

Consultation Paper on: Modernisation and Consolidation of the Trade Marks Rules



CONSULTATION PAPER ON: MODERNISATION AND CONSOLIDATION OF THE TRADE MARKS RULES

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Introduction

1. The Trade Marks Rules 2000 (S.I. 2000/136, as amended) set out procedural and operational requirements which apply to trade marks and trade mark applications. This consultation document presents proposals to consolidate these Rules and also proposes some specific changes to some rules and seeks comments on these proposals.

Summary

2. The Trade Marks Rules 2000 have been amended seven times since they came into force. We suggest that it would be appropriate to issue a consolidated version of the Rules adopting a more modern drafting style and incorporating changes to the rules of procedure which better reflect current litigation practice.
3. The policy objectives of this exercise are fourfold:
 - I. Consolidation of existing changes to the Trade Marks Rules 2000 in order to increase accessibility and remove existing duplication, inconsistency and possible confusion.
 - II. Bringing the UK fully into line with international best practice and enabling ratification of the Singapore Treaty on Trade Mark Law.
 - III. Making the tribunal system more flexible, efficient and proportionate.
 - IV. Introducing business changes so as to increase the speed and efficiency of processes and reduce costs.
4. A similar consolidation and modernisation exercise has been carried out for registered designs and patents. This led to the Registered Designs Rules 2006¹ and the Patents Rules 2007².
5. We would welcome any comments on these proposals and the draft statutory instrument which is attached in Annex A. We would be particularly interested in responses to the 13 specific questions asked in this document.

Responding to the consultation:

6. Please email any views you have to consultation@ipo.gov.uk. Alternatively please send us your views in writing to the following postal address marked "Trade Marks Rules Consolidation":

Paul Crawford
UK Intellectual Property Office
Concept House
Cardiff Road
Newport, NP10 8QQ

Tel: 01633 814061
Fax: 01633 811055

¹ <http://www.opsi.gov.uk/si/si2006/20061975.htm>

² http://www.opsi.gov.uk/si/si2007/uksi_20073291_en_1

7. In line with the Government's code of practice on consultations (attached at Annex B), please let us have your responses by ~~Monday 26 May 2008~~. N.B. The **deadline** for this consultation has been **extended to 27 May 2008** to allow for the Spring Bank Holiday
8. Responses are welcomed from any individual, organisation, company or firm. Copies of this document, including large print versions, are available from the contact address given above. A full list of the organisations and individuals being sent this document is given in Annex C.

Impact assessment

9. Partial impact assessments (IAs) have been produced and are attached in Annex D. The IAs set out our assessment of the impact that these new procedures will have on users. Please take time to read these documents and let us have any comments you may have on their contents. After considering any comments we receive, and if we decide to implement the proposals the IAs will be finalised and accompany the legislation in order that the responsible Minister can confirm that the benefits of the legislation justify any costs that it will introduce.

Openness/Confidentiality

10. This is part of a review exercise, the results or conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in your fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.
11. Information provided in response to this review, including personal information, may be subject to publication or disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want other information that you request to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.
12. In view of this it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. An automatic confidentiality disclaimer generated by your IT system will not, of itself, be regarded as binding. The UK Intellectual Property Office will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.

Summary of Consultation Questions

Question 1: Do you agree that draft Rules 11 and 12 are an effective means of introducing the requirement for an address for service in the UK, EEA or Channel Islands in contested trade mark proceedings? Do you believe that any further or consequential changes are required?

Question 2: Would the benefit of speeding up by 7 weeks the time taken to register the majority of new trade marks offset the new burden of needing in some cases to complete a simple on-line form within 6 weeks of the publication of new trade marks in order to file an opposition during the balance of the three month opposition period?

Question 3: If you believe that the 'split' system would be too burdensome, would a fixed two month opposition period combined with a cooling off period of up to 18 months provide sufficient opportunities to avoid and resolve litigation?

Question 4: Do you agree that the length of the cooling off period should be more flexible?

Question 5: Do you agree with the proposal that the cooling off period should be 9 months initially, but extendible to 18?

Question 6: Do you agree that extension of the cooling off period should be subject only to compliance with the requirements that 1) it is sought within the initial 9 month period, 2) it is agreed by the parties, and 3) the request is accompanied by a statement supported by a statement of truth confirming that the parties are negotiating a settlement?

Question 7: Do you have any alternative ideas as to how the current opposition/cooling off arrangements could be improved?

Question 8: Do you agree that in non-use revocation cases the normal rule should be that proprietors should have one (extendible) period in which to file all their evidence of use?

Question 9: In framing the new rule to provide for the setting aside of decisions we would be grateful for user's thoughts on the most appropriate way to ensure equity, including the appropriate time period allowed for applying for reinstatement.

Question 10: We would be interested in respondents' experience of the operation of the provisions for appeals in Article 57(2) of the Community Trade Mark Regulation and any evidence that shows why similar provisions should be not be adopted into the national rules governing appeals.

Question 11: Would you welcome faster publication of new applications? Would publishing data only for information purposes on the Office web site present you with difficulties (and, if so, what are they)?

Question 12: Can you identify any serious problems that would arise from amending the specified time periods as proposed in paragraphs 57 and 59?

Question 13: Do you agree that priority documents should normally only be required to support a priority claim where there is a third party opposition or invalidation?

Section I: - Consolidation of the Trade Marks Rules

13. The Trade Mark Rules 2000 are the main piece of secondary legislation made under the Trade Marks Act 1994. The Rules have been amended seven times since they came into force; these amendments have led to some unnecessary duplication and possible causes of confusion.
14. The first purpose of the consolidation is to ensure that the Rules are as clear as possible and all in one place. We expect that this will save users of the trade mark system time in establishing the current Rules governing national registration procedures. Indeed, anecdotal feedback from users is that a consolidation of the Rules would be welcomed.

Section II: - International Harmonisation

15. The UK was one of the initial signatories to the Singapore Treaty on the Law of Trade Marks in March 2006³. This treaty sets out international minimum standards for the benefit of users of registration systems, which the UK is keen to promote. The UK system is already compliant with the Singapore Treaty with only one exception. Article 14 of the Treaty requires the states which have ratified it to offer one of three relief measures to users who have missed a deadline in most *ex parte* dealings with the registration authority. We propose that (in accordance with Article 14(2)(i)) in most dealings between applicants and proprietors and the UK-IPO (*ex parte matters*) the applicant or proprietor will have the right to a retrospective extension of time to complete an action before the UK-IPO provided it is sought within two months of the end of the relevant expired period. Such retrospective requests will have to be filed on Form TM9 and will be subject to a £50 filing fee. Some periods will not be extendible as of right. For example, the periods allowed for filing appeals or renewal requests (which already benefit from a self contained regime for obtaining late renewal). Nor will the right to obtain a retrospective extension apply to parties taking part in proceedings before the registrar involving a second party (*inter partes matters*). These provisions are contained in rule 77 of the draft instrument attached in Annex A.
16. In 2006 amendments were made to the Trade Mark Rules 2000 to liberalise requirements imposed on applicants for registered intellectual property rights. Since then an address for service in the UK, the European Economic Area (EEA) or the Channel Islands has been sufficient for all dealings with the UK-IPO, except for contested proceedings where a UK address for service has usually continued to be required. In practice, all but a handful of those conducting business before the Office have continued to provide an address for service in the UK. However, as companies increasingly operate on a Europe-wide basis, and communications across European borders become easier, the practical benefits of maintaining a requirement for a UK address for service for contested proceedings are reduced, and companies may wish to use a single address for dealings with all national offices, instead of supplying

³ http://www.wipo.int/treaties/en/ip/singapore/singapore_treaty.html

multiple addresses for service. Moreover, the Office for Harmonisation in the Internal Market (OHIM) operates a Community-wide trade mark tribunal with service throughout the EC. In this context, it is hard to justify a requirement for a national address for service.

17. We plan to extend the current provisions allowing addresses for service anywhere in the EEA and the Channel Islands, to all dealings with the UK-IPO including contested proceedings. This would enable businesses to operate more flexibly and efficiently, allowing them to take advantage of the free provision of services in the EU, which is enshrined in Article 49 of the EC Treaty. The UK, in common with all EU Member States, is committed to providing free access by European service providers to the UK market, allowing consumers to benefit from increased choice over service providers. Maintaining a requirement for a UK address for service beyond the time that it can be objectively justified might result in the UK defaulting on its obligations under Article 49 of the EC Treaty. Several other EU Member States have faced challenges to similar restrictions in recent years, which have led them to remove their national restrictions on trade mark service providers.
18. It has therefore been decided to amend the rules so that an address for service in the United Kingdom, another EEA State or the Channel Islands is acceptable for all purposes. Proposed new rules 11 and 12 will bring about this result.
19. The purpose of this consultation is not to seek your views about whether the change should be made, but rather about whether the method of implementation we propose is an effective and sufficient means to achieve it.

Question 1: Do you agree that draft rules 11 and 12 are an effective means of introducing the requirement for an address for service in the UK, EEA or Channel Islands in contested trade mark proceedings? Do you believe that any further or consequential changes are required?

Section III: - Making the Tribunal system more efficient and proportionate.

Changes to opposition procedures.

20. In 1994 the opposition period for trade mark applications was changed from an extendible period of one month to a fixed period of three months. One of the purposes of this extension was to allow a long enough (but not indefinite) period of time for negotiation between parties so as to avoid formal opposition. Since this change was introduced a twelve month post opposition cooling off period has also been introduced in order to allow time for more extended negotiations so as to resolve opposition proceedings at an early stage and thus minimise cost to the parties. The cooling off period has been very successful: nearly 90% of those cases entering the cooling off period are resolved without the litigation continuing. It appears to us that the introduction of a post opposition cooling off period has reduced some of the justification for the length of the

three month opposition period. Further, a user survey in August 2006 indicated a strong desire amongst some user groups for faster trade mark registration. This manifested itself again recently in user comments on the proposal to introduce a 'fast track' procedure for examining new trade mark applications. Although that proposal was received positively overall, a number of respondents noted that the advantage of expedited examination would be diluted to some extent by the length of the statutory opposition period, which now accounts for the majority of the time it takes to register a new trade mark.

21. We have looked at practice elsewhere in the world in order to see whether there is an international 'norm' for a trade mark opposition period. An international comparison reveals that twenty three Trade Mark Offices currently have a non extendible opposition period of two months. These include Japan, Benelux, France and Denmark. Twenty one Offices currently have a non extendible opposition period of three months. These include OHIM, Ireland, Switzerland and Romania. This information was taken from the INTA International Opposition Guide⁴ which provides information on opposition practices in 130 jurisdictions. We have therefore concluded that there is no *de facto* international standard. Opposition periods tend to be either 2 or 3 months. However, there are significant exceptions. For example, the USA has an initial 30 day opposition period which can be extended by 90 days without consent of the applicant, followed by a further sixty days with the applicant's consent.

22. Only 3% of Trade Marks published in 2006/7 were opposed. Early experience of the opposition rate following the Section 5 (Relative Grounds) changes to examination system made last year suggests that the rate of opposition is likely to remain at 10% or less. On the face of it therefore, the registration of 90% of published trade marks is delayed by three months for no productive purpose. However, it is recognised that some oppositions are avoided by discussions between the parties which take place in the opposition period, without which the opposition rate would be higher. It may therefore be the case that 20% or more of published trade marks are seriously considered for opposition. Even that figure implies that the registration of up to 80% of published marks is unnecessarily delayed by three months.

23. We are therefore considering two possible options:

- Reducing the current opposition period to 2 months to accelerate the registration of unopposed trade marks. OR
- Splitting the opposition period so as to accelerate unopposed trade marks. Following publication there would be an initial period of six weeks for parties to consider whether they might wish to oppose the application. If opposition is not filed within the initial six week period, but is still being considered, then an electronic form TM7A would be filed and the opposition period would be automatically extended to three months. The TM7A will be a simple form with no associated fee.

