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STATUTORY INSTRUMENTS

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**2004 No. 947**

**The Trade Marks (Amendment) Rules 2004**

**Amendments to the Trade Marks Rules 2000**

7. For rule 13 (opposition proceedings) there shall be substituted—

**“Opposition proceedings: filing of notice of opposition; s38(2) (Form TM7)**

**13.—**(1) Any person may, within three months of the date on which the application was published, give notice to the registrar of opposition to the registration on Form TM7 which shall include a statement of the grounds of opposition.

(2) Where the opposition is based on a trade mark which has been registered, there shall be included in the statement of the grounds of opposition a representation of that mark and—

- (a) the details of the authority with which the mark is registered;
- (b) the registration number of that mark;
- (c) the classes in respect of which that mark is registered;
- (d) the goods and services in respect of which—
  - (i) that mark is registered; and
  - (ii) the opposition is based; and

(e) where the registration procedure for the mark was completed before the start of the period of five years ending with the date of publication, a statement detailing whether during the period referred to in section 6A(3)(a)(1) the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use (for the purposes of rule 13C this is the “statement of use”).

(3) Where the opposition is based on a trade mark in respect of which an application for registration has been made, there shall be included in the statement of the grounds of opposition a representation of that mark and those matters set out in paragraph (2)(a) to (d), with references to registration being construed as references to the application for registration.

(4) Where the opposition is based on an unregistered trade mark or other sign which the person opposing the application claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds of opposition a representation of that mark or sign and the goods and services in respect of which such protection is claimed.

(5) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is done shall, for the purposes of rule 13A, be the “notification date”.

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(1) Section 6A was inserted into the Trade Marks Act 1994 by regulation 4 of the Trade Marks (Proof of Use, etc.) Regulations 2004.

**Opposition proceedings: filing of counter-statement and cooling off period (Forms TM8, TM9c & TM9t)**

**13A.**—(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement, otherwise his application for registration shall be deemed to be withdrawn.

(2) Unless either paragraph (3) or (4) applies, the relevant period shall begin on the notification date and end three months after that date.

(3) This paragraph applies where—

- (a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;
- (b) within the period of three months beginning on the notification date, either party files Form TM9c requesting an extension of time for the filing of Form TM8; and
- (c) during the period beginning on the date Form TM9c was filed and ending twelve months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration,

and where this paragraph applies the relevant period shall begin on the notification date and end twelve months after that date.

(4) This paragraph applies where—

- (a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c; and
- (b) the person opposing the registration has filed a notice to continue on Form TM9t,

and where this paragraph applies the relevant period shall begin on the notification date and end one month after the date on which Form TM9t was filed or three months after the notification date, whichever is the later.

(5) The registrar shall send a copy of Form TM8 to the person opposing the registration and, unless rule 13B applies, the date upon which this is sent shall, for the purposes of rule 13C, be the “initiation date”.

**Opposition proceedings: preliminary indication (Form TM53)**

**13B.**—(1) This rule applies if—

- (a) the opposition or part of it is based on the relative grounds of refusal set out in section 5(1) or (2); and
- (b) the registrar has not indicated to the parties that she thinks that it is inappropriate for this rule to apply.

(2) After considering the statement of the grounds of opposition and the counter-statement the registrar shall notify the parties whether it appears to her that the mark should or should not be registered in respect of the goods and services listed in the application.

(3) The date upon which such notification is sent shall be the “indication date”.

(4) Where it appeared to the registrar under paragraph (2) that—

- (a) the mark should be registered for all the goods and services listed in the application, the person opposing the registration shall, within one month of the indication date, file notice of intention to proceed on Form TM53, otherwise he shall be deemed to have withdrawn his opposition;
- (b) the mark should be registered for some, but not all, of the goods and services listed in the application, unless—

- (i) within the period of one month of the indication date, the applicant or the person opposing the registration files a notice of intention to proceed on Form TM53; or
- (ii) within the period of one month beginning immediately after the end of the period mentioned in paragraph (i), the applicant requests the amendment of his application so that it relates only to the goods and services which the registrar notified the parties to be goods and services for which it appeared the mark should be registered;

the applicant shall be deemed to have withdrawn his application for registration in its entirety; or

- (c) the mark should not be registered for any of the goods and services listed in the application, the applicant shall, within one month of the indication date, file notice of intention to proceed on Form TM53, otherwise he shall be deemed to have withdrawn his application for registration.

(5) The registrar need not give reasons why it appears to her that the mark should or should not be registered, nor shall her view be subject to appeal.

(6) If a notice of intention to proceed has been filed by either party then the registrar shall send a copy of that notice to all the other parties and the date upon which this is sent shall, for the purposes of rule 13C, be the “initiation date”.

#### **Opposition proceedings: evidence rounds (Form TM54)**

**13C.—**(1) The person opposing the registration, within three months of the initiation date—

- (a) shall file any evidence he considers necessary to adduce in support of his grounds of opposition; and
- (b) where—
  - (i) the opposition is based on an earlier trade mark;
  - (ii) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication; and
  - (ii) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant,

shall file evidence supporting the statement of use.

(2) Where the person opposing the registration files no evidence under paragraph (1), he shall, unless the registrar otherwise directs, be deemed to have withdrawn his opposition.

(3) The registrar shall notify the applicant of any direction given under paragraph (2).

(4) The applicant may file any evidence he may consider necessary to adduce in support of his application—

- (a) within three months of the evidence being filed under paragraph (1); or
- (b) within three months of the registrar sending him notification that a direction has been given under paragraph (2).

(5) Where the applicant files evidence under paragraph (4), the person opposing the registration may, within three months of such evidence being filed, file any evidence in reply; such evidence shall be confined to matters strictly in reply to the applicant’s evidence.

(6) The registrar may, at any time if she thinks fit, give leave to either party to file evidence upon such terms as she thinks fit.

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**Status:** This is the original version (as it was originally made). This item of legislation is currently only available in its original format.

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(7) Under this rule, evidence shall only be considered filed when—

- (a) it has been received by the registrar accompanied by Form TM54; and
- (b) it has been sent to all other parties to the opposition.

(8) Where the periods for filing evidence under paragraphs (1) and (4) and, if relevant, paragraph (5) have expired, the registrar shall request that the parties give written notice of whether they wish to be heard.

(9) Where any party requests to be heard, the registrar shall send to the parties notice of a date for the hearing.”.