



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART I

#### REGISTERED TRADE MARKS

##### *Licensing*

#### **28 Licensing of registered trade mark.**

- (1) A licence to use a registered trade mark may be general or limited.

A limited licence may, in particular, apply—

- (a) in relation to some but not all of the goods or services for which the trade mark is registered, or
- (b) in relation to use of the trade mark in a particular manner or a particular locality.

- (2) A licence is not effective unless it is in writing signed by or on behalf of the grantor.

Except in Scotland, this requirement may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.

- (3) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest.

References in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.

- (4) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

#### **29 Exclusive licences.**

- (1) In this Act an "exclusive licence" means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person

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*Status: Point in time view as at 20/11/2002.*

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

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granting the licence, to use a registered trade mark in the manner authorised by the licence.

The expression “exclusive licensee” shall be construed accordingly.

- (2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

### **30 General provisions as to rights of licensees in case of infringement.**

- (1) This section has effect with respect to the rights of a licensee in relation to infringement of a registered trade mark.

The provisions of this section do not apply where or to the extent that, by virtue of section 31(1) below (exclusive licensee having rights and remedies of assignee), the licensee has a right to bring proceedings in his own name.

- (2) A licensee is entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

- (3) If the proprietor—

- (a) refuses to do so, or  
(b) fails to do so within two months after being called upon,

the licensee may bring the proceedings in his own name as if he were the proprietor.

- (4) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee 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 a licensee alone.

- (5) A proprietor who is added as a defendant as mentioned in subsection (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 trade mark any loss suffered or likely to be suffered by licensees 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 licensees.

- (7) The provisions of this section apply in relation to an exclusive licensee if or to the extent that he has, by virtue of section 31(1), the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

### **31 Exclusive licensee having rights and remedies of assignee.**

- (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

Where or to the extent that such provision is made, the licensee is entitled, subject to the provisions of the licence and to the following provisions of this section, to bring infringement proceedings, against any person other than the proprietor, in his own name.

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- (2) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.
- (3) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.
- (4) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

This does not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

- (5) A person who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.
- (6) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action—
  - (a) the court shall in assessing damages take into account—
    - (i) the terms of the licence, and
    - (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;
  - (b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and
  - (c) the court shall if an account of profits is directed apportion the profits between them as the court considers just, subject to any agreement between them.

The provisions of this subsection apply whether or not the proprietor and the exclusive licensee are both parties to the action; and if they are not both parties the court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

- (7) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 16 (order for delivery up); and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.
- (8) The provisions of subsections (4) to (7) above have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

**Status:**

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**Changes to legislation:**

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