



Trade Marks Act 1994

1994 CHAPTER 26

PART I

REGISTERED TRADE MARKS

Surrender, revocation and invalidity

47 Grounds for invalidity of registration.

- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

- (2) [^{F1}Subject to subsections (2A) and (2G),] the registration of a trade mark may be declared invalid on the ground—

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[^{F2}(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).]

[^{F3}(2A) ^{F4}... The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

Status: Point in time view as at 31/12/2020. This version of this provision has been superseded.

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- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if—

- [^{F5}(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—
 - (i) within the period of 5 years ending with the date of application for the declaration, and
 - (ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or]
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

- (a) use of a trade mark includes use in a form [^{F6}(the “variant form”)] differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [^{F7}(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)], and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

^{F8}(2D)

^{F9}(2DA)

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.]

[^{F10}(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).]

[^{F11}(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));
- (b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);
- (c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).]

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- (3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—
- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
 - (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.
- (4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.
- (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.
- [^{F12}(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.]
- (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:
Provided that this shall not affect transactions past and closed.

Textual Amendments

- F1** Words in s. 47(2) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(2)** (with Pt. 5)
- F2** S. 47(2ZA) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(3)** (with Pt. 5)
- F3** S. 47(2A)-(2E) inserted (5.5.2004) by [Trade Marks \(Proof of Use, etc.\) Regulations 2004 \(S.I. 2004/946\)](#), regs. 1, **6** (with reg. 9)
- F4** Word in s. 47(2A) omitted (14.1.2019) by virtue of [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(4)** (with Pt. 5)
- F5** S. 47(2B)(a) substituted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(5)** (with Pt. 5)
- F6** Words in s. 47(2C)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(6)(a)** (with Pt. 5)
- F7** Words in s. 47(2C)(a) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(6)(b)** (with Pt. 5)
- F8** S. 47(2D) 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. 9** (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)**)
- F9** S. 47(2DA) 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. 9** (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)**)
- F10** S. 47(2F) inserted (10.5.2008) by [Trade Marks \(Earlier Trade Marks\) Regulations 2008 \(S.I. 2008/1067\)](#), regs. 1, **5(3)** (with regs. 7, 8)
- F11** S. 47(2G)(2H) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(8)** (with Pt. 5)
- F12** S. 47(5A) inserted (14.1.2019) by [The Trade Marks Regulations 2018 \(S.I. 2018/825\)](#), regs. 1(1), **23(9)** (with Pt. 5)

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Modifications etc. (not altering text)

- C1** S. 47 applied (with modifications) (1.4.1996) by [S.I. 1996/714](#), **art. 13**
S. 47 applied (with modifications) (14.8.1996) by S.I. 1908, reg. 3(3)
- C2** S. 47(2B) modified (20.5.2016) by [The Standardised Packaging of Tobacco Products Regulations 2015 \(S.I. 2015/829\)](#), regs. 1(2), **13(5)(b)(6)** (with regs. 13(9), 14(5), 20)
- C3** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 1151/2012, Art. 14b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 18, **Sch. 2 Pt. 3**)
- C4** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 251/2014, Art. 19b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 21, **Sch. 4 Pt. 3**)
- C5** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 33/2019, Art. 32b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 26(31), **Sch. 8 Pt. 3**)
- C6** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) 2019/787, Art. 36b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1661\)](#), reg. 1(3), **Sch. 5 Pt. 2**)
- C7** S. 47(3)-(6) applied (with modifications) (31.12.2020) by Regulation (EU) No. 1308/2013, Art. 102b(1)(2) (as inserted by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(7), 20, **Sch. 3 Pt. 2**)

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