



Trade Marks Act 1938 (repealed 31.10.1994)

1938 CHAPTER 22 1 and 2 Geo 6

REGISTRATION, INFRINGEMENT AND OTHER SUBSTANTIVE PROVISIONS

Registrability and validity of registration

9 Distinctiveness requisite for registration in Part A.

- (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:—
 - (a) the name of a company, individual, or firm, represented in a special or particular manner;
 - (b) the signature of the applicant for registration or some predecessor in his business;
 - (c) an invented word or invented words;
 - (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
 - (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.
- (2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
- (3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which—

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- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10 Capability of distinguishing requisite for registration in Part B.

- (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
- (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which—
 - (a) the trade mark is inherently capable of distinguishing as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.
- (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

11 Prohibition of registration of deceptive, &c., matter.

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

12 Prohibition of registration of identical and resembling trade marks.

- (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with [^{F1}or nearly resembles a mark belonging to a different proprietor and already on the register in respect of—
 - (a) the same goods,
 - (b) the same description of goods, or
 - (c) services or a description of services which are associated with those goods or goods of that description.]
- (2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration [^{F2}by more than one proprietor, in respect of—
 - (a) the same goods,
 - (b) the same description of goods, or
 - (c) goods and services or descriptions of goods and services which are associated with each other,
 of marks that are identical or nearly resemble each other,] subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

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- (3) Where separate applications are made by different persons to be registered as proprietors respectively of [^{F3}marks that are identical or nearly resemble each other, in respect of—
- (a) the same goods,
 - (b) the same description of goods, or
 - (c) goods and services or descriptions of goods and services which are associated with each other,], the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be.

Textual Amendments

- F1** Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\), s. 1\(4\), Sch. 2 para. 2\(2\)](#)
- F2** Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\), s. 1\(4\), Sch. 2 para. 2\(3\)](#)
- F3** Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\), s. 1\(4\), Sch. 2 para. 2\(4\)](#)

13 Registration in Part A to be conclusive as to validity after seven years.

- (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section thirty-two of this Act) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—
- (a) that registration was obtained by fraud, or
 - (b) the trade mark offends against the provisions of section eleven of this Act.
- (2) Nothing in subsection (1) of section five of this Act shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

14 Registration subject to disclaimer.

If a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character;

the Registrar or the Board of Trade or the Court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register,—

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the tribunal holds him not to be entitled; or
- (ii) that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under the registration:

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Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

15 Words used as name or description of an article or substance.

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance:

Provided that, if it is proved either—

- (a) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent (being a patent in force on, or granted after, the twenty-third day of December nineteen hundred and nineteen), that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance; the provisions of the next succeeding subsection shall have effect.

(2) Where the facts mentioned in paragraph (a) or (b) of the proviso to the foregoing subsection are proved with respect to any word or words, then—

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section thirty-two of this Act to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the Court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark,—
 - (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description, or
 - (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of the proviso to the foregoing subsection first became well known and established, or at the expiration of the period of two years mentioned in paragraph (b) of that proviso.

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- (3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section thirteen of this Act, be deemed for the purposes of section thirty-two of this Act to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require: Provided that the foregoing provisions of this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

16 Effect of limitation as to colour, and of absence thereof.

A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark.

If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

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