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## STATUTORY INSTRUMENTS

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**2004 No. 947**

### **TRADE MARKS**

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

*Made* - - - - -

*28th March 2004*

*Laid before Parliament*

*31st March 2004*

*Coming into force in accordance with rule 1(2).*

The Secretary of State, in exercise of the powers conferred upon her by sections 38(2), 39(3), 41, 44(3), 65, 76(1) and 78 of the Trade Marks Act 1994(1), after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992(2), hereby makes the following Rules:

#### **Citation and commencement**

- 1.—(1) These Rules may be cited as the Trade Marks (Amendment) Rules 2004.
- (2) These Rules shall come into force on 5th May 2004 immediately after the Trade Marks (Proof of Use, etc.) Regulations 2004(3) have come into force.

#### **Amendments to the Trade Marks Rules 2000**

2. The Trade Marks Rules 2000(4) shall be amended as follows.
3. In rule 5 (applications for registration) paragraphs (2) to (4) shall be omitted.
4. In rule 8 (application may relate to more than one class and shall specify the class) for paragraphs (2) and (3) there shall be substituted—
  - “(2) Every application shall specify—
    - (a) the class in Schedule 4 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 Schedule 4.

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(1) 1994 c. 26.

(2) 1992 c. 53.

(3) SI 2004/946.

(4) SI 2000/136, amended by SI 2001/3832.

(3) If the application relates to more than one class in Schedule 4 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.”.

5. After rule 8 there shall be inserted—

**“Determination of classification**

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

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

(3) Where the applicant fails to satisfy those requirements before the expiry of the period specified under paragraph (2) his application shall be treated as abandoned.”.

6. In rule 11 (deficiencies in application) for the word “8(2)”, in both places it occurs, there shall be substituted “8(2)(a)”.

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)(**5**) 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

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

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”.

**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.

(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.”.

**8.** In rule 14(1) (decision of registrar in opposition proceedings) for the words “rule 13” there shall be substituted “rules 13 to 13C”.

**9.** In rule 18 (amendment of application after publication) for paragraphs (2) and (3) there shall be substituted—

“(2) Any person claiming to be affected by the amendment may, within one month of the date on which the amendment or a statement of the effect of the amendment was published under paragraph (1), give notice to the registrar of objection to the amendment on Form TM7 which shall include a statement of the grounds of objection which shall, in particular, indicate why the amendment would not fall within section 39(2).

(3) The registrar shall send a copy of Form TM7 to the applicant and the procedure in rules 13A to 14 shall apply to the proceedings relating to the objection to the amendment as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

- (a) any reference to—
  - (i) an application for registration shall be construed as a reference to a request for amendment of an application;
  - (ii) the person opposing the registration shall be construed as a reference to the person objecting to the amendment of an application;
  - (iii) the opposition shall be construed as a reference to the objection;
- (b) the relevant period, referred to in rule 13A(1), shall for these purposes be the period of three months beginning on the date upon which the registrar sent a copy of Form TM7 to the applicant;
- (c) rules 13A(2) to (4), rule 13B and rule 13C(1)(b) shall not apply.”.

**10.—(1)** Rule 21 (registration of a series of trade marks) shall be amended as follows.

(2) In paragraph (2) for the words from “shall, if” to the end of the paragraph there shall be substituted

“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).”.

(3) After paragraph (3) there shall be inserted—

“(3A) Where under paragraph (3) 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.”.

**11.** In rule 23 (amendment of regulations of collective and certification marks) for paragraphs (4) and (5) there shall be substituted—

“(4) Any person may, within three months of the date on which the notice was published under paragraph (2), give notice to the registrar of opposition to the amendment on Form TM7 which shall include a statement of the grounds of opposition indicating why the amended regulations do not comply with the requirements of paragraph 6(1) of Schedule 1, or, as the case may be, paragraph 7(1) of Schedule 2.

