

1990 No. 1800

TRADE MARKS

The Trade Marks and Service Marks (Fees) Rules 1990

Made - - - - 3rd September 1990

Laid before Parliament 5th September 1990

Coming into force 1st October 1990

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 and the Official Journal (Patents) on 8th August 1990 and 15th August 1990, 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 40, 41 and 68(1) of the Trade Marks Act 1938 and now vested in him (b), of the power conferred on him by the Department of Trade and Industry (Fees) Order 1988(c), and of all other powers enabling him in that behalf, after consultation with the Council on Tribunals pursuant to section 10(1) of the Tribunals and Inquiries Act 1971(d) and with the sanction of the Treasury pursuant to the said section 41, hereby makes the following Rules:—

1.—(1) These Rules may be cited as the Trade Marks and Service Marks (Fees) Rules 1990 and shall come into force on 1st October 1990.

(2) The Trade Marks and Service Marks (Fees) Rules 1989(e) are hereby revoked.

2. These Rules shall be construed as one with the Trade Marks and Service Marks Rules 1986 (f).

3. The fees to be paid in respect of any matters arising under the Trade Marks Act 1938 shall be those specified in the Schedule to these Rules; and in any case where a form specified in the Schedule as the corresponding form in relation to any matter is required by the Trade Marks and Service Marks Rules 1986 to be used, that form shall be accompanied by the fee specified in respect of that matter.

(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) S.I. 1970/1537.

(c) S.I. 1988/93, as amended by S.I. 1990/1473, which was made under section 102 of the Finance (No. 2) Act 1987 (c.51). The relevant provisions of that Order are article 5 and Part II of Schedule 1.

(d) 1971 c.62.

(e) S.I. 1989/903.

(f) S.I. 1986/1319, to which there are amendments not relevant to these Rules.

3rd September 1990

Douglas Hogg
Department of Trade and Industry

We sanction the making of these Rules.

Michael Fallon
Kenneth Carlisle
Two of the Lords Commissioners
of Her Majesty's Treasury

20th August 1990

SCHEDULE
FEES PAYABLE

Rule 3

(In this Schedule, references to a section or a Schedule are references to that section of or Schedule to the Trade Marks Act 1938 as it has effect with respect to trade marks or with respect to service marks, as the context may require; and references to a rule are references to that rule of the Trade Marks and Service Marks Rules 1986.)

<i>Number of corresponding form</i>	<i>Item</i>	<i>Amount £</i>
TM3	On application, filed on or after 1st October 1990, to register a trade mark, a service mark or a series of trade marks or service marks for a specification of goods or services included in one class, (whether or not accepted for registration)–	160
TM5	On request to the Registrar to state grounds of decision relating to an application to register a trade mark or a service mark and materials used–	100
TM6	On application, filed on or after 1st October 1990, to register a certification trade mark for a specification of goods included in one class, or in respect of each class on application made at the same time to register one certification trade mark for specifications of goods not all included in one class, (whether or not accepted for registration)–	160
TM7	On notice of opposition before the Registrar under section 18 or paragraph 2(2) of Schedule 1, for each application opposed, by opponent–	31
TM8	On filing a counterstatement in answer to a notice of opposition under section 18 or paragraph 2(2) of Schedule 1, for each application opposed, by the applicant; or in answer to an application under section 26, 27, 32 or 33 by the proprietor in respect of each trade mark or service mark: or in answer to a notice of opposition under section 35 or 36, for each application or conversion opposed, by the proprietor–	20
TM10	In respect of an application to register filed before 1st October 1990, for registration of a trade mark (including a certification or defensive trade mark), a service mark or a series of trade marks or service marks for a specification of goods or services included in one class; or in respect of each class for registration upon applications made at the same time of one certification trade mark for specifications of goods not all included in one class–	95

SCHEDULE (*continued*)

<i>Number of corresponding form</i>	<i>Item</i>	<i>Amount £</i>
TM11	For renewal of registration of a trade mark, a service mark or a series of trade marks or service marks at expiration of last registration; or in respect of each class for renewal of registrations of the same certification trade mark with the same date for goods in more than one class—	230
TM11	Additional fee under Rule 67—	31
TM13	Restoration fee under Rule 68—	83
TM16	On application to register a subsequent proprietor in a case of assignment or transmission of a single trade mark or a single service mark—	20
TM16	On application to register a subsequent proprietor of more than one trade mark or service mark standing in the same name, the devolution of title being the same in each case:	
	for the first mark—	20
	and for every other mark—	5
TM19	On application to dissolve the association between registered trade marks, registered service marks or both registered trade marks and registered service marks—	17
TM23	For striking out goods or services from those for which a trade mark or a service mark is registered on the request of the registered proprietor—	7
TM24	On request by registered proprietor of a trade mark or a service mark for entry of disclaimer or memorandum in the register—	13
TM25	On application to the Registrar for leave to add to or alter a single registered trade mark—	35
TM25	On application to the Registrar for leave to add to or alter more than one registered trade mark or service mark of the same proprietor, being identical marks, the addition or alteration to be made in each case being the same:	
	for the first mark—	35
	and for every other mark—	20
TM26	On application under section 26, 27, 32 or 33 for rectification of the register or removal of a trade mark or a service mark from the register—	35
TM27	On application for leave to intervene in proceedings under section 26, 27, 32 or 33 for rectification of the register or removal of a trade mark or a service mark from the register—	28
TM30	On appeal from the Registrar, otherwise than to the Court, in respect of each decision appealed against, by appellant—	31
TM31	For certificate of the Registrar (other than certification under section 19(2)) of the registration of a trade mark, a service mark or a series of trade marks or service marks—	11
TM32	On application, filed on or after 1st October 1990, to register a defensive trade mark for a specification of goods included in one class, (whether or not accepted for registration)—	160

