

## STATUTORY INSTRUMENTS

**1986 No. 1319****TRADE MARKS****The Trade Marks and Service Marks Rules 1986**

<i>Made</i>	- - -	<i>28th July 1986</i>
<i>Laid before Parliament</i>		<i>30th July 1986</i>
<i>Coming into Operation</i>		<i>1st October 1986</i>

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Whereas in pursuance of the requirements of section 40(3) of the Trade Marks Act 1938(a) the Secretary of State has, before making the following Rules under that Act, published notice of his intention to make such Rules and of the place where copies of the draft Rules might be obtained by advertising such notice in the Trade Marks Journal on 21st May 1986 and 28th May 1986 and the Official Journal (Patents) on 21st May 1986 and 28th May 1986, being the manner which he considered most expedient so as to enable persons affected to make representations to him before the Rules were finally settled:

Now, therefore, the Secretary of State, in exercise of the powers conferred by sections 36, 40 and 40A of the Trade Marks Act 1938(b) and now vested in him(c) and after consultation with the Council on Tribunals pursuant to section 10(1) of the Tribunals and Inquiries Act 1971(d) hereby makes the following Rules:—

### *Preliminary*

#### *Citation and commencement*

1. These Rules may be cited as the Trade Marks and Service Marks Rules 1986 and shall come into operation on 1st October 1986.

#### *Revocation*

2. The Rules specified in Schedule 1 to these Rules are hereby revoked.

#### *Interpretation*

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

“the 1938 Act” means the Trade Marks Act 1938(e) as it has effect with respect to trade marks;

“the modified 1938 Act” means the Trade Marks Act 1938(f) as it has effect with respect to service marks;

“assignment” includes assignation;

“the Journal” means the Trade Marks Journal;

“the Office” means the Trade Marks Registry of the Patent Office;

“the Manchester Branch” means the Manchester Branch of the Office;

“the Keeper” means the Keeper of the Manchester Branch;

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(a) 1938 c.22; the Act was applied, with modifications, to service marks by the Trade Marks (Amendment) Act 1984 (c.19), section 1, as amended by the Patents, Designs and Marks Act 1986 (c.39), section 2(1) and Schedule 3.

(b) Section 40A was added by the Statute Law (Repeals) Act 1986 (c.12), Schedule 2, paragraph 2.

(c) S.I. 1970/1537.

(d) 1971 c.62.

(e) 1938 c.22, as amended by the Trade Marks (Amendment) Act 1984 (c.19), section 1(5) and Schedule 2, and the Patents, Designs and Marks Act 1986 (c.39), Schedule 1, paragraphs 1 and 2, Schedule 2, paragraphs 3, 4, 5 and 6 and Schedule 3.

(f) 1938 c.22, as amended, applied and modified by the Trade Marks (Amendment) Act 1984 (c.19), section 1 and Schedule 1, amended by the Patents, Designs and Marks Act 1986 (c.39), section 2(1), Schedule 2, paragraphs 9, 10, 11 and 12 and Schedule 3.

“send” includes give;

“specification” means the designation of goods or (as the case may be) services in respect of which a trade mark or service mark, or a registered user of a trade mark or service mark, is registered or proposed to be registered.

(2) In these Rules, references to something being filed at a place or with a person are to be construed as references to its being sent to that place or person or made or left at that place or given or made to or left with that person, or to that person being furnished with it; and, subject to Rule 22(4) below, references to the filing of any thing without an indication of the place at which or person with whom it is to be filed are to be construed as references to its being filed with the Registrar at the Office.

#### *Forms*

4.— (1) The forms mentioned in these Rules are forms prescribed by rules.

(2) The prescribed form of certificate of registration required by section 19(2) of the 1938 Act and of the modified 1938 Act shall be as set out in Schedule 2 to these Rules.

#### *Classification*

##### *Classification of goods and services*

5.— (1) For the purposes of trade mark registrations dated before 27th July 1938 and of registrations of registered users thereunder, goods are classified in accordance with Schedule 3 to these Rules except in the case of a specification converted to Schedule 4 in accordance with Rule 6 below.

(2) For the purpose of trade mark registrations dated on or after 27th July 1938 and of registrations of registered users thereunder, and for the purposes of any registrations dated before that day in respect of which the specifications have been converted in accordance with Rule 6 below, goods are classified in accordance with Part I of Schedule 4 to these Rules.

(3) For the purpose of service mark registrations, services are classified in accordance with Part II of Schedule 4 to these Rules.

##### *Application for conversion*

6.— (1) Where the specification of a registered trade mark is founded on Schedule 3 to these Rules, the registered proprietor may, by filing form TM 45, apply for the conversion of that specification so that it may be founded on Schedule 4 to these Rules, with or without the striking-out of goods therefrom, but so that the registration shall retain its original date.

(2) The registered proprietor shall include in the application a request for the like conversion of the specification of the goods of any registered users under the registration.

(3) Upon receipt of the application the Registrar, in accordance with section 36(3) of the 1938 Act, shall send to the registered proprietor a proposal in writing showing the form which, in the Registrar's view, the amendment of the register should take.

(4) Two or more registrations of a trade mark in respect of goods falling within the same class of the said Schedule 4, having the same date of registration, may be amalgamated upon conversion in accordance with this Rule.

*Proposal for amendment*

7.— (1) The advertisement of a proposal for amendment under section 36(3) of the 1938 Act shall be made in the Journal.

(2) Notice of any opposition shall be filed on form TM 46 within one month from the date of the advertisement, and shall be accompanied by a duplicate of the notice and by a statement in duplicate showing how the proposed conversion would be contrary to section 36(2) of the 1938 Act.

(3) Forthwith upon receipt the Registrar shall send the duplicates to the registered proprietor who may, within one month from the date of receipt of such duplicates, file a counter-statement on form TM 8 setting out fully the grounds on which the opposition is contested, and if he does so he shall send to the opponent a copy of the counter-statement.

(4) Upon receipt of the counter-statement the Registrar may require or admit evidence directed to the questions in issue, and if so desired by either party he shall, before deciding the matter, give the parties an opportunity to be heard thereon.

(5) If the Registrar decides that the proposal shall be amended it shall be advertised in the Journal as so amended; and thereupon paragraphs (2) to (4) above and this paragraph shall apply, but only in respect of matter contained in the amended proposal not contained in the proposal before amendment.

*Registration of conversions*

8.— (1) When a proposal for the conversion of a specification in accordance with Rule 6 above has been advertised and has not been opposed and the time for notice of opposition has expired, or having been opposed the opposition has been determined and a conversion allowed, the Registrar shall make all the entries in the register necessary to give effect to the conversion in accordance with the proposal as advertised under Rule 7(1) above or, if it was amended, under Rule 7(5) above, and shall enter in the register the date when such entries were made.

(2) In respect of the entries made in the register in accordance with paragraph (1) above, the expiration of the last registration within the meaning of section 20 of the 1938 Act shall be the same as that in respect of the corresponding entries before conversion.

*General points of procedure*

*Size, etc. of documents*

9. Except to the extent that the Registrar may otherwise permit, all documents authorised or required by the 1938 Act, the modified 1938 Act or

these Rules to be filed at the Office or the Manchester Branch or with the Secretary of State, the Registrar, the Keeper or the Cutlers' Company shall be on strong paper measuring approximately 330mm by not less than 200mm nor more than 210mm (13 inches by 8 inches to  $8\frac{1}{4}$  inches) or approximately 297mm by approximately 210mm ( $11\frac{1}{4}$  inches by  $8\frac{1}{4}$  inches) and have on the left-hand side thereof a margin of not less than 25mm (1 inch).

#### *Signature of documents*

**10.**— (1) A document signed for or on behalf of a firm shall be signed by all of the partners, by any partner stating that he signs on behalf of the firm (or, in the case of a firm formed under the law of Scotland, by any partner in the firm's name) or by any other person who satisfies the Registrar that he is authorised to sign the document.

(2) If such a document does not contain the names of all of the partners in full the Registrar may send to the firm a written request to furnish him with a written statement of those names; and in such a case the Registrar may decline to take any further step in the matter to which the document in question relates until the firm has so furnished such a statement.

(3) A document signed for or on behalf of a body corporate shall be signed by a director or the secretary or other principal officer of the body or by any other person who satisfies the Registrar that he is authorised to sign the document.

(4) A document signed for or on behalf of an unincorporated body or association of persons other than a firm may be signed by any person who satisfies the Registrar that he is authorised to sign the document.

#### *Service of documents*

**11.** Any thing required or permitted by the 1938 Act, the modified 1938 Act or these Rules to be sent to any person or place or otherwise filed may be sent by post and except for the purposes of Rule 65(2) below shall, if so sent, be deemed to have been received or filed at the time when the letter containing it would be delivered in the ordinary course of post.

#### *Furnishing of address*

**12.** Where an address is filed under the 1938 Act, the modified 1938 Act or these Rules it shall be as full as possible for the purpose of enabling any other person easily to find the place of trade or business of the person in question.

#### *Address for service*

**13.**— (1) An applicant, opponent, agent, registered proprietor or registered user who does not reside or carry on business within the United Kingdom shall file an address for service within the United Kingdom.

(2) Any other applicant, opponent, agent, registered proprietor or registered user may file an address for service within the United Kingdom.

(3) In any case in which an address for service is filed at the same time as the filing of a form prescribed in these Rules which makes provision for the furnishing of an address for service, the address shall be filed on that form; and in any other case it shall be filed on form TM 33.

(4) In any case in which no address for service is filed, the Registrar shall treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.

(5) Anything sent to any person at an address filed by him, or treated by the Registrar, as his address for service shall be deemed to be properly sent.

(6) Where, in the case of an address for service entered in the register in accordance with Rule 60, 77 or 108 below, doubt arises as to whether it is still appropriate, the Registrar may send to that address a letter requesting the person for whom it is entered to confirm it and to the trade or business address of that person a copy of the letter, and if within three months from the date of sending the letter and the copy the Registrar receives no confirmation of the address he may strike it off the register.

#### *Agents*

14.— (1) Except as otherwise required by these Rules but without prejudice to Rule 10 above, any act required or permitted to be done under the 1938 Act, the modified 1938 Act or these Rules by or to any person may be done by or to an agent authorised by that person orally or in writing.

