
STATUTORY INSTRUMENTS

2000 No. 136

TRADE MARKS

The Trade Marks Rules 2000

<i>Made</i>	- - - -	<i>23rd January 2000</i>
<i>Laid before Parliament</i>		<i>26th January 2000</i>
<i>Coming into force</i>	- -	<i>17th February 2000</i>

The Secretary of State, in exercise of the powers conferred upon him by sections 4(4), 13(2), 25(1), (5) and (6), 34(1), 35(5), 38(1) and (2), 39(3), 40(4), 41(1) and (3), 43(2), (3), (5) and (6), 44(3), 45(2), 63(2) and (3), 64(4), 65, 66(2), 67(1) and (2), 68(1) and (3), 69, 76(1), 78, 80(3), 81, 82 and 88 of, paragraph 6(2) of Schedule 1 to, paragraph 7(2) of Schedule 2 to, and paragraphs 10(2), 12 and 14(5) of Schedule 3 to, the Trade Marks Act 1994⁽¹⁾, after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992⁽²⁾, hereby makes the following Rules:—

Preliminary

Citation and commencement

1. These Rules may be cited as the Trade Marks Rules 2000 and shall come into force on 17th February 2000.

Interpretation

2.—(1) In these Rules, unless the context otherwise requires—

“the Act” means the Trade Marks Act 1994;

“the Journal” means the Trade Marks Journal published in accordance with rule 71 below;

“the Office” means the Patent Office;

“old law” means the Trade Marks Act 1938⁽³⁾ (as amended) and any rules made thereunder existing immediately before the commencement of the Act;

“proprietor” means the person registered as the proprietor of the trade mark;

“publish” means publish in the Journal;

(1) 1994 c. 26.

(2) 1992 c. 53.

(3) 1938 c. 22.

“send” includes give;

“specification” means the statement of goods or services in respect of which a trade mark is registered or proposed to be registered;

“United Kingdom” includes the Isle of Man.

(2) In these Rules, except where otherwise indicated, a reference to a section is a reference to that section in the Act, a reference to a rule is a reference to that rule in these Rules, a reference to a Schedule is a reference to that Schedule to these Rules and a reference to a form is a reference to that form as published by the registrar under rule 3 below.

(3) In these Rules references to the filing of any application, notice or other document, unless the contrary intention appears, are to be construed as references to its being delivered to the registrar at the Office.

Forms and directions of the registrar under s. 66

3.—(1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before her under the Act pursuant to section 66 and any directions with respect to their use shall be published and any amendment or modification of a form or of the directions with respect to its use shall be published.

(2) A requirement under this rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.

Requirement as to fees

4.—(1) The fees to be paid in respect of any application, registration or any other matter under the Act and these Rules shall be those (if any) prescribed in relation to such matter by rules under section 79 (fees).

(2) Any form required to be filed with the registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules.

Application for registration

Applications for registration; s. 32 (Form TM3)

5.—(1) An application for the registration of a trade mark shall be filed on Form TM3 and shall be subject to the payment of the application fee and such class fees as may be appropriate.

(2) An application for registration of a three-dimensional mark shall not be treated as such unless the application contains a statement to that effect.

(3) Where colour is claimed as an element of the trade mark, it shall not be treated as such unless the application contains a statement to that effect and specifies the colour.

(4) An application to register a trade mark which is or includes a word shall be treated as an application to register that word in the graphical form shown in the application, unless the applicant includes a statement that the application is for registration of the word without regard to its graphical form.

Claim to priority; ss. 35 & 36

6.—(1) Where a right to priority is claimed by reason of an application for protection of a trade mark duly filed in a Convention country under section 35 or in another country or territory in respect of which provision corresponding to that made by section 35 is made under section 36, particulars

of that claim shall be included in the application for registration under rule 5 above and, where no certificate as is referred to in paragraph (2) below is filed with the application, such particulars shall include the country or countries and the date or dates of filing.

(2) Unless it has been filed at the time of the filing of the application for registration, there shall be filed, within three months of the filing of the application under rule 5, a certificate by the registering or other competent authority of that country certifying, or verifying to the satisfaction of the registrar, the date of the filing of the application, the country or registering or competent authority, the representation of the mark, and the goods or services covered by the application.

Classification of goods and services; s. 34

7.—(1) For the purposes of trade mark registrations in respect of goods dated before 27th July 1938, goods are classified in accordance with Schedule 2 to these Rules, except where a specification has been converted, whether under the old law or under rule 46 below, to Schedule 3.

(2) For the purposes of trade mark registrations in respect of goods dated on or after 27th July 1938 and for the purposes of any registrations dated before that date in respect of which the specifications were converted under the old law, and for the purposes of trade mark registrations in respect of services, goods and services are classified in accordance with Schedule 3, which sets out the current version of the classes of the International Classification of Goods and Services⁽⁴⁾.

Application may relate to more than one class and shall specify the class (Form TM3A)

8.—(1) An application may be made in more than one class of Schedule 3.

(2) Every application shall specify the class in Schedule 3 to which it relates and shall list the goods or services appropriate to that class.

(3) If the application relates to more than one class in Schedule 3 the specification contained in it shall set out the classes in consecutive numerical order.

(4) If the specification contained in the application lists items by reference to a class in Schedule 3 in which they do not fall, the applicant may request, by filing Form TM3A, that his application be amended to include the appropriate class for those items, and upon the payment of such class fee as may be appropriate the registrar shall amend his application accordingly.

Prohibition on registration of mark consisting of arms; s. 4

9. Where a representation of any arms or insignia as is referred to in section 4(4) appears in a mark, the registrar shall refuse to accept an application for the registration of the mark unless satisfied that the consent of the person entitled to the arms has been obtained.

Address for service (Form TM33)

10.—(1) For the purposes of any proceedings before the registrar under these Rules or any appeal from a decision of the registrar under the Act or these Rules, an address for service in the United Kingdom shall be filed by—

- (a) every applicant for the registration of a trade mark;
- (b) every person opposing an application for registration of a trade mark;

(4) The International Classification is drawn up under the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of marks of 15th June 1957 (as last revised on 13th May 1977) (Cmnd 6898). The current version of the International Classification is the Seventh Edition, which entered into force on 1st January 1997.