SCHEDULE (continued)

<i>Number of corresponding form</i>	<i>Item</i>	<i>Amount £</i>
TM35	On request by the registered proprietor of a certification trade mark to permit alteration of the deposited regulations thereof: for the regulations of one such registration— and for the same or substantially the same regulations of each other registration proposed to be altered in the same way and included in the same request—	35 6
TM36	On application under Rule 93 to expunge or vary the registration of a certification trade mark or to vary the deposited regulations of a certification trade mark or of certification trade marks of the same registered proprietor where the regulations are substantially the same—	35
TM37	On notice to the Secretary of State of opposition under paragraph 2(2) of Schedule 1, for each application opposed, by the opponent—	31
TM40	On application for certificate of the Registrar under section 22(5) or approval of the Registrar under section 22(6): for the first mark proposed to be assigned or transmitted— and for every other mark included in the same assignment or transmission—	35 6
TM43	On application for directions by the Registrar for advertisement of assignment of trade marks or service marks in use, without goodwill: for the first mark assigned— and for every other mark assigned with the same devolution of title—	20 6
TM45	On application by registered proprietor under Rule 6 for conversion of specification—	8
TM46	On notice of opposition to a conversion of the specification or specifications of a registered trade mark or registered trade marks: for the first mark— and for every other mark of the same proprietor having the same specification—	31 6
TM47	On notice of opposition to application for leave to add to or alter registered trade marks or service marks, for each application opposed—	31
TM48	For every entry in the register of a rectification thereof or an alteration therein ordered by the Court—	20
TM49	On request to enter in the register and advertise a certificate of validity under section 47: for the first registration certified— and for every other registration certified in the same certificate—	14 6
TM50	On application to register a registered user of a single registered trade mark or a single registered service mark in respect of goods or services within the specification thereof—	50

SCHEDULE (*continued*)

<i>Number of corresponding form</i>	<i>Item</i>	<i>Amount £</i>
TM50	On application to register the same registered user of more than one registered trade mark or registered service mark of the same registered proprietor in respect of goods or services within the respective specifications thereof and subject to the same conditions and restrictions in each case:	
	for the first mark—	50
	and for every other mark of the proprietor included in the application and statement of case—	6
TM51	On application by the proprietor of a single trade mark or a single service mark under section 28(8)(a) to vary entry of a registered user thereof—	50
TM51	On application by the proprietor of more than one trade mark or service mark under section 28(8)(a) to vary the entries of a registered user thereof:	
	for the first mark—	50
	and for every other mark of the proprietor for which the same user is registered included in the application—	6
TM54	On notice under section 28(9) of the intention to intervene in one proceeding for the variation or cancellation of entries of a registered user of trade marks or service marks—	31
TM55	For the continuance of a cotton mark in each class of the collection of refused marks at the end of each period of fourteen years after the date of the application—	83
TM56	For certificate of the Keeper of an entry in the Manchester Record relating to one trade mark or a series of trade marks—	11
—	On request for the Registrar's preliminary advice under Rule 20, for each trade mark or service mark submitted in respect of one class at the same time:	
	for the first mark—	32
	and for each additional mark—	11
—	For certifying office copies, manuscripts or photographic or printed matter, each—	11
—	For inspecting register or Manchester Record, or notice of opposition, counterstatement or decision in connection with any rectification of the register relating to any particular trade mark or service mark, for every quarter of an hour	1.10

The fee to be paid on any proceeding at the Manchester Branch and at the office of the Cutlers' Company shall be the same as for the similar proceeding at the Office.

For the purpose of these fees (except as specifically provided above) every mark of a series under section 21, or any preceding similar enactment, shall be deemed to be a mark separately registered.

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules revoke and replace the Trade Marks and Service Marks (Fees) Rules 1989 (the 1989 Rules) and prescribe, in respect of all applications to register a trade mark or service mark filed on or after the date of the coming into force of these Rules (1st October 1990), a composite fee of £160 for an application to register a mark and for the registration of the mark (whether or not accepted for registration). Under the 1989 Rules an application to register a mark was subject to an initial fee of £68, with a further fee of £95 on its acceptance for registration; the latter fee will continue to apply to applications to register made before 1st October 1990. All other fees remain unchanged.

Although the composite fee for registration prescribed under these Rules will result in a marginal reduction in the total fee (£163) payable under the 1989 Rules for an application to register a mark which proceeds to registration, it is estimated that its effect will be to generate additional revenue sufficient to cover the unit cost of the combined service; in the event that there is no change in demand trade mark revenue per annum would increase by 25.8%

£1.40 net

ISBN 0 11 004800 8

Printed in the United Kingdom for HMSO

833/WO 1642 C17 9/90 452/1 9385/0450/8215 88352