(2) In any particular case the Registrar may require the personal signature or presence of any person.

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

(4) Where, after a person has become a party to proceedings before the Registrar, he appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file form TM 1 in duplicate on or before the first occasion on which he acts as agent.

(5) The Registrar may decline to recognise as an agent any person who is proved to the Registrar or, on appeal, to the Secretary of State to have been guilty of conduct discreditable to an agent appointed to act in accordance with this Rule; and without prejudice to the generality of the foregoing the following shall be regarded as evidence of such conduct:

- (a) conviction of a criminal offence;
- (b) having been struck off and not restored to the Roll of Solicitors (other than for reasons which would not be discreditable in a person who was not a solicitor);
- (c) having, by reason of being adjudged guilty of conduct discreditable to a patent agent, been erased from and not restored to the Register of Patent Agents kept in pursuance of rules made under the Patents Act 1977(a);
- (d) suspension for the time being from acting as a solicitor or patent agent.

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(a) 1977 c.37.

*Registrability**Marks subject to statutory restriction*

**15.**— (1) The Registrar shall refuse to accept an application for the registration of a mark on which appears—

- (a) any emblem, designation, design or wording if the use thereof by the applicant would be an offence contrary to section 6 of the Geneva Conventions Act 1957(a) (use of Red Cross and other emblems), or
- (b) the Royal Arms, or Arms so nearly resembling them as to be calculated to deceive, if the use thereof by the applicant would be an offence contrary to section 92(2) of the Patents Act 1949(b), or
- (c) the word “Anzac” if the use thereof by the applicant would be an offence contrary to the “Anzac” (Restriction on Trade Use of Word) Act 1916(c).

(2) In any case in which there appears on a mark any thing the use of which by the applicant would not be an offence as aforesaid but which may be likely to be mistaken for any of the things mentioned in subparagraph (a), (b) or (c) of paragraph (1) above, the Registrar shall consider whether, if otherwise he would accept the application, the acceptance should be subject to any amendment, modification, condition or limitation.

*Marks requiring particular consideration*

**16.** The Registrar shall consider whether to refuse to accept an application for the registration of a mark on which any of the following appear:—

- (a) representations of the Royal crests or armorial bearings or of insignia or devices so nearly resembling any of them as to be likely to be mistaken for them;
- (b) representations of the Royal crown or of the Royal or national flags;
- (c) representations of Her Majesty or any member of the Royal Family or any colourable imitation thereof;
- (d) the use of any words, letters or devices in such a manner as to be likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation;
- (e) any word or words the false use of which would be capable of being an offence contrary to section 35 of the Registered Designs Act 1949(d) (false representation of design as registered) or section 110 or 111 of the Patents Act 1977 (unauthorised claim of patent rights or that patent has been applied for);
- (f) any word or words suggestive of copyright or similar protection or suggesting that trade mark infringement is a criminal offence.

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(a) 1957 c.52.

(b) 1949 c.87.

(c) 1916 c.51.

(d) 1949 c.88.

*Arms of city, etc.*

17. Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations or flags of any international organisation, state, city, borough, town, place, society, body corporate, institution or person appears on a mark, the Registrar shall consider whether to refuse to accept an application for the registration of the mark unless the consent of such official or other person as appears to the Registrar to be entitled to give consent is filed.

*Persons living or recently dead*

18. Where the name or representation of any person living or recently dead appears on a mark, the Registrar shall consider whether to refuse to accept an application for the registration of the mark unless the consent of that person or, as the case may be, his executors or other legal representatives is filed.

*Goods or services described on a mark*

19.— (1) Where the name or description of any goods appears on a trade mark or the name or description of any services appears on a service mark, the Registrar shall consider whether to refuse to register such mark in respect of any goods or services, as the case may be, other than the goods or services so named or described.

(2) Where the name or description of any goods appears on a trade mark or the name or description of any service appears on a service mark and (in either case) the name or description in use varies, the Registrar shall consider whether to refuse to permit the registration of the mark for those and other goods or services, as the case may be, unless the applicant states in his application that the name or description will be varied when the mark is used upon goods or services covered by the specification other than the named or described goods or services.

*Preliminary advice*

20.— (1) Any person who proposes to apply for the registration of a trade mark or a service mark in respect of any goods or services may apply orally or in writing for advice as to whether the mark, of which duplicate representations shall be filed, appears to the Registrar prima facie to be inherently adapted to distinguish, within the meaning of section 9 of the 1938 Act or of the modified 1938 Act, as the case may be, in relation to those goods or services or prima facie to be inherently capable of distinguishing, within the meaning of section 10 of the 1938 Act or of the modified 1938 Act, as the case may be, in relation to those goods or services.

(2) Separate applications under paragraph (1) above shall be made in respect of goods or services comprised within different classes as set out in Schedule 4 to these Rules.

(3) Notice of withdrawal of an application for the registration of a trade mark or a service mark given under section 42(3) of the 1938 Act or of the modified 1938 Act, as the case may be, for the purpose of obtaining repayment of any fee paid on the filing of the application shall be in writing and filed within six months from the date on which the Registrar gives notice of his objections.

*Application for registration**Application for registration and request for amendment*

21.— (1) An application for the registration of a trade mark or a service mark shall be signed by the applicant or his agent or in accordance with Rule 10 above; but if the applicant is a firm the full names of all the partners shall be given in the application.

(2) An application for registration of a trade mark shall be made by filing the appropriate form, as follows:

- (a) except in the case of a certification or defensive trade mark, form TM 2;
- (b) in the case of a certification trade mark, form TM 6;
- (c) in the case of a defensive trade mark, form TM 32;

and each application shall be for registration in respect of goods in only one class of Schedule 4 to these Rules.

(3) An application for registration of a service mark shall be made by filing form TM 2; and each application shall be for registration in respect of services in only one class of Schedule 4 to these Rules.

(4) Where, by reason of an application to register a trade mark or a service mark made or deemed to have been made in a relevant country as defined in subsection (10) of section 39A of the 1938 Act or of the modified 1938 Act, as the case may be, a claim for priority under the said section 39A is made in an application for registration of the mark filed with the Registrar, the application filed with the Registrar shall state the name of the country in question and the date of the application made or deemed to have been made there, and the applicant shall file a certificate by the registrar or other registering authority of that country or shall otherwise to the satisfaction of the Registrar verify the application made or deemed to have been made there.

(5) In the case of an application for registration in respect of all of the goods or services included in a class or in respect of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made or which he intends to make if and when it is registered.

(6) A request under section 17(7) of the 1938 Act or of the modified 1938 Act for the amendment of an application for registration may be made by filing form TM 20, and shall be so made if the Registrar requires.

(7) Where an applicant for registration is a Scottish firm and the identity of the partners changes in the course of the application, a request for amendment of the application accordingly shall be made by filing form TM 20.

*Addresses for applications*

22.— (1) An application for the registration of a trade mark in respect of textile goods (whether with or without other goods in the class of the application) for which provision is made in section 39 of the 1938 Act and Rule 101 below shall be filed with the Registrar at the Office or at the Manchester Branch.



(2) An application for the registration of a trade mark in respect of metal goods (whether with or without other goods in the class of the application) for which provision is made in section 38 of and Schedule 2 to the 1938 Act and Rule 95 below shall be filed with either the Registrar at the Office or the Cutlers' Company at the Cutlers' Hall, Sheffield 1.

(3) Any other application to register a trade mark and every application to register a service mark shall be filed with the Registrar at the Office.

(4) An applicant electing to file an application at the Office shall, unless otherwise required, file all subsequent communications respecting that application there; but an applicant electing to file an application at the Manchester Branch or with the Cutlers' Company may file subsequent communications there or at the Office.

#### *Separate applications*

23.— (1) Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

(2) Where a trade mark is registered under the same official number for goods in more than one class, whether on conversion of the specification under Rule 6 above or otherwise, the registration in respect of the goods included in each separate class shall be deemed to be a separate registration for all the purposes of the 1938 Act.

#### *Representation of mark*

24.— (1) Every application for the registration of a trade mark or a service mark shall contain a representation of the mark in the space provided on the application form for that purpose.

(2) Where the representation exceeds the said space in size the representation shall be mounted upon linen, tracing cloth or, with the consent of the Registrar, other suitable material; part of the mounting shall be affixed to the said space and the rest may be folded.

#### *Additional forms and representations*

25.— (1) There shall be included with every application for the registration of a trade mark or a service mark three additional representations of the mark either on form TM 4 or on sheets of strong paper of a size prescribed in Rule 9 above.

(2) There shall also be included with every application filed with the Cutlers' Company for registration of a trade mark in respect of metal goods and with every application for registration of a certification trade mark a duplicate of the application.

(3) The representation of the mark on the application, that on the duplicate (if any) and the additional representations shall correspond exactly.

(4) The additional representations shall be noted with the specification in question and such other particulars as may be required and shall, if required, be signed by the applicant or his agent.

#### *Physical requirements*

26. The representation of a mark shall be clear and durable; and the Registrar may at any time, if dissatisfied with any representation of a mark, require another representation satisfactory to him to be substituted before proceeding with the application.

#### *Cases of difficulty*

27. Where a representation cannot be filed in accordance with Rules 24 to 26 above, a specimen or copy of the mark either of full size or on a reduced scale may, subject to the consent of the Registrar, be filed in any convenient form.

#### *Retention of specimen or copy*

28. The Registrar shall retain for inspection by the public each specimen or copy filed under Rule 27 above and may refer thereto in the register in such manner as he may think fit.

#### *Series of marks*

29. Where application is made for the registration of a series of trade marks or service marks under section 21(2) of the 1938 Act or of the modified 1938 Act, a representation of each mark of the series shall, in accordance with Rules 24 to 26 above and subject to Rule 27 above, be included in the application form, in the duplicate thereof (if any) and in each of the accompanying forms TM 4 or (as the case may be) sheets of paper complying with Rule 25(5) above.

