

UNAUTHORISED USE OF TRADE MARK

Trade Marks Act 1994

92. - (1) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—
- (a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trade mark, or
 - (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign, or
 - (c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- (2) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—
- (a) applies a sign identical to, or likely to be mistaken for, a registered trade mark to material intended to be used—
 - (i) for labelling or packaging goods,
 - (ii) as a business paper in relation to goods, or
 - (iii) for advertising goods, or
 - (b) uses in the course of a business material bearing such a sign for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, or
 - (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- (3) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—
- (a) makes an article specifically designed or adapted for making copies of a sign identical to, or likely to be mistaken for, a registered trade mark, or
 - (b) has such an article in his possession, custody or control in the course of a business, knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods.

Maximum Sentence:

Trade Marks Act 1994, s.92(6)

Indictment: 10 years imprisonment and/or Unlimited Fine

Summarily: 6 months imprisonment and/or Fine of the prescribed sum (£5,000)

Assessment of Offence

(Starting points and ranges based on 1st time offender convicted following contest)

<u>Nature of Offence</u>		<u>Starting Point</u>	<u>Sentencing Range</u>
Small number of counterfeit items	No involvement in production	Fine	Fine to Community Order
	Involvement in production	Community Order	Fine to Community Order
Larger number of counterfeit items but no involvement in production		Community Order	Community Order to 6 months Custody

<u>Examples of Possible Aggravating Factors of Offence</u>	<u>Examples of Possible Mitigating Factor of Offence</u>
<ol style="list-style-type: none"> 1. High degree of professionalism 2. High level of profit 3. Purchaser at risk of harm (e.g. from counterfeit medicines/health supplements) 	<ol style="list-style-type: none"> 1. Mistake or ignorance about provenance of goods

Relevant Cases:

NI Cases:

R v Rymacki and Jankowski [2013] NICC 20

R v Mahoney [2016] NICA 27

English Cases:

1. R v Yanko [1996] 1 Cr App R(S) 217

2. R v Du'Kett [1998] 2 Cr App R(S) 59

3. R v Adam [1999] 1 Cr App R(S) 403

4. R v Gleeson [2002] 1 Cr App R(S) 112

5. R v Woolridge [2006] 1 Cr App R(S) 13

6. R v Hatton [2008] 1 Cr App R(S) 74

7. R v Brayford [2011] 1 Cr App R(S) 107

Notes:

1. A person does not commit an offence under section 92 unless (a) the goods are goods in respect of which the trade mark is registered, or (b) the trade mark has a reputation in the United Kingdom and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark. – Section 92(4) of the 1994 Act.
2. It is a defence to an offence under section 92 to show reasonable belief that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark. – Section 92(5) of the 1994 Act.