



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

##### *Introductory*

#### **1 Trade marks**

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

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

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

#### **2 Registered trade marks**

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

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

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

#### **3 Absolute grounds for refusal of registration**

- (1) The following shall not be registered—

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

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

- (2) A sign shall not be registered as a trade mark if it consists exclusively of—
  - (a) the shape which results from the nature of the goods themselves,
  - (b) the shape of goods which is necessary to obtain a technical result, or
  - (c) the shape which gives substantial value to the goods.
- (3) A trade mark shall not be registered if it is—
  - (a) contrary to public policy or to accepted principles of morality, or
  - (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).
- (4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.
- (5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).
- (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

#### **4 Specially protected emblems**

- (1) A trade mark which consists of or contains—
  - (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,
  - (b) a representation of the Royal crown or any of the Royal flags,
  - (c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or
  - (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,
 shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.
- (2) A trade mark which consists of or contains a representation of—
  - (a) the national flag of the United Kingdom (commonly known as the Union Jack), or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man, shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.

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

- (3) A trade mark shall not be registered in the cases specified in—  
section 57 (national emblems, &c. of Convention countries), or  
section 58 (emblems, &c. of certain international organisations).
- (4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains—  
(a) arms to which a person is entitled by virtue of a grant of arms by the Crown, or  
(b) insignia so nearly resembling such arms as to be likely to be mistaken for them,

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

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

## **5 Relative grounds for refusal of registration**

- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- (2) A trade mark shall not be registered if because—  
(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or  
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,  
there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

- (3) A trade mark which—  
(a) is identical with or similar to an earlier trade mark, and  
(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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

- (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—  
(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or  
(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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

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

## **6 Meaning of “earlier trade mark”**

- (1) In this Act an “earlier trade mark” means—
- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
  - (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
  - (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.
- (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.
- (3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

## **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 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.

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

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

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

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

### *Effects of registered trade mark*

## **9 Rights conferred by registered trade mark**

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

The acts amounting to infringement, if done without the consent of the proprietor, are specified in section 10.
- (2) References in this Act to the infringement of a registered trade mark are to any such infringement of the rights of the proprietor.
- (3) The rights of the proprietor have effect from the date of registration (which in accordance with section 40(3) is the date of filing of the application for registration):

Provided that—

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- (a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
- (b) no offence under section 92 (unauthorised use of trade mark, &c. in relation to goods) is committed by anything done before the date of publication of the registration.

## **10 Infringement of registered trade mark**

- (1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.
- (2) A person infringes a registered trade mark if he uses in the course of trade a sign where because—
  - (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or
  - (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.
- (3) A person infringes a registered trade mark if he uses in the course of trade a sign which—
  - (a) is identical with or similar to the trade mark, and
  - (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.
- (4) For the purposes of this section a person uses a sign if, in particular, he—
  - (a) affixes it to goods or the packaging thereof;
  - (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
  - (c) imports or exports goods under the sign; or
  - (d) uses the sign on business papers or in advertising.
- (5) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.
- (6) Nothing in the preceding provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee.

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

## **11 Limits on effect of registered trade mark**

- (1) A registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered (but see section 47(6) (effect of declaration of invalidity of registration)).
- (2) A registered trade mark is not infringed by—
  - (a) the use by a person of his own name or address,
  - (b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services, or
  - (c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts),provided the use is in accordance with honest practices in industrial or commercial matters.
- (3) A registered trade mark is not infringed by the use in the course of trade in a particular locality of an earlier right which applies only in that locality.

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

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

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

## **12 Exhaustion of rights conferred by registered trade mark**

- (1) A registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market in the European Economic Area under that trade mark by the proprietor or with his consent.
- (2) Subsection (1) does not apply where there exist legitimate reasons for the proprietor to oppose further dealings in the goods (in particular, where the condition of the goods has been changed or impaired after they have been put on the market).

## **13 Registration subject to disclaimer or limitation**

- (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may—
  - (a) disclaim any right to the exclusive use of any specified element of the trade mark, or
  - (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

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

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

### *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.

#### **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.

#### **17 Meaning of “infringing goods, material or articles”**

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



- (2) Goods are “infringing goods”, in relation to a registered trade mark, if they or their packaging bear a sign identical or similar to that mark and—
  - (a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark, or
  - (b) the goods are proposed to be imported into the United Kingdom and the application of the sign in the United Kingdom to them or their packaging would be an infringement of the registered trade mark, or
  - (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.
- (3) Nothing in subsection (2) shall be construed as affecting the importation of goods which may lawfully be imported into the United Kingdom by virtue of an enforceable Community right.
- (4) Material is “infringing material”, in relation to a registered trade mark if it bears a sign identical or similar to that mark and either—
  - (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark, or
  - (b) it is intended to be so used and such use would infringe the registered trade mark.
- (5) “Infringing articles”, in relation to a registered trade mark, means articles—
  - (a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark, and
  - (b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.