#### *Transliteration and translation*

30.— (1) Where a trade mark or a service mark contains a word or words in characters other than Roman, there shall, unless the Registrar otherwise directs, be endorsed on the application form and on each of the accompanying forms or sheets bearing additional representations a sufficient transliteration and translation of that word or each of those words to the satisfaction of the Registrar, and every such endorsement shall state the language to which the word in question belongs and shall be signed by the applicant or his agent.

(2) Where a trade mark or a service mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof together with the name of the language, and such translation and name shall, if he so requires, be endorsed and signed as provided for in paragraph (1) above.

*Search*

**31.**— (1) Upon receipt of an application for the registration of a trade mark or a service mark, the Registrar shall, for the appropriate purpose specified in paragraph (2) or (3) below, cause a search to be made amongst registered marks, marks at the time included in the collection of refused marks mentioned in Rule 102 below and pending applications; and the Registrar may cause the search to be renewed at any time before the acceptance of the application, but shall not be bound to do so.

(2) In the case of an application for the registration of a trade mark in respect of any goods the appropriate purpose mentioned in paragraph (1) above is that of ascertaining whether, for the same goods, for the same description of goods or for services or a description of services associated with the goods or goods of that description, there are on record any marks identical with the mark applied for or so nearly resembling it as to render the mark applied for likely to deceive or cause confusion.

(3) In the case of an application for the registration of a service mark in respect of any services the appropriate purpose mentioned in paragraph (1) above is that of ascertaining whether for the same services, for the same description of services or for goods or a description of goods associated with the services or services of that description, there are on record any marks identical with the mark applied for or so nearly resembling it as to render the mark applied for likely to deceive or cause confusion.

*Acceptance and objection*

**32.** After search in accordance with Rule 31 above and after consideration of the application and of any evidence of use or distinctiveness or of any other matter which the applicant may, or may be required to, file, the Registrar may accept the application absolutely, or he may object to it, or he may express his willingness to accept it subject to such conditions, amendments, disclaimer, modifications or limitations as he may think right to impose.

*Response to objections*

**33.** If the Registrar objects to the application he shall send his objections to the applicant in writing, and unless within six months from the date of receipt of those objections the applicant files an application for a hearing or a considered reply in writing to those objections he shall be deemed to have withdrawn his application.

*Conditions, etc.*

**34.**— (1) If the Registrar is willing to accept the application subject to any conditions, amendments, disclaimer, modifications or limitations he shall send to the applicant written notice of such willingness.

(2) If the applicant objects to such conditions, amendments, disclaimer, modifications or limitations he shall within six months from the date of the receipt of the notice apply for a hearing or file his considered objections in writing, and if he does not do so he shall be deemed to have withdrawn his application.

(3) If the applicant does not object to such conditions, amendments, disclaimer, modifications or limitations he shall within six months from the date of receipt of the notice file a written statement of his absence of objection and alter his application accordingly, and if he does not do so he shall be deemed to have withdrawn his application.

#### *Decision of Registrar*

35.— (1) When the Registrar has made a decision following a hearing as mentioned in Rule 33 or 34(2) above or, if the applicant has not applied for a hearing in accordance with those Rules, after considering any considered reply or considered objections filed in accordance with those Rules, the Registrar shall send his decision to the applicant in writing.

(2) If the applicant objects to the decision he may within one month from the date of receipt of the decision by filing form TM 5 require the Registrar to state in writing the grounds for his decision and the materials used by him in arriving at it.

(3) Where the applicant does not object to every condition, amendment, disclaimer, modification or limitation sent to him under Rule 34(1) above, the Registrar may decline to issue a statement as required in paragraph (2) above until the applicant has altered his application in accordance with those to which he does not object.

(4) The date when the statement is sent to the applicant shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

#### *Disclaimer*

36. The Registrar may call on an applicant to insert into his application such disclaimer as the Registrar may think fit in order that the public generally may understand what the applicant's rights, if his mark is registered, will be.

#### *Application for defensive trade mark*

37.— (1) An application for the registration of a defensive trade mark under section 27 of the 1938 Act shall be accompanied by a statement of case setting forth full particulars of the facts on which the applicant relies in support of his application, verified by a statutory declaration made by the applicant or some other person approved for the purpose by the Registrar.

(2) The applicant may file with the statutory declaration or within such time as the Registrar may allow such other evidence as he may desire, whether after request made by the Registrar or otherwise, and the Registrar shall consider the whole of the evidence before deciding on the application.

(3) Subject to paragraphs (1) and (2) above, these Rules shall, except to the extent that they are inappropriate or it is otherwise provided, apply to applications for the registration of defensive trade marks as they apply to applications for the registration of ordinary trade marks.

*Certification trade marks**Application for certification trade mark*

38. These Rules shall apply to applications for the registration of certification trade marks as they apply to applications for the registration of ordinary trade marks, except that for references therein to acceptance of an application there shall be substituted references to authorisation to proceed with the application.

*Address of applicant*

39. The address of an applicant for the registration of a certification trade mark shall be deemed to be a trade or business address for all the purposes for which such an address is required by these Rules.

*Case and draft regulations*

40.— (1) The applicant for registration of a certification trade mark shall file (with his application or when required by the Registrar) a statement of case setting out the grounds on which he relies in support of his application and draft regulations for governing the use of the mark, both being in duplicate.

(2) The Registrar may send to the applicant any observations which he may wish to make on the sufficiency of the case or the suitability of the draft regulations and the applicant may modify either of those documents.

*Directions by Secretary of State*

41.— (1) If the Registrar decides to authorise an application for registration of a certification trade mark to proceed he shall report to the Secretary of State thereon.

(2) The Secretary of State may at any time call for such evidence, if any, as he thinks fit, and shall if required hear the applicant and the Registrar before giving directions as provided in paragraph 1(5) of Schedule 1 to the 1938 Act.

(3) Where such directions have been given and the application has been accepted, the regulations for governing the use of the mark approved by the Secretary of State and the form of application shall be open to public inspection.

*Advertisement and opposition**Advertisement of application*

42.— (1) An application for registration of a trade mark or a service mark required or permitted to be advertised by section 18(1) of or paragraph 2(1) of Schedule 1 to the 1938 Act or by section 18(1) of the modified 1938 Act, as the case may be, shall be advertised in the Journal; and Rule 43 below shall apply.

(2) In the case of an application with which the Registrar proceeds only after the applicant has filed the written consent to the proposed registration of the registered proprietor, or the applicant for the registration, of another mark (whether a trade mark or a service mark) the words "By Consent" and the number of the other mark shall appear in the advertisement.

(3) If no representation of the mark be included in the advertisement, the Registrar shall refer in the advertisement to the place or places where a specimen or copy of the mark is available for inspection.

*Representation for advertisement*

43. Where a mark consists other than of a word or words in plain type, the applicant for its registration shall, if required by the Registrar for the purposes of advertisement, file a representation of the mark in a form which permits direct reproduction by photography, electro-static processes and photo-offset in an unlimited number of copies; and such a representation shall be of such dimensions as the Registrar may require or permit for the purpose.

*Advertisement of series*

44. When an application relates to a series of marks differing from one another in respect of the particulars mentioned in section 21(2) of the 1938 Act or of the modified 1938 Act, the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in which the marks differ from one another.

*Advertisement under section 18 or 35*

45. Advertisements under section 18(10), 35(2) and 35(4) of the 1938 Act and of the modified 1938 Act shall be made in the same manner, with such modifications as may be required to suit the circumstances, as advertisements relating to an application for registration.

*Notice of opposition*

46. Any person may within one month from the date of any advertisement in the Journal of an application for registration of a trade mark or a service mark file in duplicate on form TM 7 notice of opposition to the registration; and the Registrar shall forthwith send the duplicate to the applicant.

*Contents of notice*

47.— (1) Notice of opposition shall include a statement of the grounds upon which the opponent objects to the registration opposed.

(2) If registration is opposed on the ground that the mark resembles another mark already on the register or the registration of which is the subject of a current application, the number and class of that other mark and (except in the case of a mark the subject of an application not yet advertised) the number of the Journal in which it has been advertised shall be set out in the notice.

(3) If the registration is opposed on the ground that the mark resembles a mark included in the collection of refused marks mentioned in section 39(8) of the 1938 Act, the number of the mark in that collection shall be set out in the notice.

*Counter-statement*

48.— (1) Within two months from the date of receipt of the duplicate provided for in Rule 46 above the applicant shall file a counter-statement on form TM 8 setting out the grounds on which he relies as supporting his application and the facts, if any, alleged in the notice of opposition which he admits.

(2) The counter-statement shall be accompanied by a duplicate.

*Evidence in support of opposition*

49. Upon receipt of the counter-statement and duplicate provided for in Rule 48 above the Registrar shall forthwith send the duplicate to the opponent and within six months from the date of receipt of the duplicate the opponent shall file such evidence by way of statutory declaration as he may desire to adduce in support of his opposition and shall send to the applicant a copy of that evidence.

*Evidence in support of application*

50. If the opponent files no evidence in accordance with Rule 49 above he shall, unless the Registrar otherwise directs, be deemed to have abandoned his opposition; but if he does so file evidence the applicant shall, within six months from the date of his receipt of the copy of the opponent's evidence provided for in Rule 49 above, file such evidence by way of statutory declaration as he may desire to adduce in support of his application and shall send to the opponent a copy of that evidence.

*Evidence in reply*

51.— (1) Within six months from the date of receipt by the opponent of the copy of the applicant's evidence provided for in Rule 50 above the opponent may file evidence in reply by way of statutory declaration and shall send to the applicant a copy of that evidence.

(2) Evidence in reply shall be confined to matters strictly in reply to the applicant's evidence.

*Further evidence*

52. No further evidence may be filed on either side, except that in any proceedings before him the Registrar may at any time if he thinks fit give leave to either party to file evidence upon such terms as to costs or otherwise as he may think fit.

*Exhibits*

**53.—** (1) Where there are exhibits to delarations filed as evidence in an opposition, the party filing them shall, on the request and at the expense of the other party, send to him a copy or impression of each exhibit or, if a copy or impression cannot conveniently be sent, the originals shall be filed in order that they may be open to inspection.

(2) The originals shall be produced at the hearing unless the Registrar otherwise directs.

