
STATUTORY INSTRUMENTS

2008 No. 1797

The Trade Marks Rules 2008

Publication, observations, oppositions and registration

Publication of application for registration; section 38(1)

16. An application which has been accepted for registration shall be published in the Journal.

Opposition proceedings: filing of notice of opposition; section 38(2) (Form TM7)

17.—(1) Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning with the date on which the application was published.

(4) Where a person makes a request for an extension of time under paragraph (3), Form TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.

(5) 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 goods and services in respect of which—
 - (i) that mark is registered, and
 - (ii) the opposition is based; and
- (d) 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) 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 20 this is the “statement of use”).

(6) 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 (5)(a) to (c), with references to registration being construed as references to the application for registration.

(7) 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.

(8) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is sent shall, for the purposes of rule 18, be the “notification date”.

(9) In this rule “subsidiary” and “holding company” have the same meaning as in the Companies Act 2006(1).

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

18.—(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a Form TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date.

(4) 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 two 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 nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

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

(5) This paragraph applies where—

- (a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c in accordance with paragraph (4)(b);
- (b) during the period referred to in paragraph (4)(c), either party files Form TM9e requesting a further extension of time for the filing of Form TM8 which request includes a statement confirming that the parties are seeking to negotiate a settlement of the opposition proceedings; and
- (c) the other party agrees to the further extension of time for the filing of Form TM8,

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

(6) This paragraph applies where—

- (a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c in accordance with paragraph (4)(b); 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 two months after the notification date, whichever is the later.

(1) 2006 c.46.

- (7) The registrar shall send a copy of Form TM8 to the person opposing the registration.

Opposition proceedings: preliminary indication (Form TM53)

19.—(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 the registrar 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 send notice to the parties (“the preliminary indication”) stating whether it appears to the registrar that—

- (a) registration of the mark should not be refused in respect of all or any of the goods and services listed in the application on the grounds set out in section 5(1) or (2); or
- (b) registration of the mark should be refused in respect of all or any of the goods and services listed in the application on the grounds set out in section 5(1) or (2).

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

(4) Where it appeared to the registrar under paragraph (2) that registration of the mark should not be refused in respect of all or any of the goods or services listed in the application on the grounds set out in section 5(1) or (2), the person opposing the registration shall, within one month of the indication date, file a notice of intention to proceed with the opposition based on those grounds by filing a Form TM53, otherwise that person’s opposition to the registration of the mark in relation to those goods or services on the grounds set in section 5(1) or (2) shall be deemed to have been withdrawn

(5) Where it appeared to the registrar under paragraph (2) that registration of the mark should be refused in respect of all or any of the goods or services listed in the application on the grounds set out in section 5(1) or (2), the applicant shall, within one month of the indication date, file a notice of intention to proceed on Form TM53, otherwise the applicant shall be deemed to have withdrawn the request to register the mark in respect of the goods or services for which the registrar indicated registration should be refused.

(6) A person who files a Form TM53 shall, at the same time, send a copy to all other parties to the proceedings.

(7) The registrar need not give reasons for the preliminary indication nor shall the preliminary indication be subject to appeal.

Opposition proceedings: evidence rounds

20.—(1) Where—

- (a) Form TM53 has been filed by either party;
- (b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2) and the applicant has filed a Form TM8; or
- (c) the registrar has indicated to the parties that it is inappropriate for rule 19 to apply,

the registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(2) Where—

- (a) the opposition is based on an earlier trade mark of a kind falling within section 6(1)(c); or

- (b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2); or
- (c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant,

the person opposing the registration (“the opposer”) shall file evidence supporting the opposition.

(3) Where the opposer files no evidence under paragraph (2), the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on—

- (a) the matters in paragraph (2)(a) or (b); or
- (b) an earlier trade mark which has been registered and which is the subject of the statement of use referred to in paragraph (2)(c).

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

Procedure for intervention

21.—(1) If the opposition or part of it is based on the relative grounds for refusal set out in section 5(1), (2) or (3), any person in paragraph (3) may file an application to the registrar on Form TM27 for leave to intervene and the registrar may, after hearing the parties concerned if so required, refuse such leave or grant leave upon such terms and conditions (including any undertaking as to costs) as the registrar thinks fit.

(2) Any person granted leave to intervene shall, subject to any terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings for the purposes of the application of the provisions of rules 19, 20 and 62 to 73.

(3) The persons referred to in paragraph (1) are—

- (a) where the opposition is based on an earlier trade mark, a licensee of that mark; and
- (b) where the opposition is based on an earlier collective mark or certification mark, an authorised user of that mark.

Observations on application to be sent to applicant; section 38(3)

22. The registrar shall send to the applicant a copy of any document containing observations made under section 38(3).

Publication of registration; section 40

23. On the registration of the trade mark the registrar shall publish the registration on the Office website, specifying the date upon which the trade mark was entered in the register.