



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART II

#### COMMUNITY TRADE MARKS AND INTERNATIONAL MATTERS

##### *Community trade marks*

#### **51 Meaning of “Community trade mark”.**

In this Act—

“Community trade mark” has the meaning given by Article 1(1) of the Community Trade Mark Regulation; and

“the Community Trade Mark Regulation” means <sup>M1</sup>Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community trade mark.

#### **Marginal Citations**

**M1** O.J. No. L11, 14.1.94, p.1.

#### **52 Power to make provision in connection with Community Trade Mark Regulation.**

- (1) The Secretary of State may by regulations make such provision as he considers appropriate in connection with the operation of the Community Trade Mark Regulation.
- (2) Provision may, in particular, be made with respect to—
  - (a) the making of applications for Community trade marks by way of the Patent Office;
  - (b) the procedures for determining *a posteriori* the invalidity, or liability to revocation, of the registration of a trade mark from which a Community trade mark claims seniority;

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- (c) the conversion of a Community trade mark, or an application for a Community trade mark, into an application for registration under this Act;
  - (d) the designation of courts in the United Kingdom having jurisdiction over proceedings arising out of the Community Trade Mark Regulation.
- (3) Without prejudice to the generality of subsection (1), provision may be made by regulations under this section—
- (a) applying in relation to a Community trade mark the provisions of—
    - (i) section 21 (remedy for groundless threats of infringement proceedings);
    - (ii) sections 89 to 91 (importation of infringing goods, material or articles); and
    - (iii) sections 92, 93, 95 and 96 (offences); and
  - (b) making in relation to the list of professional representatives maintained in pursuance of Article 89 of the Community Trade Mark Regulation, and persons on that list, provision corresponding to that made by, or capable of being made under, sections 84 to 88 in relation to the register of [<sup>F1</sup>trade mark attorneys and registered trade mark attorneys].
- (4) Regulations under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

**Subordinate Legislation Made**

**P1** S. 52 power fully exercised (23.7.1996): 14.8.1996 appointed day by [S.I. 1996/1908](#)

**Textual Amendments**

**F1** Words in s. 52(3)(b) substituted (1.1.2010) by [Legal Services Act 2007 \(c. 29\)](#), s. 211(2), [Sch. 21 para. 110](#) (with [ss. 29, 192, 193](#)); [S.I. 2009/3250](#), art. 2(h)

*The Madrid Protocol: international registration*

**53 The Madrid Protocol.**

In this Act—

“the Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989;

“the International Bureau” has the meaning given by Article 2(1) of that Protocol; and

[<sup>F2</sup> “international trade mark ( EC )” means a trade mark which is entitled to protection in the European Community under that Protocol; ]

“international trade mark (UK)” means a trade mark which is entitled to protection in the United Kingdom under that Protocol.

**Textual Amendments**

**F2** Words in s. 53 inserted (1.10.2004) by [Trade Marks \(International Registrations Designating the European Community, etc.\) Regulations 2004 \(S.I. 2004/2332\)](#), regs. 1(2), 5

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## **54 Power to make provision giving effect to Madrid Protocol.**

- (1) The Secretary of State may by order make such provision as he thinks fit for giving effect in the United Kingdom to the provisions of the Madrid Protocol.
- (2) Provision may, in particular, be made with respect to—
  - (a) the making of applications for international registrations by way of the Patent Office as office of origin;
  - (b) the procedures to be followed where the basic United Kingdom application or registration fails or ceases to be in force;
  - (c) the procedures to be followed where the Patent Office receives from the International Bureau a request for extension of protection to the United Kingdom;
  - (d) the effects of a successful request for extension of protection to the United Kingdom;
  - (e) the transformation of an application for an international registration, or an international registration, into a national application for registration;
  - (f) the communication of information to the International Bureau;
  - (g) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.
- (3) Without prejudice to the generality of subsection (1), provision may be made by regulations under this section applying in relation to an international trade mark (UK) the provisions of—
  - (a) section 21 (remedy for groundless threats of infringement proceedings);
  - (b) sections 89 to 91 (importation of infringing goods, material or articles); and
  - (c) sections 92, 93, 95 and 96 (offences).
- (4) An order under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

*The Paris Convention: supplementary provisions*

## **55 The Paris Convention.**

- (1) In this Act—
  - (a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,<sup>F3</sup> . . .
  - <sup>F4</sup>(aa) “the WTO agreement” means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994<sup>F5</sup>, and ]
  - (b) a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention [<sup>F6</sup>or to that Agreement].
- (2) The Secretary of State may by order make such amendments of this Act, and rules made under this Act, as appear to him appropriate in consequence of any revision or amendment of the Paris Convention [<sup>F7</sup>or the WTO agreement] after the passing of this Act.
- (3) Any such order shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

