

Eight things you might not know about the Trade Marks Act 1994

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17 July 2014

ITMA Manchester lunchtime seminar

serle court

The byways of the TMA 1994

- s 21: groundless threats
- s 24: assignment of TMs and goodwill
- s 34: classification issues
- ss 43 & 45: renewal and surrender
- s 46: time periods for revocation
- s 64: rectification
- s 68: security for costs
- s 87: privilege

s 21: groundless threats

- the relief is against the threatener
 - lay client, professional client, individual
- can be used to start the litigation
- alternatively, by way of counterclaim if sued
 - but then need permission to join a new party
 - *Reckitt Benkiser (UK) Ltd v Home Pairfum Ltd*
 - [2004] EWHC 302 (Ch); [2004] FSR 37; [2005] ETMR 94
- Law Commission report on Threats

s 24: assignment of TMs and goodwill

- **s 24(1): a TM may be assigned “independently” of the goodwill of a business**
- **consequences if sever the goodwill from the TM**
 - assignor can still trade using the indicium
 - the TM may now be misleading and so be vulnerable to revocation pursuant to s 46(1)(d)
- **s 24(6): does not affect the assignment of an indicium as part of the goodwill of a business**
 - assignment in gross of goodwill is void at common law

s 34: classification issues

- s 34(2): registrar's decision is final on classification issues
- therefore, cannot appeal the point
 - only judicial review is available
 - wrong in law or unreasonable decision
- *IP Translator* points:
 - eg *Advance Magazine v OHIM* Case T-229/12
 - “accessories” in class 18 “not sufficiently identifiable”

ss 43 & 45: renewal and surrender

- **voluntary – may result from mediation**
- **s 43, rr-34-37, TM11 and TM13: renewal (at the request of the proprietor (vs. reg. pro.)(payment by a TP) and removal for non-payment of renewal fees**
 - r 37(1): restoration “if just to do so”
- **s 45, r 33, TM22 and TM23: surrender**
 - r 33(2): 3 months’ notice to a person with a registered interest in the mark in question – intervention possible?
- **contrast ss 46 and 47:**
 - court-ordered with no notice provisions to third parties

s 46: time periods for revocation

- “Calendar confusion”
 - *ITMA review*, issue 401, May 2013, pp 16-17
- filed 1 Jan 00; reg 1 Oct 00; TM26(N) 20 May 2014
- 5 year periods:
 - s 46(1)(a): 2 Oct 00 – 1 Oct 05
 - intervening s 46(1)(b): 2 Oct 05 – 1 Oct 10
 - last s 46(1)(b): 20 May 09 – 19 May 14
- effective revocation dates
 - 2 Oct 05, 2 Oct 10, 20 May 14
- more than 3 periods possible

s 64: rectification or correction of the register

- **revocation / invalidation / rectification vs cancellation**
- **s 64(1), r 44, TM26(R): error / omission (but not affecting validity of the TM) (*Avon Gripster* [2009] RPC 17)**
 - maybe by a TP
 - unless otherwise ordered: *ab initio*
- **s 64(4), r 52, TM 21: name / address of pro or Lee**
 - r 52: any person having an interest in or charge on a TM
- **s 64(5), r 53, TM7:**
 - removal of matter ceasing to have effect
 - notice to those affected

s 68: security for costs

- **CPR Part 24 rr 12-15**
 - against protagonist
 - out of the jurisdiction or not Brussels Contracting State
- **s 68: against any party to the proceedings**
 - consequences if security is not given
- **r 68(2): in default, consider withdrawn &c.**
- **r 62(1)(f): stays, &c**

s 87: privilege

- s 87(1): “any matter relating to the protection of any design or trade mark or as to any matter involving passing-off”
- s 87(2): akin to legal advice privilege (*R (otao Prudential plc) v Special Commissioner of Income Tax (AIPPI intervening)*): [2013] 2 WLR 325; [2013] 2 All ER 247)
- s 87(3): registered trade mark attorney
 - not trainees (unless working for an RTA or similar)
 - in-house (*Akzo Nobel Chemicals v EC Case C-550/07 P*)

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■ MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)

■ All areas of IP law and practice, in particular patents, trade marks, copyright and designs.

■ Over a 100 reported cases since 2000, of which two thirds were appeals or judicial reviews. Appeared often before the CJEU and the GC (Luxembourg) in appeals from OHIM and Article 267 references (over 40 cases), and in the EPO (Legal and Technical BoA and Opposition Division). Appeared in over 275 matters before the TM registry, and over 60 appeals before the Appointed Person.

■ Acted for the UK government, Comptroller-General of Patents, Registrar of Trade Marks, CIPA, ITMA and AIPPI UK.

IP Juniors at Serle Court



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