



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART III U.K.

#### ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

##### *Trade mark agents*

#### 82 Recognition of agents. U.K.

Except as otherwise provided by rules <sup>[F1]</sup>and subject to the Legal Services Act 2007], any act required or authorised by this Act to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or to an agent authorised by that person orally or in writing.

#### Textual Amendments

F1 Words in s. 82 inserted (1.1.2010) by [Legal Services Act 2007 \(c. 29\)](#), **ss. 184(2)**, 211(2) (with [ss. 29](#), 192, 193); [S.I. 2009/3250](#), art. 2(f)(i)

#### Commencement Information

II S. 82 wholly in force at 31.10.1994; s. 82 not in force at Royal Assent see s. 109; s. 82 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by [S.I. 1994/2550](#), [arts. 2](#), 3(1), [Sch.](#)

#### <sup>[F2]</sup>83 The register of trade mark attorneys U.K.

- (1) There is to continue to be a register of persons who act as agent for others for the purpose of applying for or obtaining the registration of trade marks.
- (2) In this Act a registered trade mark attorney means an individual whose name is entered on the register kept under this section.
- (3) The register is to be kept by the Institute of Trade Mark Attorneys.

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

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- (4) The Secretary of State may, by order, amend subsection (3) so as to require the register to be kept by the person specified in the order.
- (5) Before making an order under subsection (4), the Secretary of State must consult the Legal Services Board.
- (6) An order under this section must be made by statutory instrument.
- (7) An order under this section may not be made unless a draft of it has been laid before, and approved by a resolution of, each House of Parliament.

#### Textual Amendments

- F2** Ss. 83, 83A substituted for s. 83 (1.1.2010) by [Legal Services Act 2007 \(c. 29\)](#), **ss. 184(3)**, 211(2) (with [ss. 29, 192, 193](#)) (as amended (15.12.2009) by [S.I. 2009/3339](#), arts. 1, 2); [S.I. 2009/3250](#), art. 2(f)(i)

### 83A Regulation of trade mark attorneys **U.K.**

- (1) The person who keeps the register under section 83 may make regulations which regulate—
  - (a) the keeping of the register and the registration of persons;
  - (b) the carrying on of trade mark agency work by registered persons.
- (2) Those regulations may, amongst other things, make—
  - (a) provision as to the educational and training qualifications, and other requirements, which must be satisfied before an individual may be registered or for an individual to remain registered;
  - (b) provision as to the requirements which must be met by a body (corporate or unincorporate) before it may be registered or for it to remain registered, including provision as to the management and control of the body;
  - (c) provision as to the educational, training or other requirements to be met by regulated persons;
  - (d) provision regulating the practice, conduct and discipline of registered persons or regulated persons;
  - (e) provision authorising in such cases as may be specified in the regulations the erasure from the register of the name of any person registered in it, or the suspension of a person's registration;
  - (f) provision requiring the payment of such fees as may be specified in or determined in accordance with the regulations;
  - (g) provision about the provision to be made by registered persons in respect of complaints made against them;
  - (h) provision about the keeping of records and accounts by registered persons or regulated persons;
  - (i) provision for reviews of or appeals against decisions made under the regulations;
  - (j) provision as to the indemnification of registered persons or regulated persons against losses arising from claims in respect of civil liability incurred by them.
- (3) Regulations under this section may make different provision for different purposes.

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- (4) Regulations under this section which are not regulatory arrangements within the meaning of the Legal Services Act 2007 are to be treated as such arrangements for the purposes of that Act.
- (5) Before the appointed day, regulations under this section may be made only with the approval of the Secretary of State.
- (6) The powers conferred to make regulations under this section are not to be taken to prejudice—
  - (a) any other power which the person who keeps the register may have to make rules or regulations (however they may be described and whether they are made under an enactment or otherwise);
  - (b) any rules or regulations made by that person under any such power.
- (7) In this section—

“appointed day” means the day appointed for the coming into force of paragraph 1 of Schedule 4 to the Legal Services Act 2007;

“manager”, in relation to a body, has the same meaning as in the Legal Services Act 2007 (see section 207);

“registered person” means—

- (a) a registered trade mark attorney, or
- (b) a body (corporate or unincorporate) registered in the register kept under section 83;

“regulated person” means a person who is not a registered person but is a manager or employee of a body which is a registered person;

“trade mark agency work” means work done in the course of carrying on the business of acting as agent for others for the purpose of—

- (a) applying for or obtaining the registration of trade marks in the United Kingdom or elsewhere, or
- (b) conducting proceedings before the Comptroller relating to applications for or otherwise in connection with the registration of trade marks.]