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#### Textual Amendments

- F3** Word in s. 55(1) omitted (29.7.1999) by virtue of S.I. 1999/1899, **reg. 13(2)**
- F4** S. 55(1)(aa) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(2)**
- F5** Cm. 2556–59, 2561–2, 2564–69, 2571–74. The Agreement Establishing the World Trade Organisation was declared a Community Treaty as defined in section 1(2) of the European Communities Act 1972 by S.I. 1995/265.
- F6** Words in s. 55(1)(b) inserted (29.4.2006) by Intellectual Property (Enforcement, etc) Regulations 2006 (S.I. 2006/1028), **art. 1, Sch. 2 para. 18**
- F7** Words in s. 55(2) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(3)**

### 56 Protection of well-known trade marks: Article 6bis.

- (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention [<sup>F8</sup>or the WTO agreement] as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who—

- (a) is a national of a Convention country, or  
(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

- (2) The proprietor of a trade mark which is entitled to protection under the Paris Convention [<sup>F8</sup>or the WTO agreement] as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

- (3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

#### Textual Amendments

- F8** Words in s. 56(1)(2) inserted (29.7.1999) by S.I. 1999/1899, **reg. 13(4)** (with **reg. 14(1)**)

### 57 National emblems, &c. of Convention countries: Article 6ter.

- (1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorisation.

- (2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention [<sup>F9</sup>or the WTO agreement] shall not be registered without the authorisation of the competent authorities of that country.

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- (3) A trade mark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention [<sup>F9</sup>or the WTO agreement], be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.
- (4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.
- (5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.
- (6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use of the mark in the United Kingdom without their authorisation.

#### Textual Amendments

**F9** Words in s. 57(2)(3) inserted (29.7.1999) by S.I. 1999/1899, reg. 13(5)

### 58 Emblems, &c. of certain international organisations: Article 6ter.

- (1) This section applies to—
  - (a) the armorial bearings, flags or other emblems, and
  - (b) the abbreviations and names,of international intergovernmental organisations of which one or more Convention countries are members.
- (2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention [<sup>F10</sup>or the WTO agreement] shall not be registered without the authorisation of the international organisation concerned, unless it appears to the registrar that the use of the emblem, abbreviation or name in the manner proposed—
  - (a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark, or
  - (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.
- (3) The provisions of this section as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.
- (4) Where by virtue of this section the authorisation of an international organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain by injunction any use of the mark in the United Kingdom without its authorisation.
- (5) Nothing in this section affects the rights of a person whose *bona fide* use of the trade mark in question began before 4th January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom).

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#### Textual Amendments

**F10** Words in s. 58(2) inserted (29.7.1999) by S.I. 1999/1899, reg. 13(6) (with art. 14(2))

### 59 Notification under Article 6ter of the Convention.

- (1) For the purposes of section 57 state emblems of a Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that—
  - (a) the country in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, sign or hallmark,
  - (b) the notification remains in force, and
  - (c) the United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.
- (2) For the purposes of section 58 the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—
  - (a) the organisation in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, abbreviation or name,
  - (b) the notification remains in force, and
  - (c) the United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.
- (3) Notification under Article 6ter(3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.
- (4) The registrar shall keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of—
  - (a) the state emblems and official signs or hallmarks, and
  - (b) the emblems, abbreviations and names of international organisations,
 which are for the time being protected under the Paris Convention by virtue of notification under Article 6ter(3).
- [<sup>F11</sup>(5) Any reference in this section to Article 6ter of the Paris Convention shall be construed as including a reference to that Article as applied by the WTO agreement]

#### Textual Amendments

**F11** S. 59(5) inserted (29.7.1999) by S.I. 1999/1899, reg. 13(7)

### 60 Acts of agent or representative: Article 6septies.

- (1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.
- (2) If the proprietor opposes the application, registration shall be refused.

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- (3) If the application (not being so opposed) is granted, the proprietor may—
  - (a) apply for a declaration of the invalidity of the registration, or
  - (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.
- (4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in the United Kingdom which is not authorised by him.
- (5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.
- (6) An application under subsection (3)(a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

*Miscellaneous*

<sup>F12</sup>61 .....

**Textual Amendments**

**F12** S. 61 repealed (28.7.2000 with effect as mentioned in Sch. 40 Pt. III Note 1 of the amending Act) by 2000 c. 17, s. 156, **Sch. 40 Pt. III**

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