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STATUTORY INSTRUMENTS

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**2000 No. 138**

**TRADE MARKS**

**The Trade Marks (International  
Registration) (Amendment) Order 2000**

<i>Made</i>	- - - -	<i>23rd January 2000</i>
<i>Laid before Parliament</i>		<i>26th January 2000</i>
<i>Coming into force</i>	- -	<i>17th February 2000</i>

The Secretary of State, in exercise of the powers conferred by section 54 of the Trade Marks Act 1994<sup>(1)</sup> (“the Act”), hereby makes the following Order:—

1. This Order may be cited as the Trade Marks (International Registration) (Amendment) Order 2000 and shall come into force on 17th February 2000.

2. The Trade Marks (International Registration) Order 1996<sup>(2)</sup> is amended as set out in articles 3 to 11.

3. In article 2, for the definition of “the Rules” substitute—

““the Rules” means the Trade Marks Rules 2000<sup>(3)</sup> and references to a rule shall, unless the context otherwise requires, be construed accordingly;”.

4. In article 6, for paragraph (6) substitute—

“(6) “Prescribed particulars” means the particulars prescribed by rule 40.”.

5. In article 10—

(a) for paragraph (4) substitute—

“(4) Subject to paragraphs (4A) and (4B) below, within three months of the date on which notice of refusal based on opposition is given to the International Bureau, the holder may file a counter-statement, in conjunction with notice of the same on Form TM8 and an address for service in the United Kingdom.

(4A) Subject to paragraph (4B), at any time before the expiry of the period prescribed by paragraph (4) above for filing of Form TM8 by the holder the registrar may, on request, grant an extension of three months to that period where such request is filed on Form TM9c and with the agreement of both the holder and the opposing party (the “cooling off

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<sup>(1)</sup> 1994 c. 26.

<sup>(2)</sup> S.I. 1996/714.

<sup>(3)</sup> S.I. 2000/136.

period”); the registrar may, on request, extend the cooling off period for a further three months where such request is filed on Form TM9c and with the agreement of both the holder and the opposing party.

(4B) Within one month after the expiry of the cooling off period the holder may file a counter-statement, in conjunction with notice of the same on Form TM8 and an address for service in the United Kingdom.”;

(b) after paragraph (5) insert—

“(5A) The provisions of rule 36 (case management) and rule 37 (pre-hearing review) shall apply in relation to opposition proceedings.”.

6. In article 11,—

(a) for paragraph (4)(b)(i) substitute—

“(i) the holder files a counter-statement within the period specified in article 10(4) or 10(4B), or”;

(b) for paragraph (5)(b) substitute—

“(b) after notice of refusal based on an opposition, the holder files a counter-statement within the period specified in article 10(4) or 10(4B),”.

7. In article 12, for paragraph (1)(a)(iii) substitute—

“(iii) notice of refusal has been given in respect of some only of the goods or services in respect of which protection in the United Kingdom has been requested and the registrar informs the International Bureau in accordance with article 11(4) that the holder has made no representations within the period specified in article 9(4) or has filed no counter-statement within the period specified in article 10(4) or 10(4B) (as the case may be) or that the holder has informed the registrar that he does not intend to make such representations or file such a counter-statement, or”.

8. In article 13, for paragraph (4) substitute—

“(4) The provisions of rules 31, 32 and 33, with necessary modifications, apply respectively in relation to the procedure on application for revocation (on grounds of non-use), revocation (on grounds other than non-use) and declaration of invalidity of protection of a protected international trade mark (UK).

(4A) The provisions of rule 35 (intervention), rule 36 (case management) and rule 37 (pre-hearing review) apply in relation to a procedure on application for revocation (on grounds of non-use), revocation (on grounds other than non-use) and declaration of invalidity of protection of a protected international trade mark (UK).”.

9. In article 24, for paragraph (3) substitute—

“(3) Rules 40 to 45 apply, with the necessary modifications, in relation to the supplementary register.”.

10. In article 25, for paragraph (5) substitute—

“(5) Paragraphs (2) to (5) of rule 50, and rule 51, apply in relation to the right of inspection conferred by paragraph (3) above.”.

11. For the heading to Article 32 substitute—

**“Application of Trade Mark Rules 2000”.**

23rd January 2000

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

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## EXPLANATORY NOTE

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

This Order amends the Trade Marks (International Registration) Order 1996 (S.I. [1996/714](#)) as a consequence of the replacement of the Trade Marks Rules 1994 (S.I. [1994/2583](#)) by the Trade Mark Rules 2000 (S.I. [2000/136](#)) (“the Rules”). The amendments of substance made by this Order are as follows:

- (a) with the consent of both of the parties the registrar may grant a “cooling-off” period in actions for opposition to registration of an international trade mark (UK) under article 10(4)-(4B) (article 5);
- (b) provision has been made for the registrar to call case management conferences and pre-hearing reviews in relation to procedures on opposition proceedings and application for revocation (on grounds of non-use), revocation (on grounds other than non-use) and invalidity of protection of a protected international trade mark (UK) under article 13(4A) (articles 5 and 8);

Other changes relevant to the operation of the system provided for by the Trade Marks (International Registration) Order 1996 have been effected by the replacement of the Trade Marks Rules 1994 by the Trade Mark Rules 2000, in particular by virtue of the provisions of articles 3 and 11 of this Order, and article 32 of the 1996 Order. These include:

- (1) certain time limits in actions for revocation (on grounds other than non-use) and invalidity have been reduced from three months to six weeks (rules 32 and 33 of the Rules);
- (2) the time limit for appeal to the appointed person has been reduced from one month to 28 days (rule 63 of the Rules);
- (3) provision has been made for “filing” of a document with the registrar to mean delivery of that document to the registrar at the Office (rule 2 of the Rules);
- (4) where the Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may now be used as an alternative (rule 55 of the Rules);
- (5) provision has been made for the calling and cross-examination of persons in proceedings where a party has adduced evidence of a statement made by a person otherwise than while giving oral evidence in those proceedings and does not call that person as a witness (rule 55 of the Rules).