(5) The registrar shall send a copy of Form TM7 to the proprietor and the procedure in rules 13A to 14 shall apply to the proceedings relating to the opposition to the amendment as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

(a) any reference to—

- (i) the applicant shall be construed as a reference to the proprietor;
- (ii) an application for registration shall be construed as a reference to an application for the amendment of the regulations;
- (iii) the person opposing the registration shall be construed as a reference to the person opposing the amendment of the regulations;

(b) the relevant period, referred to in rule 13A(1), shall for these purposes be the period of three months beginning on the date upon which the registrar sent a copy of Form TM7 to the proprietor;

(c) rules 13A(2) to (4), rule 13B and rule 13C(1)(b) shall not apply.”.

**12.** In rule 25 (alteration of registered trade mark) for paragraph (3) there shall be substituted—

“(3) Any person claiming to be affected by the alteration may, within three months of the date on which the mark as altered was published under paragraph (2), give notice to the registrar of objection to the alteration on Form TM7 which shall include a statement of the grounds of objection.

(4) The registrar shall send a copy of Form TM7 to the proprietor and the procedure in rules 13A to 14 shall apply to the proceedings relating to the objection to the alteration as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

(a) any reference to—

- (i) the applicant shall be construed as a reference to the proprietor;
- (ii) an application for registration shall be construed as a reference to a request for alteration;
- (iii) the person opposing the registration shall be construed as a reference to the person objecting to the alteration;
- (iv) the opposition shall be construed as a reference to the objection;

(b) the relevant period, referred to in rule 13A(1), shall for these purposes be the period of three months beginning on the date upon which the registrar sent a copy of Form TM7 to the proprietor;

(c) rules 13A(2) to (4), rule 13B and rule 13C(1)(b) shall not apply.”.

13. For rules 31 to rule 33 there shall be substituted—

**“Application for revocation (on the grounds of non-use); s 46(1)(a) or (b) (Forms TM8 & TM26(N))**

**31.**—(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N) and be accompanied by a statement of the grounds on which the application is made.

(2) The registrar shall send a copy of Form TM26(N) and the statement of the grounds on which the application is made to the proprietor.

(3) The proprietor shall, within three months of the date on which he was sent a copy of Form TM26(N) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, and be accompanied by—

(a) two copies of evidence of use of the mark; or

(b) reasons for non-use of the mark,

otherwise the registrar may treat him as not opposing the application.

(4) The evidence of use of the mark shall—

(a) cover the period of non-use alleged by the applicant on Form TM26(N), or

(b) where the proprietor intends to rely on section 46(3), show that use of the mark commenced or resumed after the end of that period but before the application for revocation was made.

(5) The reasons for non-use of the mark shall cover the period of non-use alleged by the applicant on Form TM26(N).

(6) The registrar shall send a copy of Form TM8 and any evidence of use, or reasons for non-use, filed by the proprietor to the applicant and the date upon which this is sent shall, for the purposes of rule 31A, be the “initiation date”.

**Application for revocation (on the grounds of non-use): evidence rounds (Form TM54)**

**31A.**—(1) The applicant may, within three months of the initiation date, file any evidence he may consider necessary to adduce in support of the grounds on which the application was made.

(2) Where the applicant files no evidence under paragraph (1), the registrar shall notify the proprietor that no evidence was filed.

(3) The proprietor may, within the relevant period, file such evidence as he may consider necessary to adduce in support of his case.

(4) The relevant period—

(a) where the applicant files evidence under paragraph (1), is the period beginning on the date on which a copy of the evidence is filed and ending three months after that date; or

(b) where the applicant does not file evidence under paragraph (1), is the period beginning on the date on which the registrar sent the proprietor a notification under paragraph (2) that no evidence was filed and ending three months after that date.

(5) Where the proprietor files evidence under paragraph (3), the applicant 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 proprietor’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.
- (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 revocation proceedings.
- (8) Where the periods for filing evidence under paragraphs (1) and (3) 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.