- (c) every applicant applying to the registrar under section 46 for the revocation of the registration of a trade mark, under section 47 for the invalidation of the registration of a trade mark, or under section 64 for the rectification of the register;
 - (d) every person granted leave to intervene under rule 35 (the intervener); and
 - (e) every proprietor of a registered trade mark which is the subject of an application to the registrar for the revocation, invalidation or rectification of the registration of the mark.
- (2) The address for service of an applicant for registration of a trade mark shall upon registration of the mark be deemed to be the address for service of the registered proprietor, subject to any filing to the contrary under paragraph (1) above or rule 44(2) below.
- (3) In any case in which an address for service is filed at the same time as the filing of a form required by the registrar under rule 3 which requires the furnishing of an address for service, the address shall be filed on that form and in any other case it shall be filed on Form TM33.
- (4) Anything sent to any applicant, opponent, intervener or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.
- (5) An address for service in the United Kingdom may be filed at any time by the proprietor of a registered trade mark and by any person having an interest in or charge on a registered trade mark which has been registered under rule 40.
- (6) Where an address for service is not filed as required by paragraph (1) above, the registrar shall send the person concerned notice to file an address for service within two months of the date of the notice and if that person fails to do so—
- (a) in the case of an applicant as is referred to in sub-paragraph (a) or (c), the application shall be treated as abandoned;
 - (b) in the case of a person as is referred to in sub-paragraph (b) or (d), he shall be deemed to have withdrawn from the proceedings; and
 - (c) in the case of the proprietor referred to in sub-paragraph (e), he shall not be permitted to take part in any proceedings.

Deficiencies in application; s. 32

11. Where an application for registration of a trade mark does not satisfy the requirements of section 32(2), (3) or (4) or rule 5(1) or 8(2), the registrar shall send notice thereof to the applicant to remedy the deficiencies or, in the case of section 32(4), the default of payment and if within two months of the date of the notice the applicant—

- (a) fails to remedy any deficiency notified to him in respect of section 32(2), the application shall be deemed never to have been made; or
- (b) fails to remedy any deficiency notified to him in respect of section 32(3) or rule 5(1) or 8(2) or fails to make payment as required by section 32(4) the application shall be treated as abandoned.

Publication, observations, oppositions and registration

Publication of application for registration; s. 38(1)

12. An application which has been accepted for registration shall be published.

Opposition proceedings; s. 38(2) (Forms TM7, TM8 & TM9c)

13.—(1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicant.

(2) Where the opposition is based on an earlier trade mark there shall be included in the notice:

- (a) a representation of that mark; and
- (b) if registered, the classes in respect of which that mark is registered; and
- (c) the goods and services in respect of which that mark is registered, or if not registered, used; and
- (d) where the earlier mark is defined in section 6(1)(a) and (b),
 - (i) the application and/or registration number(s) of that mark, and
 - (ii) except in the case of a mark the subject of an application not yet published, the number of the publication in which it was published.

(3) Subject to paragraphs (4) and (5) below, within three months of the date on which a copy of the notice and statement is sent by the registrar to the applicant, the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(4) Subject to paragraph (5), at any time before the expiry of the period prescribed in paragraph (3) above for filing of Form TM8 by the applicant the registrar may, on request, grant an extension of three months to that period where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party (the “cooling off period”); the registrar may, on request, extend the cooling off period for a further three months where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party.

(5) Within one month after the expiry of the cooling off period the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within that one month period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(6) Where a notice and counter-statement are not filed by the applicant within the period prescribed by paragraph (3) or paragraph (5) as appropriate, he shall be deemed to have withdrawn his application for registration.

(7) Within three months of the date upon which a copy of the counter-statement is sent by the registrar to the person opposing the registration, that person may file such evidence as he may consider necessary to adduce in support of his grounds of opposition and shall send a copy thereof to the applicant.

(8) If the person opposing the registration files no evidence under paragraph (7) above in support of his grounds of opposition, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his opposition.

(9) If the person opposing the registration files evidence under paragraph (7) above or the registrar otherwise directs under paragraph (8) above, the applicant who has filed a notice and counter-statement under paragraph (3) or paragraph (5) as appropriate above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary to adduce in support of his application for registration and shall send a copy thereof to the person opposing the application.

(10) Within three months of the date upon which a copy of the applicant’s evidence is sent to him under paragraph (9) above, the person opposing the application may file evidence in reply which

shall be confined to matters strictly in reply to the applicant's evidence, and shall send a copy thereof to the applicant.

(11) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(12) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

Decision of registrar in opposition proceedings

14.—(1) When the registrar has made a decision on the acceptability of an application for registration following the procedure under rule 13, she shall send the applicant and the person opposing the application written notice of it, stating the reasons for her decision.

(2) For the purpose of any appeal against the registrar's decision the date of the decision shall be the date when notice of the decision is sent under paragraph (1) above.

Observations on application to be sent to applicant; s. 38(3)

15. The registrar shall send to the applicant a copy of any documents containing observations made under section 38(3).

Publication of registration; s. 40

16. On the registration of the trade mark the registrar shall publish the registration, specifying the date upon which the trade mark was entered in the register.

Amendment of application

Amendment of application; s. 39 (Form TM21)

17. A request for an amendment of an application to correct an error or to change the name or address of the applicant or in respect of any amendment requested after publication of the application shall be made on Form TM21.

Amendment of application after publication; s. 39 (Form TM7)

18.—(1) Where, pursuant to section 39, a request is made for amendment of an application which has been published and the amendment affects the representation of the trade mark or the goods or services covered by the application, the amendment or a statement of the effect of the amendment shall also be published.

(2) Notice of opposition to the amendment shall be filed on Form TM7 within one month of the date on which the application as amended was published under paragraph (1) above, and shall include a statement of the grounds of objection and, in particular, how the amendments would be contrary to section 39(2).

(3) The provisions of rule 13 shall apply to proceedings relating to the opposition to the amendment of the application as they apply to proceedings relating to opposition to the registration of a trade mark.

Division, merger and series of marks

Division of application; s. 41 (Form TM12)

19.—(1) At any time before registration an applicant may send to the registrar a request on Form TM12 for a division of his application for registration (the original application) into two or more separate applications (divisional applications), indicating for each division the specification of goods or services; each divisional application shall be treated as a separate application for registration with the same filing date as the original application.

(2) Where the request to divide an application is sent after publication of the application, any objections in respect of, or opposition to, the original application shall be taken to apply to each divisional application and shall be proceeded with accordingly.

(3) Upon division of an original application in respect of which notice has been given to the registrar of particulars relating to the grant of a licence, or a security interest or any right in or under it, the notice and the particulars shall be deemed to apply in relation to each of the applications into which the original application has been divided.

Merger of separate applications or registrations; s. 41 (Form TM17)

20.—(1) An applicant who has made separate applications for registration of a mark may, at any time before preparations for the publication of any of the applications have been completed by the Office, request the registrar on Form TM17 to merge the separate applications into a single application.

(2) The registrar shall, if satisfied that all the applications which are the subject of the request for merger—

- (a) are in respect of the same trade mark,
- (b) bear the same date of application, and
- (c) are, at the time of the request, in the name of the same person, merge them into a single application.

