



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

##### *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 [F<sup>1</sup>subsections (1) to (3) of] section 10.

[F<sup>2</sup>(1A) See subsection (3B) of section 10 for provision about certain other acts amounting to infringement of a registered trade mark.

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

- (2) References in this Act to the infringement of a registered trade mark are to any <sup>F<sup>3</sup></sup>... infringement of the rights of the proprietor [F<sup>4</sup>such as is mentioned in subsection (1) or (1A)].

- (3) The rights of the proprietor have effect from the date of registration (which in accordance with section 40(3) is the date of filing of the application for registration): Provided that—

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

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

### Textual Amendments

- F1** Words in s. 9(1) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(2)** (with Pt. 5)
- F2** S. 9(1A)(1B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(3)** (with Pt. 5)
- F3** Word in s. 9(2) omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(4)(a)** (with Pt. 5)
- F4** Words in s. 9(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **9(4)(b)** (with Pt. 5)

## 10 Infringement of registered trade mark.

- (1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.
- (2) A person infringes a registered trade mark if he uses in the course of trade a sign where because—
- 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
  - 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<sup>F5</sup>, in relation to goods or services,] a sign which—
- is identical with or similar to the trade mark,<sup>F6</sup> ...
  - <sup>F6</sup>(b) .....
- where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.
- <sup>F7</sup>(3A) Subsection (3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered.
- (3B) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of the trade mark, a person infringes a registered trade mark if the person carries out in the course of trade any of the following acts—
- affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed; or
  - offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.]
- (4) For the purposes of this section a person uses a sign if, in particular, he—

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- (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;<sup>F8</sup> ...
- [<sup>F9</sup>(ca) uses the sign as a trade or company name or part of a trade or company name;]
- (d) uses the sign on business papers [<sup>F10</sup>and] in advertising[<sup>F11</sup>; or]
- [<sup>F12</sup>(e) uses the sign in comparative advertising in a manner that is contrary to the Business Protection from Misleading Marketing Regulations 2008.]

<sup>F13</sup>(5) .....

<sup>F13</sup>(6) .....

#### Textual Amendments

- F5** Words in s. 10(3) inserted (5.5.2004) by Trade Marks (Proof of Use, etc.) Regulations 2004 (S.I. 2004/946), regs. 1, **7(2)(a)**
- F6** S. 10(3)(b) and preceding word omitted (5.5.2004) by virtue of Trade Marks (Proof of Use, etc.) Regulations 2004 (S.I. 2004/946), regs. 1, **7(2)(b)**
- F7** S. 10(3A)(3B) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(2)** (with Pt. 5)
- F8** Word in s. 10(4)(c) omitted (14.1.2019) by virtue of The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(3)** (with Pt. 5)
- F9** S. 10(4)(ca) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(4)** (with Pt. 5)
- F10** Word in s. 10(4)(d) substituted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(5)(a)** (with Pt. 5)
- F11** Word in s. 10(4)(d) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(5)(b)** (with Pt. 5)
- F12** S. 10(4)(e) inserted (14.1.2019) by The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(6)** (with Pt. 5)
- F13** S. 10(5)(6) omitted (14.1.2019) by virtue of The Trade Marks Regulations 2018 (S.I. 2018/825), regs. 1(1), **10(7)** (with Pt. 5)

#### [<sup>F14</sup>10A Right to prevent goods entering the UK without being released for free circulation

- (1) The proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into the United Kingdom in the course of trade without being released for free circulation if they are goods for which the trade mark is registered which—
  - (a) come from outside the customs territory of the [<sup>F15</sup>United Kingdom]; and
  - (b) bear without authorisation a sign which is identical with the trade mark or cannot be distinguished in its essential aspects from the trade mark.
- (2) In subsection (1) the reference to goods for which the trade mark is registered includes a reference to the packaging of goods for which the trade mark is registered.
- (3) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of application for registration of the trade mark, or (where applicable) the date of the priority claimed in respect of that application.
- (4) The entitlement of the proprietor under subsection (1) is to lapse if—

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- (a) proceedings are initiated in accordance with the European Customs Enforcement Regulation to determine whether the trade mark has been infringed; and
  - (b) during those proceedings evidence is provided by the declarant or the holder of the goods that the proprietor of the trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.
- (5) References in this Act to the “European Customs Enforcement Regulation” are references to Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights [<sup>F16</sup>as amended from time to time].