## **18 Period after which remedy of delivery up not available**

- (1) An application for an order under section 16 (order for delivery up of infringing goods, material or articles) may not be made after the end of the period of six years from—
  - (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging,
  - (b) in the case of infringing material, the date on which the trade mark was applied to the material, or
  - (c) in the case of infringing articles, the date on which they were made,except as mentioned in the following provisions.
- (2) If during the whole or part of that period the proprietor of the registered trade mark—
  - (a) is under a disability, or
  - (b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.
- (3) In subsection (2) “disability”—
  - (a) in England and Wales, has the same meaning as in the Limitation Act 1980;

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- (b) in Scotland, means legal disability within the meaning of the Prescription and Limitation (Scotland) Act 1973;
- (c) in Northern Ireland, has the same meaning as in the Limitation (Northern Ireland) Order 1989.

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

- (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 16, an application may be made to the court—
  - (a) for an order that they be destroyed or forfeited to such person as the court may think fit, or
  - (b) for a decision that no such order should be made.
- (2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and protect their interests.
- (3) Provision shall be made by rules of court as to the service of notice on persons having an interest in the goods, material or articles, and any such person is entitled—
  - (a) to appear in proceedings for an order under this section, whether or not he was served with notice, and
  - (b) to appeal against any order made, whether or not he appeared;and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.
- (4) Where there is more than one person interested in the goods, material or articles, the court shall make such order as it thinks just.
- (5) If the court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up is entitled to their return.
- (6) References in this section to a person having an interest in goods, material or articles include any person in whose favour an order could be made under this section or under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988 (which make similar provision in relation to infringement of copyright, rights in performances and design right).

## **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.

## **21 Remedy for groundless threats of infringement proceedings**

- (1) Where a person threatens another with proceedings for infringement of a registered trade mark other than—
  - (a) the application of the mark to goods or their packaging,
  - (b) the importation of goods to which, or to the packaging of which, the mark has been applied, or
  - (c) the supply of services under the mark,any person aggrieved may bring proceedings for relief under this section.
- (2) The relief which may be applied for is any of the following—
  - (a) a declaration that the threats are unjustifiable,
  - (b) an injunction against the continuance of the threats,
  - (c) damages in respect of any loss he has sustained by the threats;and the plaintiff is entitled to such relief unless the defendant shows that the acts in respect of which proceedings were threatened constitute (or if done would constitute) an infringement of the registered trade mark concerned.
- (3) If that is shown by the defendant, the plaintiff is nevertheless entitled to relief if he shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.
- (4) The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

### *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).

## **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).

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- (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.

## **24 Assignment, &c. of registered trade mark**

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

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

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

- (a) in relation to some but not all of the goods or services for which the trade mark is registered, or
- (b) in relation to use of the trade mark in a particular manner or a particular locality.

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

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

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

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

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

## **25 Registration of transactions affecting registered trade mark**

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

- (a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction, or
  - (b) any other person claiming to be affected by such a transaction,
- the prescribed particulars of the transaction shall be entered in the register.

- (2) The following are registrable transactions—

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

- (b) the grant of a licence under a registered trade mark;
  - (c) the granting of any security interest (whether fixed or floating) over a registered trade mark or any right in or under it;
  - (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it;
  - (e) an order of a court or other competent authority transferring a registered trade mark or any right in or under it.
- (3) Until an application has been made for registration of the prescribed particulars of a registrable transaction—
- (a) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it, and
  - (b) a person claiming to be a licensee by virtue of the transaction does not have the protection of section 30 or 31 (rights and remedies of licensee in relation to infringement).
- (4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, then unless—
- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date, or
  - (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,
- he is not entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the prescribed particulars of the transaction are registered.
- (5) Provision may be made by rules as to—
- (a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence, and
  - (b) the removal of such particulars from the register—
    - (i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired, or
    - (ii) where no such period is indicated and, after such period as may be prescribed, the registrar has notified the parties of his intention to remove the particulars from the register.
- (6) Provision may also be made by rules as to the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.

## **26 Trusts and equities**

- (1) No notice of any trust (express, implied or constructive) shall be entered in the register; and the registrar shall not be affected by any such notice.
- (2) Subject to the provisions of this Act, equities (in Scotland, rights) in respect of a registered trade mark may be enforced in like manner as in respect of other personal or moveable property.

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

- (1) The provisions of sections 22 to 26 (which relate to a registered trade mark as an object of property) apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark.
- (2) In section 23 (co-ownership of registered trade mark) as it applies in relation to an application for registration the reference in subsection (1) to the granting of the registration shall be construed as a reference to the making of the application.
- (3) In section 25 (registration of transactions affecting registered trade marks) as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the registrar of those particulars.

*Licensing***28 Licensing of registered trade mark**

- (1) A licence to use a registered trade mark may be general or limited.  
A limited licence may, in particular, apply—
  - (a) in relation to some but not all of the goods or services for which the trade mark is registered, or
  - (b) in relation to use of the trade mark in a particular manner or a particular locality.
- (2) A licence is not effective unless it is in writing signed by or on behalf of the grantor.  
Except in Scotland, this requirement may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.
- (3) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest.  
References in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.
- (4) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

**29 Exclusive licences**

- (1) In this Act an “exclusive licence” means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence.  
The expression “exclusive licensee” shall be construed accordingly.
- (2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

### **30 General provisions as to rights of licensees in case of infringement**

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

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

- (2) A licensee is entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.
- (3) If the proprietor—
- (a) refuses to do so, or
  - (b) fails to do so within two months after being called upon,
- the licensee may bring the proceedings in his own name as if he were the proprietor.