⁴ http://www.inta.org/index.php?option=com_content&task=view&id=57&Itemid=121&getcontent=1

Should no opposition or TM7A be filed within six weeks of publication then the mark will be registered. The simplified flow charts on page 10 set out the current application procedure, and how this proposal would change it.

24. In making the proposal for a new 'split' opposition process as described above we have noted that the system which operated in the UK up until 1994 provided only a one month opposition period. Although this period was extendible, the evidence of having operated this system suggests that the vast majority of users were able to oppose or seek an extension of the opposition period within the initial one month period. We therefore believe that the six week period proposed should be perfectly workable from that point of view. Draft rule 17(2) and (3) reflect this second option.

Changes to the Cooling Off Period

25. Although the cooling off period has been successful, there is some evidence that the 12 month period allowed is sometimes not long enough: a significant number of requests to stay the proceedings are received immediately following the end of the cooling off period. Further, although the cooling off period can be terminated before the end of the 12 month period, the number of such periods being terminated early in practice (because the parties have settled) is very small. It would be surprising if 12 months was nearly always necessary for the parties to resolve matters. It therefore appears that the current arrangements are not encouraging disputes to be settled as quickly as they could be in some cases, and in other cases the period allowed does not appear to be long enough.
26. In order to minimise the administrative burden and costs to parties and the UK-IPO we prefer to keep the cooling off arrangements as simple as possible consistent with our twin objectives of 1) encouraging parties to settle early, but 2) providing greater flexibility where negotiations are underway. We therefore propose to reduce the initial cooling off period from 12 months to 9 months. As now the period would be calculated from the date that the notice of opposition is sent to the applicant. We further propose that this period should be extendible through one extension to 18 months provided that:
- the extension request is made within the initial period of 9 months
 - the parties agree to the extension, and
 - the request is accompanied by a statement that the parties are negotiating a settlement supported by a statement of truth.

In the event that the cooling off period is made extendible to 18 months, we would envisage taking a stronger line on applications for stays of proceedings made immediately following the end of the cooling off period, which appear in some cases to be attempts to circumvent the supposedly fixed length of the cooling off period. However, the Rules would still give the Registrar the power to stay proceedings at any time if there is a sufficiently good reason for doing so, and this could include the time immediately following the end of the cooling off period.

27. We are therefore considering this change:

- Reducing the cooling off period to 9 months initially, but introducing the option for parties to seek a single extension of the period to a maximum period of 18 months. The proposal is reflected in draft rule 18.

Related Changes

28. We are considering making related changes to the periods for filing notices of opposition and counterstatements in relation to the following matters so that two months is allowed for this purpose in each case.

- i) Opposition to alteration of registered trade marks (draft rule 32).
- ii) Opposition to the removal of matter from register (draft rule 53).
- iii) Opposition to proposals for a change to classification (draft rule 55).
- iv) Opposition to the amendment of the regulations governing a collective or certification mark (draft rule 30).

Question 2: Would the benefit of speeding up by 7 weeks the time taken to register the majority of new trade marks offset the new burden of needing in some cases to complete a simple on-line form within 6 weeks of the publication of new trade marks in order to file an opposition during the balance of the three month opposition period?

Question 3: If you believe that the 'split' system would be too burdensome, would a fixed two month opposition period combined with a cooling off period of up to 18 months provide sufficient opportunities to avoid and resolve litigation?

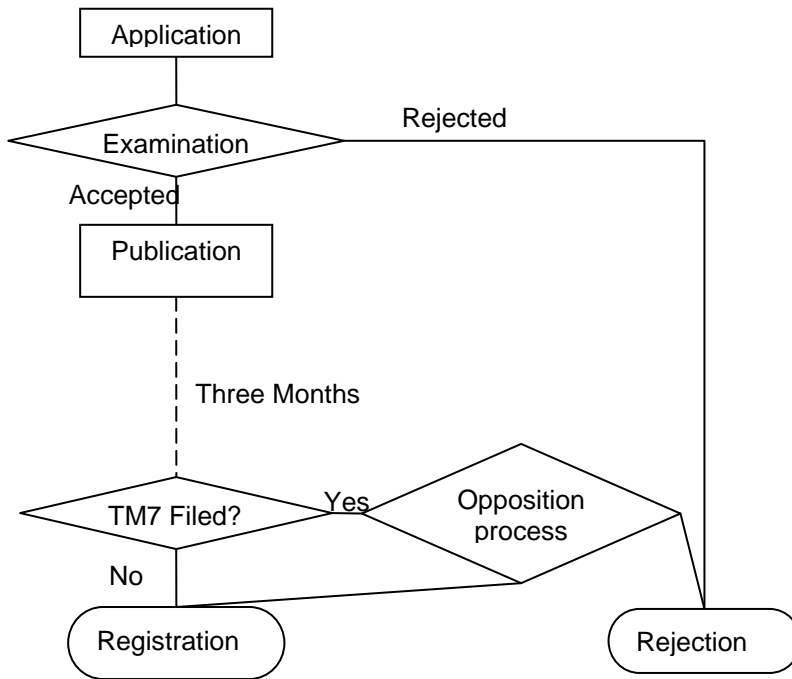
Question 4: Do you agree that the length of the cooling off period should be more flexible?

Question 5: Do you agree with the proposal that the cooling off period should be 9 months initially, but extendible to 18?

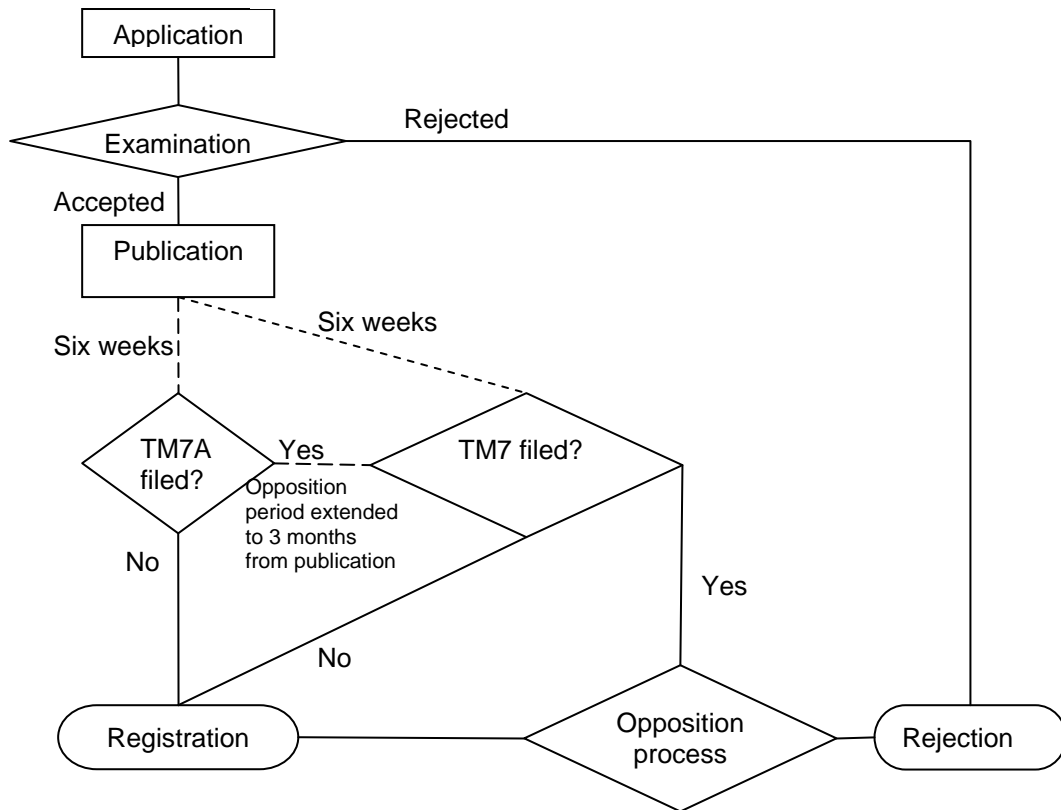
Question 6: Do you agree that extension of the cooling off period should be subject only to compliance with the requirements that 1) it is sought within the initial 9 month period, 2) it is agreed by the parties, and 3) the request is accompanied by a statement supported by a statement of truth confirming that the parties are negotiating a settlement?

Question 7: Do you have any alternative ideas as to how the current opposition/cooling off arrangements could be improved?

Current Process



Proposed process post October 2008



Periods for Filing Counterstatements

29. We are also seeking greater consistency in the periods allowed for undertaking similar tasks in analogous types of proceedings. For example, (cooling off arrangements aside) three months is currently allowed to file a counterstatement in opposition proceedings, whereas in post registration invalidation actions only six weeks is allowed for filing the same document. As most proprietors appear to be able to operate with a six week period for filing a counterstatement in invalidation proceedings, it is not clear why more time is required in opposition proceedings. However, given the larger volume of opposition proceedings compared to post registration cancellation actions and the extra demands this volume places on professional representatives, we propose to standardise the period for filing a counterstatement in opposition, invalidation and revocation proceedings at two months in each case.
30. We recognise that the current three month period for filing a counterstatement in revocation cases where the grounds for revocation are non-use is influenced by the current requirement that evidence of use must be filed within the same period. There is a proposal below for the period for filing evidence of use in non-use revocation cases to be changed. One of the consequences of this proposal is that it will no longer be tied to the period allowed to file a counterstatement. Consequently, we believe that two months will also be an appropriate period of time for the filing of a counterstatement in this class of revocation proceedings.

Consequences of failing to file a Counterstatement in Opposition Proceedings.

31. At present, if an applicant fails to file a counterstatement in the period allowed for filing opposition their application is automatically refused. We feel this can be heavy handed on occasions and propose to amend the rules to give the Registrar discretion to “direct otherwise”. This would permit a late defence to be considered provided that the request is made before the application is refused (draft rule 18(2)).

Preliminary Indications (PI).

32. The rules give the Registrar discretion to give a preliminary indication as to the likely outcome of an opposition based on section 5(1) or (2) of the Act (relative grounds for refusal). At present the rules provide that, in the event of a PI that is adverse to the opponent and where no TM53 is filed the opposition should be deemed withdrawn in its entirety. We are considering a change to the Rules so that the effect of an adverse PI on the opponent will be that unless a TM53 is filed, the opposition to the extent that it is based on the section 5(1) or (2) grounds **only** will be deemed abandoned. As a consequence of this it will no longer be necessary to file a TM53 to proceed with other grounds of opposition. The new rule will also make it clear that where no TM53 is filed and the PI indicates partial success for the opponent on 5(1) or (2) grounds the application will only be deemed withdrawn in respect of the opposed goods/services subject to the adverse PI. These proposals are reflected in draft rule 19.

Filing Evidence and Case Management Powers – General

33. At present the rules specify fixed time periods for the filing of evidence and such periods are specified separately for the different types of proceeding. In some instances this makes the rules rather duplicative. Further, although the standard time periods set out in the rules are suitable for the majority of the cases to which they apply they are inherently inflexible and limit the UK-IPO's ability to respond to less usual circumstances where longer or shorter time periods of time for filing evidence might be appropriate.
34. In order to address this weakness and bring the rules of the tribunal for Trade Marks into line with the rules governing the filing of evidence before the UK-IPO in disputes concerning other registered rights, it is proposed that the rules governing the filing of evidence in contested trade mark proceedings should give the Registrar the power to set a timetable for the parties to file evidence, taking account of the circumstances of each case.
35. It is further proposed that the Registrar be given express powers to manage proceedings covering the sorts of things that the Registrar has, up until now, dealt with on the basis of an assumed inherent jurisdiction (for example, amendments to documents filed in proceedings and stays to, and consolidations of, proceedings). Further, it is proposed that the Registrar be given powers to direct the issues on which evidence is required, the sort of evidence required to address those issues and the way in which the evidence is to be placed before the Registrar. The exercise of these powers has the potential to better focus evidence in trade mark proceedings onto relevant matters, thus reducing wasted costs and saving time. This is likely to be more important in the future as the volume of contested cases before the Registrar increases as a result of the recent changes to the system of examining new trade mark applications on relative grounds.
36. The case management powers proposed in new rule 62 are very similar to the equivalent powers provided in the Patents and Registered Designs Rules. The proposed change to the Trade Mark Rules would therefore also produce greater consistency between the different rules operating in the tribunals of the UK-IPO.
37. Similarly, new rule 64 governing the form in which evidence must be filed and the rules about the taking of oral evidence follows equivalent provisions in the Patents and Registered Designs Rules rather than that set out in rule 55 of the existing Trade Mark Rules, which has been criticised for lacking clarity.

