



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

##### *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) [<sup>F1</sup>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.

#### **Textual Amendments**

- F1** S. 37(2) ceases to have effect (1.10.2007) by virtue of [Trade Marks \(Relative Grounds\) Order 2007 \(S.I. 2007/1976\)](#), arts. 1, 3 (with art. 6)

*Status: Point in time view as at 14/01/2019.*

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

### 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.

[<sup>F2</sup>(2A) Where a notice of opposition is filed on the basis of one or more earlier trade marks or other earlier rights—

- (a) the rights (if plural) must all belong to the same proprietor;
- (b) the notice may be filed on the basis of part, or the totality, of the goods or services in respect of which the earlier right is protected or applied for.

(2B) A notice of opposition may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.]

- (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.

#### Textual Amendments

**F2** S. 38(2A)(2B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), 19(2) (with Pt. 5)

#### Commencement Information

**II** S. 38 wholly in force at 31.10.1994; s. 38 not in force at Royal Assent see s. 109; s. 38(1)(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 38 not already in force by [S.I. 1994/2550](#), art. 2, 3(1), [Sch.](#)

### 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.

*Status: Point in time view as at 14/01/2019.*

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- (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.

#### Commencement Information

- I2** S. 39 wholly in force at 31.10.1994; s. 39 not in force at Royal Assent see s. 109; s. 39(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 39 not already in force by [S.I. 1994/2550](#), [arts. 2, 3\(1\)](#), [Sch.](#)

### 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, the registrar shall register the trade mark, unless it appears to him having regard to matters coming to his notice [<sup>F3</sup>since the application was accepted that the registration requirements (other than those mentioned in section 5(1), (2) or (3)) were not met at that time.]
- (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.

#### Textual Amendments

- F3** Words in s. 40(1) substituted (5.5.2004) by [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), [regs. 1, 5](#) (with [reg. 8](#))

#### Commencement Information

- I3** S. 40 wholly in force at 31.10.1994; s. 40 not in force at Royal Assent see s. 109; s. 40(4) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 40 not already in force by [S.I. 1994/2550](#), [arts. 2, 3\(1\)](#), [Sch.](#)

### 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;

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- [<sup>F4</sup>(aa) the division of a registration of a trade mark into several registrations;]
  - (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 [<sup>F5</sup>or registration] to which the rules apply is to be treated as a single application [<sup>F5</sup>or registration] and those for which it is to be treated as a number of separate applications [<sup>F5</sup>or registrations].

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#### **Textual Amendments**

- F4** S. 41(1)(aa) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **20(2)** (with Pt. 5)
- F5** Words in s. 41(3)(b) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **20(3)** (with Pt. 5)
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#### **Commencement Information**

- I4** S. 41 wholly in force at 31.10.1994; s. 41 not in force at Royal Assent see s. 109; s. 41(1)(3) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 41 not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

**Status:**

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**Changes to legislation:**

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Registration procedure.