*Hearing*

**54.—** (1) As soon as possible after completion of the evidence the Registrar shall send to the parties notice of a date when he will hear argument in the case.

(2) The date for hearing argument shall be at least fourteen days after the date of receipt of the notice by the parties, unless the parties consent to shorter notice.

(3) Within seven days from the date of receipt of the notice any party who intends to appear shall give notice by filing form TM 9; and any party who does not do so may be treated as not desiring to be heard, and the Registrar may act accordingly.

*Subsequent extension of time*

**55.** Where in opposition proceedings any extension of time is granted to any party, the Registrar may thereafter, if he thinks fit, without giving that party a hearing, grant to any other party any reasonable extension of time in which to take any subsequent step.

*Security for costs*

**56.** Where a party filing notice of opposition under Rule 46 above or a counter-statement under Rule 48 above neither resides nor carries on business in the United Kingdom the Registrar may require him to give security, in such form as the Registrar may deem sufficient, for the costs or expenses of the proceedings before the Registrar, for such amount as to the Registrar may seem fit, and at any stage in the opposition proceedings may require further security to be given at any time before giving his decision in the case.

*Costs in uncontested cases*

**57.** In deciding whether costs or expenses should be awarded to an opponent whose opposition is not contested by the applicant the Registrar shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was filed.



*Opposition to certification trade marks*

58.— (1) Within one month from the date of any advertisement in the Journal of an application for the registration of a certification trade mark, any person may, by filing form TM 7 in duplicate, give notice of opposition under paragraph 2(1) of Schedule 1 to the 1938 Act.

(2) Any person may file with the Secretary of State in duplicate on form TM 37 notice of opposition under paragraph 2(2) of Schedule 1 to the 1938 Act.

(3) The Registrar shall forthwith send to the applicant the duplicate filed under paragraph (1) or (2) above, as the case may be, and thereafter Rules 47 to 57 above shall apply with such modifications as may be required to suit the circumstances.

(4) In case of doubt, any party may apply to the Registrar or the Secretary of State, as the case may be, for directions.

*Registration and renewal**Non-completion*

59.— (1) In any case falling within section 19(3) of the 1938 Act or of the modified 1938 Act, that is to say, in any case in which, by reason of default on the part of the applicant, registration of the trade mark or service mark in question is not completed on or before the first anniversary of the date on which the application in question was filed under Rule 22 above, the time specified in the notice of non-completion given by the Registrar under that section within which the application must be completed if it is not to be liable to be treated as abandoned shall be not less than fourteen days from the date on which the notice is given.

(2) In any case not falling within the said section 19(3), that is to say, in any case in which registration of the mark is not completed on or before the said anniversary but the failure to register the mark on or before that anniversary is not attributable to default on the part of the applicant, the provisions of paragraphs (3) to (5) below shall apply; but those paragraphs shall not otherwise apply.

(3) If the requirements for completion are not satisfied before the end of the period of one month beginning on the day following whichever of the events specified in paragraph (4) below last occurs he may give notice of non-completion to the effect that if the requirements for completion are not satisfied within the time specified in the notice he may treat the application as abandoned; and the time so specified shall be not less than fourteen days from the date on which the notice is given.

(4) The events referred to in paragraph (3) above are—

- (a) expiry of the time within which notice of opposition may be filed under Rule 46 or, as the case may be, Rule 58 above;
- (b) the final determination of any opposition proceedings (including the disposal of any appeal);
- (c) acceptance by the Registrar of the application absolutely;

(d) the final determination of any proceedings under Rule 35 above (including the disposal of any appeal).

(5) If the requirements for completion are not satisfied within the time specified in a notice of non-completion given under paragraph (3) above the Registrar may, subject to paragraph (7) below, treat the application as abandoned.

(6) The Registrar shall give notice of non-completion under the aforementioned section 19(3) or under paragraph (3) above, as the case may be, by sending it to the applicant or his agent; and where the notice is sent to an agent, the Registrar shall send a duplicate to the applicant.

(7) The Registrar shall not treat an application as abandoned under the aforementioned section 19(3) or under paragraph (5) above if the requirements for completion are satisfied before he does so.

(8) For the purposes of this Rule, the requirements for completion are satisfied when the Registrar has received the prescribed fee referred to in Rule 60(1) below, form TM 10 duly completed and (where required) the representation referred to in Rule 60(2) below.

#### *Entry in register*

**60.—** (1) As soon as may be after the expiry of the period of one month from the date of the advertisement in the Journal of an application for the registration of a trade mark or a service mark, the Registrar shall, subject to any opposition and the determination thereof and subject also to the provisions of section 19(1) of the 1938 Act or of the modified 1938 Act, as the case may be, and upon receipt of form TM 10, accompanied by the prescribed fee, enter the mark in the register.

(2) Except where the mark consists of a word or words in plain type or the Registrar has retained a specimen or copy under Rule 28 above, the applicant shall file with the fee referred to in paragraph (1) above a representation of the mark agreeing in all respects with the representation then appearing on the form of application and, subject to Rule 27 above, complying with Rule 26 above.

(3) The entry of a trade mark or a service mark in the register shall give the date of the registration, the goods or services in respect of which it is registered and all the particulars specified in section 1(1) of the 1938 Act or of the modified 1938 Act, as the case may be, including—

- (a) the name and the trade or business address of the proprietor (including the names of all the partners where the proprietor is a firm),
- (b) any address for service filed under Rule 13 above,
- (c) particulars of any undertakings given by the proprietor and entered on the form of application, and
- (d) particulars affecting the scope of the registration or the rights conferred by it.

(4) In the case of an application which the Registrar accepts only after the

applicant has filed the written consent to the proposed registration of the registered proprietor of another trade mark or service mark or another applicant for registration, the entry in the register shall state that it is "By Consent" and shall give the number of the other registration or application.

*Associated marks*

**61.**— (1) Where a mark is registered as associated with any other mark or marks the Registrar shall note in the register in connection with the first-mentioned mark the numbers of the marks with which it is associated and shall also note in the register in connection with each of the associated marks the number of the first-mentioned mark as being a mark associated with it.

(2) An application under section 23(5) of the 1938 Act or of the modified 1938 Act for the dissolution of the association between two or more associated marks shall be made by filing form TM 19 and shall include a statement of the grounds of the application.

*Death of applicant; assignment after application*

**62.**— (1) If an applicant for the registration of a trade mark or a service mark dies after his application has been made and before the mark has been entered on the register and another person proves to the satisfaction of the Registrar that he enjoys the same rights in or in respect of the mark that the applicant enjoyed, the application shall proceed and Rule 60 above shall apply as if that person were the applicant.

(2) Where an applicant for the registration of a trade mark or a service mark is also the registered proprietor of a trade mark or a service mark registered in respect of relevant goods or services and both the registered mark and the mark the subject of the application are assigned or transmitted (other than on death) to the same person, that person may include in his application under Rule 71 below an application to be treated as the applicant for registration; and in such a case the application shall proceed and Rule 60 above shall apply as if that person were the applicant.

(3) Rule 73(3) and (4) below shall apply in respect of an application under paragraph (2) above as it applies in respect of an application under Rule 71 below.

(4) For the purposes of paragraph (2) above, relevant goods or services are—

- (a) in the case of an application for the registration of a trade mark in respect of any goods—
  - (i) the same goods, or
  - (ii) the same description of goods, or
  - (iii) services or a description of services associated with the goods or goods of that description, and
- (b) in the case of an application for the registration of a service mark in respect of any services—
  - (i) the same services, or
  - (ii) the same description of services, or

- (iii) goods or a description of goods associated with the services or services of that description.

*Certificate of registration*

63. Upon the registration of a trade mark or a service mark the Registrar shall send to the proprietor a certificate of registration in the prescribed form referred to in Rule 4(2) above and shall affix thereto the representation of the mark, if any, filed under Rule 60(2) above.

*Reminder of renewal*

64. At any time not earlier than three months nor later than one month before the expiration of the last registration of a trade mark or a service mark the Registrar shall, in accordance with Rule 13(5) above, send to the registered proprietor on form TM 11 notice of the approaching expiration.

*Renewal*

65.— (1) Subject to paragraphs (2) and (3) and Rule 67(2) below, renewal of registration shall not be effected except upon the filing of the form TM 11 sent in accordance with Rule 64 above, or an exact replica thereof, duly completed; and the form or replica shall not be filed until after the date one month before the expiration of the last registration.

(2) If, for any reason, the proprietor has not received the said form by the date one month before the expiration of the last registration, renewal may be effected upon the filing of any form TM 11.

(3) In considering whether a form filed is an exact replica of a form sent in accordance with Rule 64 above, the Registrar may disregard any differences which he considers to be immaterial.

(4) If the form or replica referred to in paragraph (1) above is filed on or before the date one month before the expiration of the last registration, it shall be treated as having been filed on the first day after that date.

(5) In any case the form TM 11 filed shall be accompanied by the prescribed renewal fee.

*Authority for renewal*

66. If the person filing form TM 11 is not the registered proprietor he shall enter on the form his name and address and sign a statement thereon to the effect that he is directed by the proprietor to pay the renewal fee.

*Late renewal*

67.— (1) If on the expiration of the last registration of a trade mark or a service mark the renewal fee has not been paid, the Registrar shall advertise that fact forthwith in the Journal; and if within one month from the date of the advertisement form TM 11 is filed accompanied by the renewal fee and the prescribed additional fee he shall renew the registration without removing the mark from the register.

(2) Rule 65(1) above shall not apply in a case falling within paragraph (1) above.

*Removal and restoration*

68. If the renewal fee and the prescribed additional fee have not been paid by the end of the period of one month referred to in Rule 67(1) above, the Registrar may remove the mark from the register as of the expiration of the last registration; but upon the filing of form TM 13 accompanied by the renewal fee and the prescribed restoration fee he may restore the mark to the register and renew its registration upon such conditions as he may think fit if satisfied that it is just to do so.

*Record of removal*

69. Where a mark has been removed from the register, the Registrar shall cause to be entered in the register a record of the removal and of its cause.

*Notice and advertisement of renewal or restoration*

70. Upon the renewal or restoration and renewal of a registration, a notice to that effect shall be sent to the registered proprietor and the renewal or restoration and renewal shall be advertised in the Journal.

