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STATUTORY INSTRUMENTS

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**2012 No. 1003**

**TRADE MARKS**

The Trade Marks and Trade Marks  
(Fees) (Amendment) Rules 2012

<i>Made</i>	- - - -	<i>3rd April 2012</i>
<i>Laid before Parliament</i>		<i>4th April 2012</i>
<i>Coming into force</i>	- -	<i>1st October 2012</i>

The Secretary of State has consulted the Administrative Justice and Tribunals Council pursuant to paragraph 24 of Schedule 7 to the Tribunals, Courts and Enforcement Act 2007<sup>(1)</sup>.

The Secretary of State, in exercise of the powers conferred by sections 41(1) and (3), 78 and 79 of the Trade Marks Act 1994<sup>(2)</sup>, makes the following Rules—

**Citation and commencement**

1. These Rules may be cited as the Trade Marks and Trade Marks (Fees) (Amendment) Rules 2012 and come into force on 1st October 2012 (‘the commencement date’).

**Amendments to the Trade Marks Rules 2008**

2.—(1) The Trade Mark Rules 2008<sup>(3)</sup> are amended as follows.

(2) In Rule 14—

(a) for paragraph (2) substitute—

“(2) In paragraph (1), “relevant proprietor” means the proprietor of a registered trade mark or international trade mark (UK) which is an earlier trade mark in relation to which it appears to the registrar that the conditions set out in section 5(1) or (2) obtain but does not include a proprietor who does not wish to be notified and who has notified the registrar to this effect.”.

(b) paragraphs (4) to (6) are revoked.

(3) In Rule 27—

(a) paragraphs (1) and (2) are revoked;

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(1) [2007 c.15](#). The comptroller-general of patents, designs and trade marks is listed for the purposes of paragraph 25(2) of Schedule 7 to the Tribunals Courts and Enforcement Act 2007 by [S.I. 2007/2951](#).  
(2) [1994 c.26](#).  
(3) [S.I.2008/1797](#), to which there are amendments not relevant to these Rules.

- (b) in paragraph (3) after “The proprietor of two or more registrations of a trade mark” insert “, the applications relating to which were filed on the same date,”; and
- (c) after paragraph (3) insert—
  - “(3A) No application under paragraph (3) may be granted in respect of the registration of a trade mark which—
    - (a) is the subject of proceedings for its revocation or invalidation; or
    - (b) is the subject of an international registration within the meaning of article 2 of the Trade Marks (International Registration) Order 2008 which has not become independent of the trade mark as provided for in accordance with Article 6 of the Madrid Protocol<sup>(4)</sup>.”.

### **Amendments to the Trade Marks (Fees) Rules 2008**

- 3.—(1) The Trade Marks (Fees) Rules 2008<sup>(5)</sup> are amended as follows.
- (2) The entry relating to TM6 in the Schedule to the Rules is revoked.

### **Transitional provisions**

- 4. The amendments made to Rule 27 of the Trade Marks Rules 2008 do not apply to any application made pursuant to rule 27(1) or 27(3) prior to the commencement date.

3rd April 2012

*Mark Prisk*  
Minister of State for Business and Enterprise  
Department for Business, Innovation and Skills

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(4) The Madrid Protocol is defined for the purposes of the Trade Marks Act 1994 (c.26) by section 53 of that Act.  
(5) S.I.2008/1958, to which there are amendments not relevant to these Rules.

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## EXPLANATORY NOTE

*(This note is not part of the Rules)*

These Rules amend the Trade Mark Rules 2008. Rule 2 amends Rule 14 to remove the ability of the proprietor of a Community trade mark or international trade mark entitled to protection in the European Union under the Madrid Protocol to request to be notified of the results of searches under article 4 of the Trade Marks (Relative Grounds) Order 2007. Rule 2 also amends article 27 of the 2008 Rules to remove the procedure for the merger of trade mark applications before any trademarks have been registered pursuant to those applications. It also provides that an application for merger of trade marks can only be made in respect of trade marks that have the same renewal date. The amendments made by Rule 2 also prohibit an application for merger of trade marks which are the subject of proceedings for revocation or invalidation or which are the subject of an international registration pursuant to the Madrid Protocol. Rule 3 contains an amendment to the Trade Marks (Fees) Rules 2008 in consequence of the amendments to Rule 14 of the Trade Marks Rules 2008. Rule 4 contains transitional provisions.

An impact assessment of the effect that these Regulations will have on the private and voluntary sectors has been prepared in respect of the amendments made to rule 27 of the 2008 Rules and is available alongside the instrument at [www.legislation.gov.uk](http://www.legislation.gov.uk). No impact assessment has been prepared in relation to the amendments to Rule 14 as they will have a negligible impact on the private and voluntary sectors.