Evidence in Opposition and Invalidation Proceedings

38. As set out in draft rules 20(1) and 42(2) the registrar must specify periods within which evidence and submissions may be filed by the parties in opposition and invalidation proceedings. The proposed provisions of these rules differ from the existing rules 13C and 33A.

39. This change is partly in response to the 2007 relative grounds changes to the examination procedure⁵. This has led to an increase in oppositions under sections 5(1) and 5(2) of the Act. In a routine 5(1) or 5(2) case the only evidence strictly required is of the existence of the earlier mark. It is not therefore appropriate for the rules to suggest that evidence is always necessary in order to bring an opposition or an application for invalidation. Instead it is proposed that the rules will indicate when the filing of evidence is essential to the continuation of the proceedings. This is what draft rules 20(2) and 42(3) provide. So, for example, a failure to file evidence to support a case (or part of a case) based upon the existence of common law rights will normally lead (as now) to that part of the case being deemed abandoned.
40. Rules 20(2) and 42(2) give the Registrar the power to specify periods for the filing of evidence and submissions. Submissions cover written arguments filed in response to the other side's evidence as opposed to evidence of fact. The policy purpose of this distinction is to discourage the filing of evidence where none is required whilst still permitting submissions to be made on the evidence filed by the other party.

Evidence – Non-Use Cases

41. The present rules provide for four rounds of evidence in non-use cases. The proprietor is required to file some evidence of use (or proper reasons for non-use) within the same period permitted for filing a counterstatement (currently 3 months). Successive decisions of the appellant tribunals have progressively reduced the threshold requirement for the sort of evidence required to be filed in this period so that now nothing more than a statement of use by a witness accompanied by a statement of truth and a modicum of particularisation is regarded as sufficient for the proceedings to continue to the subsequent evidence rounds. In the subsequent evidence rounds the proprietor has a second opportunity to submit the evidence which supports his registration.
42. This approach has led to much unproductive argument between parties about whether the proprietor's initial evidence in a particular case is sufficient to satisfy the first evidential threshold requirement, and thus open the door for the filing of further evidence. It has also tended to render the applicant's first evidence round largely pointless. This is because the burden of showing use of the mark is on the proprietor and the result of the proprietor being given two bites at the cherry is that the applicant's first opportunity to file evidence occurs before he has seen all the evidence upon which the proprietor may ultimately rely in order to rebut the applicant's non-use claim.
43. It is therefore proposed that the Rules be changed so that the proprietor is given one opportunity to file the evidence of use (or proper reasons for non-use) he intends to rely upon in order to defend the registration. The Rules will permit (but not require) this to be filed within the non-extendible

⁵ The Trade Marks (Relative Grounds) Order 2007 SI 2007/1976

period allowed for the filing of the proprietor's counterstatement (which is proposed to be two months). However, if a counterstatement is filed without evidence, the rules will provide for the Registrar to specify the periods for the filing of evidence. The intention is that the proprietor will be given one period in which to file his evidence. The applicant will be given one period to file any evidence or written submissions that he wishes to file in response to the proprietor's evidence. If the applicant files evidence or submissions on the proprietor's evidence, the proprietor will be given one further period in which to file evidence strictly in reply. Each of the periods for filing evidence would be extendible, if justified. Thus the usual number of evidence rounds will be reduced from four to three, but where the applicant files no evidence or submissions on the proprietor's evidence, there will be only one round of evidence. This should save the parties costs and also avoid unnecessary disputes about whether the proceedings should continue in the face of the proprietor's "first stab" at evidence of use of the mark. These proposals are reflected in draft rule 38.

Question 8: Do you agree that in non-use revocation cases the normal rule should be that proprietors should have one (extendible) period in which to file all their evidence of use?

Power to set aside Decisions

44. Trade marks are property and are sometimes lost because the proprietor is unaware that its mark is under attack by a third party. This is usually as a result of the ineffective service of an opposition or application for cancellation. In the majority of cases this happens because the applicant or proprietor has not kept his address for service up to date. However, in a small number of cases there may be a more complex reason as to why the service was ineffective. At present, whatever the circumstances, there is no provision under the rules to belatedly contest the removal of a trade mark due to a failure to respond to a properly addressed notice delivered to the recorded address for service. This creates a risk of injustice. We are therefore considering introducing a rule permitting holders of trade marks who have lost their property as a result of ineffective service of an opposition or application for cancellation to apply for the decision to refuse the application/cancel the registration to be set aside subject to rules on timeliness and equity.
45. The proposal is reflected in draft rule 43.
46. In order to ensure finality of litigation we propose that the new provision should permit such applications to be made only within a non-extendable period of 12 months beginning on the date that the application was refused or the registration was recorded on the register as invalid/revoked. We also propose including provision for any decision to set aside the original refusal of application/cancellation of registration to be subject to such terms or conditions as the registrar thinks fit. We anticipate that these may include terms governing the re-commencement of the original proceedings and conditions governing the exercise of any rights the applicant or proprietor may have (or acquire) in respect of the period between the date

of the original refusal/cancellation of the trade mark and the date of the subsequent decision to set aside that original decision.

Question 9: In framing the new rule to provide for the setting aside of decisions we would be grateful for user's thoughts on the most appropriate way to ensure equity, including the appropriate time period allowed for applying for reinstatement.

Timing of procedural appeals

47. At present an appeal can be lodged following any decision of the Registrar, including procedural decisions which do not terminate the proceedings. The majority of appeals which fall into this category are about decisions of the Registrar to refuse the appellant, or grant an opponent, additional time, usually for filing evidence. Interim appeals on procedural grounds can substantially affect the length and cost of proceedings. However, the outcome of the procedural appeal, even if successful, does not always change the eventual outcome of the proceedings. It may be assumed that a party who has ultimately been successful despite the Registrar's procedural ruling, or who has lost for reasons unconnected with it, will see less need to pursue an appeal against the procedural decision at the conclusion of the proceedings than he might have seen at the time of the procedural decision. Accordingly, some such appeals are rendered unnecessary by subsequent events.
48. The recent changes to the examination system in the UK means that the UK-IPO will, in future, have to process substantially more contested cases. If this greater number of cases is to be processed in acceptable time periods it is important that the system is as efficient as possible and not unduly disrupted by applications which have no bearing on the ultimate outcome of the proceedings. Section 76 of the Act provides rule making powers that may be used to exclude certain categories of decisions of the Registrar from appeal. We propose to introduce a new rule controlling the timing of appeals on procedural grounds where the Registrar's decision does not terminate the proceedings.
49. The new rule would be modelled on Article 57(2) of the Community Trade Mark Regulation 40/94 which makes similar provision governing appeals in relation to decisions affecting Community trade marks. It would mean that interim decisions of the Registrar which do not terminate the proceedings may not be appealed against independently of the Registrar's final decision in the proceedings without the leave of the Registrar. Further, the Registrar's decision as to whether to grant such leave would not itself be subject to independent appeal. It is envisaged that leave would be granted where the interim procedural decision is likely to have a determinative bearing on the outcome of the proceedings, but not otherwise.
50. The proposal is reflected in draft rule 70.

Question 10: We would be interested in respondents' experience of the operation of the provisions for appeals in Article 57(2) of the Community Trade Mark Regulation and any evidence that shows why similar

provisions should be not be adopted into the national rules governing appeals.

Introduction of a Respondent's Notice in Appeals to the Appointed Person

51. Respondents to appeals to the Appointed Person sometimes serve a Respondent's Notice asking for the Registrar's decision to be upheld on additional or different grounds to those given by the Registrar. The Appointed Person has on several occasions noted the absence of any express provision in the rules for such a notice whilst nevertheless accepting that a Respondent's Notice may be appropriate.
52. We therefore propose to introduce into the rules a timescale for the filing of a Respondent's Notice. It is proposed that such notices should be filed within 21 days of the date that the appellant's appeal is sent to the respondent. This change will not affect the period for filing appeals or cross appeals. This proposal is reflected in draft rule 71.

Section IV: - Modernisation and Optimisation

53. This section outlines a number of other changes that we are considering. The overarching objective is to look at the current registration processes and see if there is scope for speeding up the registration of new marks, making the process more accessible and reducing costs.

Changes to published information

54. At present all information on Trade Marks is published online in the weekly Trade Marks Journal. The journal is split into two parts, with the first part used for the publication of new marks for opposition purposes and the second part containing changes to published applications and details of registrations, renewals, changes to the register and various other matters.
55. We are considering a change to the rules to make this information more accessible. Applications and amendments to applications made after publication, and any other change which is open to third party opposition would be published in the Trade Mark Journal, as at present.
56. Registration, renewals, assignments, revocations and other post registration information would be presented in a searchable format on the UK-IPO website. This will not change the information available but will make it more accessible by reducing the amount of information users have to sift through in order to assess whether to file an opposition. It will also reduce the administrative burden of producing the Trade Marks Journal, which will help to speed up the publication of new applications.

Question 11: Would you welcome faster publication of new applications? Would publishing data only for information purposes on the Office web site present you with difficulties (and, if so, what are they)?

Changes to time periods - Deficiencies in application

57. At present rule 11 allows two months to remedy deficiencies in the application, such as failing to identify the applicant or provide a list of goods and services, or to pay the application fees. It seems archaic to allow two months for the submission of basic components of the application and payment of application fees. We therefore intend to shorten this period and are considering a number of options as follows:

- i) Changing the period to “a period specified by the registrar, which shall be not less than 14 days”
- ii) Changing the period to “a period specified by the registrar, which shall be not less than one month”

58. We are minded to implement proposal (i), allowing a period of at least 14 days (and this is reflected in draft rule 13). The period would be extendible under rule 77.

59. We are also considering shortening the period allowed for the correction of classification queries, many of which are very straightforward. We propose that the period to respond to a notice will be reduced from “not less than two months” to “not less than one month” (see draft rule 9). The intention is that a two month period would continue to be allowed where the classification matter is not straightforward. In either case the period would be extendible as with most other examination related periods.

Question 12: Can you identify any serious problems that would arise from amending the specified time periods as proposed in paragraphs 57 and 59?

Verification of Priority Claims

60. At present formal certification is required to support claims for priority under the International Paris Convention. This is out of line with the procedures in some other offices (e.g. OHIM) and we feel it is no longer necessary, except perhaps where the application is the subject of third party opposition or invalidation on relative grounds. We propose to change the rules to make the submission of priority documents discretionary and, where they are required, provide the Registrar with discretion to accept a wider range of means of verification of the claim. This proposal is reflected in draft rule 6.

Question 13: Do you agree that priority documents should normally only be required to support a priority claim where there is a third party opposition or invalidation?

 STATUTORY INSTRUMENTS

2008 No. [—]

TRADE MARKS

The Trade Marks Rules 2008

Made - - - - ***

Laid before Parliament ***

Coming into force - - ***

The Secretary of State makes the following rules in exercise of the powers conferred upon the Secretary of State 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, and paragraph 7(2) of Schedule 2 to, the Trade Marks Act 1994⁽⁶⁾.

In accordance with section 8 of the Tribunals and Inquiries Act 1992⁽⁷⁾, the Secretary of State has consulted the Administrative Justice and Tribunals Council before making these Rules.

*Preliminary***Citation and commencement**

1. These Rules may be cited as the Trade Marks Rules 2008 and shall come into force on [—] 2008.

Interpretation

2.—(1) In these Rules—

“the Act” means the Trade Marks Act 1994;

“EEA State” means a member State, Iceland, Liechtenstein or Norway;

“the Journal” means the Trade Marks Journal published in accordance with rule 81;

“the “Nice Agreement” means the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15th June 1957, which was last amended on 28th September 1979;

“the “Nice Classification” means the system of classification under the Nice Agreement;

“the Office” means the Patent Office which operates under the name “the UK Intellectual Property Office”;

⁽⁶⁾ 1994 c.26.