*Assignments and transmissions**Application for entry of assignment or transmission*

71. Where a person becomes entitled by assignment or transmission to a registered trade mark or a registered service mark, application to register his title shall be made by filing form TM 16.

*Joint applications*

72. Application under Rule 71 above may be made jointly with the registered proprietor.

*Particulars to be stated and copies of documents*

73.— (1) An application under Rule 71 above shall contain the name and trade or business address of the applicant, together with full particulars of the instrument, if any, under which he claims his entitlement.

(2) If the applicant is a firm the full names of all the partners shall be given in the application.

(3) There shall be filed with the application, for retention by the Registrar, an attested copy of any instrument of which particulars are given, but such a copy shall not be open to public inspection.

(4) The Registrar may at any time, by notice in writing sent to the applicant, require him to produce for inspection any instrument of which an attested copy has been filed.

*Case accompanying application*

74.— (1) Where an applicant under Rule 71 above does not claim under any document or instrument which is capable in itself of furnishing proof of his title, he shall, unless the Registrar otherwise directs, file with the application a statement of case setting forth the full particulars of the facts upon which his claim to be proprietor of the mark in question is based and showing that it has been assigned or transmitted to him.

(2) If the Registrar so requires the case shall be verified by statutory declaration.

*Proof of title*

75. The Registrar may call on any person who applies to be registered as proprietor of a registered trade mark or registered service mark for such proof or additional proof of title as he may require for his satisfaction.

*Assignment without goodwill*

76.— (1) An application under Rule 71 above relating to an assignment of a trade mark or a service mark in respect of any goods or services shall state—

- (a) whether the mark was, at the time of the assignment, used in a business in any of those goods or services, as the case may be, and
- (b) whether the assignment was made otherwise than in connection with the goodwill of that business,

and if both those circumstances subsist the applicant shall file a copy of the directions of the Registrar for advertisement of the assignment (which shall have been obtained upon application under section 22(7) of the 1938 Act or of the modified 1938 Act, as the case may be, and Rule 80 below) and such proof, including copies of advertisements or otherwise, as the Registrar may require that his directions have been fulfilled.

(2) If the Registrar is not satisfied that the directions have been fulfilled, he shall not proceed with the application.

(3) For the purposes of section 29(4) of the 1938 Act and of the modified 1938 Act, the period within which a corporation may be registered as the subsequent proprietor of a registered trade mark or registered service mark upon application made under Rule 71 above shall be six months from the date on which the mark was entered in the register or such further period not exceeding six months as the Registrar may allow on application made by the applicant for registration of title or the registered proprietor, as the case may be, by filing form TM 14 at any time before or during the period for which extension may be allowed.

*Entry of assignment or transmission in register*

77. When the Registrar is satisfied as to the title of an applicant under Rule 71 above he shall cause him to be registered as proprietor of the mark in question in respect of the relevant goods or services and shall enter in the register—

- (a) the name and the trade or business address of the new proprietor (including the names of all the partners where the proprietor is a firm),
- (b) any address for service filed under Rule 13 above, and
- (c) particulars of the assignment or transmission.

*Separate registrations*

**78.** Where, pursuant to an application under Rule 71 above and as a result of a division and separation of the goods or services of a registration or a division and separation of places or markets, different persons become registered separately, whether or not under different official numbers, as subsequent proprietors of a trade mark or a service mark, each of the resulting separate registrations in the names of those different persons shall be treated as a separate registration for all of the purposes of the 1938 Act or the modified 1938 Act, as the case may be.

*Registrar's certificate or approval*

**79.** — (1) Any person wishing to obtain the Registrar's certificate under subsection (5) of section 22 of the 1938 Act or of the modified 1938 Act or his notification of approval under subsection (6) of that section shall file an application on form TM 40, a statement of case in duplicate setting out the circumstances and a copy of any instrument or proposed instrument effecting the assignment or transmission in question.

(2) The Registrar may call for any evidence or further information that he may consider necessary, and the statement of case shall if required be amended to include all the relevant circumstances or verified by statutory declaration; and if the statement of case is amended, two fair copies in its final form shall be filed.

(3) After hearing the applicant (if so required) and any other person whom he may consider to be interested in the transfer, the Registrar shall consider the matter and issue a certificate thereon or a notification in writing of approval or disapproval thereof, as the case may be, and shall seal to the certificate or notification a copy of the statement of case in its final form.

*Advertisement of assignment without goodwill*

**80.**— (1) An application to the Registrar under subsection (7) of section 22 of the 1938 Act or of the modified 1938 Act shall be made by the assignee by filing form TM 43 and shall state the date on which the assignment was made.

(2) In the case of a registered trade mark or a registered service mark the application shall give particulars of the registration.

(3) In the case of an unregistered mark the application shall show the mark and shall give particulars of the registered mark that has been assigned with it in accordance with subsection (3) of the said section 22.

(4) The Registrar may call for any evidence or further information, and if he is satisfied about the matters in question he shall issue directions in writing with respect to the advertisement of the assignment.

(5) The Registrar may refuse to consider an application under the said subsection (7) in a case to which subsection (6) of the said section 22 applies unless his approval has been obtained under subsection (6) and a reference identifying the Registrar's notification of approval is included in the application.

(6) Extension of the period within which the application may be made shall be for not more than six months; and a request to the Registrar for such extension shall be made by filing form TM 44 before the end of the period for which extension may be allowed.

#### *Alteration and rectification of the register*

##### *Alteration of address*

**81.**— (1) A registered proprietor or registered user of a trade mark or a service mark whose—

- (a) trade or business address is changed, or
- (b) address for service as entered in the register is no longer appropriate, whether by reason of discontinuance of the entered address or otherwise,

so that the entry in the register is rendered incorrect shall forthwith, by filing form TM 18 or TM 33, as appropriate, request the Registrar to make the appropriate alteration of the address in the register.

(2) Upon a request under paragraph (1) above the Registrar shall, if he is satisfied in the matter, alter the register accordingly.

(3) If the address of one person is the address for service of more than one registered proprietor or registered user, that person may request the Registrar to make the appropriate alteration in respect of every such proprietor or user by filing a single form TM 33 suitably amended so as to give particulars of each registration; and the Registrar may, on proof that the address is that of the applicant and if satisfied that it is just to do so, alter the register accordingly.

##### *Application for rectification or removal*

**82.**— (1) An application to the Registrar under section 26, 27, 32 or 33 of the 1938 Act or section 26, 32 or 33 of the modified 1938 Act for making, expunging or varying an entry in the register shall be made by filing form TM 26, accompanied by a statement setting out fully the nature of the applicant's interest, the facts on which he bases his case and the relief which he seeks.

(2) Where the application is made by a person who is not the registered proprietor of the mark in question it shall be accompanied by two additional copies of the application and two additional copies of the statement, and the Registrar shall forthwith send those copies to the registered proprietor at his trade or business address as entered in the register and, if an address for service different therefrom is entered in the register, at that address also.

##### *Further procedure*

**83.**— (1) When an application under Rule 82 above has been made and



(where appropriate) copies have been sent to the registered proprietor, the provisions of Rules 48 to 57 above shall apply to the further proceedings thereon with such modifications as may be required to suit the circumstances; but the Registrar shall not rectify the register or remove the mark in question from the register merely because the registered proprietor has not filed a counter-statement.

(2) In any case of doubt arising under this Rule, any party may apply to the Registrar for directions.

#### *Intervention by third parties*

**84.**— (1) Any person other than the registered proprietor alleging interest in a registered trade mark or registered service mark in respect of which an application is made under Rule 82 above may apply for leave to intervene by filing form TM 27, stating thereon the nature of his interest, and the Registrar may, after hearing the parties concerned if so required, grant or refuse such leave upon such terms or conditions as he may think fit.

(2) Before dealing in any way with an application for leave to intervene the Registrar may require the applicant to give an undertaking to pay such costs as he may award to any party.

#### *Request for alteration of the register*

**85.**— (1) A request under section 34 of the 1938 Act or of the modified 1938 Act for the alteration of the register shall be made by filing form TM 18, TM 20, TM 21, TM 22, TM 23, TM 24 or TM 33, as appropriate.

(2) Where the registered proprietor or registered user of a trade mark or a service mark is a Scottish firm and the identity of the partners changes, a request for alteration of the register accordingly shall be made by filing form TM 21.

(3) Where it appears to the Registrar that the description formerly entered in the register of the registered proprietor or registered user of a trade mark is no longer correct, he may, if he thinks fit, remove it from the register.

#### *Evidence for alteration*

**86.** Where a request is made under the said section 34 or Rule 85(2) above, the Registrar may require such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application is made.

#### *Advertisement of request to enter disclaimer or memorandum*

**87.** Before deciding on a request made under subsection (1)(e) of the said section 34 for the entry of a disclaimer or memorandum, the Registrar shall advertise the request in the Journal in order to enable any person wishing to do so to state, within one month from the date of the advertisement, any reasons in writing against the making of the entry.

*Certificates of validity*

**88.**— (1) Where the Court has certified with regard to the validity of a registered trade mark or registered service mark as provided in section 47 of the 1938 Act or of the modified 1938 Act, the registered proprietor of the mark may, by filing form TM 49, request the Registrar to add to the entry in the register a note that the certificate of validity has been so granted.

(2) The proceedings in the course of which the certificate was granted shall be named in the request.

(3) An office copy of the certificate shall be sent with the request, and the Registrar shall enter a note in the register as requested and publish it in the Journal.

*Application for alteration of registered mark*

**89.** Application under section 35 of the 1938 Act or the modified 1938 Act for addition to or alteration of a registered trade mark or registered service mark shall be made by filing form TM 25 accompanied by three representations of the mark as it will appear when added to or altered; and every such representation shall, subject to Rule 27 above, comply with Rule 26 above.

*Advertisement before decision*

**90.**— (1) The Registrar shall consider each application filed in accordance with Rule 89 above and, if it appears to him to be expedient to do so, shall advertise it in the Journal before deciding it.

(2) Within one month from the date of the advertisement any person may give notice of opposition to the application by filing form TM 47 accompanied by a statement of objections, both in duplicate.

