

*Status: Point in time view as at 14/01/2019.*

*Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, SCHEDULE 1. (See end of Document for details)*

## SCHEDULES

### SCHEDULE 1

Section 49.

#### COLLECTIVE MARKS

##### Commencement Information

- II** Sch. 1 wholly in force at 31.10.1994; Sch. 1 not in force at Royal Assent; Sch. 1 para. 6(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 1 not already in force by 1994/2550, arts. 2, 3(1), Sch.

##### *General*

- 1 The provisions of this Act apply to collective marks subject to the following provisions.

##### *Signs of which a collective mark may consist*

- 2 In relation to a collective mark the reference in section 1(1) (signs of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

##### *Indication of geographical origin*

- 3 (1) Notwithstanding section 3(1)(c), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.
- (2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

##### *Mark not to be misleading as to character or significance*

- 4 (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.
- (2) The registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

Notwithstanding section 39(2), an application may be amended so as to comply with any such requirement.

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*Regulations governing use of collective mark*

- 5 (1) An applicant for registration of a collective mark must file with the registrar regulations governing the use of the mark.
- (2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and <sup>F1</sup>... the conditions of use of the mark, including any sanctions against misuse.
- [<sup>F2</sup>(3) Where the regulations govern use of a mark referred to in paragraph 3(1), they must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.]
- [<sup>F3</sup>(4)] Further requirements with which the regulations have to comply may be imposed by rules.

**Textual Amendments**

- F1** Words in Sch. 1 para. 5(2) omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(2)(a)** (with Pt. 5)
- F2** Sch. 1 para. 5(3) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(2)(c)** (with Pt. 5)
- F3** Words in Sch. 1 para. 5(2) renumbered as Sch. 1 para. 5(4) (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(2)(b)** (with Pt. 5)

*Approval of regulations by registrar*

- 6 (1) A collective mark shall not be registered unless the regulations governing the use of the mark—
- (a) comply with paragraph 5(2) [<sup>F4</sup>and (3)] and any further requirements imposed by rules, and
- (b) are not contrary to public policy or to accepted principles of morality.
- (2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant must file the regulations with the registrar and pay the prescribed fee.

If he does not do so, the application shall be deemed to be withdrawn.

**Textual Amendments**

- F4** Words in Sch. 1 para. 6(1)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(3)** (with Pt. 5)

**Commencement Information**

- I2** Sch. 1 wholly in force at 31.10.1994; Sch. 1 not in force at Royal Assent see s. 109; Sch. 1 para. 6(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 1 not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

- 7 (1) The registrar shall consider whether the requirements mentioned in paragraph 6(1) are met.

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- (2) If it appears to the registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations.
  - (3) If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse the application.
  - (4) If it appears to the registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 38 (publication, opposition proceedings and observations).
- 8       The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 6(1).
- This is in addition to any other grounds on which the application may be opposed or observations made.

*Regulations to be open to inspection*

- 9       The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

*Amendment of regulations*

- 10     (1) An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with the registrar and accepted by him.
- (2) Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published.
  - (3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 6(1).

*Infringement: rights of authorised users*

- 11     The following provisions apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark—
- (a) section 10(5) (definition of infringement: unauthorised application of mark to certain material);
  - (b) section 19(2) (order as to disposal of infringing goods, material or articles: adequacy of other remedies);
  - (c) section 89 (prohibition of importation of infringing goods, material or articles: request to Commissioners of Customs and Excise).
- 12     (1) The following provisions (which correspond to the provisions of section 30 (general provisions as to rights of licensees in case of infringement)) have effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.
- [<sup>F5</sup>(2) Subject to any agreement to the contrary between the authorised user and the proprietor, an authorised user may only bring proceedings for infringement of a registered collective mark with the consent of the proprietor.]

<sup>F6</sup>(3) .....

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- (4) [<sup>F7</sup>Where proceedings are brought by an authorised user for infringement of a registered collective mark (with the consent of the proprietor or pursuant to any agreement referred to in sub-paragraph (2))], the authorised user may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

This does not affect the granting of interlocutory relief on an application by an authorised user alone.

- (5) A proprietor who is added as a defendant as mentioned in sub-paragraph (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.
- (6) In infringement proceedings brought by the proprietor of a registered collective mark any loss suffered or likely to be suffered by authorised users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

- [<sup>F8</sup>(7) Where the proprietor of a registered collective mark brings infringement proceedings, an authorised user who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.]

#### Textual Amendments

- F5** Sch. 1 para. 12(2) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(4)(a)** (with Pt. 5)
- F6** Sch. 1 para. 12(3) omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(4)(b)** (with Pt. 5)
- F7** Words in Sch. 1 para. 12(4) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(4)(c)** (with Pt. 5)
- F8** Sch. 1 para. 12(7) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(4)(d)** (with Pt. 5)

#### *Grounds for revocation of registration*

- 13 Apart from the grounds of revocation provided for in section 46, the registration of a collective mark may be revoked on the ground—
- (a) that the manner in which the mark has been used by the [<sup>F9</sup>persons authorised to use it] has caused it to become liable to mislead the public in the manner referred to in paragraph 4(1), or
  - (b) that the proprietor [<sup>F10</sup>has not taken reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in] the regulations governing the use of the mark [<sup>F11</sup>(as amended from time to time)], or
  - (c) that an amendment of the regulations has been made so that the regulations—
    - (i) no longer comply with paragraph 5(2) [<sup>F12</sup>and (3)] and any further conditions imposed by rules, or
    - (ii) are contrary to public policy or to accepted principles of morality.

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#### Textual Amendments

- F9** Words in Sch. 1 para. 13(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(5)(a)** (with Pt. 5)
- F10** Words in Sch. 1 para. 13(b) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(5)(b)(i)** (with Pt. 5)
- F11** Words in Sch. 1 para. 13(b) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(5)(b)(ii)** (with Pt. 5)
- F12** Words in Sch. 1 para. 13(c)(i) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(5)(c)** (with Pt. 5)

#### *Grounds for invalidity of registration*

- 14 Apart from the grounds of invalidity provided for in section 47, the registration of a collective mark [<sup>F13</sup>shall] be declared invalid on the ground that the mark was registered in breach of the provisions of [<sup>F14</sup>section 49(1A) (definition of who may be registered as the proprietor of a certification mark) or] paragraph 4(1) or 6(1) [<sup>F15</sup>unless the breach was only of paragraph 6(1) and the proprietor of the mark, by amending the regulations governing use, complies with the requirements of paragraph 6(1)].

#### Textual Amendments

- F13** Word in Sch. 1 para. 14 substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(6)(a)** (with Pt. 5)
- F14** Words in Sch. 1 para. 14 inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(6)(b)** (with Pt. 5)
- F15** Words in Sch. 1 para. 14 inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **33(6)(c)** (with Pt. 5)

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