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STATUTORY INSTRUMENTS

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**2000 No. 136**

**The Trade Marks Rules 2000**

*Application for registration*

*Applications for registration; s. 32 (Form TM3)*

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.

(4) An application to register a trade mark which is or includes 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.

*Claim to priority; ss. 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, particulars of that claim shall be included in the application for registration under rule 5 above and, where no certificate as is referred to in paragraph (2) below is filed with the application, such particulars shall include the country or countries and the date or dates of filing.

(2) Unless it has been filed at the time of the filing of the application for registration, there shall be filed, within three months of the filing of the application under rule 5, a certificate by the registering or other competent authority of that country certifying, or verifying to the satisfaction of the registrar, the date of the filing of the application, the country or registering or competent authority, the representation of the mark, and the goods or services covered by the application.

*Classification of goods and services; s. 34*

7.—(1) For the purposes of trade mark registrations in respect of goods dated before 27th July 1938, goods are classified in accordance with Schedule 2 to these Rules, except where a specification has been converted, whether under the old law or under rule 46 below, to Schedule 3.

(2) For the purposes of trade mark registrations in respect of goods dated on or after 27th July 1938 and for the purposes of any registrations dated before that date in respect of which the specifications were converted under the old law, and for the purposes of trade mark registrations in

respect of services, goods and services are classified in accordance with Schedule 3, which sets out the current version of the classes of the International Classification of Goods and Services<sup>(1)</sup>.

*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 Schedule 3.

(2) Every application shall specify the class in Schedule 3 to which it relates and shall list the goods or services appropriate to that class.

(3) If the application relates to more than one class in Schedule 3 the specification contained in it shall set out the classes in consecutive numerical order.

(4) If the specification contained in the application lists items by reference to a class in Schedule 3 in which they do not fall, the applicant may request, by filing Form TM3A, that his 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 his application accordingly.

*Prohibition on registration of mark consisting of arms; s. 4*

**9.** Where 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 (Form TM33)*

**10.—**(1) For the purposes of any proceedings before the registrar under these Rules or any appeal from a decision of the registrar under the Act or these Rules, an address for service in the United Kingdom shall be filed by—

- (a) every applicant for the registration of a trade mark;
- (b) every person opposing an application for registration of a trade mark;
- (c) every applicant applying to the registrar under section 46 for the revocation of the registration of a trade mark, under section 47 for the invalidation of the registration of a trade mark, or under section 64 for the rectification of the register;
- (d) every person granted leave to intervene under rule 35 (the intervener); and
- (e) every proprietor of a registered trade mark which is the subject of an application to the registrar for the revocation, invalidation or rectification of the registration of the mark.

(2) The address for service of an applicant for registration of a trade mark shall upon registration of the mark be deemed to be the address for service of the registered proprietor, subject to any filing to the contrary under paragraph (1) above or rule 44(2) below.

(3) In any case in which an address for service is filed at the same time as the filing of a form required by the registrar under rule 3 which requires 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 TM33.

(4) Anything sent to any applicant, opponent, intervener or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.

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(1) The International Classification is drawn up under the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of marks of 15th June 1957 (as last revised on 13th May 1977) (Cmnd 6898). The current version of the International Classification is the Seventh Edition, which entered into force on 1st January 1997.

(5) An address for service in the United Kingdom may be filed at any time by the proprietor of a registered trade mark and by any person having an interest in or charge on a registered trade mark which has been registered under rule 40.

(6) Where an address for service is not filed as required by paragraph (1) above, the registrar shall send the person concerned notice to file an address for service within two months of the date of the notice and if that person fails to do so—

- (a) in the case of an applicant as is referred to in sub-paragraph (a) or (c), the application shall be treated as abandoned;
- (b) in the case of a person as is referred to in sub-paragraph (b) or (d), he shall be deemed to have withdrawn from the proceedings; and
- (c) in the case of the proprietor referred to in sub-paragraph (e), he shall not be permitted to take part in any proceedings.

*Deficiencies in application; s. 32*

**11.** 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) or 8(2), the registrar shall send notice thereof to the applicant to remedy the deficiencies or, in the case of section 32(4), the default of payment and if within two months of the date of the notice the applicant—

- (a) fails to remedy any deficiency notified to him 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 him in respect of section 32(3) or rule 5(1) or 8(2) or fails to make payment as required by section 32(4) the application shall be treated as abandoned.