(3) The proprietor of two or more registrations of a trade mark may request the registrar on Form TM17 to merge them into a single registration; and the registrar shall, if satisfied that the registrations are in respect of the same trade mark, merge them into a single registration.

(4) Where any registration of a trade mark to be merged under paragraph (3) above is subject to a disclaimer or limitation, the merged registration shall also be restricted accordingly.

(5) Where any registration of a trade mark to be merged under paragraph (3) above has had registered in relation to it particulars relating to the grant of a licence or a security interest or any right in or under it, or of any memorandum or statement of the effect of a memorandum, the registrar shall enter in the register the same particulars in relation to the merged registration.

(6) The date of registration of the merged registration shall, where the separate registrations bear different dates of registration, be the latest of those dates.

Registration of a series of trade marks; s. 41 (Form TM12)

21.—(1) The proprietor of a series of trade marks may apply to the registrar on Form TM3 for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series; and the registrar shall, if satisfied that the marks constitute a series, accept the application.

(2) At any time before preparations of publication of the application have been completed by the Office, the applicant under paragraph (1) above may request on Form TM12 the division of the application into separate applications in respect of one or more marks in that series and the registrar

shall, if she is satisfied that the division requested conforms with section 41(2), divide the application accordingly.

(3) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series, and the registrar shall delete the mark accordingly.

(4) The division of an application into one or more applications under paragraph (2) above shall be subject to the payment of a divisional fee and such application and class fees as are appropriate.

Collective and certification marks

Filing of regulations for collective and certification marks; Schs. 1 & 2 (Form TM35)

22. Within nine months of the date of the application for the registration of a collective or certification mark, the applicant shall file Form TM35 accompanied by a copy of the regulations governing the use of the mark.

Amendment of regulations of collective and certification marks; Sch. 1 para. 10 and Sch. 2 para. 11 (Forms TM36 & TM7)

23.—(1) An application for the amendment of the regulations governing the use of a registered collective or certification mark shall be filed on Form TM36.

(2) Where it appears expedient to the registrar that the amended regulations should be made available to the public she shall publish a notice indicating where copies of the amended regulations may be inspected.

(3) Any person may, within three months of the date of publication of the notice under paragraph (2) above, make observations to the registrar on the amendments relating to the matters referred to in paragraph 6(1) of Schedule 1 in relation to a collective mark, or paragraph 7(1) of Schedule 2 in relation to a certification mark; the registrar shall send a copy thereof to the proprietor.

(4) Any person may, within three months of the date of publication of the notice, file notice on Form TM7 to the registrar of opposition to the amendment, accompanied by a statement of the grounds of opposition, indicating why the amended regulations do not comply with the requirements of paragraph 6(1) of Schedule 1 or, as the case may be, paragraph 7(1) of Schedule 2.

(5) The registrar shall send a copy of the notice and the statement to the proprietor and thereafter the procedure in paragraphs (3) and (6)–(12) of rule 13 shall apply to the proceedings as they apply to proceedings relating to opposition to an application for registration.

Disclaimers, limitations and alteration or surrender of registered trade mark

Registration subject to disclaimer or limitation; s. 13

24. Where the applicant for registration of a trade mark or the proprietor by notice in writing sent to the registrar—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark, or
- (b) agrees that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

the registrar shall make the appropriate entry in the register and publish such disclaimer or limitation.

Alteration of registered trade mark; s. 44 (Forms TM25 & TM7)

25.—(1) The proprietor may request the registrar on Form TM25 for such alteration of his registered mark as is permitted under section 44; and the registrar may require such evidence by statutory declaration or otherwise as to the circumstances in which the application is made.

(2) Where, upon the request of the proprietor, the registrar proposes to allow such alteration, she shall publish the mark as altered.

(3) Any person claiming to be affected by the alteration may within three months of the date of publication of the alteration under paragraph (2) send a notice on Form TM7 to the registrar of opposition to the alteration and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the proprietor and thereafter the procedure in paragraphs (3) and (6)–(12) of rule 13 shall apply to the proceedings as they apply to proceedings relating to opposition to an application for registration.

Surrender of registered trade mark; s. 45 (Forms TM22 & TM23)

26.—(1) Subject to paragraph (2) below, the proprietor may surrender a registered trade mark, by sending notice to the registrar—

- (a) on Form TM22 in respect of all the goods or services for which it is registered; or
- (b) on Form TM23, in respect only of those goods or services specified by him in the notice.

(2) A notice under paragraph (1) above shall be of no effect unless the proprietor in that notice—

- (a) gives the name and address of any person having a registered interest in the mark, and
- (b) certifies that any such person—
 - (i) has been sent not less than three months' notice of the proprietor's intention to surrender the mark, or
 - (ii) is not affected or if affected consents thereto.

(3) The registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish the same.

Renewal and restoration

Reminder of renewal of registration; s. 43

27.—(1) Subject to paragraph (2) below, at any time not earlier than six months nor later than one month before the expiration of the last registration of a trade mark, the registrar shall (except where renewal has already been effected under rule 28 below) send to the registered proprietor notice of the approaching expiration and inform him at the same time that the registration may be renewed in the manner described in rule 28 below.

(2) If it appears to the registrar that a trade mark may be registered under section 40 at any time within six months before or at any time after the date on which renewal would be due (by reference to the date of application for registration), the registrar shall be taken to have complied with paragraph (1) if she sends to the applicant notice thereof within one month following the date of actual registration.

Renewal of registration; s. 43 (Form TM11)

28. Renewal of registration shall be effected by filing a request for renewal on Form TM11 at any time within the period of six months ending on the date of the expiration of the registration.

Delayed renewal and removal of registration; s. 43 (Form TM11)

29.—(1) If on the expiration of the last registration of a trade mark, the renewal fee has not been paid, the registrar shall publish that fact; and if, within six months from the date of the expiration of the last registration, the request for renewal is filed on Form TM11 accompanied by the appropriate renewal fee and additional renewal fee, the registrar shall renew the registration without removing the mark from the register.

(2) Where no request for renewal is filed as aforesaid, the registrar shall, subject to rule 30 below, remove the mark from the register.

(3) Where a mark is due to be registered after the date on which it is due for renewal (by reference to the date of application for registration), the request for renewal shall be filed together with the renewal fee and additional renewal fee within six months after the date of actual registration.

(4) The removal of the registration of a trade mark shall be published.