(3) The Registrar shall send to the applicant the duplicate of the notice and of any accompanying statement of objections, and the provisions of Rules 48 to 57 above shall apply to any further proceedings on the application with such modifications as may be required to suit the circumstances.

(4) In any case of doubt arising under this Rule, any party may apply to the Registrar for directions.

*Alteration of mark*

**91.** If the Registrar decides to allow an application filed in accordance with Rule 89 above he shall add to or alter the mark in the register in accordance with the application, and unless the application has been advertised under Rule 90(1) above and no notice has been given under Rule 90(2) he shall advertise the mark in the Journal as added to or altered.

*Advertisement of altered mark*

**92.** Rule 43 above shall apply in respect of advertisements under Rules 90(1) and 91 above.

*Rectification in respect of certification trade marks*

**93.** An application to the Secretary of State by an aggrieved person on any of the grounds mentioned in paragraph 4 of Schedule 1 to the 1938 Act for an order expunging or varying an entry in the register of or relating to a certification trade mark or varying the relevant regulations deposited under section 37(7) of the 1938 Act shall be made by filing form TM 36 and shall include full particulars of the grounds on which the application is made.

*Variation of regulations*

**94.—** (1) An application by the registered proprietor of a certification trade mark for variation of the regulations deposited under section 37(7) of the 1938 Act and the consent of the Secretary of State thereto shall be made by filing form TM 35.

(2) Where the Secretary of State causes such an application to be advertised the time within which any person may give to him notice of opposition to the application shall be one month from the date of the advertisement.

*Sheffield marks**Metal goods*

**95.** For the purposes of paragraph 12(1) of Schedule 2 to the 1938 Act and of Rule 22 above, the classes which refer predominantly to metal goods shall be classes 6 to 14 and 21 of Schedule 4 to these Rules.

*Notice from Cutlers' Company*

**96.** The Cutlers' Company shall, within seven days from the date of receipt by them of an application to register a trade mark, send to the Registrar the original of the application and three of the additional representations filed with them under Rule 25(1) above.

*Objection by Registrar*

**97.** Where the Cutlers' Company have, pursuant to paragraph 4 of Schedule 2 to the 1938 Act, communicated to the applicant a notice of objection given by the Registrar then unless within six months from the date of receipt of that communication the applicant files an application for a hearing or a considered reply in writing to the objection he shall be deemed to have withdrawn his application.

*Advertisement by Registrar*

**98.** Where the Registrar has authorised the Cutlers' Company to proceed with an application he shall advertise it in the same manner as an application filed at the Office; and rule 43 above shall apply.

*Notice to Cutlers' Company*

**99.** When the Registrar receives an application for the registration of a trade mark in respect of metal goods, the manner in which the Registrar shall notify to the Cutlers' Company the application and proceedings thereon shall be by sending to the Company a copy of the Journal containing an advertisement of the application or proceedings.

*Application of Rules*

**100.** The provision of these Rules as to forms, representations, the proceedings on opposition to registration, registration and all proceedings subsequent to registration shall, as far as circumstances allow, apply to all applications to register trade marks filed with the Cutlers' Company and to all proceedings consequent thereon.

*Textile marks**Textile goods*

**101.** The classes specified for the purpose of the definition of "textile goods" in section 39(2) of the 1938 Act shall be classes 22 to 26 of Schedule 4 to these Rules; but that section shall not apply to goods in classes 22, 25 and 26 which are neither composed to a substantial extent of artificial or natural textile fibres nor complete articles of clothing.

*Collection of refused cotton marks*

**102.—** (1) No addition shall be made to the collection of refused marks mentioned in section 39(8) of the 1938 Act.

(2) A trade mark which immediately before 27th July 1938 was included in the collection shall be continued in it for a period of fourteen years from the date of the commencement of the period in respect of which the last prescribed continuance fee was paid.

(3) A trade mark which has been so continued shall not be continued further unless the applicant or any other person owning the mark shall, before the end of the said period, pay the prescribed fee in respect of a further period of fourteen years; and so on for each succeeding period of fourteen years.

(4) The prescribed fee shall be filed with form TM 55.

*Discontinuance of refused cotton mark*

**103.** Before removing a mark from the collection of refused marks for non-payment of the prescribed continuance fee the Registrar shall, at a date not more than six months nor less than three months before the date on which the mark would be so removed, give notice in writing that the mark will not be continued in the collection unless the prescribed fee is paid within the time prescribed in Rule 102(3) above.

*Notice of discontinuance*

**104.—** (1) The notice provided for in Rule 103 above shall be sent to the applicant at the address given on the form of application or at his last known

trade or business address or to such other person as may own the trade mark in question.

(2) If the notice is returned as not having reached the applicant or other owner the Registrar shall endeavour, without the undue devotion of time or incurring of expense, to discover the address of the applicant or other owner with a view to bringing the notice to the attention of either or both of them.

#### *Certificate by the Keeper*

**105.** A certificate under the hand of the Keeper of any copy entered in the Manchester Record of an entry in the register may be requested by filing form TM 56 at the Manchester Branch, and the Keeper may thereupon give the certificate required.

#### *Copy of mark in certificate*

**106.** Except in a case falling within Rule 124 below the Keeper shall not be obliged to include in a certificate given under Rule 105 above a copy of any trade mark unless a suitable copy is filed for that purpose at the Manchester Branch.

### *Registered users*

#### *Application for entry of registered user*

**107.** An Application under section 28 of the 1938 Act or of the modified 1938 Act for the registration of a person as a registered user of a registered trade mark or a registered service mark shall be made by that person and the registered proprietor by filing form TM 50; and where the said person is a firm the full names of all the partners shall be given in the application.

#### *Entry of registered user*

**108.—** (1) The entry of a registered user in the register shall state the date on which the application for such entry was made, and that date shall be deemed to be the date on which the person mentioned in the entry as a registered user was so registered.

(2) The entry shall state the name and the trade or business address of the registered user (including the names of all the partners where the registered user is a firm) and any address for service filed under Rule 13 above.

(3) The Registrar shall send to the registered proprietor of the trade mark or service mark in question and to the registered user notification in writing of the registration of the registered user and shall insert such notification in the Journal.

#### *Application to vary entry*

**109.** Application by the registered proprietor of a trade mark or a service mark for the variation of the registration of a registered user of the mark under section 28(8)(a) of the 1938 Act or of the modified 1938 Act, as the case may be,

shall be made by filing form TM 51 together with a statement of the grounds on which the application is made, and where the registered user in question consents, with his written consent.

*Application by proprietor or user to cancel entry*

**110.** Application by the registered proprietor or any registered user of a trade mark or a service mark for the cancellation of the registration of a registered user of the mark under section 28(8)(b) of the 1938 Act or of the modified 1938 Act, as the case may be, shall be made by filing form TM 52 together with a statement of the grounds on which the application is made.

*Application by any person to cancel entry*

**111.** Application for the cancellation of the registration of a registered user under section 28(8)(c) of the 1938 Act or of the modified 1938 Act shall be made by filing form TM 52 together with a statement of the grounds on which the application is made.

*Notification and hearing*

**112.—** (1) When an application is made in accordance with Rule 109, 110 or 111 above, the Registrar shall send written notice thereof to the registered proprietor and to each registered user (not being the applicant), and shall advertise the application in the Journal.

(2) If the registered proprietor, a registered user or any other interested person intends to intervene in the proceedings he shall give notice within one month from the date of publication of the advertisement by filing form TM 54 together with a statement of the grounds of his intervention.

(3) The Registrar shall send a copy of the notice and the statement referred to in paragraph (2) above to the applicant, the registered proprietor, each registered user whose registration is the subject of the application and any other person who intervenes.

(4) Any of the persons mentioned in paragraph (3) above may, within such time or times as the Registrar may appoint, file evidence in support of his case.

(5) After giving such persons the opportunity of being heard the Registrar may accept or refuse the application or accept it subject to any conditions, amendments, modifications or limitations which he may think right to impose.

*Cancellation and striking out*

**113.—** (1) Where, in accordance with section 28(4)(d) of the 1938 Act or of the modified 1938 Act, the registration of a registered user is for a period, the Registrar shall cancel the relevant entry at the end of the period.

(2) Where some or all of the goods or services, as the case may be, are struck out from those in respect of which a trade mark or a service mark is registered, the Registrar shall at the same time strike them out from those specifications of registered users of the mark in which they are comprised.

(3) The Registrar shall send written notice of every cancellation or striking out under this Rule to the registered users whose permitted use is affected thereby and to the registered proprietor of the trade mark or service mark in question.

### *Supplementary*

#### *Extension of time*

**114.**— (1) If in any particular case the Registrar is satisfied that the circumstances are such as to justify an extension of the time for doing any act or taking any proceeding under these Rules, not being a time expressly provided in the 1938 Act or the modified 1938 Act or prescribed by Rule 76 or 80 above or paragraph (4) below, he may extend the time upon such notice to other parties and upon such terms as, subject to paragraph (5) below, he may direct.

(2) An extension may be granted although the time has expired for doing the act or taking the proceeding in question.

(3) Where the time in respect of which an extension is sought is prescribed in Rule 7, 46, 48, 49, 50, 51, 58, 87, 90, 94 or 112, the party seeking the extension shall send to every other person who at the time is a party to the proceedings a copy of the request for extension filed with the Registrar.

(4) Any such person may, within one month from the date of receipt of the copy referred to in paragraph (3) above, file observations on the request for extension.

(5) In considering whether to grant an extension of time in a case falling within paragraph (3) above the Registrar shall take account of any observations filed under paragraph (4) above or submitted at a hearing under Rule 116 below; and he shall send a copy of his decision to the party seeking the extension and to every other person referred to in paragraph (3).

#### *Calculation of times or periods*

**115.**— (1) Subject to the provisions of paragraphs (2) and (3) below, where any period of time specified in these Rules for the sending or filing of any notice, application or other document expires on a day certified by the Registrar as being one on which there is a general interruption or subsequent dislocation in the postal services of the United Kingdom, the period shall be extended to the first day (not being an excluded day) following the end of the period of interruption or dislocation.

