



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

#### *<sup>F1</sup>Unjustified threats*

#### Textual Amendments

- F1** Ss. 21-21F and cross-heading substituted for s. 21 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017 \(c. 14\)](#), **ss. 2(2), 8**; S.I. 2017/771, **reg. 2(1)(b)** (with **reg. 3**)

#### **21 Threats of infringement proceedings**

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that—
- (a) a registered trade mark exists, and
  - (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the registered trade mark by—
    - (i) an act done in the United Kingdom, or
    - (ii) an act which, if done, would be done in the United Kingdom.
- (2) References in this section and in section 21C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

#### **21A Actionable threats**

- (1) Subject to subsections (2) to (6), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.

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- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
- (a) applying, or causing another person to apply, a sign to goods or their packaging,
  - (b) importing, for disposal, goods to which, or to the packaging of which, a sign has been applied, or
  - (c) supplying services under a sign.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a), (b) or (c).
- (4) A threat of infringement proceedings is not actionable if the threat—
- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to goods or their packaging, and
  - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to those goods or their packaging.
- (5) A threat of infringement proceedings is not actionable if the threat—
- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(c) in relation to services, and
  - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to those services.
- (6) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (7) In sections 21C and 21D “an actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

## **21B Permitted communications**

- (1) For the purposes of section 21A(6), a communication containing a threat of infringement proceedings is a “permitted communication” if—
- (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
  - (b) all of the information that relates to the threat is information that—
    - (i) is necessary for that purpose (see subsection (5)(a) to (c) for some examples of necessary information), and
    - (ii) the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose”—
- (a) giving notice that a registered trade mark exists;
  - (b) discovering whether, or by whom, a registered trade mark has been infringed by an act mentioned in section 21A(2)(a), (b) or (c);
  - (c) giving notice that a person has a right in or under a registered trade mark, where another person's awareness of the right is relevant to any proceedings that may be brought in respect of the registered trade mark.
- (3) The court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.

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- (4) But the following may not be treated as a “permitted purpose”—
- (a) requesting a person to cease using, in the course of trade, a sign in relation to goods or services,
  - (b) requesting a person to deliver up or destroy goods, or
  - (c) requesting a person to give an undertaking relating to the use of a sign in relation to goods or services.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see subsection (1)(b)(i))—
- (a) a statement that a registered trade mark exists and is in force or that an application for the registration of a trade mark has been made;
  - (b) details of the registered trade mark, or of a right in or under the registered trade mark, which—
    - (i) are accurate in all material respects, and
    - (ii) are not misleading in any material respect; and
  - (c) information enabling the identification of the goods or their packaging, or the services, in relation to which it is alleged that the use of a sign constitutes an infringement of the registered trade mark.

## **21C Remedies and defences**

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
- (a) a declaration that the threat is unjustified;
  - (b) an injunction against the continuance of the threat;
  - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.
- (2) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the registered trade mark.
- (3) It is a defence for the person who made the threat to show—
- (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 21A(2)(a), (b) or (c) in relation to the goods or their packaging or the services which are the subject of the threat, and
  - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

## **21D Professional advisers**

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in subsection (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—
- (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and

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- (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
  - (a) in making the communication the professional adviser is acting on the instructions of another person, and
  - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that subsection (1) applies to prove (if required) that at the material time—
  - (a) the person concerned was acting as a professional adviser, and
  - (b) the conditions in subsection (3) were met.

#### **21E Supplementary: pending registration**

- (1) In sections 21 and 21B references to a registered trade mark include references to a trade mark in respect of which an application for registration has been published under section 38.
- (2) Where the threat of infringement proceedings is made after an application for registration has been published (but before registration) the reference in section 21C(2) to “the registered trade mark” is to be treated as a reference to the trade mark registered in pursuance of that application.

#### **21F Supplementary: proceedings for delivery up etc.**

In section 21(1)(b) the reference to proceedings for infringement of a registered trade mark includes a reference to—

- (a) proceedings for an order under section 16 (order for delivery up of infringing goods, material or articles), and
- (b) proceedings for an order under section 19 (order as to disposal of infringing goods, material or articles).]

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