

SCHEDULE 2

Rule 3

Order 100

The Trade Marks Act 1938 as Amended by The Trade Marks (Amendment) Act 1984; The Trade Marks Act 1994 and the Olympic Symbol Etc (Protection) Act 1995

Interpretation

1. In this Order—

“the 1938 Act” means the Trade Marks Act 1938(1) as amended by the Trade Marks (Amendment) Act 1984(2);

“the 1994 Act” means the Trade Marks Act 1994(3);

“the Olympic Symbol Act” means the Olympic Symbol etc (Protection) Act 1995(4);

“the Olympic Symbol Regulations” means the Olympic Association Right (Infringement Proceedings) Regulations 1995(5);

“the Registrar” means the Comptroller General of Patents, Designs and Trade Marks;

“the register” means the register or trade marks maintained by the Registrar pursuant to section 63 of the 1994 Act.

Assignment to Chancery Division

2. Proceedings in the High Court under the 1938 Act, the 1994 Act, the Olympic Symbol Act or the Olympic Symbol Regulations shall be assigned to the Chancery Division.

Appeals and applications under the 1938 Act, the 1994 Act and the Olympic Symbol Act

3.—(1) Subject to rule 4 and paragraph (6) below every application to the High Court under the 1938 Act, the 1994 Act, the Olympic Symbol Act and the Olympic Symbol Regulations must be begun by originating motion.

(2) Notice of the motion by which any application is made under the 1938 Act or the 1994 Act must be served on the Registrar.

(3) Where—

(a) the Registrar refers to the High Court an application made to him under the 1938 Act or the 1994 Act;

(b) the Board of Trade under the 1938 Act or an appointed person under section 76 of the 1994 Act refers to that Court an appeal,

then unless within one month after receiving notification of the decision to refer, the applicant or the appellant, as the case may be, makes to that court the application or appeal referred, he shall be deemed to have abandoned it;

(4) The period prescribed by Order 55, rule 14(2), or by paragraph (3) in relation to an application or appeal to which that paragraph applies may be extended by the Registrar on the application of any party interested and may be so extended although the application is not made until after the

(1) 1938 c. 22
(2) 1984 c. 19
(3) 1994 c. 26
(4) 1995 c. 32
(5) S.I.1995/3325

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expiration of that period, but the foregoing provision shall not be taken to affect the power of the Court under Order 3, rule 5, to extend that period.

(5) Where under subsection (6) of section 17, or subsection (9) of section 18, of the said Act of 1938 an appellant becomes entitled to withdraw his application which is the subject matter of the appeal, he must give notice of his intention to the Registrar and to any other party to the appeal within one month after the Court has given leave under the said subsection (6) or the said subsection (9), as the case may be, for further grounds of objection to be taken.

(6) An application under section 16 or section 19 of the 1994 Act or regulation 3 or regulation 5 of the Olympic Symbol Regulations shall be made by originating summons or, if it is made in a pending action by summons or motion in that action.

(7) Where an application is made under section 19 of the 1994 Act or regulation 5 of the Olympic Symbol Regulations the applicant shall serve notice of the application on all persons so far as reasonably ascertainable having an interest in the goods, material or articles which are the subject of the application including any person in whose favour an order could be made in respect of the goods, material or articles under the said section of the 1994 Act or the said regulation of the Olympic Symbol Regulations or under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988.

Proceedings for infringement or registered trade mark; validity of registration disputed or revocation or rectification sought

4.—(1) Where in any proceedings a claim is made for relief for infringement of the rights conferred on the proprietor of a registered trade mark by section 9 of the 1994 Act, the party against whom the claim is made may in his defence put in issue the validity of the registration of that trade mark or may counterclaim for an order for revocation of the registration or for a declaration of invalidity of the registration or for rectification of the register, or may do any or all of those things.

(2) A party to any such proceedings who in his pleading (whether a defence or counterclaim) disputes the validity of the registration of a registered trade mark or seeks a declaration of invalidity or an order for revocation of the registration, or rectification of the register, must serve with his pleading particulars of the objections to the validity of the registration or of any grounds for revocation or rectification, on which he relies.

(3) A party to any such proceedings who counterclaims for an order for revocation of the registration or for a declaration of invalidity of the registration or for rectification of the register must serve on the Registrar a copy of the counterclaim together with a copy of the particulars mentioned in paragraph (2) and the Registrar shall be entitled to take such part in the proceedings as he may think fit but need not serve a defence or other unless ordered to do so by the Court.

Service of documents

5.—(1) This rule applies to the service of any document (including originating process) on a party until such time as that party has provided an address for service within the meaning of Order 6 rule 4(2) or Order 12 rule 3(3).

(2) Subject to paragraph (3) for the purposes of any proceedings relating to a registered trade mark (including proceedings for revocation, declaration of invalidity or non-infringement or groundless threats of infringement proceedings or any other proceedings under the 1938 Act or the 1994 Act), where any document is served in the manner prescribed by Order 10 or Order 65 at an address for service given in the register kept under section 63 of the 1994 Act—

- (a) service shall be deemed to have been effected on the registered proprietor of the trade mark on the date on which the document was served at the said address:

- (b) the party on whom service is deemed to have been effected under sub-paragraph (a), shall be treated, for the purposes of any provision of these rules which specifies a time-limit for responding to the document so served (whether by acknowledging service, giving notice of intention to defend or otherwise), as having been served on the seventh day after the date on which the document was served at the said address.
- (3) Nothing in this rule shall prevent service being effected on the proprietor in accordance with the provisions of these rules.

Service of orders on the Registrar

6. Where an order is made by the Court in any case under the 1938 Act or the 1994 Act, the person in whose favour the order is made or, if there is more than one, such one of them as the Court shall direct, shall serve an office copy of the order on the Registrar.