#### **Decision of registrar in revocation (on the grounds of non-use) proceedings**

- 31B.**—(1) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision.
- (2) For the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

#### **Application for revocation (on grounds other than non-use); s 46(1)(c) or (d) (Forms TM8 & TM26(O))**

- 32.**—(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(c) or (d), shall be made on Form TM26(O) and be accompanied by a statement of the grounds on which the application is made.
- (2) The registrar shall send a copy of Form TM26(O) and the statement of the grounds on which the application is made to the proprietor.
- (3) The proprietor shall, within six weeks of the date on which he was sent a copy of Form TM26(O) and the statement by the registrar, file a Form TM8 which shall include a counter-statement, otherwise the registrar may treat him as not opposing the application.
- (4) The registrar shall send a copy of Form TM8 to the applicant and the date upon which this is sent shall, for the purposes of rule 32A, be the “initiation date”.

#### **Application for revocation (on grounds other than non-use): evidence rounds (Form TM54)**

- 32A.**—(1) The applicant shall, within six weeks of the initiation date, file any evidence he may consider necessary to adduce in support of the grounds on which the application was made.
- (2) Where the applicant files no evidence under paragraph (1), he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.
- (3) The registrar shall notify the proprietor of any direction given under paragraph (2).
- (4) The proprietor may file any evidence he may consider necessary to adduce in support of his case—
  - (a) within six weeks of the evidence being filed under paragraph (1); or
  - (b) within six weeks of the registrar sending him a notification that a direction has been given under paragraph (2).

(5) Where the proprietor files evidence under paragraph (4), the applicant may, within six weeks of such evidence being filed, file any evidence in reply; such evidence shall be confined to matters strictly in reply to the proprietor'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.

(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 revocation proceedings.

(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.

#### **Decision of registrar in revocation (on grounds other than non-use) proceedings**

**32B.**—(1) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision.

(2) For the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

#### **Application for invalidation: filing of application and counter-statement; s 47 (Forms TM8 & TM26(I))**

**33.**—(1) An application to the registrar for a declaration of invalidity under section 47 shall be made on Form TM26(I) and be accompanied by a statement of the grounds on which the application is made.

(2) Where the application is based on a trade mark which has been registered, there shall be included in the statement of the grounds on which the application is made 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 application is based; and

(e) where neither section 47(2A)(a) nor (b)(6) applies to the mark, a statement detailing whether during the period referred to in section 47(2B)(a) it has been put to genuine use in relation to each of the goods and services in respect of which the application is based or whether there are proper reasons for non-use (for the purposes of rule 33A this is the "statement of use").

(3) Where the application 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 on which the application is made a representation of that mark and those matters set out in

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(6) Subsections (2A) to (2E) of section 47 were inserted into the Trade Marks Act 1994 by regulation 6 of the Trade Marks (Proof of Use, etc.) Regulations 2004.

paragraph (2)(a) to (d), with references to registration being construed as references to the application for registration.

(4) Where the application is based on an unregistered trade mark or other sign which the applicant 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 on which the application is made 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 TM26(I) and the statement of the grounds on which the application is made to the proprietor.

(6) The proprietor shall, within six weeks of the date on which he was sent a copy of Form TM26(I) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat him as not opposing the application.

(7) The registrar shall send a copy of Form TM8 to the applicant and the date upon which this is sent shall, for the purposes of rule 33A, be the “initiation date”.

#### **Application for invalidation: evidence rounds (Form TM54)**

**33A.—(1)** The applicant, within six weeks of the initiation date—

(a) shall file any evidence he may consider necessary to adduce in support of the grounds on which the application was made; and

(b) where—

(i) the application is based on an earlier trade mark;

(ii) neither section 47(2A)(a) nor (b) applies to the mark; and

(iii) the truth of a matter set out in the statement of use is either denied or not admitted by the proprietor,

shall file evidence supporting the statement of use.

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

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

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

(a) within six weeks of the evidence being filed under paragraph (1); or

(b) within six weeks of the registrar sending him a notification that a direction has been given under paragraph (2).

(5) Where the proprietor files evidence under paragraph (4), the applicant may, within six weeks of such evidence being filed, file any evidence in reply; such evidence shall be confined to matters strictly in reply to the proprietor’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.

(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 invalidation proceedings.

(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.

#### **Decision of registrar in invalidation proceedings**

**33B.**—(1) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision.

(2) For the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.”.

