



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

##### *Infringement proceedings*

#### **14 Action for infringement.**

- (1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.
- (2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.

#### **15 Order for erasure, &c. of offending sign.**

- (1) Where a person is found to have infringed a registered trade mark, the court may make an order requiring him—
  - (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control, or
  - (b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.
- (2) If an order under subsection (1) is not complied with, or it appears to the court likely that such an order would not be complied with, the court may order that the infringing goods, material or articles be delivered to such person as the court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

*Status: Point in time view as at 01/11/2004.*

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

**Modifications etc. (not altering text)**

C1 S. 15: power to apply conferred (20.9.1995) by 1995 c. 32, s. 7(1); S.I. 1995/2472, art. 2

**16 Order for delivery up of infringing goods, material or articles.**

- (1) The proprietor of a registered trade mark may apply to the court for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business.
- (2) An application shall not be made after the end of the period specified in section 18 (period after which remedy of delivery up not available); and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 19 (order as to disposal of infringing goods, &c.).
- (3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under section 19 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.
- (4) Nothing in this section affects any other power of the court.

**Modifications etc. (not altering text)**

C2 S. 16: power to apply conferred (20.9.1995) by 1995 c. 32, 7(1); S.I. 1995/2472, art. 2

**17 Meaning of “infringing goods, material or articles”.**

- (1) In this Act the expressions “infringing goods”, “infringing material” and “infringing articles” shall be construed as follows.
- (2) Goods are “infringing goods”, in relation to a registered trade mark, if they or their packaging bear a sign identical or similar to that mark and—
  - (a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark, or
  - (b) the goods are proposed to be imported into the United Kingdom and the application of the sign in the United Kingdom to them or their packaging would be an infringement of the registered trade mark, or
  - (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.
- (3) Nothing in subsection (2) shall be construed as affecting the importation of goods which may lawfully be imported into the United Kingdom by virtue of an enforceable Community right.
- (4) Material is “infringing material”, in relation to a registered trade mark if it bears a sign identical or similar to that mark and either—
  - (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark, or

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- (b) it is intended to be so used and such use would infringe the registered trade mark.
- (5) “Infringing articles”, in relation to a registered trade mark, means articles—
  - (a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark, and
  - (b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.

## **18 Period after which remedy of delivery up not available.**

- (1) An application for an order under section 16 (order for delivery up of infringing goods, material or articles) may not be made after the end of the period of six years from—
  - (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging,
  - (b) in the case of infringing material, the date on which the trade mark was applied to the material, or
  - (c) in the case of infringing articles, the date on which they were made,except as mentioned in the following provisions.
- (2) If during the whole or part of that period the proprietor of the registered trade mark—
  - (a) is under a disability, or
  - (b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.
- (3) In subsection (2) “disability”—
  - (a) in England and Wales, has the same meaning as in the <sup>M1</sup>Limitation Act 1980;
  - (b) in Scotland, means legal disability within the meaning of the <sup>M2</sup>Prescription and Limitation (Scotland) Act 1973;
  - (c) in Northern Ireland, has the same meaning as in the <sup>M3</sup>Limitation (Northern Ireland) Order 1989.

### **Modifications etc. (not altering text)**

**C3** S. 18: power to apply conferred (20.9.1995) by 1995 c. 32, s. 7(1); S.I. 1995/2472, art. 2

### **Marginal Citations**

**M1** 1980 c. 58.

**M2** 1973 c. 52.

**M3** S.I. 1989/1339 (N.I. 11).

## **19 Order as to disposal of infringing goods, material or articles.**

- (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 16, an application may be made to the court—

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- (a) for an order that they be destroyed or forfeited to such person as the court may think fit, or
  - (b) for a decision that no such order should be made.
- (2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and protect their interests.
- (3) Provision shall be made by rules of court as to the service of notice on persons having an interest in the goods, material or articles, and any such person is entitled—
- (a) to appear in proceedings for an order under this section, whether or not he was served with notice, and
  - (b) to appeal against any order made, whether or not he appeared;
- and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.
- (4) Where there is more than one person interested in the goods, material or articles, the court shall make such order as it thinks just.
- (5) If the court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up is entitled to their return.
- (6) References in this section to a person having an interest in goods, material or articles include any person in whose favour an order could be made under this section or under section 114, 204 or 231 of the <sup>M4</sup>Copyright, Designs and Patents Act 1988 (which make similar provision in relation to infringement of copyright, rights in performances and design right).

**Modifications etc. (not altering text)**

C4 S. 19: power to apply conferred (20.9.1995) by 1995 c. 32, S.I. 1995/2472, art. 2

**Marginal Citations**

M4 1988 c. 48

## 20 Jurisdiction of sheriff court or county court in Northern Ireland.

Proceedings for an order under section 16 (order for delivery up of infringing goods, material or articles) or section 19 (order as to disposal of infringing goods, &c.) may be brought—

- (a) in the sheriff court in Scotland, or
- (b) in a county court in Northern Ireland.

This does not affect the jurisdiction of the Court of Session or the High Court in Northern Ireland.

**Modifications etc. (not altering text)**

C5 S. 20: power to apply conferred (20.9.1995) by 1995 c. 32, s. 7(1); S.I. 1995/2472, art. 2

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## **21 Remedy for groundless threats of infringement proceedings.**

- (1) Where a person threatens another with proceedings for infringement of a registered trade mark other than—
  - (a) the application of the mark to goods or their packaging,
  - (b) the importation of goods to which, or to the packaging of which, the mark has been applied, or
  - (c) the supply of services under the mark,any person aggrieved may bring proceedings for relief under this section.
- (2) The relief which may be applied for is any of the following—
  - (a) a declaration that the threats are unjustifiable,
  - (b) an injunction against the continuance of the threats,
  - (c) damages in respect of any loss he has sustained by the threats;and the plaintiff is entitled to such relief unless the defendant shows that the acts in respect of which proceedings were threatened constitute (or if done would constitute) an infringement of the registered trade mark concerned.
- (3) If that is shown by the defendant, the plaintiff is nevertheless entitled to relief if he shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.
- (4) The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

### **Modifications etc. (not altering text)**

- C6** S. 21 applied (with modifications) by S.I. 1996/1908, reg. 4 (as substituted (1.11.2004) by [Trade Marks \(International Registrations Designating the European Community, etc.\) Regulations 2004 \(S.I. 2004/2332\)](#), regs. 1(3), **10**)

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