



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART II

#### [<sup>F1</sup>EUROPEAN UNION] TRADE MARKS AND INTERNATIONAL MATTERS

##### Textual Amendments

- F1** Words in Pt. II heading substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), regs. 1(1), 3 (with reg. 13)

#### *[<sup>F2</sup>European Union] trade marks*

##### Textual Amendments

- F2** Words in s. 51 cross-heading substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), regs. 1(1), 3 (with reg. 13)

#### [<sup>F3</sup>51. Meaning of “European Union trade mark”

In this Act—

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

“the European Union Trade Mark Regulation” means [<sup>F4</sup>Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark [<sup>F5</sup>(as it had effect immediately before IP completion day)].]

##### Textual Amendments

- F3** S. 51 substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), regs. 1(1), 4 (with reg. 13)

*Status: Point in time view as at 31/12/2020.*

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

- F4** Words in s. 51 substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **26** (with Pt. 5)
- F5** Words in s. 51 inserted (31.12.2020) by [The Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/269\)](#), reg. 1(1), **Sch. 3 para. 10** (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 S.I. 2020/1050, regs. 1(2), **10(c)** and (26.11.2021) by S.I. 2021/1235, regs. 3, 4); 2020 c. 1, **Sch. 5 para. 1(1)**

<sup>F7</sup>**52 Power to make provision in connection with [<sup>F6</sup>European Union] Trade Mark Regulation.**

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**Textual Amendments**

- F6** Words in s. 52 heading substituted (6.4.2016) by [The European Union Trade Mark Regulations 2016 \(S.I. 2016/299\)](#), regs. 1(1), **5(2)** (with regs. 13, 14)
- F7** S. 52 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. 11** (with Sch. 5 para. 7, 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)**

<sup>F8</sup>**52A Certain trade marks registered as European Union trade marks to be treated as registered trade marks**

Schedule 2A makes provision for European Union trade marks (including certain expired and removed marks) to be treated as registered trade marks with effect from IP completion day and about certain applications for a European Union trade mark made before IP completion day.]

**Textual Amendments**

- F8** S. 52A inserted (31.12.2020) by [The Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/269\)](#), reg. 1(1), **Sch. 1 para. 2** (as amended by S.I. 2020/1050, regs. 1(2), **9(a)**); 2020 c. 1, **Sch. 5 para. 1(1)**

*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>F9</sup>  
...

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

*Status: Point in time view as at 31/12/2020.*

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

#### Textual Amendments

- F9** Words in s. 53 omitted (31.12.2020) by virtue of [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019](#) (S.I. 2019/638), reg. 1, **Sch. 8 para. 18** (with reg. 10(2), 10A) (as amended (26.11.2021) by S.I. 2021/1235, regs. 6, 7); 2020 c. 1, **Sch. 5 para. 1(1)**

#### **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—
- <sup>F10</sup>(a) sections 21 to 21F (unjustified threats);]
  - (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.

#### Textual Amendments

- F10** S. 54(3)(a) substituted (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), **ss. 2(4), 8**; S.I. 2017/771, reg. 2(1)(b) (with reg. 3)

#### <sup>F11</sup>**54A Certain international trade marks protected in the European Union to be treated as registered trade marks**

Schedule 2B makes provision for international trade marks protected in the European Union (including certain expired marks) to be treated as registered trade marks with effect from IP completion day and about certain applications for the protection of an international trade mark in the European Union and transformation applications made before IP completion day.]

*Status: Point in time view as at 31/12/2020.*

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

### Textual Amendments

- F11** S. 54A inserted (31.12.2020) by [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/638\)](#), reg. 1, **Sch. 4 para. 2** (as amended by S.I. 2020/1050, regs. 1(2), **22(a)**); 2020 c. 1, **Sch. 5 para. 1(1)** Edit

### *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>F12</sup> . . .
- <sup>F13</sup>(aa) “the WTO agreement” means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994<sup>F14</sup>, and ]
- (b) a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention [<sup>F15</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>F16</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.

### Textual Amendments

- F12** Word in s. 55(1) omitted (29.7.1999) by virtue of [S.I. 1999/1899](#), **reg. 13(2)**
- F13** S. 55(1)(aa) inserted (29.7.1999) by [S.I. 1999/1899](#), **reg. 13(2)**
- F14** 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](#).
- F15** 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**
- F16** 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>F17</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.

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

- (2) The proprietor of a trade mark which is entitled to protection under the Paris Convention [<sup>F17</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 *anybona fide* use of a trade mark begun before the commencement of this section.

#### Textual Amendments

**F17** 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>F18</sup>or the WTO agreement] shall not be registered without the authorisation of the competent authorities of that country.
- (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>F18</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

**F18** Words in s. 57(2)(3) inserted (29.7.1999) by S.I. 1999/1899, reg. 13(5)

*Status: Point in time view as at 31/12/2020.*

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

## 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>F19</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).

### Textual Amendments

**F19** 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,

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- (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>F20</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**

**F20** S. 59(5) inserted (29.7.1999) by [S.I. 1999/1899](#), [reg. 13\(7\)](#)

<sup>F21</sup>**60 Acts of agent or representative: Article 6septies.**

**Textual Amendments**

**F21** S. 60 omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), [regs. 1\(1\)](#), [28](#) (with [Pt. 5](#))

*Miscellaneous*

<sup>F22</sup>**61** .....

**Textual Amendments**

**F22** 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](#)

<sup>F23</sup>*Nice Classification*

**Textual Amendments**

**F23** S. 60A and cross-heading inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), [regs. 1\(1\)](#), [29](#) (with [Pt. 5](#))

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*Status: Point in time view as at 31/12/2020.*

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

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## **60A Similarity of goods and services**

- (1) For the purposes of this Act goods and services—
  - (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;
  - (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
- (2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.]



**Status:**

Point in time view as at 31/12/2020.

**Changes to legislation:**

There are currently no known outstanding effects for the Trade Marks Act 1994, Part II.