
STATUTORY INSTRUMENTS

1998 No. 925

TRADE MARKS

The Trade Marks (Amendment) Rules 1998

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| <i>Made</i> | - - - - | <i>30th March 1998</i> |
| <i>Laid before Parliament</i> | | <i>31st March 1998</i> |
| <i>Coming into force</i> | - - | <i>27th April 1998</i> |

The Secretary of State, in exercise of the powers conferred upon her by sections 34(1), 38(2), 39(3), 41(1), 43(2) and (3), 63(2), 67(1) and 78 of, and paragraph 11(2) of Schedule 3 to, the Trade Marks Act 1994⁽¹⁾, after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992⁽²⁾, hereby makes the following Rules:—

Citation and commencement

1. These Rules may be cited as the Trade Marks (Amendment) Rules 1998 and shall come into force on 27th April 1998.

Interpretation

2. In these Rules, unless the context otherwise requires—

“the Act” means the Trade Marks Act 1994;

“the Principal Rules” means the Trade Marks Rules 1994⁽³⁾;

3. The Principal Rules are amended as set out in rules 4-19 below subject to the transitional provision set out in rule 20.

4. For rule 5 (applications for registration), there shall be substituted the following:

“5.—(1) An application for the registration of a trade mark shall be filed on Form TM3 and shall be subject to the payment of the application fee and such class fees as may be appropriate.

(2) An application for registration of a three-dimensional mark shall not be treated as such unless the application contains a statement to that effect.

(3) Where colour is claimed as an element of the trade mark, it shall not be treated as such unless the application contains a statement to that effect and specifies the colour.

(1) 1994 c. 26.
(2) 1992 c. 53.
(3) S.I. 1994/2583.

(4) An application to register a trade mark which is a word shall be treated as an application to register that word in the graphical form shown in the application, unless the applicant includes a statement that the application is for registration of the word without regard to its graphical form.”

5. In rule 11 (deficiencies in application) for the words “rule 5 or 8(2)” where they appear substitute “rule 5(1) or 8(2)”.

6. For rule 13 (opposition proceedings), there shall be substituted the following:

“13.—(1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicant.

(2) Within three months of the date on which a copy of the notice and statement is sent by the registrar to the applicant, the applicant may file a counter-statement, in conjunction with a notice of the same, on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(3) Where a notice and counter-statement are not filed by the applicant within the period prescribed by paragraph (2), he shall be deemed to have withdrawn his application for registration.

(4) Within three months of the date upon which a copy of the counter-statement is sent by the registrar to the person opposing the registration, that person may file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of his opposition and shall send a copy thereof to the applicant.

(5) If the person opposing the registration files no evidence under paragraph (4) above in support of his opposition, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his opposition.

(6) If the person opposing the registration files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the applicant who has filed a notice and counter-statement under paragraph (2) above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of his application for registration and shall send a copy thereof to the person opposing the application.

(7) Within three months of the date upon which a copy of the applicant’s evidence is sent to him under paragraph (6) above, the person opposing the application may file evidence in reply by statutory declaration or affidavit which shall be confined to matters strictly in reply to the applicant’s evidence, and shall send a copy thereof to the applicant.

(8) No further evidence may be filed, except that, in relation to any proceedings before him, the registrar may at any time if he thinks fit give leave to either party to file such evidence upon such terms as he may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to him in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.”.

7. In rule 18(2) (amendment of application), for the words “sent to the registrar”, substitute “filed”.

8. In rule 20(6) (merger of applications or registrations), for the words “bear different dates”, substitute “bear different dates of registration”.

9. In rule 23(5) (amendment of certification and collective marks regulations) and 25(3) (alterations), for the words “rule 13(2) – (8)” where they appear, there shall be substituted “paragraphs (2) and (4) – (9) of rule 13”.

10. For rule 27 (reminder of renewal), substitute—

“27.—(1) Subject to paragraph (2) below, at any time not earlier than six months nor later than one month before the expiration of the last registration of a trade mark, the registrar shall (except where renewal has already been effected under rule 28 below) send to the registered proprietor notice of the approaching expiration and inform him at the same time that the registration may be renewed in the manner described in rule 28 below.

(2) If it appears to the registrar that a trade mark may be registered under section 40 at any time within six months before or after the date on which renewal would be due (by reference to the date of application for registration), the registrar shall be taken to have complied with paragraph (1) if he sends to the applicant notice thereof within one month following the date of actual registration.”.

11. In rule 29 (delayed renewal), for paragraphs (3), (4) and (5) substitute—

“(3) Where a mark is due to be registered after the date on which it is due for renewal (by reference to the date of application for registration), the request for renewal shall be filed together with the renewal fee and additional renewal fee within six months after the date of actual registration.

(4) The removal of the registration of a trade mark shall be published.”.