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

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

- (5) A proprietor who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.
- (6) In infringement proceedings brought by the proprietor of a registered trade mark any loss suffered or likely to be suffered by licensees shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of licensees.
- (7) The provisions of this section apply in relation to an exclusive licensee if or to the extent that he has, by virtue of section 31(1), the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

### **31 Exclusive licensee having rights and remedies of assignee**

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

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

- (2) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.
- (3) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

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

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

- (5) A person who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.
- (6) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action—
- (a) the court shall in assessing damages take into account—
    - (i) the terms of the licence, and
    - (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;
  - (b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and
  - (c) the court shall if an account of profits is directed apportion the profits between them as the court considers just, subject to any agreement between them.

The provisions of this subsection apply whether or not the proprietor and the exclusive licensee are both parties to the action; and if they are not both parties the court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

- (7) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 16 (order for delivery up); and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.
- (8) The provisions of subsections (4) to (7) above have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

#### *Application for registered trade mark*

### **32 Application for registration**

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



- (3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.
- (4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.

### **33 Date of filing**

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

If the documents are furnished on different days, the date of filing is the last of those days.
- (2) References in this Act to the date of application for registration are to the date of filing of the application.

### **34 Classification of trade marks**

- (1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.
- (2) Any question arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final.

### *Priority*

### **35 Claim to priority of Convention application**

- (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.
- (2) If the application for registration under this Act is made within that six-month period—
  - (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and
  - (b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.
- (3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

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

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- (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.

### **36 Claim to priority from other relevant overseas application**

- (1) Her Majesty may by Order in Council make provision for conferring on a person who has duly filed an application for protection of a trade mark in—
- (a) any of the Channel Islands or a colony, or
  - (b) a country or territory in relation to which Her Majesty’s Government in the United Kingdom have entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks,
- a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.
- (2) An Order in Council under this section may make provision corresponding to that made by section 35 in relation to Convention countries or such other provision as appears to Her Majesty to be appropriate.
- (3) A statutory instrument containing an Order in Council under this section shall be subject to annulment in pursuance of a resolution of either House of Parliament.

#### *Registration procedure*

### **37 Examination of application**

- (1) The registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act (including any requirements imposed by rules).
- (2) For that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.
- (3) If it appears to the registrar that the requirements for registration are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to amend the application.

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

### **38 Publication, opposition proceedings and observations**

- (1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.
- (2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

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

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

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

### **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.

### **40 Registration**

- (1) Where an application has been accepted and—
  - (a) no notice of opposition is given within the period referred to in section 38(2), or
  - (b) all opposition proceedings are withdrawn or decided in favour of the applicant,

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

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

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

- (3) A trade mark when registered shall be registered as of the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.
- (4) On the registration of a trade mark the registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.

#### **41 Registration: supplementary provisions**

- (1) Provision may be made by rules as to—
- (a) the division of an application for the registration of a trade mark into several applications;
  - (b) the merging of separate applications or registrations;
  - (c) the registration of a series of trade marks.
- (2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.
- (3) Rules under this section may include provision as to—
- (a) the circumstances in which, and conditions subject to which, division, merger or registration of a series is permitted, and
  - (b) the purposes for which an application to which the rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.

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

#### **42 Duration of registration**

- (1) A trade mark shall be registered for a period of ten years from the date of registration.
- (2) Registration may be renewed in accordance with section 43 for further periods of ten years.

#### **43 Renewal of registration**

- (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of a renewal fee.
- (2) Provision shall be made by rules for the registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

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

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

- (4) Renewal shall take effect from the expiry of the previous registration.
- (5) If the registration is not renewed in accordance with the above provisions, the registrar shall remove the trade mark from the register.

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

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

#### **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.

#### *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.

#### **46 Revocation of registration**

- (1) The registration of a trade mark may be revoked on any of the following grounds—
- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
  - (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

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- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
  - (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- (2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:
- 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.

#### **47 Grounds for invalidity of registration**

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

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

- (2) The registration of a trade mark may be declared invalid on the ground—
- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,  
unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
- (3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—
- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.
- (4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.
- (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.
- (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:
- Provided that this shall not affect transactions past and closed.

#### **48 Effect of acquiescence**

- (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right—
- (a) to apply for a declaration that the registration of the later trade mark is invalid, or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,
- unless the registration of the later trade mark was applied for in bad faith.
- (2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

#### *Collective marks*

#### **49 Collective marks**

- (1) A collective mark is a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.
- (2) The provisions of this Act apply to collective marks subject to the provisions of Schedule 1.

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### *Certification marks*

#### **50 Certification marks**

- (1) A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.
- (2) The provisions of this Act apply to certification marks subject to the provisions of Schedule 2.