
STATUTORY INSTRUMENTS

2008 No. 1797

The Trade Marks Rules 2008

Application for registration

Application for registration; section 32 (Form TM3)

5.—(1) An application for the registration of a trade mark shall be filed on Form TM3 (except where the application is a transformation application in which case the application for registration shall be filed on Form TM4) and shall be subject to the payment of the application fee and such class fees as may be appropriate.

(2) Where an application is for the registration of a single trade mark, an applicant may request the registrar to undertake an expedited examination of the application.

(3) A request for expedited examination shall be made on Form TM3 which shall be filed electronically using the filing system provided on the Office website, or by such other means as the registrar may permit in any particular case, and shall be subject to payment of the prescribed fee.

(4) Where an applicant makes a request for expedited examination, the application fee and any class fees payable in respect of the application shall be payable at the time the application is made and accordingly rule 13 shall not apply insofar as it relates to the failure of an application to satisfy the requirements of section 32(4).

(5) In this rule and rule 15 a “request for expedited examination” means a request that, following an examination under section 37, the registrar notify the applicant within a period of ten business days (as specified in a direction given by the registrar under section 80) beginning on the business day after the date of filing of the application for registration whether or not it appears to the registrar that the requirements for registration are met.

Claim to priority; sections 35 & 36

6.—(1) Where a right to priority is claimed by reason of an application for protection of a trade mark duly filed in a Convention country under section 35 or in another country or territory in respect of which provision corresponding to that made by section 35 is made under section 36 (an “overseas application”), the application for registration under rule 5 shall specify—

- (a) the number accorded to the overseas application by the registering or other competent authority of the relevant country;
- (b) the country in which the overseas application was filed; and
- (c) the date of filing.

(2) The registrar may, in any particular case, by notice require the applicant to file, within such period of not less than one month as the notice may specify, such documentary evidence as the registrar may require certifying, or verifying to the satisfaction of the registrar, the date of the filing of the overseas application, the country or registering or competent authority, the representation of the mark and the goods or services covered by the overseas application.

Classification of goods and services; section 34

7.—(1) The prescribed system of classification for the purposes of the registration of trade marks is the Nice Classification.

(2) When a trade mark is registered it shall be classified according to the version of the Nice Classification that had effect on the date of application for registration.

Application may relate to more than one class and shall specify the class (Form TM3A)

8.—(1) An application may be made in more than one class of the Nice Classification.

(2) Every application shall specify—

- (a) the class in the Nice Classification to which it relates; and
- (b) the goods or services which are appropriate to the class and they shall be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the classes in the Nice Classification.

(3) If the application relates to more than one class in the Nice Classification the specification contained in it shall set out the classes in consecutive numerical order and the specification of the goods or services shall be grouped accordingly.

(4) If the specification contained in the application lists items by reference to a class in the Nice Classification in which they do not fall, the applicant may request, by filing Form TM3A, that the application be amended to include the appropriate class for those items, and upon the payment of such class fee as may be appropriate the registrar shall amend the application accordingly.

Determination of classification

9.—(1) Where an application does not satisfy the requirements of rule 8(2) or (3), the registrar shall send notice to the applicant.

(2) A notice sent under paragraph (1) shall specify a period, of not less than one month, within which the applicant must satisfy those requirements.

(3) Where the applicant fails to satisfy the requirements of rule 8(2) before the expiry of the period specified under paragraph (2), the application for registration, insofar as it relates to any goods or services which failed that requirement, shall be treated as abandoned.

(4) Where the applicant fails to satisfy the requirements of rule 8(3) before the expiry of the period specified under paragraph (2), the application for registration shall be treated as abandoned.

Prohibition on registration of mark consisting of arms; section 4

10. Where having regard to matters coming to the notice of the registrar it appears to the registrar that a representation of any arms or insignia as is referred to in section 4(4) appears in a mark, the registrar shall refuse to accept an application for the registration of the mark unless satisfied that the consent of the person entitled to the arms has been obtained.

Address for service

11.—(1) For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by—

- (a) an applicant for the registration of a trade mark;
- (b) any person who opposes the registration of a trade mark in opposition proceedings;
- (c) any person who applies for revocation, a declaration of invalidity or rectification under the Act;

(d) the proprietor of the registered trade mark who opposes such an application.

(2) The proprietor of a registered trade mark, or any person who has registered an interest in a registered trade mark, may file an address for service on Form TM33 or, in the case of an assignment of a registered trade mark, on Form TM16.