12. In rule 33 (entry in register of particulars of registered trade marks):

(a) omit the “and” immediately preceding paragraph (j); and

(b) for paragraph (j) substitute:

“(j) where the mark is registered pursuant to section 5(5) with the consent of the proprietor of an earlier trade mark or other earlier right, that fact;

(k) where the mark is registered pursuant to a transformation application, the number of the international registration and either:

(i) the date accorded to the international registration under Article 3(4), or

(ii) the date of recordal of the request for extension to the United Kingdom of the international registration under Article 3ter,

as the case may be, of the Madrid Protocol;

(l) where the mark arises from the conversion of a Community trade mark or an application for a Community trade mark, the number of any other registered trade mark from which the Community trade mark or the application for a Community trade mark claimed seniority and the earliest seniority date.”.

13. In paragraph 2 of rule 39 (removal of matter from register), for the reference to “rule 47”, substitute “rule 48”.

14. In rule 44 (inspection of documents), for subparagraph (b) of paragraph (4) substitute:

“(b) any document or information filed at or sent to or by the Office before 31st October 1994, or

(c) any document or information filed at or sent to or by the Office after 31st October 1994 relating to an application for registration of a trade mark under the Trade Marks Act 1938.”.

15. In rule 56 (decision of registrar), for paragraph (1) substitute:

“(1) When, in any proceedings before him, the registrar has made a decision, he shall send to each party to the proceedings written notice of it, and for the purposes of any appeal against that decision, subject to paragraph (2) below, the date on which the notice is sent shall be taken to be the date of the decision.”.

16. For rule 60 (correction of irregularities), substitute—

“**60.** Subject to rule 62 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.”.

17. In rule 62 (alteration of time limits)—

(a) in paragraph (1), for the sentence beginning “may, at the request of the person or party concerned,” to the end of the paragraph, substitute “subject to paragraph (2) below, may, at the written request of the person or party concerned, be extended by the registrar as he thinks fit and upon such terms as he may direct.”;

(b) for paragraph (2) substitute—

“(2) Where a request for the extension of a time or periods prescribed by these Rules

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(a) is sought in respect of a time or periods prescribed by rules 13, 18, 23, or 25, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

(b) is filed after the application has been published under rule 12 above, the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.”;

(c) for paragraph (3) substitute:

“(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rule 13(2) (time for filing counter-statement), rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), and rule 41 (time for filing opposition).”;

(d) in paragraph (5), for the words “and it appears to him that any extension would not disadvantage any other person or party affected by it” substitute “and it appears to him to be just and equitable to do so”;

(e) after paragraph (6), insert—

“(7) Without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which—

(a) consists of a failure to comply with any limitation as to times or periods specified in the Act, these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and

(b) is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to him should be rectified,

he may direct that the time or period in question shall be altered in such manner as he may specify upon such terms as he may direct.”.

18. The provisions in rule 68 (form for conversions of pending applications) and in Schedule 2 are omitted.

19. In Schedule 4 (classification of goods and services), for the paragraph headed “*Class 7*” substitute—

“Class 7 Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements (other than hand operated); incubators for eggs;”.

20. Rule 4 shall apply only to applications made after the date on which these Rules come into force.

30th March 1998

Ian McCartney
Minister of State,
Department of Trade and Industry

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Trade Marks Rules 1994 (S.I. [1994/2583](#)), made under the Trade Marks Act 1994 (“the Act”), which revoked and replaced from 31st October 1994 the Trade Marks and Service Marks Rules 1986 (S.I. [1986/1319](#) as amended).

The Trade Marks Rules 1994 regulate practice and procedure in relation to all trade mark applications. The amendments made by these Rules modify the 1994 Rules in order to give better effect to the provisions of the 1994 Act. The changes of substance are as follows—

- (a) where in an application for registration of a trade mark, a colour, a particular graphical representation or a three-dimensional mark is claimed, the applicant is required to make a statement to that effect in the application (rule 4);
- (b) the provisions prescribing the procedure relating to opposition to the registration of a trade mark have been extended to clarify their operation and now expressly provide for an application for registration of a trade mark which has been opposed to be deemed to be withdrawn if the applicant fails to file a notice and counter-statement in reply to the notice of opposition within the prescribed time-limits (rule 6);
- (c) rule 29 has been amended to take account of the report of the Joint Committee on Statutory Instruments on the Trade Marks Rules 1994. The Joint Committee noted that where a registration takes effect after the date of renewal calculated from the date of filing of the application for registration, the provisions of rule 29(4) permitted late renewal without requiring payment of the additional renewal fee, contrary to section 43(3) of the Act. The amendment to rule 27 is intended to permit the Registrar to comply with the provisions of section 43(2) in relation to such late renewals (rules 10 and 11).

The addresses for the filing of documents at the Patent Office are prescribed in the Patent Office (Address) Rules 1991 (S.I. [1991/675](#)), namely—

- (i) Cardiff Road, Newport, Gwent NP9 1RH; and
- (ii) 25 Southampton Buildings, London WC2A 1AY.