**14.**—(1) Rule 34 (procedure on application for rectification) shall be amended as follows.

(2) After paragraph (2) there shall be inserted—

“(2A) A direction under paragraph (2)(b) may include a requirement that 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 application.”.

(3) In paragraph (3) for the words “Upon completion of the evidence” there shall be substituted “Where the periods for filing evidence specified in directions given under paragraph (2)(b) have expired.”.

**15.** In rule 35(2) (procedure for intervention)—

- (a) for the words “rule 31” there shall be substituted “rules 31 to 31B”;
- (b) for the words “rule 32” there shall be substituted “rules 32 to 32B”;
- (c) for the words “rule 33” there shall be substituted “rules 33 to 33B”.

**16.** For rule 47(1) (opposition to proposals) there shall be substituted—

“(1) Any person may, within three months of the date on which the proposals were published under rule 46, give notice to the registrar of opposition to the proposals on Form TM7 which shall include a statement of the grounds of opposition which shall, in particular, indicate why the proposed amendments would be contrary to section 65(3).”.

**17.** For rule 63(1) (appeal to person appointed) there shall be substituted—

“(1) Notice of appeal to the person appointed under section 76 shall be filed on Form TM55 which shall include the appellant's grounds of appeal and his case in support of the appeal.

(1A) Such notice shall be filed with the registrar within the period of 28 days beginning on the date of the registrar's decision which is the subject of the appeal.”.

**18.** For rule 65 (hearing of appeal) there shall be substituted—

#### **“Hearing and determination of appeal; s 76(4)**

**65.**—(1) Where the person appointed does not refer the appeal to the court, he shall send written notice of the time and place appointed for the oral hearing of the appeal—

- (a) where no person other than the appellant was a party to the proceedings in which the decision appealed against was made, to the registrar and to the appellant; and
- (b) in any other case, to the registrar and to each person who was a party to those proceedings.

(2) The person appointed shall send the notice at least fourteen days before the time appointed for the oral hearing.

(3) If all the persons notified under paragraph (1) inform the person appointed that they do not wish to make oral representations then—

(a) the person appointed may hear and determine the case on the basis of any written representations; and

(b) the time and place appointed for the oral hearing may be vacated.

(4) Rules 55 to 58 and rules 60 and 61 shall apply to the person appointed and to proceedings before the person appointed as they apply to the registrar and to proceedings before the registrar.

(5) If there is an oral hearing of the appeal then rule 59 shall apply to the person appointed and to proceedings before the person appointed as it applies to the registrar and to proceedings before the registrar.

(6) The person appointed shall send a copy of his decision, with a statement of his reasons therefor, to the registrar and to each person who was a party to the appeal.”.

**19.**—(1) Rule 68 (alteration of time limits) shall be amended as follows.

(2) In paragraph (2)(a)—

(a) after the words “rule 13” there shall be inserted “to 13C”;

(b) for the words “31, 32, 33” there shall be substituted “31, 31A, 32, 32A, 33, 33A”.

(3) In paragraph (3)—

(a) for the words from “rule 13(1)” to “provided for in that rule” there shall be substituted “rule 13(1) (time for filing opposition), rule 13A(1) (time for filing counter-statement),”;

(b) for the words “rule 31(2) (time for filing counter-statement)” there shall be substituted “rule 31(3) (time for filing counter-statement and evidence of use or reasons for non-use)”;

(c) for the words “rule 32(2)” there shall be substituted “rule 32(3)”;

(d) for the words “rule 33(2)” there shall be substituted “rule 33(6)”.

### **Transitional arrangements**

**20.** In rules 22 to 24—

“the unamended Rules” means the Trade Marks Rules 2000 in the form they were immediately prior to these Rules coming into force;

“the amended Rules” means the Trade Marks Rules 2000 in the form they are after these Rules have come into force.

**21.** Rules 4, 5 and 6 shall not apply in respect of any application for the registration of a trade mark which was filed before they came into force.