Restoration of registration; s. 43 (Form TM13)

30.—(1) Where the registrar has removed the mark from the register for failure to renew its registration in accordance with rule 29 above, she may, upon a request filed on Form TM13 within six months of the date of the removal of the mark accompanied by the appropriate renewal fee and appropriate restoration fee, restore the mark to the register and renew its registration if, having regard to the circumstances of the failure to renew, she is satisfied that it is just to do so.

(2) The restoration of the registration shall be published, with the date of restoration shown.

Revocation, invalidation and rectification

Procedure on application for revocation (on the grounds of non-use); s. 46(1)(a) and (b) (Forms TM8 & TM26(N))

31.—(1) An application to the registrar for revocation under section 46(1)(a) or (b) of the registration of a trade mark shall be made on Form TM26(N) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within three months of the date on which a copy of the notice and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8 and either:

- (a) two copies of evidence of use made of the mark; or
- (b) reasons for non-use of the mark.

Where such a notice and counter-statement, and evidence of use of the mark or reasons for non-use of the mark, are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement, and the evidence of use of the mark or the reasons for non-use of the mark, to the applicant.

(3) Where a counter-statement, in conjunction with a notice of the same, on Form TM8, and evidence of use of the mark or reasons for non-use of the mark, are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within three months of the date upon which a copy of the Form TM8 and counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such further evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within three months of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure on application for revocation (on grounds other than non-use); s.46(1)(c) or (d) (Forms TM8 & TM26(O))

32.—(1) An application to the registrar for revocation under section 46(1)(c) or (d) of the registration of a trade mark shall be made on Form TM26(O) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within six weeks of the date on which a copy of the application and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the applicant.

(3) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within six weeks of the date upon which a copy of the counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure on application for invalidation; s. 47 (Forms TM8 & TM26(I))

33.—(1) An application to the registrar for a declaration of invalidity under section 47(1) or (2) of the registration of a trade mark shall be made on Form TM26(I) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within six weeks of the date on which a copy of the application and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the applicant.

(3) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within six weeks of the date upon which a copy of the counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary to adduce in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure on application for rectification; s. 64 (Form TM26(R))

34.—(1) An application for rectification of an error or omission in the register under section 64(1) shall be made on Form TM26(R) together with:

- (a) a statement of the grounds on which the application is made; and
- (b) any evidence to support those grounds.

(2) Where any application is made under paragraph (1) by a person other than the proprietor of the registered trade mark the registrar—

- (a) shall send a copy of the application and the statement, together with any evidence filed, to the proprietor; and
- (b) may give such direction as she thinks fit with regard to the filing of subsequent evidence upon such terms as she may think fit.

(3) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(4) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure for intervention

35.—(1) Any person, other than the registered proprietor, claiming to have an interest in proceedings on an application under rule 31, rule 32, rule 33 or rule 34 may file an application to the registrar on Form TM27 for leave to intervene, stating the nature of his interest and the registrar may, after hearing the parties concerned if so required, refuse such leave or grant leave upon such terms and conditions (including any undertaking as to costs) as she thinks fit.

(2) Any person granted leave to intervene (the intervener) shall, subject to any terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings for the purposes of the application of the provisions of rule 31, rule 32, rule 33 or rule 34 (as appropriate).

Case Management Conference and Pre-Hearing Review

Case Management Conference; s. 78

36. At any stage of any proceedings before her, the registrar may direct that the parties to the proceedings attend a case management conference where they shall have an opportunity to be heard with regard to the future conduct of the proceedings, and in particular with regard to the proposed exercise of any of the registrar's powers. The registrar shall give the parties at least fourteen days notice of the date of the case management conference.

Pre-hearing review; s. 78

37. Before hearing any party that desires to be heard in any proceedings before her, the registrar may direct that the parties to the proceedings attend a pre-hearing review at which she may give such directions as to the conduct of the hearing as she may think fit. The registrar shall give the parties at least fourteen days notice of the date of the pre-hearing review.

The register

Form of register; s. 63(1)

38. The register required to be maintained by the registrar under section 63(1) need not be kept in documentary form.

Entry in register of particulars of registered trade marks; s. 63(2) (Form TM24)

39. In addition to the entries in the register of registered trade marks required to be made by section 63(2)(a), there shall be entered in the register in respect of each trade mark registered therein the following particulars—

- (a) the date of registration as determined in accordance with section 40(3) (that is to say, the date of the filing of the application for registration);
- (b) the actual date of registration (that is to say, the date of the entry in the register);
- (c) the priority date (if any) to be accorded pursuant to a claim to a right to priority made under section 35 or 36;
- (d) the name and address of the proprietor;
- (e) the address for service (if any) as furnished pursuant to rule 10 above;
- (f) any disclaimer or limitation of rights under section 13(1)(a) or (b);
- (g) any memorandum or statement of the effect of any memorandum relating to a trade mark of which the registrar has been notified on Form TM24;
- (h) the goods or services in respect of which the mark is registered;
- (i) where the mark is a collective or certification mark, that fact;
- (j) where the mark is registered pursuant to section 5(5) with the consent of the proprietor of an earlier trade mark or other earlier right, that fact;
- (k) where the mark is registered pursuant to a transformation application,
 - (a) the number of the international registration, and
 - (b) either:
 - (i) the date accorded to the international registration under Article 3(4), or
 - (ii) the date of recordal of the request for extension to the United Kingdom of the international registration under Article 3ter,
 as the case may be, of the Madrid Protocol;
 - (l) where the mark arises from the conversion of a Community trade mark or an application for a Community trade mark, the number of any other registered trade mark from which the Community trade mark or the application for a Community trade mark claimed seniority and the earliest seniority date.

Entry in register of particulars of registrable transactions; s. 25

40. Upon application made to the registrar by such person as is mentioned in section 25(1)(a) or (b) there shall be entered in the register the following particulars of registrable transactions, that is to say—

- (a) in the case of an assignment of a registered trade mark or any right in it—
 - (i) the name and address of the assignee,
 - (ii) the date of the assignment, and

- (iii) where the assignment is in respect of any right in the mark, a description of the right assigned;
 - (b) in the case of the grant of a licence under a registered trade mark—
 - (i) the name and address of the licensee,
 - (ii) where the licence is an exclusive licence, that fact,
 - (iii) where the licence is limited, a description of the limitation, and
 - (iv) the duration of the licence if the same is or is ascertainable as a definite period;
 - (c) in the case of the grant of any security interest over a registered trade mark or any right in or under it—
 - (i) the name and address of the grantee,
 - (ii) the nature of the interest (whether fixed or floating), and
 - (iii) the extent of the security and the right in or under the mark secured;
 - (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it—
 - (i) the name and address of the person in whom the mark or any right in or under it vests by virtue of the assent, and
 - (ii) the date of the assent; and
 - (e) in the case of a court or other competent authority transferring a registered trade mark or any right in or under it—
 - (i) the name and address of the transferee,
 - (ii) the date of the order, and
 - (iii) where the transfer is in respect of a right in the mark, a description of the right transferred;
- and, in each case, there shall be entered the date on which the entry is made.