#### Textual Amendments

- F2** Ss. 83, 83A substituted for s. 83 (1.1.2010) by [Legal Services Act 2007 \(c. 29\), ss. 184\(3\), 211\(2\)](#) (with [ss. 29, 192, 193](#)) (as amended (15.12.2009) by [S.I. 2009/3339](#), arts. 1, 2); [S.I. 2009/3250](#), art. 2(f)(i)

## 84 Unregistered persons not to be described as registered trade mark agents. **U.K.**

- (1) An individual who is not a registered trade mark [<sup>F3</sup>attorney] shall not—
  - (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent” [<sup>F4</sup> or registered trade mark attorney]; or
  - (b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent [<sup>F5</sup> or a registered trade mark attorney].
- (2) A partnership [<sup>F6</sup> or other unincorporated body] shall not—

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- (a) carry on a business under any name or other description which contains the words “registered trade mark agent” [<sup>F7</sup>or registered trade mark attorney]; or
- (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a firm of registered trade mark agents [<sup>F8</sup>or registered trade mark attorneys],
- unless [<sup>F9</sup>the partnership or other body is registered in the register kept under section 83.]
- (3) A body corporate shall not—
- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent” [<sup>F10</sup>or registered trade mark attorney]; or
- (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trade mark agent [<sup>F11</sup>or a registered trade mark attorney],
- unless [<sup>F12</sup>the body corporate is registered in the register kept under section 83.]
- (4) A person who contravenes this section commits an offence and is liable on summary conviction to a fine not exceeding level 5 on the standard scale; and proceedings for such an offence may be begun at any time within a year from the date of the offence.

#### Textual Amendments

- F3** Word in s. 84(1) substituted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 111(a)(i)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F4** Words in s. 84(1)(a) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 111(a)(ii)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F5** Words in s. 84(1)(b) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 111(a)(iii)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F6** Words in s. 84(2) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), **ss. 184(4)(a)(i)**, 211(2) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(f)(i)
- F7** Words in s. 84(2)(a) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 111(b)(i)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F8** Words in s. 84(2)(b) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 111(b)(ii)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F9** Words in s. 84(2) substituted (1.1.2010) by Legal Services Act 2007 (c. 29), **ss. 184(4)(a)(ii)**, 211(2) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(f)(i)
- F10** Words in s. 84(3)(a) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 111(c)(i)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F11** Words in s. 84(3)(b) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 111(c)(ii)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F12** Words in s. 84(3) substituted (1.1.2010) by Legal Services Act 2007 (c. 29), **ss. 184(4)(b)**, 211(2) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(f)(i)

<sup>F13</sup>**85** Power to prescribe conditions, &c. for mixed partnerships and bodies corporate. **U.K.**

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#### Textual Amendments

- F13** S. 85 repealed (1.1.2010) by [Legal Services Act 2007 \(c. 29\)](#), ss. 184(5), 211(2), [Sch. 23](#) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(f)(i)(ix)

### 86 Use of the term “trade mark attorney”. **U.K.**

- (1) No offence is committed under the enactments restricting the use of certain expressions in reference to persons not qualified to act as solicitors by the use of the term “trade mark attorney” in reference to a registered trade mark [<sup>F14</sup>attorney].
- (2) The enactments referred to in subsection (1) are section 21 of the <sup>M1</sup>Solicitors Act 1974, section 31 of the <sup>M2</sup>Solicitors (Scotland) Act 1980 and Article 22 of the Solicitors (Northern Ireland) Order 1976.

#### Textual Amendments

- F14** Word in s. 86(1) substituted (1.1.2010) by [Legal Services Act 2007 \(c. 29\)](#), s. 211(2), [Sch. 21 para. 112](#) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)

#### Marginal Citations

- M1** 1974 c. 47. S.I. 1976/582 (N.I. 12)  
**M2** 1980 c. 46.

