
STATUTORY INSTRUMENTS

2008 No. 1797

The Trade Marks Rules 2008

Proceedings before and decision of registrar, evidence and costs

General powers of registrar in relation to proceedings

62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

- (a) require a document, information or evidence to be filed within such period as the registrar may specify;
 - (b) require a translation of any document;
 - (c) require a party or a party's legal representative to attend a hearing;
 - (d) hold a hearing by telephone or by using any other method of direct oral communication;
 - (e) allow a statement of case to be amended;
 - (f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;
 - (g) consolidate proceedings;
 - (h) direct that part of any proceedings be dealt with as separate proceedings;
 - (i) exclude any evidence which the registrar considers to be inadmissible.
- (2) The registrar may control the evidence by giving directions as to—
- (a) the issues on which evidence is required; and
 - (b) the way in which the evidence is to be placed before the registrar.
- (3) When the registrar gives directions under any provision of these Rules, the registrar may—
- (a) make them subject to conditions; and
 - (b) specify the consequences of failure to comply with the directions or a condition.

(4) The registrar may at any stage of any proceedings direct that the parties to the proceedings attend a case management conference or pre-hearing review.

Decisions of registrar to be taken after hearing

63.—(1) Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings, give that party an opportunity to be heard.

(2) The registrar shall give that party at least fourteen days' notice, beginning on the date on which notice is sent, of the time when the party may be heard unless the party consents to shorter notice.

Evidence in proceedings before the registrar; section 69

64.—(1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

- (a) by witness statement, affidavit, statutory declaration; or
- (b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement may only be given in evidence if it includes a statement of truth.

(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.

(4) For the purposes of these Rules, a statement of truth—

- (a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and
- (b) shall be dated and signed by—
 - (i) in the case of a witness statement, the maker of the statement,
 - (ii) in any other case, the party or legal representative of such party.

(5) In these Rules, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

(6) Under these Rules, evidence shall only be considered filed when—

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

Registrar to have power of an official referee; section 69

65. The registrar shall have the powers of an official referee of the Supreme Court as regards—

- (a) the attendance of witnesses and their examination on oath; and
- (b) the discovery and production of documents,

but the registrar shall have no power to punish summarily for contempt.

Hearings before registrar to be in public

66.—(1) The hearing before the registrar of any dispute between two or more parties relating to any matter in connection with an application for the registration of a mark or a registered mark shall be in public unless the registrar, after consultation with those parties who appear in person or are represented at the hearing, otherwise directs.

(2) Nothing in this rule shall prevent a member of the Administrative Justice and Tribunals Council or of its Scottish Committee from attending a hearing in their capacity as such member.

Costs of proceedings; section 68

67. The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and by what parties they are to be paid.

Security for costs; section 68

68.—(1) The registrar may require any person who is a party in any proceedings under the Act or these Rules to give security for costs in relation to those proceedings; and may also require security for the costs of any appeal from the registrar's decision.

(2) In default of such security being given, the registrar, in the case of the proceedings before the registrar, or in the case of an appeal, the person appointed under section 76 may treat the party in default as having withdrawn their application, opposition, objection or intervention, as the case may be.

Decision of registrar (Form TM5)

69.—(1) The registrar shall send to each party to the proceedings written notice of any decision made in any proceedings before the registrar stating the reasons for that decision and for the purposes of any appeal against that decision, subject to paragraph (2), the date on which the notice is sent shall be taken to be the date of the decision.

(2) Where a statement of the reasons for the decision is not included in the notice sent under paragraph (1), any party may, within one month of the date on which the notice was sent to that party, request the registrar on Form TM5 to send a statement of the reasons for the decision and upon such request the registrar shall send such a statement, and the date on which that statement is sent shall be deemed to be the date of the registrar’s decision for the purpose of any appeal against it.