⁽⁷⁾ 1992 c.53; the definition of “Council” has been amended by the Tribunals, Courts and Enforcement Act 2007 (c.15), Schedule 8, paragraph 30.

“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

“transformation application” means an application to register a trade mark under the Act where that mark was the subject of an international registration prior to that registration being cancelled.

(2) 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 section 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 the registrar 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

Application for registration; section 32 (Form TM3)

5.—(1) An application for the registration of a trade mark shall be filed on Form TM3 (except where the application is a transformation application in which case the application for registration shall be filed on Form TM4) and shall be subject to the payment of the application fee and such class fees as may be appropriate.

(2) Where an application is for the registration of a single trade mark, an applicant may request the registrar to undertake an expedited examination of the application.

(3) A request for expedited examination shall be made on Form TM3 which shall be filed electronically using the filing system provided on the Office website, or by such other means as the registrar may permit in any particular case, and shall be subject to payment of the prescribed fee.

(4) Where an applicant makes a request for expedited examination, the application fee and any class fees payable in respect of the application shall be payable at the time the application is made and accordingly rule 13 shall not apply insofar as it relates to the failure of an application to satisfy the requirements of section 32(4).

(5) In this rule and rule 15 a “request for expedited examination” means a request that, following an examination under section 37, the registrar notify the applicant within a period of ten business days (as specified in a direction given by the registrar under section 80) beginning on the business day after the date of filing of the application for registration whether or not it appears to the registrar that the requirements for registration are met.

Claim to priority; sections 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 (an “overseas application”), the application for registration under rule 5 above shall specify-

- (a) the number accorded to the overseas application by the registering or other competent authority of the relevant country;
- (b) the country in which the overseas application was filed; and
- (c) the date of filing.

(2) The registrar may, in any particular case, by notice require the applicant to file, within such period of not less than one month as the notice may specify, such documentary evidence as the registrar may require certifying, or verifying to the satisfaction of the registrar, the date of the filing of the overseas application, the country or registering or competent authority, the representation of the mark, and the goods or services covered by the overseas application.

Classification of goods and services; section 34

7.—(1) The prescribed system of classification for the purposes of the registration of trade marks is the Nice Classification.

(2) When a trade mark is registered it shall be classified according to the version of the Nice Classification that had effect on the date of application for registration.

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 the Nice Classification.

(2) Every application shall specify—

- (a) the class in the Nice Classification to which it relates; and
- (b) the goods or services which are appropriate to the class and they shall be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the classes in the Nice Classification.

(3) If the application relates to more than one class in the Nice Classification the specification contained in it shall set out the classes in consecutive numerical order and the specification of the goods or services shall be grouped accordingly.

(4) If the specification contained in the application lists items by reference to a class in the Nice Classification in which they do not fall, the applicant may request, by filing Form TM3A, that the 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 the application accordingly.

Determination of classification

9.—(1) Where an application does not satisfy the requirements of rule 8(2) or (3), the registrar shall send notice to the applicant.

(2) A notice sent under paragraph (1) shall specify a period, of not less than one month, within which the applicant must satisfy those requirements.

(3) Where the applicant fails to satisfy the requirements of rule 8(2) before the expiry of the period specified under paragraph (2), the application for registration, insofar as it relates to any goods or services which failed that requirement, shall be treated as abandoned.

(4) Where the applicant fails to satisfy the requirements of rule 8(3) before the expiry of the period specified under paragraph (2), the application for registration shall be treated as abandoned.

Prohibition on registration of mark consisting of arms; section 4

10. 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

11.—(1) For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by—

- (a) an applicant for the registration of a trade mark;
- (b) any person who opposes the registration of a trade mark in opposition proceedings;
- (c) any person who applies for revocation, a declaration of invalidity or rectification under the Act;
- (d) the proprietor of the registered trade mark who opposes such an application.

(2) The proprietor of a registered trade mark, or any person who has registered an interest in a registered trade mark, may file an address for service on Form TM33 or, in the case of an assignment of a registered trade mark, on Form TM16.

(3) Where a person has provided an address for service under paragraph (1) or (2), that person may substitute a new address for service by notifying the registrar on Form TM33.

(4) An address for service filed under paragraph (1), (2) or (3) shall be an address in the United Kingdom, another EEA State or the Channel Islands.

Failure to provide an address for service

12.—(1) Where—

- (a) a person has failed to file an address for service under rule 11(1); and
- (b) the registrar has sufficient information enabling the registrar to contact that person,

the registrar shall direct that person to file an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of one month beginning with the date of the direction, file an address for service.

(3) Paragraph (4) applies where—

- (a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or
- (b) the registrar had insufficient information to give a direction under paragraph (1),

and the person has failed to provide an address for service.

(4) Where this paragraph applies—

- (a) in the case of an applicant for registration of a trade mark, the application shall be treated as withdrawn;
- (b) in the case of a person opposing the registration of a trade mark, that person's opposition shall be treated as withdrawn;
- (c) in the case of a person applying for revocation, a declaration of invalidity or rectification, that person's application shall be treated as withdrawn; and
- (d) in the case of the proprietor opposing such an application, the proprietor shall be deemed to have withdrawn from the proceedings.

(5) In this rule an "address for service" means an address which complies with the requirements of rule 11(4).

Deficiencies in application; section 32

13.—(1) 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), the registrar shall send notice to the applicant to remedy the deficiencies or, in the case of section 32(4), the default of payment.

(2) A notice sent under paragraph (1) shall specify a period, of not less than fourteen days, within which the applicant must remedy the deficiencies or the default of payment.

(3) Where, before the expiry of the period specified under paragraph (2), the applicant—

- (a) fails to remedy any deficiency notified to the applicant 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 the applicant in respect of section 32(3) or rule 5(1) or fails to make payment as required by section 32(4), the application shall be treated as abandoned.

Notifying results of search

14.—(1) Where, following any search under Article 4 of the Trade Marks (Relative Grounds) Order 2007⁽⁸⁾, it appears to the registrar that the requirements for registration mentioned in section 5 are not met, the registrar shall notify this fact to—

- (a) the applicant; and
- (b) any relevant proprietor.

(2) In paragraph (1), “relevant proprietor” means—

- (a) 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; and
- (b) the proprietor of a Community trade mark or international trade mark (EC) 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 and who has filed a request to be notified in relation to that mark in accordance with paragraph (4) below.

(3) References in paragraph (2) to the proprietor of a trade mark include a person who has applied for registration of a trade mark which, if registered, would be an earlier trade mark by virtue of section 6(1)(a) or (b).

(4) The proprietor of a Community trade mark or international trade mark (EC) may file a request to be notified in relation to that mark of the results of a notifiable search on Form TM6, which shall be filed electronically using the filing system provided on the Office website, or by such other means as the registrar may permit in any particular case, and shall be subject to payment of the prescribed fee.

(5) In paragraph (4) a “notifiable search” means any search under Article 4 of the Trade Marks (Relative Grounds) Order 2007 conducted within the period of three years beginning with the date on which the request was filed.

(6) The filing of any request under paragraph (4) shall be subject to such terms or conditions as the registrar may specify generally by published notice or in any particular case by written notice to the person desiring to file the request otherwise than by electronic means.

(7) Rule 63 shall not apply to any decision made in pursuance of this rule.

(8) No decision made in pursuance of this rule shall be subject to appeal.

Compliance with request for expedited examination

15. Where the registrar receives a request for expedited examination under rule 5, the date on which the registrar shall be deemed to have notified the applicant whether or not it appears to the

⁽⁸⁾ S.I. 2007/1976

registrar that the requirements for registration are met shall be the date on which notice is sent to the applicant.

Publication, observations, oppositions and registration

Publication of application for registration; section 38(1)

16. An application which has been accepted for registration shall be published in the Journal.

Opposition proceedings: filing of notice of opposition; section 38(2) (Form TM7)

17.—(1) Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of six weeks beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form [TMXX], before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) shall be the period of three months beginning with the date on which the application was published.

(4) Where a person makes a request for an extension of time under paragraph (3), Form [TMXX] shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.

(5) Where the opposition is based on a trade mark which has been registered, there shall be included in the statement of the grounds of opposition a representation of that mark and—

- (a) the details of the authority with which the mark is registered;
- (b) the registration number of that mark;
- (c) the goods and services in respect of which—
 - (i) that mark is registered, and
 - (ii) the opposition is based; and

(d) where the registration procedure for the mark was completed before the start of the period of five years ending with the date of publication, a statement detailing whether during the period referred to in section 6A(3)(a) the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use (for the purposes of rule 20 this is the “statement of use”).

(6) Where the opposition is based on a trade mark in respect of which an application for registration has been made, there shall be included in the statement of the grounds of opposition a representation of that mark and those matters set out in paragraph (5)(a) to (c), with references to registration being construed as references to the application for registration.

(7) Where the opposition is based on an unregistered trade mark or other sign which the person opposing the application claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds of opposition a representation of that mark or sign and the goods and services in respect of which such protection is claimed.

(8) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is done shall, for the purposes of rule 18, be the “notification date”.

Opposition proceedings: filing of counter-statement and cooling off period (Forms TM8, TM9c & TM9t)

18.—(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a Form TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date.

(4) This paragraph applies where—

- (a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;
- (b) within the period of two months beginning on the notification date, either party files Form TM9c requesting an extension of time for the filing of Form TM8; and
- (c) during the period beginning on the date Form TM9c was filed and ending nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

and where this paragraph applies the relevant period shall begin on the notification date and end nine months after that date.

(5) This paragraph applies where—

- (a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c;
- (b) during the period referred to in paragraph (4)(c), either party files Form TM9e requesting a further extension of time for the filing of Form TM8 which request includes a statement supported by a statement of truth confirming that the parties are negotiating a settlement of the opposition proceedings; and
- (c) the other party agrees to the further extension of time for the filing of Form TM8,

and where this paragraph applies the relevant period shall begin on the notification date and end eighteen months after that date.

(6) This paragraph applies where—

- (a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c; and
- (b) the person opposing the registration has filed a notice to continue on Form TM9t,

and where this paragraph applies the relevant period shall begin on the notification date and end one month after the date on which Form TM9t was filed or two months after the notification date, whichever is the later.

(7) The registrar shall send a copy of Form TM8 to the person opposing the registration.

Opposition proceedings: preliminary indication (Form TM53)

19.—(1) This rule applies if—

- (a) the opposition or part of it is based on the relative grounds of refusal set out in section 5(1) or (2); and
- (b) the registrar has not indicated to the parties that the registrar thinks that it is inappropriate for this rule to apply.

(2) After considering the statement of the grounds of opposition and the counter-statement the registrar shall send notice to the parties (“the preliminary indication”) stating whether it appears to the registrar that—

- (a) registration of the mark should not be refused in respect of all or any of the goods and services listed in the application on the grounds set out in section 5(1) or (2); or
- (b) registration of the mark should be refused in respect of all or any of the goods and services listed in the application on the grounds set out in section 5(1) or (2).

(3) The date upon which the preliminary indication is sent shall be the “indication date”.

- (4) Where it appeared to the registrar under paragraph (2) that—
- (a) registration of the mark should not be refused in respect of all or any of the goods or services listed in the application on the grounds set out in section 5(1) or (2), the person opposing the registration shall, within one month of the indication date, file a notice of intention to proceed with the opposition based on those grounds by filing a Form TM53, otherwise that person's opposition to the registration of the mark in relation to those goods or services on the grounds set in section 5(1) or (2) shall be deemed to have been withdrawn; or
 - (b) registration of the mark should be refused in respect of all or any of the goods or services listed in the application on the grounds set out in section 5(1) or (2), the applicant shall, within one month of the indication date, file a notice of intention to proceed on Form TM53, otherwise the applicant shall be deemed to have withdrawn the request to register the mark in respect of the goods or services for which the registrar indicated registration should be refused.
- (5) A person who files a Form TM53 shall, at the same time, send a copy to all other parties to the proceedings.
- (6) The registrar need not give reasons for the preliminary indication nor shall the preliminary indication be subject to appeal.