Application to register or give notice of transaction; ss. 25 & 27(3) (Forms TM16, TM24, TM50 & TM51)

41.—(1) An application to register particulars of a transaction to which section 25 applies or to give notice to the registrar of particulars of a transaction to which section 27(3) applies shall be made, subject to paragraph (2) below,

- (a) relating to an assignment or transaction other than a transaction referred to in sub-paragraphs (b) to (d) below, on form TM16;
 - (b) relating to a grant of a licence, on form TM50;
 - (c) relating to an amendment to, or termination of a licence, on form TM51;
 - (d) relating to the grant, amendment or termination of any security interest, on form TM24; and
 - (e) relating to the making by personal representatives of an assent or to an order of a court or other competent authority, on form TM24.
- (2) An application under paragraph (1) above shall—
- (a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment;
 - (b) where the transaction falls within sub-paragraphs (b), (c) or (d) of paragraph (1) above, be signed by or on behalf of the grantor of the licence or security interest;

or be accompanied by such documentary evidence as suffices to establish the transaction.

(3) Where the transaction is effected by an instrument chargeable with duty, the application shall be subject to the registrar being satisfied that the instrument has been duly stamped.

(4) Where an application to give notice to the registrar has been made of particulars relating to an application for registration of a trade mark, upon registration of the trade mark, the registrar shall enter those particulars in the register.

Public inspection of register; s. 63(3)

42.—(1) The register shall be open for public inspection at the Office during the hours of business of the Office as published in accordance with rule 70 below.

(2) Where any portion of the register is kept otherwise than in documentary form, the right of inspection is a right to inspect the material on the register.

Supply of certified copies etc; s. 63(3) (Form TM31R)

43. The registrar shall supply a certified copy or extract or uncertified copy or extract, as requested on Form TM31R, of any entry in the register.

Request for change of name or address in register; s. 64(4) (Forms TM21 & TM33)

44.—(1) The registrar shall, on a request made on Form TM21 by the proprietor of a registered trade mark or a licensee or any person having an interest in or charge on a registered trade mark which has been registered under rule 40, enter any change in his name or address as recorded in the register.

(2) The registrar may at any time, on a request made on Form TM33 by any person who has furnished an address for service under rule 10 above, if the address is recorded in the register, change it.

Removal of matter from register; s. 64(5) (Form TM7)

45.—(1) Where it appears to the registrar that any matter in the register has ceased to have effect, before removing it from the register—

- (a) she may, where she considers it appropriate, publish her intention to remove that matter, and
- (b) where any person appears to her to be affected by the removal, she shall send notice of her intention to that person.

(2) Within three months of the date on which her intention to remove the matter is published, or notice of her intention is sent, as the case may be—

- (a) any person may file notice of opposition to the removal on form TM7; and
- (b) the person to whom a notice is sent under paragraph (1)(b) above may file, in writing—
 - (i) his objections, if any, to the removal, or
 - (ii) a request to have his objections heard orally;

and where such opposition or objections are made, rule 54 shall apply.

(3) If the registrar is satisfied after considering any objections or opposition to the removal that the matter has not ceased to have effect, she shall not remove it.

(4) Where there has been no response to the registrar's notice she may remove the matter; where representations objecting to the removal of the entry have been made (whether in writing or orally) the registrar may, if she is of the view after considering the objections that the entry or any part thereof has ceased to have effect, remove it or, as appropriate, the part thereof.

Change of classification

Change of classification; ss. 65(2) & 76(1)

46.—(1) Subject to section 65(3), the registrar may—

- (a) in order to reclassify the specification of a registered trade mark founded on Schedule 2 to one founded on Schedule 3, or
- (b) consequent upon an amendment of the International Classification of Goods and Services referred to in rule 7(2) above,

make such amendments to entries on the register as she considers necessary for the purposes of reclassifying the specification of the registered trade mark.

(2) Before making any amendment to the register under paragraph (1) above the registrar shall give the proprietor of the mark written notice of her proposals for amendments and shall at the same time advise him that—

- (a) he may make written objections to the proposals, within three months of the date of the notice, stating the grounds of his objections, and
- (b) if no written objections are received within the period specified the registrar will publish the proposals and he will not be entitled to make any objections thereto upon such publication.

(3) If the proprietor makes no written objections within the period specified in paragraph (2) (a) above or at any time before the expiration of that period gives the registrar written notice of his intention not to make any objections, the registrar shall as soon as practicable after the expiration of that period or upon receipt of the notice publish the proposals.

(4) Where the proprietor makes written objections within the period specified in paragraph (2) (a) above, the registrar shall, as soon as practicable after she has considered the objections, publish the proposals or, where she has amended the proposals, publish the proposals as amended; and her decision shall be final and not subject to appeal.

Opposition to proposals; ss. 65(3) & 76(1) (Form TM7)

47.—(1) Notice of any opposition shall be filed on Form TM7 within three months of the date of publication of the proposals under rule 46 above and there shall be stated in the notice the grounds of opposition and, in particular, how the proposed amendments would be contrary to section 65(3).

(2) The registrar may require or admit evidence directed to the questions in issue and if so requested by any person opposing the proposal give that person the opportunity to be heard thereon before deciding the matter.

(3) If no notice of opposition under paragraph (1) above is filed within the time specified, or where any opposition has been determined, the registrar shall make the amendments as proposed and shall enter in the register the date when they were made; and her decision shall be final and not subject to appeal.

Request for information, inspection of documents and confidentiality

Request for information; s. 67(1) (Form TM31C)

48. A request for information relating to an application for registration or to a registered trade mark shall be made on Form TM31C.

Information available before publication; section 67(2)

49.—(1) Before publication of an application for registration the registrar shall make available for inspection by the public the application and any amendments made to it and any particulars contained in a notice given to the registrar under rule 41.

(2) Nothing in section 67(2) relating to publication of information shall be construed as preventing the publication of decisions on cases relating to trade marks decided by the registrar.

Inspection of documents; ss. 67 & 76(1)

50.—(1) Subject to paragraphs (2) and (3) below, the registrar shall permit all documents filed or kept at the Office in relation to a registered mark or, where an application for the registration of a trade mark has been published, in relation to that application, to be inspected.

(2) The registrar shall not be obliged to permit the inspection of any such document as is mentioned in paragraph (1) above until she has completed any procedure, or the stage in the procedure which is relevant to the document in question, which she is required or permitted to carry out under the Act or these Rules.

