
STATUTORY INSTRUMENTS

2008 No. 1797

The Trade Marks Rules 2008

Division, merger and series of marks

Division of application; section 41 (Form TM12)

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

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

(3) Where the request to divide an application is sent after publication of the application, any objections in respect of, or opposition to, the original application shall be taken to apply to each divisional application and shall be proceeded with accordingly.

(4) Upon division of an original application in respect of which notice has been given to the registrar of particulars relating to the grant of a licence, or a security interest or any right in or under it, the notice and the particulars shall be deemed to apply in relation to each of the applications into which the original application has been divided.

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

27.—(1) An applicant who has made separate applications for registration of a mark may, at any time before preparations for the publication of any of the applications have been completed by the Office, request the registrar on Form TM17 to merge the separate applications into a single application.

(2) The registrar shall, if satisfied that all the applications which are the subject of the request for merger—

- (a) are in respect of the same trade mark;
- (b) bear the same date of application; and
- (c) are, at the time of the request, in the name of the same person,

merge them into a single application.

(3) The proprietor of two or more registrations of a trade mark may request the registrar on Form TM17 to merge them into a single registration and the registrar shall, if satisfied that the registrations are in respect of the same trade mark, merge them into a single registration.

(4) Where any registration of a trade mark to be merged under paragraph (3) is subject to a disclaimer or limitation, the merged registration shall also be restricted accordingly.

(5) Where any registration of a trade mark to be merged under paragraph (3) has had registered in relation to it particulars relating to the grant of a licence or a security interest or any right in or under it, or of any memorandum or statement of the effect of a memorandum, the registrar shall enter in the register the same particulars in relation to the merged registration.

(6) The date of registration of the merged registration shall, where the separate registrations bear different dates of registration, be the latest of those dates.

Registration of a series of trade marks; section 41 (Form TM12)

28.—(1) The proprietor of a series of trade marks may apply to the registrar on Form TM3 for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series.

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

(3) At any time before registration, the applicant under paragraph (1) may request on Form TM12 the division of the application into separate applications in respect of one or more marks in that series and the registrar shall divide the application accordingly, provided that at least one application remaining after such a division would comprise of either—

(a) a single mark; or

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

(4) Where the request to divide an application is sent after publication of the application, any objections in respect of, or opposition to, the original application shall be taken to apply to each divisional application and shall be proceeded with accordingly.

(5) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series and, following such request, the registrar shall delete the mark accordingly.

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

(7) The division of an application into one or more applications under paragraph (3) shall be subject to the payment of a divisional fee and such application and class fees as are appropriate.