Opposition proceedings: evidence rounds

20.—(1) Where—

- (a) Form TM53 has been filed by either party;
- (b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2) and the applicant has filed a Form TM8; or
- (c) the registrar has indicated to the parties that it is inappropriate for rule 19 to apply,

the registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(2) Where—

- (a) the opposition is based on an earlier trade mark of a kind falling within section 6(1)(c); or
- (b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2); or
- (c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant,

the person opposing the registration (“the opposer”) shall file evidence supporting the opposition.

(3) Where the opposer files no evidence under paragraph (2), the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on—

- (a) the matters in paragraph (2)(a) or (b); and
- (b) an earlier trade mark which has been registered and which is the subject of the statement of use referred to in paragraph (2)(c).

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

Procedure for intervention

21.—(1) If the opposition or part of it is based on the relative grounds for refusal set out in section 5(1), (2) or (3), any person in paragraph (3) may file an application to the registrar on Form TM27 for leave to intervene 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 the registrar thinks fit.

(2) Any person granted leave to intervene 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 rules 19, 20 and 62 to 73.

(3) The persons referred to in paragraph (1) are—

- (a) where the opposition is based on an earlier trade mark, a licensee of that mark; and
- (b) where the opposition is based on an earlier collective mark or certification mark, an authorised user of that mark.

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

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

Publication of registration; section 40

23. On the registration of the trade mark the registrar shall publish the registration on the Office website, specifying the date upon which the trade mark was entered in the register.

*Amendment of application***Amendment of application; section 39 (form TM21)**

24. 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; section 39 (Form TM7)

25.—(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 in the Journal.

(2) Any person claiming to be affected by the amendment may, within one month of the date on which the amendment or a statement of the effect of the amendment was published under paragraph (1), give notice to the registrar of objection to the amendment on Form TM7 which shall include a statement of the grounds of objection which shall, in particular, indicate why the amendment would not fall within section 39(2).

(3) The registrar shall send a copy of Form TM7 to the applicant and the procedure in rules 17 to 20 shall apply to the proceedings relating to the objection to the amendment as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

- (a) any reference to—
 - (i) an application for registration shall be construed as a reference to a request for amendment of an application,
 - (ii) the person opposing the registration shall be construed as a reference to the person objecting to the amendment of an application,
 - (iii) the opposition shall be construed as a reference to the objection;
- (b) the relevant period, referred to in rule 18(1), shall for these purposes be the period of two months beginning with the date upon which the registrar sent a copy of Form TM7 to the applicant; and
- (c) rules 18(3) to (6), 19, 20(2) and (3) shall not apply.

*Division, merger and series of marks***Division of application; section 41 (form TM12)**

26.—(1) At any time before registration an applicant may send to the registrar a request on Form TM12 for a division of the application for registration (the original application) into two or more separate applications (divisional applications), indicating for each division the specification of goods or services.

(2) Each divisional application shall be treated as a separate application for registration with the same filing date as the original application.

(3) 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.

(4) 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 applications has been divided.

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

27.—(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) 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) 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; section 41 (form TM12)

28.—(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.

(2) Following an application under paragraph (1) the registrar shall, if satisfied that the marks constitute a series, accept the application.

(3) At any time before registration, the applicant under paragraph (1) 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 divide the application accordingly, provided that at least one application remaining after such a division would comprise of either—

- (a) a single mark; or
- (b) two or more marks that would be a series of trade marks within the meaning of section 41(2).

(4) 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.

(5) 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, following such request, the registrar shall delete the mark accordingly.

(6) Where under paragraph (5) the registrar deletes a trade mark from an application for registration, the application, in so far as it relates to the deleted mark, shall be treated as withdrawn.

(7) The division of an application into one or more applications under paragraph (3) 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; Schedules 1 & 2 (form TM35)

29. Where an application for registration of a collective or certification mark is filed, the applicant shall, within such period of not less than three months as the registrar may specify, file Form TM35 accompanied by a copy of the regulations governing the use of the mark.

Amendment of regulations of collective and certification marks; Schedule 1 paragraph 10 and Schedule 2 paragraph 11 (Forms TM36 & TM7)

30.—(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 to be expedient to the registrar that the amended regulations should be made available to the public the registrar shall publish a notice in the Journal indicating where copies of the amended regulations may be inspected.

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

(4) Any person may, within two months of the date on which the notice was published under paragraph (2), give notice to the registrar of opposition to the amendment on Form TM7 which shall include 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 to the Act, or, as the case may be, paragraph 7(1) of Schedule 2 to the Act.

(5) The registrar shall send a copy of Form TM7 to the proprietor and the procedure in rules 18 to 20 shall apply to the proceedings relating to the opposition to the amendment as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

- (a) any reference to—
 - (i) the applicant shall be construed as a reference to the proprietor,
 - (ii) an application for registration shall be construed as a reference to an application for the amendment of the regulations,
 - (iii) the person opposing the registration shall be construed as a reference to the person opposing the amendment of the regulations;

- (b) the relevant period, referred to in rule 18(1), shall for these purposes be the period of two months beginning with the date upon which the registrar sent a copy of Form TM7 to the proprietor;
- (c) rules 18(3) to (6), 19, 20(2) and (3) shall not apply.

Registration subject to disclaimer or limitation; section 13

31. 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 marks; section 44 (Forms TM25 & TM7)

32.—(1) The proprietor of a registered trade mark may request the registrar on Form TM25 for such alteration of the mark as is permitted under section 44 and following such request the registrar may require evidence 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, the registrar shall publish the mark as altered in the Journal.

(3) Any person claiming to be affected by the alteration may, within two months of the date on which the mark as altered was published under paragraph (2), give notice to the registrar of objection to the alteration on Form TM7 which shall include a statement of the grounds of objection.

(4) The registrar shall send a copy of Form TM7 to the proprietor and the procedure in rules 18 to 20 shall apply to the proceedings relating to the objection to the alteration as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

- (a) any reference to—
 - (i) the applicant shall be construed as a reference to the proprietor,
 - (ii) an application for registration shall be construed as a reference to a request for alteration,
 - (iii) the person opposing the registration shall be construed as a reference to the person objecting to the alteration,
 - (iv) the opposition shall be construed as a reference to the objection;
- (b) the relevant period, referred to in rule 18(1), shall for these purposes be the period of two months beginning with the date upon which the registrar sent a copy of Form TM7 to the proprietor;
- (c) rules 18(3) to (6), 19, 20(2) and (3) shall not apply.

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

33.—(1) Subject to paragraph (2), 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 the proprietor in the notice.

(2) A notice under paragraph (1) 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 to the surrender.

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

Renewal and restoration

Reminder of renewal of registration; section 43

34.—(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 35) send to the registered proprietor notice of the approaching expiration and inform the proprietor at the same time that the registration may be renewed in the manner described in rule 35.

(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 on or 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 the registrar sends to the applicant notice to that effect within one month following the date of actual registration.

Renewal of registration; section 43 (Form TM11)

35. 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; section 43 (Form TM11)

36.—(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.

(2) If, within six months from the date of the expiration of the last registration, a 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.

(3) Where no request for renewal is filed, the registrar shall, subject to rule 37, remove the mark from the register.

(4) 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.

(5) The removal of the registration of a trade mark shall be published on the Office website.

Restoration of registration; section 43 (Form TM13)

37.—(1) Where the registrar has removed the mark from the register for failure to renew its registration in accordance with rule 36, the registrar 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 —

- (a) restore the mark to the register; and
- (b) renew its registration,

if, having regard to the circumstances of the failure to renew, the registrar is satisfied that it is just to do so.

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

*Revocation, invalidation and rectification***Application for revocation (on the grounds of non-use); section 46(1)(a) or (b) (forms TM8 & TM26(N))**

38.—(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N).

(2) The registrar shall send a copy of Form TM26(N) to the proprietor.

(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8, which shall include a counter-statement.

(4) Where the proprietor fails to file evidence of use of the mark or evidence supporting the reasons for non-use of the mark within the period specified in paragraph (3) above the registrar shall specify such further period within which the evidence shall be filed.

(5) The registrar shall send a copy of Form TM8 and any evidence of use, or evidence supporting reasons for non-use, filed by the proprietor to the applicant.

(6) Where the proprietor fails to file a Form TM8 within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.

(7) Where the proprietor fails to file evidence within the period specified under paragraph (3) or any further period specified under paragraph (4), the registrar may treat the proprietor as not opposing the application and the registration of the mark shall, unless the registrar directs otherwise, be revoked.

(8) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

Application for revocation (on grounds other than non-use); section 46(1)(c) or (d) (Forms TM8 & TM26(O))

39.—(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(c) or (d), shall be made on Form TM26(O) and shall include a statement of the grounds on which the application is made and be accompanied by a statement of truth.

(2) The registrar shall send a copy of Form TM26(O) and the statement of the grounds on which the application is made to the proprietor.

(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(O) and the statement by the registrar, file a Form TM8 which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and the registration of the mark shall, unless the registrar directs otherwise, be revoked.

(4) The registrar shall send a copy of Form TM8 to the applicant.

Application for revocation (on grounds other than non-use): evidence rounds

40.—(1) Where the applicant has filed a Form TM8, the registrar shall specify the periods within which further evidence may be filed by the parties.

(2) Where the applicant files no further evidence in support of the application the applicant, shall, unless the registrar otherwise directs, be deemed to have withdrawn the application.

(3) The registrar shall notify the proprietor of any direction given under paragraph (2).

(4) The registrar may, at any time give leave to either party to file evidence upon such terms as the registrar thinks fit.

Application for invalidation: filing of application and counter-statement; section 47 (Forms TM8 & TM26(1))

41.—(1) An application to the registrar for a declaration of invalidity under section 47 shall be filed on Form TM26(1) and shall include a statement of the grounds on which the application is made and be accompanied by a statement of truth.

(2) Where the application is based on a trade mark which has been registered, there shall be included in the statement of the grounds on which the application is made a representation of that mark and—

- (a) the details of the authority with which the mark is registered;
- (b) the registration number of that mark;
- (c) the goods and services in respect of which—
 - (i) that mark is registered, and
 - (ii) the application is based; and
- (d) where neither section 47(2A)(a) nor (b) applies to the mark, a statement detailing whether during the period referred to in section 47(2B)(a) it has been put to genuine use in relation to each of the goods and services in respect of which the application is based or whether there are proper reasons for non-use (for the purposes of rule 42 this is the “statement of use”).

(3) Where the application is based on a trade mark in respect of which an application for registration has been made, there shall be included in the statement of the grounds on which the application is made a representation of that mark and those matters set out in paragraph (2)(a) to (c), with references to registration being construed as references to the application for registration.

(4) Where the application is based on an unregistered trade mark or other sign which the applicant claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds on which the application is made a representation of that mark or sign and the goods and services in respect of which such protection is claimed.

(5) The registrar shall send a copy of Form TM26(1) and the statement of the grounds on which the application is made to the proprietor.

(6) The proprietor shall, within two months of the date on which a copy of Form TM26(1) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.

(7) The registrar shall send a copy of Form TM8 to the applicant.

Application for invalidation: evidence rounds

42.—(1) Where the proprietor has filed Form TM8, the registrar shall send notice to the applicant inviting the applicant to file evidence in support of the grounds on which the application is made and any submissions and to send a copy to all the other parties.

(2) The registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(3) Where—

- (a) the application is based on an earlier trade mark of a kind falling within section 6(1)(c); or
- (b) the application or part of it is based on grounds other than those set out in section 5(1) or (2); or
- (c) the truth of a matter set out in the statement of use is either denied or not admitted by the proprietor,

the applicant shall file evidence supporting the application.

(4) Where the applicant files no evidence under paragraph (3), the applicant shall be deemed to have withdrawn the application to the extent that it is based on—

- (d) the matters in paragraph (3)(a) or (b); and
- (e) an earlier trade mark which has been registered and is the subject of the statement of use referred to in paragraph (3)(c).