(2) Where, in the case of an application for registration of a trade mark or a service mark made under section 39A of the 1938 Act or of the modified 1938 Act, as the case may be, the period of six months specified in subsection (1) of that section ends on a day which is an excluded day within the meaning of Rule 128(1) below, the application shall be treated as having been made within that period if made on the first following day which is not an excluded day.

(3) Where, in the case of an application under the said section 39A, the said period of six months ends on a day certified in accordance with paragraph (1) above, the application shall be treated as having been made within that period if made on the first day (not being an excluded day) following the end of the period of interruption or dislocation.

*Adverse exercise of discretion*

**116.** Before exercising adversely to any person any discretionary power given to the Registrar by the 1938 Act or the modified 1938 Act, as the case may be, or by these Rules, the Registrar shall hear that person thereon if so required by him.

*Request for hearing*

**117.** Except where Rule 33 or 34 above or (so far as, by virtue of paragraph 9 of Schedule 2 to the 1938 Act, this Rule applies with the substitution of the Cutlers' Company for the Registrar) Rule 97 above applies, a request for a hearing under Rule 116 above shall be filed within one month from the date on which the person filing the request receives notice sent by the Registrar of any objection to an application or of any other proposal to exercise a discretionary power.

*Notice of hearing*

**118.—** (1) Upon receipt of a request filed under Rule 117 above the Registrar shall send to the person making the request notice of a time when he may be heard, which shall be not less than ten days after the date of receipt of the notice by that person.

(2) If the person making the request intends to be heard on the matter he shall, within five days from the date of his receipt of the notice, file notice of his intention; and if he does not do so he may be treated as not intending to be heard.

*Hearing and decision*

**119.—** (1) The hearing before the Registrar of any dispute between two or more parties relating to any matter in connection with a registered trade mark or a registered service mark or an application to register a trade mark or a service mark shall be in public unless the Registrar, after consultation with those parties to the dispute who appear in person or are represented at the hearing, otherwise directs; but such direction shall not prevent a member of the Council on Tribunals or of its Scottish Committee from attending a hearing in his capacity as such.

(2) If the Registrar exercises adversely to any person a discretionary power referred to in Rule 116 above he shall send to that person notice of his decision therein and, if so required by any party, shall give reasons for his decision.

*Dispensing with evidence*

**120.** Where under these Rules any person is required to do any act or thing or any document or evidence is required to be filed and it is shown to the satisfaction of the Registrar that from any reasonable cause that person is unable to do that act or thing or that document or evidence cannot be filed, the Registrar may, upon the filing of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing or the filing of such document or evidence.



*Amendments and irregularities*

**121.** Any document filed in any proceedings before the Registrar and any drawing or other representation of a trade mark or a service mark may, if the Registrar thinks fit, be amended, and any irregularity in procedure in or before the Office may be rectified, on such terms as the Registrar may direct.

*Certificates by Registrar*

**122.—** (1) Subject to paragraph (2) below, any person may, by filing form TM 31, request the Registrar to give a certificate as to any entry, matter or thing which he is authorised or required by the 1938 Act, the modified 1938 Act or these Rules to make or do, other than a certificate of registration issued under section 19(2) of the 1938 Act or of the modified 1938 Act.

(2) Before giving a certificate under paragraph (1) above, the Registrar may, if he thinks fit, require the person making the request to show to his satisfaction an interest in the entry, matter or thing in question.

(3) Except in a case falling under Rule 124 below the Registrar shall not be obliged to include in the certificate a copy of any mark unless the person making the request has filed such a copy suitable for the purpose.

*Marks registered without limitation of colour*

**123.** Where a mark is registered without limitation of colour the Registrar, or the Keeper if required under Rule 105 above, may, for the purpose of obtaining registration abroad, give a certificate of its registration either in the colour in which it appears in the register or in any other colour or colours; but in the latter case the certificate shall be marked: "For use in obtaining registration abroad only".

*Certificates for registration abroad*

**124.—** (1) Where a certificate of registration of a trade mark or of a service mark is requested for use in obtaining registration abroad, the Registrar, or the Keeper if requested under Rule 105 above, shall, subject to paragraph (2) below, include in the certificate a copy of the mark.

(2) The Registrar or the Keeper, as the case may be, may require the person requesting the certificate to file with him a copy of the mark suitable for the purpose, and may refuse to give the certificate until such a copy is filed.

(3) The Registrar or the Keeper, as the case may be, may state in the certificate such particulars concerning the registration of the mark as he thinks fit, and may omit reference to any disclaimers appearing in the register; but in the case of such omission the certificate shall be marked: "For use in obtaining registration abroad only".

*Statutory declarations*

**125.—** (1) Any statutory declaration filed under the 1938 Act, the modified 1938 Act or these Rules shall be made and subscribed as follows:—

- (a) in the United Kingdom, before any justice of the peace or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceedings;

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

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

#### *Inspection of documents*

**126.**— (1) Subject to paragraph (2) below, the Registrar shall permit any of the following documents to be inspected at the Office:—

- (a) any document consisting of a prescribed form (other than form TM 31), including any continuation thereof on a separate sheet of paper, duly completed and filed at the Office;
- (b) any statement or counter-statement filed under Rule 7(2) or (3), 37(1), 40(1), 47(1), 48(1), 61(2), 74(1), 79(1), 82(1), 109, 110, 111 or 112(2) above;
- (c) specimens and copies retained under Rule 28 above; and
- (d) draft regulations filed under Rule 40(1) above.

(2) The Registrar shall not be obliged to permit a document to be inspected under paragraph (1) above until he has completed any procedure which he is required or permitted to carry out with respect to it by virtue of the 1938 Act, the modified 1938 Act or these Rules.

(3) The Registrar shall not permit any other filed document to be inspected under this Rule.

#### *Confidentiality*

**127.**— (1) If there is filed at the Office a document which, by virtue of Rule 126(3) above, may not be inspected and it is provided in these Rules that it, or a copy of it, shall be sent to, or made available for inspection by, any person, the person filing it or any other party to the Proceedings may apply to the Registrar for directions under paragraph (3) below.

(2) An application under paragraph (1) above shall be made at the time of the filing of the document, and a statement of the grounds relied upon in support of the application shall be filed at the same time or within fourteen days from the date thereof.

(3) Upon such application the Registrar may direct that the document or copy need not be sent or made available as otherwise required, or may be sent to or made available for inspection by only some of those otherwise entitled to

receive or inspect it or some other person in substitution for a person so entitled.

(4) These Rules shall have effect—

- (a) subject to the provision that the document or copy need not be sent or made available as otherwise required while an application under paragraph (1) above is being considered by the Registrar, and
- (b) subject to directions under paragraph (3) above which have been given and not withdrawn;

but the Registrar shall not thereby be enabled to exercise a power adversely to any person if such exercise would be contrary to the principles of natural justice.

(5) In considering whether to give any directions under paragraph (3) above, the Registrar shall take account of the provisions of section 28(7) of the 1938 Act or of the modified 1938 Act, as the case may be.

(6) An application made under paragraph (1) above may be accompanied by a request made by the person filing the document for the Registrar to return it if directions are not given under paragraph (3) above; and if in such a case directions are not given the Registrar shall return the document and it shall be treated as if it had never been filed.

(7) The Registrar shall not withdraw any direction given under paragraph (3) above without prior consultation with the person upon whose application the direction was given, unless the Registrar is satisfied that such prior consultation is not reasonably practicable.

(8) Where such a direction is given or withdrawn a record of the fact shall be filed with the document to which it relates.

*Excluded days and hours of business*

**128.**— (1) The following shall be excluded days for all purposes under the 1938 Act, the modified 1938 Act and these Rules:

- (a) all Sundays;
- (b) Good Friday and Christmas Day;
- (c) any day specified as or proclaimed to be a bank holiday in England in or under section 1 of the Banking and Financial Dealings Act 1971(a);
- (d) any Saturday immediately preceded by one of the above.

(2) Saturdays not falling within paragraph (1) above shall be excluded days for all purposes except the filing of applications for the registration of a trade mark or a service mark not falling within Rule 21(4) above.

(3) The Office, the Manchester Branch and the office of the Cutlers' Company shall be deemed to be closed—

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(a) 1971 c.80.

- (a) for the filing of notices, applications and other documents, between midnight and 10.00am on every day and between 1.00pm and midnight on Saturdays;
- (b) for all other purposes, between midnight and 10.00am and between 4.00pm and midnight on every day.

(4) The register, the Manchester Record, the Sheffield register and any document to which Rule 126 above applies shall be open to inspection on payment of the prescribed fee between 10.00am and 4.00pm on any day which is not an excluded day or, in the case of any of the Office, the Manchester Branch or the office of the Cutlers' Company, a day in respect of which notice of closure is given by being posted in a conspicuous place in the Office, the Manchester Branch or the office of the Cutlers' Company, as the case may be.

### *Appeals*

#### *Appeal to Secretary of State*

**129.**— (1) Before any person appeals to the Secretary of State under the 1938 Act or the modified 1938 Act, he shall either apply to the Registrar for a hearing or state that he does not wish to be heard and file his case in writing.

(2) The Registrar shall send to the prospective appellant a decision in writing on the point raised at the hearing or in the case provided for in paragraph (1) above, and in the case of a decision under Rule 35 above he shall also send the statement of grounds and materials provided for in Rule 35(2).

(3) Within one month from the date of his receipt of the decision sent under paragraph (2) above the prospective appellant shall give notice of his intention to appeal by filing form TM 30.

#### *Notice of appeal*

**130.** The notice provided for in Rule 129(3) above shall be accompanied—

- (a) in the case of an appeal against a decision under Rule 35 above, by two copies of the application which gave rise to the decision, each containing a representation of the mark applied for, and by two copies of the statement provided for in Rule 35(2), and
- (b) in any other case, by two copies of the Registrar's decision.

#### *Grounds for appeal*

**131.** The notice provided for in Rule 129(3) above shall also be accompanied by a statement in writing of the appellant's grounds for appealing and of his case in support of the appeal.