**22.** Any proceedings commenced under rule 13, 18, 23, 25, 32 or 33 of the unamended Rules where the applicant (or, as the case may be, the proprietor)—

(a) has not filed Form TM8 before 5th May 2004—

(i) shall proceed under the unamended Rules until the date upon which Form TM8 is filed by the applicant (or, as the case may be, the proprietor); and

(ii) shall proceed, subject to rule 23, under the amended Rules from the point in time immediately after Form TM8 is filed;

(b) has filed TM8 before 5th May 2004 shall proceed under the unamended Rules; but where a new step is taken under such Rules on or after 5th May 2004, the amended Rules, subject to rule 23, shall apply to such proceedings from the point in time immediately after that step is taken.

**23.** Rules 13C(1)(b) and 33A(1)(b) of the amended Rules shall not apply to any proceedings commenced before the coming into force of these Rules.

**24.** Any proceedings commenced under rule 31 of the unamended Rules shall proceed under those Rules.

*Sainsbury of Turville,*  
Parliamentary Under-Secretary of State for  
Science and Innovation,  
Department of Trade and Industry

28th March 2004

## EXPLANATORY NOTE

*(This note is not part of the Rules)*

These Rules amend the Trade Marks Rules 2000 ([SI 2000/136](#)) (“the 2000 Rules”).

Rule 3 revokes rules 5(2) to (4) of the 2000 Rules. This means that it will no longer be a requirement in Rules that certain elements of a trade mark must be claimed.

Rule 4 amends rule 8 of the 2000 Rules. This amendment makes it clear that the description of the goods and services to which the application relates must be worded in a clear fashion.

Rule 5 inserts a new rule 8A into the 2000 Rules. This new rule provides a sanction to ensure that applicants comply with the amended rule 8.

Rule 6 amends rule 11 of the 2000 Rules. This amendment is consequential on the amendment of rule 8 and the insertion of new rule 8A.

Rule 7 substitutes new rules 13 to 13C for rule 13 of the 2000 Rules. This introduces a new opposition procedure, where in certain cases, before evidence has been filed, the registrar will notify the parties if it appears to her that a particular mark should or should not be registered. Further, it amends the procedure surrounding the cooling off period and introduces the requirement to show use of certain earlier trade marks which a person opposing the registration of a trade mark uses as the basis of his opposition.

Rules 8 and 9 amend rules 14 and 18 of the 2000 Rules respectively. These amendments are consequential on the changes made to the rules relating to opposition proceedings and various forms.

Rule 10 amends rule 21 of the 2000 Rules. These amendments clarify the circumstances in which an application can be divided. Further, they make it clear that where a mark is deleted from the application, that application, in so far as it relates to the deleted mark shall be treated as withdrawn.

Rules 11 and 12 amend rules 23 and 25 of the 2000 Rules respectively. These amendments are consequential on the changes made to the rules relating to opposition proceedings and various forms.

Rule 13 substitutes new rules 31 to 33B for rules 31 to 33 of the 2000 Rules. These amendments make a number of changes to revocation and invalidation proceedings and the filing of evidence. In particular, where the proprietor of a trade mark is required to show use to avoid revocation, that proof of use must cover the period of alleged non-use as set out on the appropriate form. Further, rule 33 is amended to reflect the new requirements on an applicant to show use of certain earlier trade marks which he uses as the basis of his application for invalidation.

Rule 14 amends rule 34 of the 2000 Rules. This amendment reflects the new arrangements for filing evidence.

Rule 15 amends rule 35 of the 2000 Rules. This amendment is consequential on the new rules 31 to 33B.

Rule 16 amends rule 47 of the 2000 Rules. This amendment is consequential on the changes made to the relevant form.

Rule 17 amends rule 63 of the 2000 Rules. This amendment means that an appeal to the person appointed shall in future be filed on a form.

Rule 18 substitutes a new rule 65 into the 2000 Rules. This substituted rule allows the appointed person to hear and determine appeals on the basis of written representations, where all parties to the proceedings agree.

Rule 19 amends rule 68 of the 2000 Rules. These amendments are consequential on the changes made to rule 13 and rules 31 to 33B.

Rules 20 to 24 provide transitional provisions.

A Regulatory Impact Assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Trade Marks Directorate, The Patent Office, Concept Office, Cardiff Road, Newport, NP10 8QQ.