(3) The right of inspection under paragraph (1) above does not apply to—

- (a) any document until fourteen days after it has been filed at the Office;
- (b) any document prepared in the Office solely for use therein;
- (c) any document sent to the Office, whether at its request or otherwise, for inspection and subsequent return to the sender;
- (d) any request for information under rule 48 above;
- (e) any document issued by the Office which the registrar considers should be treated as confidential;
- (f) any document in respect of which the registrar issues directions under rule 51 below that it be treated as confidential.

(4) Nothing in paragraph (1) shall be construed as imposing on the registrar any duty of making available for public inspection—

- (a) any document or part of a document which in her opinion disparages any person in a way likely to damage him; or
- (b) any document or information filed at or sent to or by the Office before 31st October 1994, or
- (c) any document or information filed at or sent to or by the Office after 31st October 1994 relating to an application for registration of a trade mark under the Trade Marks Act 1938.

(5) No appeal shall lie from a decision of the registrar under paragraph (4) above not to make any document or part of a document available for public inspection.

Confidential documents

51.—(1) Where a document other than a form required by the registrar and published in accordance with rule 3 above is filed at the Office and the person filing it requests, at the time of filing or within fourteen days of the filing, that it or a specified part of it be treated as confidential, giving his reasons, the registrar may direct that it or part of it, as the case may be, be treated as confidential, and the document shall not be open to public inspection while the matter is being determined by the registrar.

(2) Where such direction has been given and not withdrawn, nothing in this rule shall be taken to authorise or require any person to be allowed to inspect the document or part of it to which the direction relates except by leave of the registrar.

(3) The registrar shall not withdraw any direction given under this rule without prior consultation with the person at whose request the direction was given, unless the registrar is satisfied that such prior consultation is not reasonably practical.

(4) The registrar may where she considers that any document issued by the Office should be treated as confidential so direct, and upon such direction that document shall not be open to public inspection except by leave of the registrar.

(5) Where a direction is given under this rule for a document to be treated as confidential a record of the fact shall be filed with the document.

Agents

Proof of authorisation of agent may be required; s. 82 (Form TM33)

52.—(1) Where an agent has been authorised under section 82, the registrar may in any particular case require the personal signature or presence of the agent or the person authorising him to act as agent.

(2) Where after a person has become a party to proceedings before the registrar, he appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file Form TM33, and any act required or authorised by the Act in connection with the registration of a trade mark or any procedure relating to a trade mark may not be done by or to the newly appointed agent until on or after the date on which he files that form.

(3) The registrar may by notice in writing sent to an agent require him to produce evidence of his authority.

Registrar may refuse to deal with certain agents; s. 88

53. The registrar may refuse to recognise as agent in respect of any business under the Act—

- (a) a person who has been convicted of an offence under section 84;
- (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents on the ground of misconduct;
- (c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in that register, render him liable to have his name erased from it on the ground of misconduct;
- (d) a partnership or body corporate of which one of the partners or directors is a person whom the registrar could refuse to recognise under paragraph (a), (b) or (c) above.

Decision of registrar, evidence and costs

Decisions of registrar to be taken after hearing

54.—(1) Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings before her, give that party an opportunity to be heard.

(2) The registrar shall give that party at least fourteen days' notice of the time when he may be heard unless that party consents to shorter notice.

Evidence in proceedings before the registrar; s.69

55.—(1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2) The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(5) Where in proceedings before the registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the registrar may, if she thinks fit, permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.

Making and subscription of statutory declaration or affidavit

56.—(1) Any statutory declaration or affidavit filed under the Act or these Rules shall be made and subscribed as follows—

- (a) in the United Kingdom, before any justice of the peace or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceedings;
- (b) in any other part of Her Majesty's dominions or in the Republic of Ireland, before any court, judge, justice of the peace or any officer authorised by law to administer an oath there for the purpose of any legal proceedings; and
- (c) elsewhere, before a commissioner for oaths, notary public, judge or magistrate.

(2) Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by paragraph (1) above to take a declaration may be admitted by the registrar without proof of the genuineness of the seal or signature, or of the official character of the person or his authority to take the declaration.

Registrar's power to require documents, information or evidence

57. At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.

Registrar to have power of an official referee; s. 69

58.—(1) The registrar shall in relation to the examination of witnesses on oath and the disclosure and production of documents have all the powers of an official referee of the Supreme Court.

(2) The rules applicable to the attendance of witnesses before such a referee shall apply in relation to the attendance of witnesses in proceedings before the registrar.

Hearings before registrar to be in public

59.—(1) The hearing before the registrar of any dispute between two or more parties relating to any matter in connection with an application for the registration of a mark or a registered mark shall be in public unless the registrar, after consultation with those parties who appear in person or are represented at the hearing, otherwise directs.

(2) Nothing in this rule shall prevent a member of the Council on Tribunals or of its Scottish Committee from attending a hearing in his capacity as such.

Costs of proceedings; s. 68

60. The registrar may, in any proceedings before her under the Act or these Rules, by order award to any party such costs as she may consider reasonable, and direct how and by what parties they are to be paid.

Security for costs; s. 68

61.—(1) The registrar may require any person who is a party in any proceedings before her under the Act or these Rules to give security for costs in relation to those proceedings; and she may require security for the costs of any appeal from her decision.

(2) In default of such security being given, the registrar, in the case of the proceedings before her, or, in the case of an appeal, the person appointed under section 76 may treat the party in default as having withdrawn his application, opposition, objection or intervention, as the case may be.

Decision of registrar (Form TM5)

62.—(1) When, in any proceedings before her, the registrar has made a decision, she shall send to each party to the proceedings written notice of it, and for the purposes of any appeal against that decision, subject to paragraph (2) below, the date on which the notice is sent shall be taken to be the date of the decision.

(2) Where a statement of the reasons for the decision is not included in the notice sent under paragraph (1) above, any party may, within one month of the date on which the notice was sent to him, request the registrar on form TM5 to send him a statement of the reasons for the decision and upon such request the registrar shall send such a statement; and the date on which that statement is sent shall be deemed to be the date of the registrar's decision for the purpose of any appeal against it.

Appeals

Appeal to person appointed; s. 76

63.—(1) Notice of appeal to the person appointed under section 76 shall be sent to the registrar within 28 days of the date of the registrar's decision which is the subject of the appeal accompanied by a statement in writing of the appellant's grounds of appeal and of his case in support of the appeal.

(2) The registrar shall send the notice and the statement to the person appointed.

(3) Where any person other than the appellant was a party to the proceedings before the registrar in which the decision appealed against was made, the registrar shall send to that person a copy of the notice and the statement.

