



Trade Marks Act 1994

1994 CHAPTER 26

PART III

ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

Trade mark agents

82 Recognition of agents

Except as otherwise provided by rules, 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.

83 The register of trade mark agents

- (1) The Secretary of State may make rules requiring the keeping of a register of persons who act as agent for others for the purpose of applying for or obtaining the registration of trade marks; and in this Act a “registered trade mark agent” means a person whose name is entered in the register kept under this section.
- (2) The rules may contain such provision as the Secretary of State thinks fit regulating the registration of persons, and may in particular—
 - (a) require the payment of such fees as may be prescribed, and
 - (b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person’s registration.
- (3) The rules may delegate the keeping of the register to another person, and may confer on that person—
 - (a) power to make regulations—
 - (i) with respect to the payment of fees, in the cases and subject to the limits prescribed by the rules, and

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- (ii) with respect to any other matter which could be regulated by the rules, and
- (b) such other functions, including disciplinary functions, as may be prescribed by the rules.

84 Unregistered persons not to be described as registered trade mark agents

- (1) An individual who is not a registered trade mark agent 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”; 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.
- (2) A partnership shall not—
 - (a) carry on a business under any name or other description which contains the words “registered trade mark agent”; 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,
 unless all the partners are registered trade mark agents or the partnership satisfies such conditions as may be prescribed for the purposes of this section.
- (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”; 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,
 unless all the directors of the body corporate are registered trade mark agents or the body satisfies such conditions as may be prescribed for the purposes of this section.
- (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.

85 Power to prescribe conditions, &c. for mixed partnerships and bodies corporate

- (1) The Secretary of State may make rules prescribing the conditions to be satisfied for the purposes of section 84 (persons entitled to be described as registered trade mark agents)—
 - (a) in relation to a partnership where not all the partners are qualified persons, or
 - (b) in relation to a body corporate where not all the directors are qualified persons,
 and imposing requirements to be complied with by such partnerships or bodies corporate.
- (2) The rules may, in particular—
 - (a) prescribe conditions as to the number or proportion of partners or directors who must be qualified persons;
 - (b) impose requirements as to—
 - (i) the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to its business, and

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- (ii) the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a sufficient degree of control over the activities of unqualified persons.
- (3) Contravention of a requirement imposed by the rules is an offence for which a person is liable on summary conviction to a fine not exceeding level 5 on the standard scale.
- (4) In this section “qualified person” means a registered trade mark agent.

86 Use of the term “trade mark attorney”

- (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 agent.
- (2) The enactments referred to in subsection (1) are section 21 of the Solicitors Act 1974, section 31 of the Solicitors (Scotland) Act 1980 and Article 22 of the Solicitors (Northern Ireland) Order 1976.

87 Privilege for communications with registered trade mark agents

- (1) This section applies to communications as to any matter relating to the protection of any design or trade mark, or as to any matter involving passing off.
- (2) Any such communication—
 - (a) between a person and his trade mark agent, or
 - (b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his trade mark agent,is privileged from, or in Scotland protected against, disclosure in legal proceedings in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his solicitor.
- (3) In subsection (2) “trade mark agent” means—
 - (a) a registered trade mark agent, or
 - (b) a partnership entitled to describe itself as a firm of registered trade mark agents, or
 - (c) a body corporate entitled to describe itself as a registered trade mark agent.

88 Power of registrar to refuse to deal with certain agents

- (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 agents 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 agents, render him liable to have his name erased from the register on the ground of misconduct;

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- (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.