### 87 Privilege for communications with registered trade mark agents. **U.K.**

- (1) This section applies to<sup>F15</sup>—
  - (a) communications as to any matter relating to the protection of any design or trade mark, or as to any matter involving passing off<sup>F16</sup>, and
  - (b) documents, material or information relating to any matter mentioned in paragraph (a).]
- <sup>F17</sup>(2) Where a trade mark attorney acts for a client in relation to a matter mentioned in subsection (1), any communication, document, material or information to which this section applies is privileged from disclosure in like manner as if the trade mark attorney had at all material times been acting as the client's solicitor.]
- (3) In subsection (2) “trade mark [<sup>F18</sup>attorney]” means—
  - (a) a registered trade mark [<sup>F18</sup>attorney], or
  - (b) a partnership entitled to describe itself as a firm of registered trade mark [<sup>F19</sup>attorneys], or
  - (c) [<sup>F20</sup>any other unincorporated body or ]a body corporate entitled to describe itself as a registered trade mark [<sup>F18</sup>attorney][<sup>F21</sup>or]
  - <sup>F22</sup>(d) a person whose name appears on the list of professional representatives for trade mark matters maintained by the European Union Intellectual Property Office referred to in Article 120 of the European Union Trade Mark Regulation.]
- <sup>F23</sup>(4) Where a trade mark attorney is a person falling within subsection (3)(d), subsection (2) applies as if the reference to a matter mentioned in subsection (1) were a reference to a matter relating to the protection of a trade mark.]

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### Textual Amendments

- F15** Words in s. 87(1) renumbered as s. 87(1)(a) (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 113(a)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F16** S. 87(1)(b) and word inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 113(b)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F17** S. 87(2) substituted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 113(c)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F18** Word in s. 87(3) substituted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 113(d)(i)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F19** Word in s. 87(3) substituted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 113(d)(ii)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F20** Words in s. 87(3)(c) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), **ss. 184(6)**, 211(2) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(f)(i)
- F21** Word in s. 87(3)(c) inserted (31.12.2020) by The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (S.I. 2019/269), reg. 1(1), **Sch. 3 para. 12(2)** (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)**
- F22** S. 87(3)(d) inserted (31.12.2020) by The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (S.I. 2019/269), reg. 1(1), **Sch. 3 para. 12(3)** (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)**
- F23** S. 87(4) inserted (31.12.2020) by The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (S.I. 2019/269), reg. 1(1), **Sch. 3 para. 12(4)** (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)**

### Modifications etc. (not altering text)

- C1** S. 87 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 5**

## 88 Power of registrar to refuse to deal with certain agents. **U.K.**

- (1) The Secretary of State may make rules authorising the registrar to refuse to recognise as agent in respect of any business under this Act—
- (a) a person who has been convicted of an offence under section 84 (unregistered persons describing themselves as registered trade mark agents);
  - (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark [<sup>F24</sup>attorneys] on the ground of misconduct;
  - (c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of trade mark [<sup>F25</sup>attorneys], render him liable to have his name erased from the register on the ground of misconduct;
  - (d) a partnership or body corporate of which one of the partners or directors is a person whom the registrar could refuse to recognise under paragraph (a), (b) or (c) above.
- (2) The rules may contain such incidental and supplementary provisions as appear to the Secretary of State to be appropriate and may, in particular, prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct.

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

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#### Textual Amendments

- F24** Word in s. 88(b) substituted (1.1.2010) by [Legal Services Act 2007 \(c. 29\)](#), s. 211(2), [Sch. 21 para. 114\(a\)](#) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)
- F25** Word in s. 88(c) substituted (1.1.2010) by [Legal Services Act 2007 \(c. 29\)](#), s. 211(2), [Sch. 21 para. 114\(b\)](#) (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)

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#### Commencement Information

- I2** S. 88 wholly in force at 31.10.1994; s. 88 not in force at Royal Assent see s. 109; s. 88 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), [Sch.](#)

**Changes to legislation:**

There are currently no known outstanding effects for the Trade Marks Act 1994, Cross Heading:  
Trade mark agents.