Determination whether appeal should be referred to court; s. 76(3)

64.—(1) Within 28 days of the date on which the notice of appeal is sent by the registrar under rule 63(3) above;

- (a) the registrar, or
- (b) any person who was a party to the proceedings in which the decision appealed against was made,

may request that the person appointed refer the appeal to the court.

(2) Where the registrar requests that the appeal be referred to the court, she shall send a copy of the request to each party to the proceedings.

(3) A request under paragraph (1)(b) above shall be sent to the registrar; the registrar shall send it to the person appointed and shall send a copy of the request to any other party to the proceedings.

(4) Within 28 days of the date on which a copy of a request is sent by the registrar under paragraph (2) or (3) above, the person to whom it is sent may make representations as to whether the appeal should be referred to the court.

(5) In any case where it appears to the person appointed that a point of general legal importance is involved in the appeal, he shall send to the registrar and to every party to the proceedings in which the decision appealed against was made, notice thereof.

(6) Within 28 days of the date on which a notice is sent under paragraph (5) above, the person to whom it was sent may make representations as to whether the appeal should be referred to the court.

Hearing of appeal; s. 76(4)

65.—(1) Where the person appointed does not refer the appeal to the court, he shall send notice of the time and place appointed for the hearing of the appeal—

- (a) where no person other than the appellant was a party to the proceedings in which the decision appealed against was made, to the registrar and to the appellant, and
- (b) in any other case, to the registrar and to each person who was a party to those proceedings.

(2) The provisions of rule 54(2) and rules 55 to 61 shall apply to the person appointed and to proceedings before the person appointed as they apply to the registrar and to proceedings before the registrar.

(3) The person appointed shall send a copy of his decision, with a statement of his reasons therefor, to the registrar and to each person who was a party to the proceedings before him.

Correction of irregularities, calculation and extension of time

Correction of irregularities of procedure

66. Subject to rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.

Calculation of times and periods

67.—(1) Where, on any day, there is—

- (a) a general interruption or subsequent dislocation in the postal services of the United Kingdom, or
- (b) an event or circumstances causing an interruption in the normal operation of the Office,

the registrar may certify the day as being one on which there is an “interruption” and, where any period of time specified in the Act or these Rules for the giving, making or filing of any notice, application or other document expires on a day so certified the period shall be extended to the first day next following (not being an excluded day) which is not so certified.

(2) Any certificate of the registrar given pursuant to this rule shall be posted in the Office.

(3) If in any particular case the registrar is satisfied that the failure to give, make or file any notice, application or other document within any period of time specified in the Act or these Rules for such giving, making or filing was wholly or mainly attributable to a failure or undue delay in the postal services in the United Kingdom, the registrar may, if she thinks fit, extend the period so that it ends on the day of the receipt by the addressee of the notice, application or other document (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day), upon such notice to other parties and upon such terms as she may direct.

(4) In this rule “excluded day” means a day which is not a business day of the Office under the registrar’s direction pursuant to section 80, as published in accordance with rule 70 below.

Alteration of time limits (Form TM9)

68.—(1) The time or periods—

- (a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or
- (b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules—

- (a) is sought in respect of a time or periods prescribed by rules 13, 18, 23, 25, 31, 32, 33 or 34, the party seeking the extension shall send a copy of the request to each person party to the proceedings;
- (b) is filed after the application has been published under rule 12 above the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rules 13(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).

(4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.

(6) Where the period within which any party to any proceedings before the registrar may file evidence under these Rules is to begin upon the expiry of any period in which any other party may file evidence and that other party notifies the registrar that he does not wish to file any, or any further, evidence the registrar may direct that the period within which the first mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

(7) without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which—

- (a) consists of a failure to comply with any limitation as to times or periods specified in the Act or these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and

(b) is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to her should be rectified,
 she may direct that the time or period in question shall be altered in such manner as she may specify upon such terms as she may direct.

Filing of documents, hours of business, Trade Marks Journal and translations

Filing of documents by electronic means

69. The registrar may, at her discretion, permit as an alternative to the sending by post or delivery of the application, notice or other document in legible form the filing of the application, notice or other document by electronic means subject to such terms or conditions as she may specify either generally by published notice or in any particular case by written notice to the person desiring to file any such documents by such means.

Directions on hours of business; s. 80

70. Any directions given by the registrar under section 80 specifying the hours of business of the Office and business days of the Office shall be published and posted in the Office.

Trade Marks Journal; s. 81

71. The registrar shall publish a journal, entitled “The Trade Marks Journal ”, containing particulars of any application for the registration of a trade mark (including a representation of the mark), such information as is required to be published under these Rules and such other information as the registrar thinks fit.

Translations

72.—(1) Where any document or part thereof which is in a language other than English is filed or sent to the registrar in pursuance of the Act or these Rules, the registrar may require that there be furnished a translation into English of the document or that part, verified to the satisfaction of the registrar as corresponding to the original text.

(2) The registrar may refuse to accept any translation which is in her opinion inaccurate and thereupon another translation of the document in question verified as aforesaid shall be furnished.

Transitional provisions and revocations

Pending applications for registration; Sch. 3, para. 10(2)

73. Where an application for registration of a mark made under the old law is advertised on or after 31st October 1994, the period within which notice of opposition may be filed shall be three months from the date of advertisement, and such period shall not be extendible.

Revocation of previous Rules

74.—(1) The Rules specified in Schedule 1 are hereby revoked.

(2) Except as provided by rule 73 above, where—

- (a) immediately before these Rules come into force, any time or period prescribed by the Rules hereby revoked has effect in relation to any act or proceeding and has not expired, and

(b) the corresponding time or period prescribed by these Rules would have expired or would expire earlier,
the time or period prescribed by those Rules and not by these Rules shall apply to that act or proceeding.

(3) Any proceeding commenced before the registrar before the entry into force of these Rules shall proceed under the Trade Mark Rules 1994 as amended or old law as appropriate; but where a new step is to be taken on or after 26th April 2000 in relation to any proceedings commenced under the Trade Mark Rules 1994 these Rules shall apply to such proceedings from that date.

23rd January 2000

Sainsbury of Turville
Parliamentary Under Secretary of State for
Science and Innovation,
Department of Trade and Industry

SCHEDULE 1

Rule 74

REVOCATIONS

<i>Rules revoked</i>	<i>Reference</i>
The Trade Marks Rules 1994	S.I. 1994/2583
The Trade Marks (Amendment) Rules 1998	S.I. 1998/925

SCHEDULE 2

Rule 7(1)

CLASSIFICATION OF GOODS (PRE-1938)

Class 1 Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.

Class 2 Chemical substances used for agricultural, horticultural, veterinary and sanitary purposes.