(3) Where a person has provided an address for service under paragraph (1) or (2), that person may substitute a new address for service by notifying the registrar on Form TM33.

(4) An address for service filed under paragraph (1)(a) or (2) shall be an address in the United Kingdom, another EEA State or the Channel Islands.

(5) An address for service filed under paragraph (1)(b) to (d) shall be an address in the United Kingdom, unless in a particular case the registrar otherwise directs.

Failure to provide an address for service

12.—(1) Where—

- (a) a person has failed to file an address for service under rule 11(1); and
- (b) the registrar has sufficient information enabling the registrar to contact that person,

the registrar shall direct that person to file an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of one month beginning with the date of the direction, file an address for service.

(3) Paragraph (4) applies where—

- (a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or
- (b) the registrar had insufficient information to give a direction under paragraph (1),

and the person has failed to provide an address for service.

(4) Where this paragraph applies—

- (a) in the case of an applicant for registration of a trade mark, the application shall be treated as withdrawn;
- (b) in the case of a person opposing the registration of a trade mark, that person's opposition shall be treated as withdrawn;
- (c) in the case of a person applying for revocation, a declaration of invalidity or rectification, that person's application shall be treated as withdrawn; and
- (d) in the case of the proprietor opposing such an application, the proprietor shall be deemed to have withdrawn from the proceedings.

(5) In this rule an "address for service" means an address which complies with the requirements of rule 11(4) or (5).

Deficiencies in application; section 32

13.—(1) Where an application for registration of a trade mark does not satisfy the requirements of section 32(2), (3) or (4) or rule 5(1), the registrar shall send notice to the applicant to remedy the deficiencies or, in the case of section 32(4), the default of payment.

(2) A notice sent under paragraph (1) shall specify a period, of not less than one month, within which the applicant must remedy the deficiencies or the default of payment.

(3) Where, before the expiry of the period specified under paragraph (2), the applicant—

- (a) fails to remedy any deficiency notified to the applicant in respect of section 32(2), the application shall be deemed never to have been made; or

- (b) fails to remedy any deficiency notified to the applicant in respect of section 32(3) or rule 5(1) or fails to make payment as required by section 32(4), the application shall be treated as abandoned.

Notifying results of search

14.—(1) Where, following any search under article 4 of the Trade Marks (Relative Grounds) Order 2007⁽¹⁾, it appears to the registrar that the requirements for registration mentioned in section 5 are not met, the registrar shall notify this fact to—

- (a) the applicant; and
 - (b) any relevant proprietor.
- (2) In paragraph (1), “relevant proprietor” means—
- (a) the proprietor of a registered trade mark or international trade mark (UK) which is an earlier trade mark in relation to which it appears to the registrar that the conditions set out in section 5(1) or (2) obtain but does not include a proprietor who does not wish to be notified and who has notified the registrar to this effect; and
 - (b) the proprietor of a Community trade mark or international trade mark (EC) which is an earlier trade mark in relation to which it appears to the registrar that the conditions set out in section 5(1) or (2) obtain and who has filed a request to be notified in relation to that mark in accordance with paragraph (4) below.

(3) References in paragraph (2) to the proprietor of a trade mark include a person who has applied for registration of a trade mark which, if registered, would be an earlier trade mark by virtue of section 6(1)(a) or (b).

(4) The proprietor of a Community trade mark or international trade mark (EC) may file a request to be notified in relation to that mark of the results of a notifiable search on Form TM6, which shall be filed electronically using the filing system provided on the Office website, or by such other means as the registrar may permit in any particular case, and shall be subject to payment of the prescribed fee.

(5) In paragraph (4) a “notifiable search” means any search under article 4 of the Trade Marks (Relative Grounds) Order 2007 conducted within the period of three years beginning with the date on which the request was filed.

(6) The filing of any request under paragraph (4) shall be subject to such terms or conditions as the registrar may specify generally by published notice or in any particular case by written notice to the person desiring to file the request otherwise than by electronic means.

(7) Rule 63 shall not apply to any decision made in pursuance of this rule.

(8) No decision made in pursuance of this rule shall be subject to appeal.

Compliance with request for expedited examination

15. Where the registrar receives a request for expedited examination under rule 5, the date on which the registrar shall be deemed to have notified the applicant whether or not it appears to the registrar that the requirements for registration are met shall be the date on which notice is sent to the applicant.