Order 1987.	In article 2—  (a) in paragraph (2), the definitions of “mark” and “trade mark”; (b) paragraph (3).
1988 c. 1.	Income and Corporation Taxes Act 1988.	In section 83, the words from “References in this section” to the end.
1988 c. 48.	Copyright, Designs and Patents Act 1988.	Sections 282 to 284.  In section 286, the definition of “registered trade mark agent”. Section 300.
1992 c. 12.	Taxation of Chargeable Gains Act 1992.	In section 275(h), the words “service marks” and “service mark”.

---

**Status:**

Point in time view as at 02/04/2007.

**Changes to legislation:**

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