



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

##### *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.

#### **Commencement Information**

- II** S. 45 wholly in force at 31.10.1994; s. 45 not in force at Royal Assent see s. 109; s. 45(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 45 not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

#### **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 [<sup>F1</sup>(the “variant form”)] differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [<sup>F2</sup>(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)], 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.

#### Textual Amendments

- F1** Words in s. 46(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **22(a)** (with Pt. 5)
- F2** Words in s. 46(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **22(b)** (with Pt. 5)

#### Modifications etc. (not altering text)

- C1** S. 46 applied (with modifications) (1.4.1996) by [S.I. 1996/714](#), **art. 13**  
S. 46 applied (with modifications) (14.8.1996) by [S.I. 1996/1908](#), **reg. 3(3)**
- C2** S. 46(1)(a)(b) modified (20.5.2016) by [The Standardised Packaging of Tobacco Products Regulations 2015 \(S.I. 2015/829\)](#), regs. 1(2), **13(7)(8)** (with regs. 13(9), 14(5), 20)

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#### 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) [<sup>F3</sup>Subject to subsections (2A) and (2G),] 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.

- [<sup>F4</sup>(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).]

- [<sup>F5</sup>(2A) <sup>F6</sup>... The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

- ( 2B ) The use conditions are met if—

- [<sup>F7</sup>(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—

- (i) within the period of 5 years ending with the date of application for the declaration, and
- (ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or]

- (b) it has not been so used, but there are proper reasons for non-use.

- (2C) For these purposes—

- (a) use of a trade mark includes use in a form [<sup>F8</sup>(the “variant form”)] differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [<sup>F9</sup>(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)], and
- (b) 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.

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<sup>F10</sup>(2D) .....

<sup>F11</sup>(2DA) .....

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.]

[<sup>F12</sup>(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).]

[<sup>F13</sup>(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));
- (b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);
- (c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).]

(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.

[<sup>F14</sup>(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.]

(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.

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### Textual Amendments

- F3** Words in s. 47(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(2)** (with Pt. 5)
- F4** S. 47(2ZA) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(3)** (with Pt. 5)
- F5** S. 47(2A)-(2E) inserted (5.5.2004) by [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, **6** (with reg. 9)
- F6** Word in s. 47(2A) omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(4)** (with Pt. 5)
- F7** S. 47(2B)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(5)** (with Pt. 5)
- F8** Words in s. 47(2C)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(6)(a)** (with Pt. 5)
- F9** Words in s. 47(2C)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(6)(b)** (with Pt. 5)
- F10** S. 47(2D) 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. 9** (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)**)
- F11** S. 47(2DA) 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. 9** (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)**)
- F12** S. 47(2F) inserted (10.5.2008) by [Trade Marks \(Earlier Trade Marks\) Regulations 2008 \(S.I. 2008/1067\)](#), regs. 1, **5(3)** (with regs. 7, 8)
- F13** S. 47(2G)(2H) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(8)** (with Pt. 5)
- F14** S. 47(5A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(9)** (with Pt. 5)

### Modifications etc. (not altering text)

- C3** S. 47 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 13**  
S. 47 applied (with modifications) (14.8.1996) by S.I. 1908, reg. 3(3)
- C4** S. 47(2B) modified (20.5.2016) by [The Standardised Packaging of Tobacco Products Regulations 2015 \(S.I. 2015/829\)](#), regs. 1(2), **13(5)(b)(6)** (with regs. 13(9), 14(5), 20)
- C5** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 1151/2012, Art. 14b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 18, **Sch. 2 Pt. 3**)
- C6** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 251/2014, Art. 19b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 21, **Sch. 4 Pt. 3**)
- C7** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 33/2019, Art. 32b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 26(31), **Sch. 8 Pt. 3**)
- C8** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) 2019/787, Art. 36b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1661\)](#), reg. 1(3), **Sch. 5 Pt. 2**)
- C9** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 1308/2013, Art. 102b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 20, **Sch. 3 Pt. 2**)

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#### **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.

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**Modifications etc. (not altering text)**

**C10** S. 48 applied (1.4.1996) by [S.I. 1996/714](#), [art. 14](#)

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**Changes to legislation:**

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