
EXPLANATORY NOTE

(This note is not part of the Order)

This Order amends the Trade Marks (International Registration) Order 1996 (S.I.1996/714) as a consequence of the replacement of the Trade Marks Rules 1994 (S.I. 1994/2583) by the Trade Mark Rules 2000 (S.I. 2000/136) (“the Rules”). The amendments of substance made by this Order are as follows:

- (a) with the consent of both of the parties the registrar may grant a “cooling-off” period in actions for opposition to registration of an international trade mark (UK) under article 10(4)-(4B) (article 5);
- (b) provision has been made for the registrar to call case management conferences and pre-hearing reviews in relation to procedures on opposition proceedings and application for revocation (on grounds of non-use), revocation (on grounds other than non-use) and invalidity of protection of a protected international trade mark (UK) under article 13(4A) (articles 5 and 8);

Other changes relevant to the operation of the system provided for by the Trade Marks (International Registration) Order 1996 have been effected by the replacement of the Trade Marks Rules 1994 by the Trade Mark Rules 2000, in particular by virtue of the provisions of articles 3 and 11 of this Order, and article 32 of the 1996 Order. These include:

- (1) certain time limits in actions for revocation (on grounds other than non-use) and invalidity have been reduced from three months to six weeks (rules 32 and 33 of the Rules);
- (2) the time limit for appeal to the appointed person has been reduced from one month to 28 days (rule 63 of the Rules);
- (3) provision has been made for “filing” of a document with the registrar to mean delivery of that document to the registrar at the Office (rule 2 of the Rules);
- (4) where the Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may now be used as an alternative (rule 55 of the Rules);
- (5) provision has been made for the calling and cross-examination of persons in proceedings where a party has adduced evidence of a statement made by a person otherwise than while giving oral evidence in those proceedings and does not call that person as a witness (rule 55 of the Rules).