(5) The registrar may, at any time give leave to either party to file evidence upon such terms as the registrar thinks fit.

Setting aside cancellation of application or revocation or invalidation of registration

43.—(1) This rule applies where—

- (a) an application for registration is treated as abandoned under rule 18(2);
- (b) the registration of a mark is revoked under rule 38(6) or rule 39(3); or
- (c) the registration of a mark is declared invalid under rule 41(6),

and the applicant or the proprietor (as the case may be) claims that the decision of the registrar to treat the application as abandoned or revoke the registration of the mark or declare the mark invalid (as the case may be) (“the original decision”) should be set aside on the grounds set out in paragraph (4).

(2) Where this rule applies, the applicant or the proprietor shall, within a period of twelve months beginning with the date that the application was refused or the register was amended to reflect the revocation or the declaration of invalidity (as the case may be), file an application to set aside the decision of the registrar on Form TM[] and shall include evidence in support of the application.

(3) The registrar shall send a copy of Form TM[] to the other party to the original proceedings under the rules referred to in paragraph (1).

(4) Where the applicant or the proprietor demonstrates to the reasonable satisfaction of the registrar that the failure to file Form TM8 within the period specified in the rules referred to in paragraph (1) was due to a failure to receive Form TM7, Form TM26(N), Form TM26(O) or Form TM26(1) (as the case may be), the original decision may be set aside on such terms and conditions as the registrar thinks fit.

(5) In considering whether to set aside the original decision the matters to which the registrar must have regard include whether the person seeking to set aside the decision made an application to do so promptly upon becoming aware of the original decision and any prejudice which may be caused to the other party to the original proceedings if the original decision were to be set aside.

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

44.—(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 with regard to the filing of subsequent evidence and upon such terms as the registrar may think fit.

Procedure for intervention

45.—(1) Any person, other than the registered proprietor, claiming to have an interest in proceedings on an application under rule 38, 39, 42, 41 or 44, may file an application to the registrar on Form TM27 for leave to intervene, stating the nature of the person's interest and the registrar may, after hearing the parties concerned if they request a hearing, refuse leave or grant leave upon such terms and conditions (including any undertaking as to costs) as the registrar thinks fit.

(2) Any person granted leave to intervene 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 rules 38 to 40, 41 and 42 or 44 (as appropriate) and rules 62 to 73.

The register

Form of register; section 63(1)

46. 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; section 63(2) (form TM 24)

47. 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 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 date of completion of the registration procedure;
 - (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) filed under rule 11;
 - (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,
 - (i) the number of the international registration, and
 - (ii) either:—
 - (aa) the date accorded to the international registration under Article 3(4), or
 - (bb) 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; section 25

48. 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; sections 25 & 27(3) (Form TM16, TM24, TM50 & TM51)

49.—(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—

- (a) relating to an assignment or transaction other than a transaction referred to in subparagraphs (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) 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), 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 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; section 63(3)

50.—(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 80.

(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; section 63(3) (form TM31R)

51. 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; section 64(4) (Form TM21)

52. 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 47 (“the applicant”), enter a change in the applicant’s name or address as recorded in the register.

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

53.—(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) the registrar may publish in the Journal the fact that it is intended to remove that matter, and
- (b) where any person appears to the registrar to be affected by the removal, notice of the intended removal shall be sent to that person.

(2) Within two months of the date on which the intention to remove the matter is published, or notice of the intended removal 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) may file in writing their objections, if any, to the removal,

and where such opposition or objections are made, rule 63 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, the registrar shall not remove it.

(4) Where there has been no response to the registrar’s notice the registrar may remove the matter and where representations objecting to the removal of the entry have been made the

registrar may, if after considering the objections the registrar is of the view that the entry or any part of it has ceased to have effect, remove it or the appropriate part of it.

Change of classification

Change of classification; sections 65(2) & 76(1)

54.—(1) The registrar may at any time amend an entry in the register which relates to the classification of a registered trade mark so that it accords with the version of the Nice Classification that has effect at that time.

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

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

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

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

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

55.—(1) Any person may, within two months of the date on which the proposals were published under rule 54, give notice to the registrar of opposition to the proposals on Form TM7 which shall include a statement of the grounds of opposition which shall, in particular, indicate why the proposed amendments would be contrary to section 65(3).

(2) If no notice of opposition under paragraph (1) 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 the registrar's decision shall be final and not subject to appeal.

Request for information, inspection of documents and confidentiality

Request for information; section 67(1) (form TM31C)

56. 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)

57.—(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 49.

(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; sections 67 & 76(1)

58.—(1) Subject to paragraphs (2) and (3), 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) until the completion of any procedure, or the stage in the procedure which is relevant to the document in question, which the registrar is required or permitted to carry out under the Act or these Rules.

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

- (a) any document prepared in the Office solely for its own use;
- (b) any document sent to the Office, whether at its request or otherwise, for inspection and subsequent return to the sender;
- (c) any request for information under rule 56;
- (d) any document received by the Office which the registrar considers should be treated as confidential;
- (e) any document in respect of which the registrar issues directions under rule 59 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 the registrar's opinion disparages any person in a way likely to cause damage to that person; 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) not to make any document or part of a document available for public inspection.

Confidential documents

59.—(1) Where a document other than a form required by the registrar and published in accordance with rule 3 is filed at the Office and the person filing it requests, at the time of filing that it or a specified part of it be treated as confidential, giving reasons for the request, 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 the registrar 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; section 82 (Form TM33)

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

(2) Where after a person has become a party to proceedings before the registrar, the person 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 the newly appointed agent files that form.

(3) The registrar may by notice in writing require an agent to produce evidence of his authority under section 82.

Registrar may refuse to deal with certain agents; section 88

61. 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 that person liable to have their 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).

*Proceedings before and decision of registrar, evidence and costs***General powers of registrar in relation to proceedings**

62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

- (a) require a document, information or evidence to be filed within such period as the registrar may specify;
- (b) require a translation of any document;
- (c) require a party or a party's legal representative to attend a hearing;
- (d) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication;
- (e) allow a statement of case to be amended;
- (f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;
- (g) consolidate proceedings;
- (h) direct that part of any proceedings be dealt with as separate proceedings.

(2) The registrar may control the evidence by giving directions as to—

- (a) the issues on which evidence is required;
- (b) the nature of the evidence which is required to decide those issues; and
- (c) the way in which the evidence is to be placed before the registrar,

and the registrar may exclude evidence which would otherwise be admissible.

(3) When the registrar gives directions under any provision of these Rules, the registrar may—

- (a) make them subject to conditions; and

(b) specify the consequences of failure to comply with the directions or a condition.

(4) The registrar may at any stage of any proceedings direct that the parties to the proceedings attend a case management conference or pre-hearing review.

Decisions of registrar to be taken after hearing

63.—(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, give that party an opportunity to be heard.

(2) The registrar shall give that party at least fourteen days' notice, beginning on the date on which notice is sent, of the time when the party may be heard unless the party consents to shorter notice.

Evidence in proceedings before the registrar; section 69

64.—(1) Subject to rule 62(1) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

- (a) by witness statement, affidavit, statutory declaration; or
- (b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement may only be given in evidence if it includes a statement of truth.

(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.

(4) For the purposes of these Rules, a statement of truth—

- (a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and
- (b) shall be dated and signed by—
 - (i) in the case of a witness statement, the maker of the statement,
 - (ii) in any other case, the party or his legal representative.

(5) In these Rules, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

(6) Under these Rules, evidence shall only be considered filed when—

- (a) it has been received by the registrar; and
- (b) it has been sent to all other parties to the proceedings.

Registrar to have power of an official referee; section 69

65. The registrar shall have the powers of an official referee of the Supreme Court as regards—

- (a) the attendance of witness and their examination on oath; and
- (b) the discovery and production of documents,

but he shall have no power to punish summarily for contempt.

Hearings before registrar to be in public

66.—(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 Administrative Justice and Tribunals Council or of its Scottish Committee from attending a hearing in their capacity as such member.

Costs of proceedings; section 68

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

Security for costs; section 68

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

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

Decision of register (Form TM5)

69.—(1) The registrar shall send to each party to the proceedings written notice of any decision made in any proceedings before the registrar stating the reasons for that decision and for the purposes of any appeal against that decision, subject to paragraph (2), 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), any party may, within one month of the date on which the notice was sent to that party, request the registrar on form TM5 to send 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***Decisions subject to appeal; section 76(1)**

70.—(1) Except as otherwise expressly provided by these Rules an appeal lies from any decision of the registrar made under these Rules relating to a dispute between two or more parties in connection with a trade mark, including a decision which terminates the proceedings as regards one of the parties ("a final decision") or a decision which is made at any point in the proceedings prior to a final decision ("an interim decision").

(2) An interim decision (including a decision refusing leave to appeal under this paragraph) may only be appealed against independently of any appeal against a final decision with the leave of the registrar.

Appeal to person appointed; section 76

71.—(1) Notice of appeal to the person appointed under section 76 shall be filed on Form TM55 which shall include the appellant's grounds of appeal and his case in support of the appeal.

(2) Such notice shall be filed with the registrar within the period of 28 days beginning with the date of the registrar's decision which is the subject of the appeal ("the original decision").

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

(4) Where any person other than the appellant was a party to the proceedings before the registrar in which the original decision was made (“the respondent”), the registrar shall send to the respondent a copy of the notice and the statement and the respondent may, within the period of 21 days beginning with the date on which the notice and statement was sent, file a notice responding to the notice of appeal.

(5) The respondent’s notice shall specify any grounds on which the respondent considers the original decision should be maintained where these differ from or are additional to the grounds given by the registrar in the original decision.

(6) The registrar shall send a copy of the respondent’s notice to the person appointed and a copy to the appellant.

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

72.—(1) Within 28 days of the date on which the notice of appeal is sent by the registrar under rule 71(4) 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, the registrar shall send a copy of the request to each party to the proceedings.

(3) A request under paragraph (1)(b) shall be sent to the registrar following which 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), 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, the person appointed shall send to the registrar and to every party to the proceedings in which the decision appealed against was made, notice to that effect.

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

Hearing and determination of appeal; section 76(4)

73.—(1) Where the person appointed does not refer the appeal to the court, the person appointed shall send written notice of the time and place appointed for the oral 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 person appointed shall send the notice at least fourteen days before the time appointed for the oral hearing.

(3) If all the persons notified under paragraph (1) inform the person appointed that they do not wish to make oral representations then—

- (a) the person appointed may hear and determine the case on the basis of any written representations; and
- (b) the time and place appointed for the oral hearing may be vacated.

(4) Rules 62, 65, 67 and 68 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.

(5) If there is an oral hearing of the appeal then rule 66 shall apply to the person appointed and to proceedings before the person appointed as it applies to the registrar and to proceedings before the registrar.

(6) A copy of the decision of the appointed person shall be sent, with a statement of the reasons for the decision, to the registrar and to each person who was a party to the appeal.

Correction of irregularities, calculation and extension of time

Correction of irregularities in procedure

74.—(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the registrar may direct.

Interrupted day

75.—(1) The registrar may certify any day as an interrupted day where—

- (a) there is an event or circumstance causing an interruption in the normal operation of the Office; or
- (b) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom.

(2) Any certificate of the registrar made under paragraph (1) shall be displayed in the Office and advertised in the Journal.

(3) The registrar shall, where the time for doing anything under these Rules expires on an interrupted day, extend that time to the next following day not being an interrupted day (or an excluded day).

(4) In this rule—

“excluded day” means a day which is not a business day as specified in a direction given by the registrar under section 80; and

“interrupted day” means a day which has been certified as such under paragraph (1).

Delays in communication services

76.—(1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be—

- (a) made after giving the parties such notice; and
- (b) subject to such conditions,

as the registrar may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.

Alteration of time limits (Form TM9)

77.—(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar's own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

(2) A request for extension under this rule may be made before or after the time or period in question has expired and shall be made—

- (a) where the application for registration has not been published and the request for an extension is made before the time or period in question has expired, in writing ; and
- (b) in any other case, on Form TM9.

