

2013 No. 2235

TRADE MARKS

**The Trade Marks (Fast Track Opposition) (Amendment) Rules
2013**

<i>Made</i>	- - - -	<i>4th September 2013</i>
<i>Laid before Parliament</i>		<i>6th September 2013</i>
<i>Coming into force</i>	- -	<i>1st October 2013</i>

The Secretary of State makes the following rules in exercise of the powers conferred upon the Secretary of State by sections 38(2) and 78 of the Trade Marks Act 1994(a).

Citation and commencement

1. These Rules may be cited as the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 and shall come into force on 1st October 2013.

Amendments to the Trade Marks Rules 2008

2.—(1) The Trade Marks Rules 2008(b) shall be amended as follows—

(2) In Rule 2(1), after the definition of “the Act” insert—

““fast track opposition” means an opposition—

- (a) brought solely on grounds under section 5(1) or 5(2) of the Act,
- (b) based on no more than 3 earlier trade marks, each of which is registered in the UK or in the EU, or is protected in one or another of those territories as an international trade mark (UK) or (EU),
- (c) where proof of use of the earlier marks can be provided with the notice of opposition, and
- (d) which the opponent considers may be determined without the need for further evidence and without an oral hearing.”

(3) At the beginning of Rule 17(1) omit “Any” and insert “Subject to Rule 17A, any”.

(4) After Rule 17, insert Rule 17A as follows—

“Opposition proceedings: filing of notice of fast track opposition; section 38(2) (Form TM7F)”

17A.—(1) A notice to the registrar of fast track opposition to the registration, including the statement of the grounds of opposition, may be filed on Form TM7F.

(a) 1994 c.26.

(b) S.I. 2008/1797 as amended by S.I. 2013/444 and to which there are further amendments which are not relevant to these Rules.

(2) A notice of fast track opposition to the registration filed on Form TM7F and a notice of opposition to the registration filed on Form TM7 shall constitute alternatives and an opponent shall not maintain more than one opposition against the same trade mark application.

(3) Unless paragraph (4) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning immediately after the date on which the application was published.

(4) This paragraph applies where a request for an extension of time for the filing of Form TM7 or TM7F has been made on Form TM7A, before the expiry of the period referred to in paragraph (3) 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 immediately after the date on which the application was published.

(5) Forms TM7F and TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.

(6) 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 or protected;
- (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;
- (d) the date of completion of the registration procedure or of granting protection to an international trade mark (UK) or (EU); and
- (e) where the registration or protection 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)(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.

(7) Where the earlier mark is subject to proof of use under section 6A of the Act, the proof of use that the opponent wishes to rely upon shall be provided with the notice of fast track opposition.

(8) The registrar shall send a copy of Form TM7F 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(b).”

(5) In Rule 19, insert after paragraph (1)—

“(1A) This rule shall not apply to fast track oppositions.”

(6) In Rule 20, insert after paragraph (4)—

“(5) Paragraphs (1)–(3) of this Rule shall not apply to fast track oppositions but paragraph (4) shall apply.”

(7) In Rule 62—

(a) for paragraph (1)(e) substitute—

“(e) allow a statement of case to be amended, provided that—

(a) Section 6A(3)(a) was inserted into the Trade Marks Act 1994 by S.I. 2004/946.

(b) 2006 c. 46.

- (i) where an application is made to add grounds of opposition other than under subsections 5(1) or (2) of the Act, the application shall be made on Form TM7G; and
 - (ii) in the case of fast track oppositions the registrar may only permit a statement of case to be amended to add additional or alternative earlier registered or protected trade marks as additional grounds of opposition under subsections 5(1) or 5(2) of the Act, provided that the total number of earlier trade marks relied upon may not exceed three;”
- (b) for paragraph (1)(g) substitute—
- “(g) consolidate proceedings provided that where a fast track opposition is consolidated with other non-fast track proceedings, it shall no longer be treated as a fast track opposition;”;
- (c) after “inadmissible” in paragraph (1)(i) insert—
- “;
- (j) direct that with effect from the date specified in the direction opposition proceedings which have been commenced on Form TM7F as a fast track opposition but which do not satisfy the criteria for a fast track opposition may continue as if the opposition proceedings were an opposition to the registration commenced under Rule 17 on Form TM7”;
- (d) after paragraph (4) insert—
- “(5) In the case of a fast track opposition—
- (a) proceedings shall be held orally only if the Office requests it or if either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; and
 - (b) the parties shall be given at least fourteen days’ notice beginning on the date on which the notice is sent, of the time when the oral proceedings are to take place unless each party to the proceedings consents to shorter notice.
- (6) In the case of a fast track opposition, where no oral hearing is held, the registrar shall give the parties the opportunity to provide arguments in writing before reaching a decision that is adverse to either party.”
- (8) After Rule 63(2) insert paragraph (3)—
- “(3) This Rule shall not apply to fast track opposition proceedings.”
- (9) In Rule 71—
- (a) at the beginning of paragraph (1) omit “Notice” and insert “Subject to paragraph (1A), notice”;
 - (b) after paragraph (1) insert—
- “(1A) Where the appeal arises in proceedings between two or more parties, notice of appeal to the person appointed under section 76 shall be filed on Form TM55P, which shall include the appellant’s grounds of appeal and his case in support of the appeal.”;
- (c) for paragraph 71(2) substitute—
- “(2) Forms TM55 or TM55P shall be filed within the period of 28 days beginning immediately after the date of the registrar’s decision which is the subject of the appeal (“the original decision”).”

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend The Trade Marks Rules 2008 (S.I. 2008/1797) (the “2008 Rules”) to provide for an additional fast track opposition procedure under the Trade Marks Act 1994 (the “Act”).

A new definition of fast track opposition is inserted in Rule 2 of the 2008 Rules. The definition has four elements so that a fast track opposition is brought solely on grounds under section 5(1) or 5(2) of the Act, is based on no more than 3 earlier trade marks, each of which is registered in the UK or in the EU, or is protected in one or another of those territories as an international trade mark (UK) or (EU), where proof of use of the earlier marks can be provided with the notice of opposition, and which the opponent considers can be determined without the need for further evidence and without an oral hearing.

The new Rule 17A sets out the procedure for filing a notice of fast track opposition on Form TM7F which is to be filed electronically.

Rules 19 and 20(1)–(3) are disapplied from fast track oppositions but Rule 20(4), which provides that the registrar may at any time give leave to either party to file evidence upon such terms as the registrar thinks fit, does apply.

Rules 62(1)(e) and (g) set out rules concerning the amendment of the statement of case and the consolidation of proceedings for fast track oppositions.

A new Rule 62(5) provides that a dispute relating to a fast track opposition may be heard before the registrar only if the Office requests it or if either party to the proceedings requests it and the registrar considers that oral proceedings are necessary in that case.

A new Rule 62(6) provides that where no oral hearing is held, the registrar shall give the parties an opportunity to set out their arguments in writing before reaching a decision.

Rule 63 is disapplied from fast track oppositions.

Rule 71 provides that when an appeal arises in proceedings between two or more parties then the notice of appeal to the person appointed shall be filed on Form TM55P.

A full impact assessment of the effect that this instrument will have on the costs of business and the voluntary sector is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport NP10 8QQ and is annexed to the Explanatory Memorandum which is available alongside the instrument on www.legislation.gov.uk. Copies have also been placed in the libraries of both Houses of Parliament.

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