



Trade Marks Act 1994

1994 CHAPTER 26

PART I

REGISTERED TRADE MARKS

Grounds for refusal of registration

5 Relative grounds for refusal of registration.

- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- (2) A trade mark shall not be registered if because—
 - (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
 - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
- (3) A trade mark which—
 - (a) is identical with or similar to an earlier trade mark, and
 - ^{F1}(b)shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom ^{F2}... and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

[^{F3}(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.]

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Section 5. (See end of Document for details)

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of [^{F4}trade, where the condition in subsection (4A) is met,]

[^{F5}(aa) by virtue of ^{F6}... any enactment or rule of law, providing for protection of designations of origin or geographical indications, where the condition in subsection (4B) is met, or]

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) [^{F7}or (aa)] above, in particular by virtue of the law of copyright [^{F8}or the law relating to industrial property rights].

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

[^{F9}(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

(4B) The condition mentioned in subsection 4(aa) is that—

(a) an application for a designation of origin or a geographical indication has been submitted prior to the date of application for registration of the trade mark or the date of the priority claimed for that application, and

(b) the designation of origin or (as the case may be) geographical indication is subsequently registered.]

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

[^{F10}(6) Where an agent or representative (“R”) of the proprietor of a trade mark applies, without the proprietor’s consent, for the registration of the trade mark in R’s own name, the application is to be refused unless R justifies that action.]

Textual Amendments

- F1** S. 5(3)(b) and preceding word omitted (5.5.2004) by virtue of [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, **7(1)**
- F2** Words in s. 5(3) 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. 3(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)**
- F3** S. 5(3A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(2)** (with Pt. 5)
- F4** Words in s. 5(4)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(3)** (with Pt. 5)
- F5** S. 5(4)(aa) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(4)** (with Pt. 5)
- F6** Words in s. 5(4)(aa) 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. 3(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)**
- F7** Words in s. 5(4)(b) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(5)(a)** (with Pt. 5)

*Changes to legislation: There are currently no known outstanding effects
for the Trade Marks Act 1994, Section 5. (See end of Document for details)*

- F8** Words in s. 5(4)(b) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(5)(b)** (with Pt. 5)
- F9** S. 5(4A)(4B) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(6)** (with Pt. 5)
- F10** S. 5(6) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **5(7)** (with Pt. 5)

Changes to legislation:

There are currently no known outstanding effects for the Trade Marks Act 1994, Section 5.