(3) Where an extension under paragraph (1) is requested in relation to proceedings before the registrar, the party seeking the extension shall send a copy of the request to every other person who is a party to the proceedings.

(4) The registrar shall extend a flexible time limit, except a time or period which applies in relation to proceedings before the registrar or the filing of an appeal to the Appointed Person under rule 71, where—

- (a) the request for extension is made before the end of the period of two months beginning with the date the relevant time or period expired; and
- (b) no previous request has been made under this paragraph.

(5) A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and
- (b) it appears to the registrar that the irregularity should be rectified.

(6) In this rule—

“flexible time limit” means—

- (i) a time or period prescribed by these Rules, except a time or period prescribed by the rules listed in Schedule 1, or
- (ii) a time or period specified by the registrar for doing any act or taking any proceedings; and

“proceedings before the registrar” means any dispute between two or more parties relating to a matter before the registrar in connection with a trade mark.

Filing of documents, hours of business, Trade Marks Journal and translations**Filing of documents by electronic means**

78. The registrar may 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 the registrar 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.

Electronic communications

79.—(1) The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.

(2) In this rule “electronic communication” has the same meaning as in the Electronic Communications Act 2000(9).

Directions on hours of business; section 80

80. 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 displayed in the Office.

Trade Marks Journal; section 81

81. The registrar shall publish a journal, entitled “The Trade Marks Journal” containing such information as is required to be published in the Journal under these Rules and such other information as the registrar thinks fit.

Translations

82.—(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 the registrar considers to be inaccurate in which event there shall be furnished another translation of the document in question verified in accordance with paragraph (1).

Transitional provisions and revocations

Revocation of previous rules and proceedings commenced under previous Rules

83.—(1) The instruments set out in Schedule 2 (“the previous rules”) are revoked to the extent specified.

(2) Where immediately before these Rules come into force, any time or period prescribed by the previous rules has effect in relation to any act or proceeding and has not expired, the time or period prescribed by the previous rules and not by these Rules shall apply to that act or proceeding.

(3) Except as provided by paragraph (4) any proceeding commenced before the registrar before the entry into force of these Rules shall proceed under the previous rules; but where a new step is to be taken on or after [2008] in relation to any proceedings commenced under the previous rules these Rules shall apply to such proceedings from that date.

(4) Where prior to the entry into force of these Rules-

- (a) a Form TM8 and counter-statement have been filed in-
 - (i) opposition proceedings, or
 - (ii) proceedings for the revocation of a trade mark on the grounds set out in section 46(1)(c) or (d); or
 - (iii) invalidation proceedings; or
- (b) an application for revocation of a trade mark on the grounds set out in section 46(1)(a) or (b) has been filed,

the previous rules shall apply with regard to the filing of any evidence in relation to those proceedings.

(9) 2000 c.7

SCHEDULE 1

Rule 77

Extension of time limits

- rule 17(2) (filing notice of opposition)
- rule 17(3) (filing notice of opposition: request for extension of time)
- rule 18(1) (counter-statement in opposition proceedings)
- rule 19(4) (responding to preliminary indication)
- rule 25(2) (opposition to amendment after publication)
- rule 30(4) (opposition to amendment of regulations of collective and certification marks)
- rule 32(3) (opposition to alteration of mark)
- rule 35 (renewal of registration)
- rule 36 (delayed renewal)
- rule 37 (restoration of registration)
- rule 38(3) (counter-statement for revocation on grounds of non-use)
- rule 39(3) (counter-statement for revocation on grounds other than non-use)
- rule 41(6) (counter-statement for invalidity)
- rule 43 (setting aside cancellation of application or revocation or invalidation of registration)
- rule 53(2) (opposition to removal of matter from register)
- rule 55(1) (opposition to proposals for change of classification)
- rule 77(4) (period for making a retrospective request to extend a flexible time period).

SCHEDULE 2

Rule 83

Revocations

<i>Rules revoked</i>	<i>Reference</i>	<i>Extent of Revocation</i>
The Trade Marks Rules 2000	SI 2000/136	The whole rules
The Trade Marks (Amendment) Rules 2001	SI 2001/3832	The whole rules
The Trade Marks (Amendment) Rules 2004	SI 2004/947	The whole rules
The Patents, Trade Marks and Designs (Address for Service and Time Limits etc.) Rules 2006	SI 2006/760	Rules 15 to 20
The Trade Marks and Designs (Address for Service)(Amendment) Rules 2006	SI 2006/1029	Rule 3
The Trade Marks (Amendment) Rules 2006	SI 2006/3039	The whole rules
The Trade Marks (Amendment) Rules 2007	SI 2007/2076	The whole rules
The Trade Marks and Trade Marks (Fees) (Amendment) Rules 2008	SI 2008/11	Rules 2 to 4

General Principles of Consultation

This consultation is being conducted according to the Code of Practice on Written Consultation available from the Better Regulation Executive's website at: <http://bre.berr.gov.uk/regulation/documents/consultation/pdf/code.pdf>. This recommends the following criteria:

1. Consult widely throughout the process, allowing a minimum of 12 weeks for written consultation at least once during the development of the policy.
2. Be clear about what your proposals are, who may be affected, what questions are being asked and the timescale for responses.
3. Ensure that your consultation is clear, concise and widely accessible.
4. Give feedback regarding the responses received and how the consultation process influenced the policy.
5. Monitor your department's effectiveness at consultation, including through the use of a designated consultation coordinator.
6. Ensure your consultation follows better regulation best practice, including carrying out a Regulatory Impact Assessment if appropriate.

Comments or complaints

If you wish to comment on the conduct of this consultation or make a complaint about the way this consultation has been conducted, please tell the UK-IPO Consultation Co-ordinator, who is:

Geoff Miller
Consultation Co-ordinator
UK Intellectual Property Office
Concept House
Cardiff Road
Newport NP10 8QQ
Tel: +44(0)1633 811195
Fax: +44(0)1633 814232
E-mail: consultation@ipo.gov.uk

The following is a list of organisations and individuals to whom a copy of this consultation document has been sent. It is also available on the Intellectual Property Office website and can be viewed and commented upon by anyone accessing it:

The Administrative Justice and Tribunals Council
The Law Society
The Law Society of Scotland
The Bar Council
The Institute of Patentees and Inventors
Trade Marks, Patents and Designs Federation
Confederation of British Industry
University of London, Queen Mary
British Retail Consortium
Incorporated Society of British Advertisers
Chartered Society of Designers
Chartered Institute of Patent Agents
Institute of Trade Mark Attorneys
Association of British Chambers of Commerce
Consumer's Association
National Consumers Council
Federation of Small Businesses
Licensing Executives Society
International Federation of Industrial Property Attorneys
International Chambers of Commerce
Association of the British Pharmaceutical Industry
Intellectual Property Institute
London Chamber of Commerce and Industry
Institute of Practitioners in Advertising
Anti-Counterfeiting Group
Intellectual Property Lawyers Association
British Brands Group
Patent and Trade Mark Group, Institute of Information Scientists
The Patent Judges
The Intellectual Property Sub-Committee of the City of London Law Society
British Pharma Group
The British Agrochemicals Association Limited
British Generics Manufacturers Association
British Library
Centre of Research for Intellectual Property & Technology (SCRIPT)
EC Laws Committee - LES Britain & Ireland
The Appointed Persons

Summary: Intervention & Options

Department /Agency:
UK Intellectual Property
Office

Title:
Impact Assessment of Consolidated Trade Marks Rules 2008

Stage: Consultation Stage

Version: 3.0

Date: 21 Feb. 08

Related Publications:

Available to view or download at: <http://www.ipo.gov.uk/about/about-consult/about-formal/about-formal-current/consult-tmrules.htm>

Contact for enquiries: Paul Crawford

Telephone: 01633814061

What is the problem under consideration? Why is government intervention necessary?

- 1) Existing Trade Mark Rules 2000 have been amended seven times since coming into force.
- 2) UK was an original signatory of the Singapore Treaty on Trade Mark Law, UK Trade Mark legislation will require amendment to enable ratification of the Singapore Treaty.
- 3) The current processes for Trade Mark Tribunals are out of line with the other registered IP rights (Patents and Designs) and also with current legal practice.
- 4) The current rules make the trade mark tribunal less efficient than it might be, and unless action is taken this will affect the UK-IPO's ability to process the substantially increased number of trade mark disputes in an acceptable timeframe.
- 5) The current trademark rules contain some inconsistent time periods and processes which unnecessarily delay unopposed Trade Mark registrations

What are the policy objectives and the intended effects?

- 1) Make the Trade Mark Rules more accessible and remove unnecessary duplication and provisions which are inconsistent.
- 2) Ensure UK benefits from access to global markets by remaining at forefront of international harmonisation of Trade Mark legislation.
- 3) Adopt flexible processes for the Trade Mark Tribunals, in line with other registered IP rights and current litigation practice.
- 4) Optimise the Trade Mark Rules to fit with business practices and ensure consistent time periods.

What policy options have been considered? Please justify any preferred option.

- 1) Status Quo
- 2) Incremental Change to address specific policy needs
- 3) Consolidation of Rules including current and planned policy amendments.

The preferred option is 3). The current Rules operate reasonably but given the number of amendments and outstanding policy amendments they are not particularly accessible and further incremental change would make this worse. Incremental change also increases the risk of unintended consequences from changes.

When will the policy be reviewed to establish the actual costs and benefits and the achievement of the desired effects? The Consolidated Rules will come into force on 1 October 2008, as they settle in they will be monitored with a more formal review in October 2009.

Ministerial Sign-off For consultation stage Impact Assessments:

I have read the Impact Assessment and I am satisfied that, given the available evidence, it represents a reasonable view of the likely costs, benefits and impact of the leading options.

Signed by the responsible Minister:



Date: 16 February 2008

Summary: Analysis & Evidence

Policy Option: 3	Description: Consolidation of Trade Mark Rules including currently planned policy amendments.
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COSTS	ANNUAL COSTS		Description and scale of key monetised costs by 'main affected groups' These proposals will not affect the UK-IPO's fee structure so the direct cost of a registering a Trade Mark or of opposing or cancelling the registration of a mark owned by someone else will be unaffected. Some changes may affect business volumes, it may be possible to monetise these costs following consultation responses.
	One-off (Transition)	Yr S	
	£		
	Average Annual Cost (excluding one-off)		
	£		Total Cost (PV) £
Other key non-monetised costs by 'main affected groups' Proposed changes in opposition proceedings will add an additional form in some cases, however this will have no fee and represent a minimal burden. Further, it can be avoided altogether if opposition is lodged within the 6 week period permitted. Changes to time periods may present some non monetised costs but these are difficult to assess.			

BENEFITS	ANNUAL BENEFITS		Description and scale of key monetised benefits by 'main affected groups' At present applications for priority have to be certified, the UK-IPO charge for a certified copy is £30 and around 800 cases per year file claims for priority. Under the proposed new rules only a negligible number of exceptional cases would require certification.
	One-off	Yr	
	£		
	Average Annual Benefit (excluding one-off)		
	£ 24000		Total Benefit (PV) £ 24000 p.a.

	<p>Other key non-monetised benefits by 'main affected groups' 90% of Trade Marks are unopposed. Proposed changes would accelerate the registration of these Marks by around seven weeks. A survey of users and potential users of the UK-IPO indicates that some customer groups desire quicker registration. Faster trade mark registration should bring greater certainty to business planning for new products and services.</p> <p>Proposals should reduce the evidentiary burden of some opposition and invalidation cases through more effective case management. The proposed changes to the revocation procedures should reduce the legal costs of bringing and defending non-use cancellation proceedings by reducing the number of evidence rounds It may be possible to monetise this after the consultation has taken place.</p>
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Key Assumptions/Sensitivities/Risks We assume that changes to optimise the process and shorten times to registration will not adversely effect existing application rates. There is sensitivity amongst some agents that quicker registrations risks a reduction in the quality of the register and an increase in post registration applications for invalidation.