#### Textual Amendments

- F14** Ss. 10A, 10B inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), [11](#) (with Pt. 5)
- F15** Word in s. 10A(1)(a) substituted (31.12.2020) by [The Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/269\)](#), reg. 1(1), [Sch. 3 para. 6\(2\)](#) (with Sch. 5 para. 7(1)(1A), 8) (as amended by [S.I. 2020/1637](#), regs. 1(6), [3](#), [S.I. 2020/1661](#), regs. 1(2)(b), [12](#), [16\(2\)](#) and (26.11.2021) by [S.I. 2021/1235](#), regs. 3, 4); 2020 c. 1, [Sch. 5 para. 1\(1\)](#))
- F16** Words in s. 10A(5) inserted (31.12.2020) by [The Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/269\)](#), reg. 1(1), [Sch. 3 para. 6\(3\)](#) (with Sch. 5 para. 7(1)(1A), 8) (as amended by [S.I. 2020/1637](#), regs. 1(6), [3](#), [S.I. 2020/1661](#), regs. 1(2)(b), [12](#), [16\(2\)](#) and (26.11.2021) by [S.I. 2021/1235](#), regs. 3, 4); 2020 c. 1, [Sch. 5 para. 1\(1\)](#))

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

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

#### Textual Amendments

- F14** Ss. 10A, 10B inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), [11](#) (with Pt. 5)

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

- (1) A registered trade mark is not infringed by the use of [<sup>F17</sup>a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1)].

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<sup>F18</sup><sup>F19</sup>(1A) .....

(1B) Where subsection (1) <sup>F20</sup>... applies, the later registered trade mark is not infringed by the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later registered trade mark.]

(2) A registered trade mark is not infringed by—

- (a) the use by <sup>F21</sup>[an individual] of his own name or address,
- (b) the use of <sup>F22</sup>[signs or indications which are not distinctive or which concern] the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services, or
- (c) the use of the trade mark <sup>F23</sup>[for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use] is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts),

provided the use is in accordance with honest practices in industrial or commercial matters.

(3) A registered trade mark is not infringed by the use in the course of trade in a particular locality of an earlier right which applies only in that locality.

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

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

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

#### Textual Amendments

**F17** Words in s. 11(1) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(2)** (with Pt. 5)

**F18** S. 11(1A) omitted (31.12.2020) by virtue of [The Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/269\)](#), reg. 1(1), **Sch. 3 para. 7(2)** (with Sch. 5 para. 7(1)(A), 8) (as amended by S.I. 2020/1637, regs. 1(6), **3**, S.I. 2020/1661, regs. 1(2)(b), **12**, 16(2) and (26.11.2021) by S.I. 2021/1235, regs. 3, **4**); 2020 c. 1, **Sch. 5 para. 1(1)**

**F19** S. 11(1A)(1B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(3)** (with Pt. 5)

**F20** Words in s. 11(1B) omitted (31.12.2020) by virtue of [The Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/269\)](#), reg. 1(1), **Sch. 3 para. 7(3)** (with Sch. 5 para. 7(1)(A), 8) (as amended by S.I. 2020/1637, regs. 1(6), **3**, S.I. 2020/1661, regs. 1(2)(b), **12**, 16(2) and (26.11.2021) by S.I. 2021/1235, regs. 3, **4**); 2020 c. 1, **Sch. 5 para. 1(1)**

**F21** Words in s. 11(2)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(4)** (with Pt. 5)

**F22** Words in s. 11(2)(b) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(5)** (with Pt. 5)

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**F23** Words in s. 11(2)(c) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **12(6)** (with Pt. 5)

## [<sup>F24</sup>11A Non-use as defence in infringement proceedings

- (1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1)(a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.
- (2) Subsection (3) applies in relation to an action for infringement of a registered trade mark where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought.
- (3) If the defendant so requests, the proprietor of the trade mark must furnish proof—
  - (a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in the United Kingdom by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action, or
  - (b) that there are proper reasons for non-use.
- (4) Nothing in subsections (2) and (3) overrides any provision of section 46, as applied by subsection (1) (including the words from “Provided that” to the end of subsection (3)).]

### Textual Amendments

**F24** S. 11A inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **13** (with Pt. 5)

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

- (1) A registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market in [<sup>F25</sup>the United Kingdom or] 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).

### Textual Amendments

**F25** Words in s. 12(1) inserted (31.12.2020) by [The Intellectual Property \(Exhaustion of Rights\) \(EU Exit\) Regulations 2019 \(S.I. 2019/265\)](#), regs. 1, **5(2)**; 2020 c. 1, Sch. 5 para. 1(1)

## 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

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(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

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

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

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**Commencement Information**

- II** S. 13 wholly in force at 31.10.1994; s. 13 not in force at Royal Assent see s. 109; s. 13(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 13 not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

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Effects of registered trade mark.