#### *Directions by Secretary of State*

**132.** Upon receipt of the notice provided for in Rule 129(3) above the Secretary of State shall give such directions with respect to parties, evidence or any other matter as he considers requisite for the purpose of hearing the appeal or referring it for hearing and determination by the Court.

*Hearing of appeal*

**133.** Where the Secretary of State intends to hear the appeal, he shall give to the Registrar and to the appellant notice of the time and place appointed for the hearing; and, unless the Secretary of State has directed a shorter period under Rule 132 above, the date for the hearing shall be not less than seven days after the date on which the Registrar and the appellant receive the notice.

*Time limit for appeal*

**134.** If notice is not given in accordance with Rule 129(3) above the Secretary of State shall not hear an appeal unless he gives special leave.

*Withdrawal of appeal*

**135.** An appellant entitled to withdraw his application under section 17(6) of the 1938 Act or of the modified 1938 Act may do so by sending to the Registrar and to any other party, within seven days from the date of his receipt of the leave referred to in the said section 17(6), notice of his intention to withdraw.

*Application to Court*

**136.** A copy of every application to the Court under the 1938 Act or the modified 1938 Act shall be filed by the applicant.

*Order of Court*

**137.—** (1) Where an order is made by the Court in any case under the 1938 Act or the modified 1938 Act the person in whose favour the order is made or, if there is more than one, such one of them as the Registrar may direct shall file an office copy of the order and, if rectification or alteration of the register is required, form TM 48.

(2) The register shall, where appropriate, be rectified or altered by the Registrar accordingly.

*Publication of order*

**138.** If the Registrar thinks that an order made by the Court under the 1938 Act or the modified 1938 Act should be given publicity he may publish it in the Journal.

*Geoffrey Pattie,*  
Minister of State,  
Department of Trade  
and Industry.

28th July 1986.

## Rule 2

## SCHEDULE 1

## REVOCATIONS

Number	Title
S.R.&O. 1938/661	The Trade Marks Rules 1938
S.I. 1964/227	The Trade Marks (Amendment) Rules 1964
S.I. 1975/229	The Trade Marks (Amendment) Rules 1975
S.I. 1980/1931	The Trade Marks (Amendment No. 2) Rules 1980
S.I. 1982/718	The Trade Marks (Amendment) Rules 1982
S.I. 1985/921	The Trade Marks (Amendment) Rules 1985

SCHEDULE 2

Rule 4(2)

CERTIFICATE OF REGISTRATION

The mark shown above [*or* A mark a specimen or copy of which is available for inspection at

and particulars of which are set out in this certificate] has been registered in Part \_\_\_\_\_ of the Register under No. \_\_\_\_\_ as of the date \_\_\_\_\_ in Class \_\_\_\_\_ in respect of

in the name of \_\_\_\_\_ .

Sealed at my direction this \_\_\_\_\_ day  
of \_\_\_\_\_ ,

Registrar.

Rule 5(1)

## SCHEDULE 3

## CLASSIFICATION OF GOODS (PRE-1938)

*Class 1.*

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

*Class 2.*

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

*Class 3.*

Chemical substances prepared for use in medicine and pharmacy.

*Class 4.*

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

*Class 5.*

Unwrought and partly wrought metals used in manufacture.

*Class 6.*

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

*Class 7.*

Agricultural and horticultural machinery, and parts of such machinery.

*Class 8.*

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

*Class 9.*

Musical instruments.

*Class 10.*

Horological instruments.

*Class 11.*

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

*Class 12.*

Cutlery and edge tools.

*Class 13.*

Metal goods, not included in other Classes.



*Class 14.*

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

*Class 15.*

Glass.

*Class 16.*

Porcelain and earthenware.

*Class 17.*

Manufactures from mineral and other substances for building or decoration.

*Class 18.*

Engineering, architectural, and building contrivances.

*Class 19.*

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

*Class 20.*

Explosive substances.

*Class 21.*

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

*Class 22.*

Carriages.

*Class 23.*

(a) Cotton yarn.  
(b) Sewing cotton.

*Class 24.*

Cotton piece goods.

*Class 25.*

Cotton goods not included in other Classes.

*Class 26.*

Linen and hemp yarn and thread.

*Class 27.*

Linen and hemp piece goods.

*Class 28.*

Linen and hemp goods not included in other Classes.

*Class 29.*

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

*Class 30.*

Silk, spun, thrown, or sewing.

*Class 31.*

Silk piece goods.

*Class 32.*

Silk goods not included in other Classes.

*Class 33.*

Yarns of wool, worsted, or hair.

*Class 34.*

Cloths and stuffs of wool, worsted, or hair.

*Class 35.*

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

*Class 36.*

Carpets, floor-cloth, and oil-cloth.

*Class 37.*

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

*Class 38.*

Articles of clothing.

*Class 39.*

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

*Class 40.*

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

*Class 41.*

Furniture and upholstery.

*Class 42.*

Substances used as food or as ingredients in food.

*Class 43.*

Fermented liquors and spirits.

*Class 44.*

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

*Class 45.*

Tobacco, whether manufactured or unmanufactured.

*Class 46.*

Seeds for agricultural and horticultural purposes.

*Class 47.*

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

*Class 48.*

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

*Class 49.*

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

*Class 50.*

Miscellaneous:—

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

Rule 5(2) and (3)

## SCHEDULE 4

## CLASSIFICATION OF GOODS AND SERVICES

## Part I

## Goods

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

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

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

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

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

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

*Class 7.* Machines and machine tools; motors (except for land vehicles); machine coupling and belting (except for land vehicles); agricultural implements; incubators for eggs.

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

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

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

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

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

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

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

*Class 15.* Musical instruments.

*Class 16.* Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

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

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

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

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

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

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

*Class 23.* Yarns and threads, for textile use.

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

*Class 25.* Clothing, footwear, headgear.

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

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

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

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

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

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

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

*Class 33.* Alcoholic beverages (except beers).

*Class 34.* Tobacco; smokers' articles; matches.

## Part II

### Services

*Class 35.* Advertising and business.

*Class 36.* Insurance and financial.

*Class 37.* Construction and repair.

*Class 38.* Communication.

*Class 39.* Transportation and storage.

*Class 40.* Material treatment.

*Class 41.* Education and entertainment.

*Class 42.* Other services.

## EXPLANATORY NOTE

*(This Note is not part of the Rules.)*

These Rules revoke and replace with modifications the Trade Marks Rules 1938, as amended. The principal change is the application of the Rules to service marks. The other changes of substance are as follows:

- (a) provision is made for advertisement of and opposition to an amended proposal for amendment of a specification (rule 7);
- (b) documents signed on behalf of a firm need not name all the partners unless the Registrar requires (rule 10(1) and (2)), except in the case of applications for registration (rule 21(1)), assignments (rule 73(2)) and registered user applications (rule 107);
- (c) any person dealing with the Registrar may file an address for service; and letters seeking confirmation of an address for service must be sent to that address as well as to the trade or business address of the person concerned (rule 13);
- (d) the provisions relating to agents are simplified (rule 14);
- (e) the provisions relating to marks the registration of which is subject to special requirements are amended (rules 15 to 19);
- (f) the times within which certain procedural steps must be taken are increased (rules 20, 33, 34, 49, 50, 51, 80 and 97);
- (g) applicants to the Manchester Branch or the Cutlers' Company may file subsequent communications at the Trade Marks Registry (rule 22(4));
- (h) certain requirements for duplicate documents are reduced (rules 25 and 89), and rule 106 of the 1938 Rules is not replaced;
- (i) failure by an applicant to file notice of absence of objection to conditions, etc, imposed by the Registrar will lead to deemed withdrawal of the application (rule 34(3)), and an applicant for a certification trade mark is no longer exempt from deemed withdrawal (rule 38);
- (j) provision is no longer made for printing blocks, and representations of marks to be inserted in advertisements must be able to be photocopied, etc, (rules 42, 43, 92 and 98);
- (k) provision is made for non-completion of applications in circumstances other than those of section 19(3) of the Trade Marks Act 1938 (rule 59);
- (l) where a mark consists of a word or words in plain type or a specimen or copy has been retained by the Registrar, the registration fee need not be accompanied by a representation of the mark (rule 60(2));
- (m) where an applicant for registration assigns or transmits the mark and assigns or transmits to the same person a registered mark in respect of the same goods or services, goods or services of the same description or associated goods or services, that person is to be treated as the applicant (rule 62(2));
- (n) provision for renewal is simplified (rules 64 to 66);
- (o) original instruments of assignment or transmission need not be produced to the Registrar unless required (rule 73);
- (p) rule 77, on entry of assignment or transmission in register, has been brought into line with rule 60, on entry in the register;

- (q) a certification of alteration is no longer required where an address is altered by the act of a public authority (rule 81);
- (r) provision is made for removal of incorrect, obsolete descriptions from the register (rule 85(3));
- (s) notification that a mark has been altered or added to is not to be advertised if the application was advertised and not opposed (rule 91);
- (t) the Registrar is no longer required to consider within one month applications filed with the Cutlers' Company, rule 97 of the 1938 Rules not being replaced;
- (u) notice of an application to vary or cancel the entry of a registered user must be sent to all registered users (rule 112(1));
- (v) the Registrar must consider the observations of other parties before granting extension of certain time limits (rule 114);
- (w) provision is made for postal dislocations and for the expiry of priority periods on an excluded day (rule 115);
- (x) a member of the Council on Tribunals may attend private hearings before the Registrar, and in all cases the Registrar must give reasons for his decisions if required (rule 119);
- (y) provision is made for the inspection of documents (rule 126);
- (z) provision is made for the treatment of certain filed documents as confidential (rule 127);
- (aa) the prescription of days as excluded days is revised; and the Registry will remain open for the filing of documents on days not prescribed as excluded days when it is otherwise closed (rule 128).

The Rules have been comprehensively redrafted and the language simplified and rendered more uniform where possible, but with a few exceptions each rule bears the same number as its corresponding predecessor in the 1938 Rules. Specific adaptations for Scottish firms are contained in rules 10(1), 21(7) and 85(2). Forms (except the form of certificate of registration) and fees are prescribed in separate sets of rules.

The addresses of the Trade Marks Registry and of its Manchester Branch are prescribed in the Patent Office (Address) Rules 1985.

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