Price Base Year	Time Period Years	Net Benefit Range (NPV) £	NET BENEFIT (NPV Best estimate) £
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What is the geographic coverage of the policy/option?		UK		
On what date will the policy be implemented?		1 st October 2008		
Which organisation(s) will enforce the policy?		UK-IPO		
What is the total annual cost of enforcement for these organisations?		£ 0		
Does enforcement comply with Hampton principles?		Yes		
Will implementation go beyond minimum EU requirements?		N/A		
What is the value of the proposed offsetting measure per year?		£ 0		
What is the value of changes in greenhouse gas emissions?		£ 0		
Will the proposal have a significant impact on competition?		No		
Annual cost (£-£) per organisation (excluding one-off)	Micro	Small	Medium	Large
Are any of these organisations exempt?	No	No	N/A	N/A

Impact on Admin Burdens Baseline (2005 Prices)				(Increase - Decrease)
Increase of	£ 20000	Decreases	£ 19500	Net £ 500

Key:	Annual costs and benefits: Constant Prices	(Net) Present Value
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Evidence Base (for summary sheets)

Summary

The UK Intellectual Property Office (UK-IPO) is an executive agency of the Department for Innovation, Universities and Skills (DIUS). UK-IPO is responsible, amongst other things for statutory registration and grant of intellectual property rights namely patents, registered designs and trade marks. The UK-IPO is internationally well regarded and places considerable importance on having up to date legislation

as indicated by the recent consolidations of the Patents Rules 2007 and Registered Designs Rules 2006. The Trade Mark Rules were last consolidated in 2000 and have been amended seven times since.

Proposal

UK-IPO is proposing to consolidate the Trade Marks Rules with effect from 1 October 2008. The four policy objectives and proposals to deliver them are set out below:

1) Make the Trade Mark Rules more accessible and remove unnecessary duplication and provisions which are inconsistent.

This will involve a consolidation exercise of the Trade Mark Rules 2000 to incorporate all amendments, thus increasing accessibility. It will also include changes such as making the rules gender neutral and adopting a more modern style of drafting. Anecdotal feedback from customers is supportive of a consolidation exercise.

2) Ensure UK benefits from access to global markets by remaining at forefront of international harmonisation of Trade Mark legislation

The UK was an initial signatory to the Singapore Treaty on Trade Mark Law. This Treaty sets minimum standards for trade mark legislation and the UK supports its adoption. In order to fully comply the UK will need to make one change to the existing Rules, and this consolidation exercise is a suitable vehicle to make this change. The necessary change is set out in paragraph 15 of the consultation document and draft rule 77, it will not present any net cost or administrative burden to users, but will be of benefit to them in dealings with the Office.

In addition, the UK-IPO is also currently proposing some changes to the Address for Service requirements across all registered IP rights. This would be included in the consolidated Trade Mark Rules with separate instruments bringing the requirements for patents and registered designs in line. This change will help the UK to ensure it meets its obligations under the EC treaty to provide free access to the market for services in the UK, to maximise the benefits of the Single Market. This change will not be an additional cost or benefit to UK customers, however it will be beneficial to customers from outside the UK involved in contested proceedings.

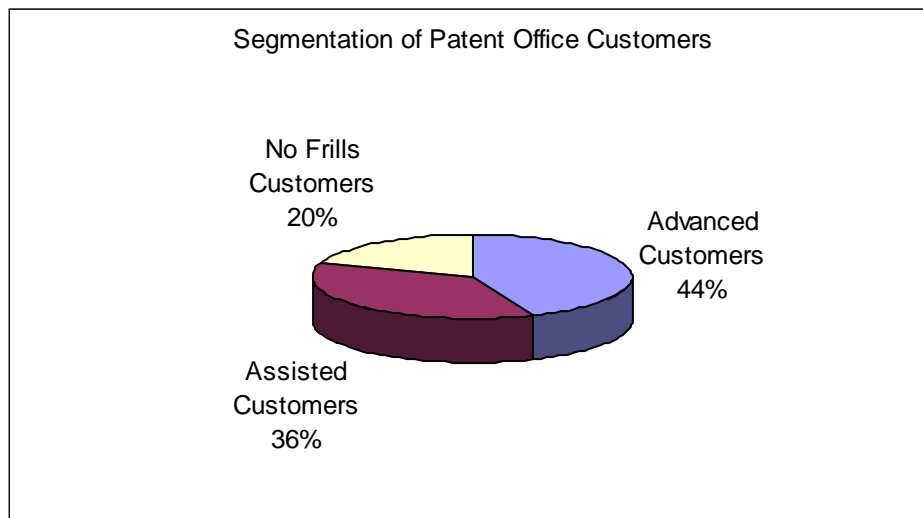
3) Adopt flexible processes for the Trade Mark Tribunals, in line with other registered IP rights and current litigation practice.

The recent Registered Designs and Patents Rules (2006 and 2007 respectively) have introduced general provisions to cover the filing of evidence and case management of tribunals. These provisions are in line with current legal practice and the UK-IPO proposes they are adopted in the Trade Mark Rules. This change will not present any additional costs, it will be of benefit to users by bringing greater coherence to provisions across registered IP rights.

4) Optimise the Trade Mark Rules to fit with business practices and ensure consistent time periods

Customer expectations and their desire for quicker Trade Mark registrations

In August 2006 the Patent Office commissioned a customer survey from IFF Research Ltd. This survey segmented the Office's customer base and identified the key things each group of customers or potential customers is looking for from the Office. Some of the results of this report are presented below:



Advanced Customers:

The most important thing to these customers is a fair and consistent process. A quick process is also fairly important to this group. Advanced Customers are likely to be attorneys (68%) or represented by agents (83%) and have dealt with the office for over 10 years (54%). As many (56%) of these customers have dealt with both Patents and Trade Marks sections so consistency across rights is relevant. Many Advanced Customers are London based with 10 or more staff (57%).

Assisted Customers

Having easily contactable staff available to help them with the process is the most important thing for these customers; they are potentially willing to pay more for a 'hand-held' service. Assisted Customers are more likely to be unrepresented applicants (47%) or potential customers (45%); they are also more likely to have dealt with the office for less than a year (48%) and know little about the Office. Assisted Customers often have no employees (50%).

No Frills Customers

A quick and cheap process is the most important thing for these customers, with the speed more important than the cost. Many of these are potential rather than actual customers (29%) so addressing their needs would be an opportunity to increase the customer base. Most (57%) No Frills customers would prefer no direct contact with the office and do business via email and the internet. No Frills customers often have no employees (31%)

This segmentation analysis indicates a substantial desire for a quick process, particularly from potential customers with a preference for online interaction with the office, representing around 10% of the survey sample. However, whilst relatively new and potential customers express a clear preference for a quick and cheap service the desire amongst 'advanced' users for consistency must not suffer, these customers represent the office's core business.

This analysis is further borne out by the responses to the recent consultation on Fast Track Examination of Trade Marks. A number of respondents to this consultation suggested that the value of the Fast Track service would be substantially increased if the three month opposition period was reduced.

Standardisation of time periods

In preparation for this consolidation exercise UK-IPO has had informal discussions with a number of key Trade Mark customers, particularly Trade Mark attorneys. In discussion these customers have agreed it would make sense for time periods to be consistent where the actions required are equivalent, e.g. filing of opposition counterstatements and post cancellation actions. However, there was some discussion on the appropriate time; this consultation is an opportunity for UK-IPO to collect wider views on this issue. We do not anticipate that this standardisation will present any additional cost as there is no change in the action required. In many cases there will also be no additional benefit, however, this will accelerate some processes which will be a benefit to customers.

Changes to the opposition period

In 2006 Andrew Gowers published his Review of Intellectual Property. One of the recommendations of this review was to introduce a fast track system for examination of Trade Mark applications to better enable applicants to respond to today's fast moving business environment. This system will be coming into force from 6 April 2008, however, a number of respondents to the public consultation exercise suggested that the value of an accelerated examination process is limited as the opposition period is still fixed at three months and outweighs the time taken for examination. Thus this consultation has been chosen as an appropriate vehicle to seek views on the opposition period and possible options for change. The proposed opposition period will be of benefit to customers seeking quicker registration. It will add a small burden to those considering opposition however this will be minimal and there will be no additional fee.

The proposal to introduce more flexible cooling periods in opposition proceedings should lead to some case being resolved more quickly and an even higher proportion of cases being resolved without continued litigation.

The consultation includes a proposal to restrict the timing of some appeals against interim decisions of the registrar should reduce by at least 50% the number of such appeals that parties feel it necessary to bring as part of their appeal against the registrar's final decision (it being assumed that a party will have no need to appeal an interim decision against them on a point if their case succeeds despite it). At present there are around 6 appeals per year against interim decisions. The increase in the number of cases coming before the Office suggests that this will grow to

around 20 per year over the next few years. The proposed change should obviate the need for, and the delay caused by, at least half of these. It may be possible to monetise this after the consultation.

The proposal will not prevent anyone from appealing any decision which has a material and adverse effect on them. Consequently, we do believe that there are any human rights issues.

Specific Impact Tests

Competition Assessment

Questions 1-4 below raise the issues considered under the competition assessment. As indicated in the answers the proposed approach will not have a substantial impact on competition.

Do these proposals:

1. Directly limit the number or range of suppliers?

None of the proposals made will materially change the nature of the protections provided by a Trade Mark registration. The proposals will also not effect access to a Trade Mark registration. Amendments to address for service requirements could increase access to and choice of representatives in contested cases.

2. Indirectly limit the number or range of suppliers?

The proposals do not indirectly affect the number or range of suppliers.

3. Limit the ability of suppliers to compete?

The proposals will not affect suppliers ability to compete.

4. Reduce suppliers' incentives to compete vigorously?

These proposals will change element of the mechanics of the Trade Mark system. However, there are no changes propose which will affect access, scope or cost of Trade Mark registration.

Small Firms Impact Test

The proposed changes do not materially affect access to or the cost of Trade Mark registration. Accelerated registration will appeal to some small businesses as they wish to be able to respond rapidly to business challenges, including Trade Mark protection. Small firms will also be a significant beneficiary of the consolidation as the new Rules will be more accessible to general users as well as Trade Mark attorneys. Consolidation should also reduce the cost of familiarisation with the Trade Mark Rules, which will benefit small firms. Any indirect impacts of the proposed changes which are raised during consultation will be considered in detail and addressed in the final Impact Assessment. During the public consultation the proposed changes will be raised at UK-IPO's outreach events through the UK-IPO website, which is the first point of contact for a small business with the office and also through Trade Marks literature distributed by UK-IPO.

Legal Aid

The proposed changes will not affect legal aid issues.

Sustainable Development.

The proposed changes will not affect sustainable development issues significantly.

Carbon Assessment

Most of the proposed changes will not have any impact on the carbon footprint of the UK-IPO or a Trade Mark application. The only new form proposed in these changes will only be available electronically which will minimise any increase in carbon production.

Other Environment

There are no other substantial environmental impacts of the proposed changes.

Health Impact Assessment

There is no health impact of the proposed changes.

Race Equality

There is no race equality impact of the proposed changes.

Disability Equality

There is no disability equality impact of the proposed changes.

Gender Equality

There is no gender impact of the proposed changes.

Human Rights

There is no human right impact of the proposed changes.

Rural Proofing

There are no additional rural impacts of the proposed changes.

Admin Burdens

The changes to admin burdens arise from changes to the fees regime. Form TM54 will be abolished, this contributes to DRID 10580, based on 2007 form logs the TM54 represents 8% of this burden equating to around £19,500. We are also proposing the introduction of a new form, of comparable complexity to the TM54. This form is the TM7a and like the TM54 it will have no associated fee. It is difficult to accurately predict volumes, but it would be related to the TM7, a cautious estimate is around double the volume. The burden of the TM7 is currently set out in DRID 10621. The form is considerably simpler than the TM7 so the actual burden of completion would be around 1/5th. On a per form basis the TM7 has a burden of around £50, so we propose a burden of £10 for the TM7a. Assuming around 2000 forms are filed this will give a new burden of around £20,000. All other burdens will be the same as for the Trade Mark Rules 2000