



Trade Marks Act 1994

1994 CHAPTER 26

PART I

REGISTERED TRADE MARKS

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).
- (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.

Status: This is the original version (as it was originally enacted).

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.

Status: This is the original version (as it was originally enacted).

- (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.