Class 3 Chemical substances prepared for use in medicine and pharmacy.

Class 4 Raw, or partly prepared, vegetable, animal, and mineral substances used in manufactures, not included in other Classes.

Class 5 Unwrought and partly wrought metals used in manufacture.

Class 6 Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines and their parts included in Class 7.

Class 7 Agricultural and horticultural machinery, and parts of such machinery.

Class 8 Philosophical instruments, scientific instruments, and apparatus for useful purposes; instruments and apparatus for teaching.

Class 9 Musical instruments.

Class 10 Horological instruments.

Class 11 Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.

Class 12 Cutlery and edge tools.

Class 13 Metal goods, not included in other Classes.

Class 14 Goods of precious metals and jewellery, and imitations of such goods and jewellery.

Class 15 Glass.

Class 16 Porcelain and earthenware.

Class 17 Manufactures from mineral and other substances for building or decoration.

Class 18 Engineering, architectural, and building contrivances.

Class 19 Arms, ammunition, and stores, not included in Class 20.

Class 20 Explosive substances.

Class 21 Naval architectural contrivances and naval equipments not included in other Classes.

Class 22 Carriages.

Class 23 (a) Cotton yarn; (b) Sewing cotton.

Class 24 Cotton piece goods.

Class 25 Cotton goods not included in other Classes.

Class 26 Linen and hemp yarn and thread.

Class 27 Linen and hemp piece goods.

Class 28 Linen and hemp goods not included in other Classes.

Class 29 Jute yarns and tissues, and other articles made of jute, not included in other Classes.

Class 30 Silk, spun, thrown, or sewing.

Class 31 Silk piece goods.

Class 32 Silk goods not included in other Classes.

Class 33 Yarns of wool, worsted, or hair.

Class 34 Cloths and stuffs of wool, worsted, or hair.

Class 35 Woollen and worsted and hair goods, not included in other Classes.

Class 36 Carpets, floor-cloth, and oil-cloth.

Class 37 Leather, skins unwrought and wrought, and articles made of leather not included in other Classes.

Class 38 Articles of clothing.

Class 39 Paper (except paper hangings), stationery, and bookbinding.

Class 40 Goods manufactured from india-rubber and gutta-percha not included in other Classes.

Class 41 Furniture and upholstery.

Class 42 Substances used as food or as ingredients in food.

Class 43 Fermented liquors and spirits.

Class 44 Mineral and aerated waters, natural and artificial, including ginger beer.

Class 45 Tobacco, whether manufactured or unmanufactured.

Class 46 Seeds for agricultural and horticultural purposes.

Class 47 Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.

Class 48 Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).

Class 49 Games of all kinds and sporting articles not included in other Classes.

Class 50 Miscellaneous:—

- (1) Goods manufactured from ivory, bone or wood, not included in other Classes.
- (2) Goods manufactured from straw or grass, not included in other Classes.
- (3) Goods manufactured from animal and vegetable substances, not included in other Classes.
- (4) Tobacco pipes.
- (5) Umbrellas, walking sticks, brushes and combs for the hair.
- (6) Furniture cream, plate powder.
- (7) Tarpaulins, tents, rick-cloths, rope (jute or hemp), twine.
- (8) Buttons of all kinds other than of precious metal or imitations thereof.
- (9) Packing and hose.
- (10) Other goods not included in the foregoing Classes.

SCHEDULE 3

Rule 7(2)

CLASSIFICATION OF GOODS AND SERVICES

Goods

Class 1 Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 2 Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 4 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.

Class 5 Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 6 Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

Class 7 Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements (other than hand operated); incubators for eggs.

Class 8 Hand tools and implements (hand operated); cutlery; side arms; razors.

Class 9 Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

Class 10 Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.

Class 11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class 12 Vehicles; apparatus for locomotion by land, air or water.

Class 13 Firearms; ammunition and projectiles; explosives; fireworks.

Class 14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 15 Musical instruments.

Class 16 Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites

(except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

Class 17 Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

Class 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 19 Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

Class 20 Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21 Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

Class 23 Yarns and threads, for textile use.

Class 24 Textiles and textile goods, not included in other classes; bed and table covers.

Class 25 Clothing, footwear, headgear.

Class 26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

Class 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

Class 28 Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 31 Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Class 32 Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33 Alcoholic beverages (except beers).

Class 34 Tobacco; smokers' articles; matches.

Services

Class 35 Advertising; business management; business administration; office functions.

Class 36 Insurance; financial affairs; monetary affairs; real estate affairs.

Class 37 Building construction; repair; installation services.

Class 38 Telecommunications.

Class 39 Transport; packaging and storage of goods; travel arrangement.

Class 40 Treatment of materials.

Class 41 Education; providing of training; entertainment; sporting and cultural activities.

Class 42 Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; services that cannot be placed in other classes.

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules revoke and replace the Trade Marks Rules 1994 (S.I. 1994/2583, as amended). They re-enact, with modifications and amendments of a drafting nature, the 1994 Rules as amended and make several changes of substance in order to give better effect to the provisions of the Trade Marks Act 1994 (“the Act”).

The changes of substance are as follows—

- (1) with the consent of both of the parties the registrar may grant a “cooling-off” period in actions for opposition to registration of a trade mark (rule 13);
- (2) certain time limits in actions for revocation (on grounds other than non-use) and invalidation have been reduced from three months to six weeks (rules 32 and 33);
- (3) the time limit for appeal to the appointed person has been reduced from one month to 28 days (rule 63);
- (4) an application for a trade mark now requires more detailed information regarding the specification of the class of goods or services in Schedule 4 to which it relates (rule 8);
- (5) provision has been made for “filing” of a document with the registrar to mean delivery of that document to the registrar at the Office (rule 2);
- (6) nothing in section 67(2) of the Act relating to publication of information is to be construed as preventing the publication of decisions of cases relating to trade marks decided by the registrar (rule 49);
- (7) provision has been made for the registrar to call case management conferences and pre-hearing reviews (rules 36 and 37);
- (8) where the Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may now be used as an alternative (rule 55);
- (9) provision has been made for the calling and cross-examination of persons in proceedings where a party has adduced evidence of a statement made by a person otherwise than while giving oral evidence in those proceedings and does not call that person as a witness (Rule 55).

Any proceeding commenced before the registrar before the entry into force of these Rules shall proceed under the Trade Mark Rules 1994 as amended or old law as appropriate, but where a new step is to be taken on or after 26th April 2000 in relation to any proceedings commenced under the Trade Mark Rules 1994 these Rules shall apply to such proceedings from that date.

A regulatory impact appraisal is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Trade Marks Directorate of the Patent Office, Room 2.005, Concept House, Cardiff Road, Newport NP10 8QQ.