

**2004 No. 948**

**TRADE MARKS**

**The Trade Marks (International Registration) (Amendment)  
Order 2004**

*Made* - - - - - *28th March 2004*

*Laid before Parliament* *31st March 2004*

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

The Secretary of State, in exercise of the powers conferred on her by section 54 of the Trade Marks Act 1994(a), after consulting with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992(b), hereby makes the following Order:

1.—(1) This Order may be cited as the Trade Marks (International Registration) (Amendment) Order 2004.

(2) This Order shall come into force on 5th May 2004 immediately after the Trade Marks (Amendment) Rules 2004(c) have come into force.

2. The Trade Marks (International Registration) Order 1996(d) shall be amended as follows.

3. In article 3 (entitlement to protection) for the words “5 to 8” there shall be substituted “5 to 8A”.

4. After article 9 there shall be inserted—

**“9A Notifications by the International Bureau of vague, incomprehensible or linguistically incorrect terms**

(1) Where the International Bureau notifies the registrar, under Rule 13(2)(b) of the Common Regulations, that a particular term used to indicate any of the goods and services included in the international registration is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect then the registrar may give notice of provisional refusal to the International Bureau in respect of that term.

(2) Notice of provisional refusal shall specify a period within which the holder may make representations.

(3) A holder making representations shall file an address for service in the United Kingdom on Form TM33.”.

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(a) 1994 c. 26.  
(b) 1992 c. 53.  
(c) SI 2004/947.  
(d) SI 1996/714, amended by SI 2000/138 and SI 2002/692.

5. For article 10 (publication, opposition proceedings and observations) there shall be substituted—

**“10 Publication, notice of opposition and observations**

(1) Where following examination under article 9 it appears to the registrar that the requirements of article 3 (entitlement to protection) are met in relation to all or some of the goods or services included in the international registration, the registrar shall publish a notice specifying particulars of the international registration and specifying the goods and services for which protection ought to be conferred.

(2) Any person may, within three months of the date on which the notice was published under paragraph (1), give notice to the registrar of opposition to the conferring of protection.

(3) Where a notice has been published under paragraph (1), any person may, at any time before protection has been conferred on the trade mark in accordance with article 12, make observations in writing to the registrar as to whether the trade mark should be protected; and the registrar shall inform the holder of any such observations.

A person who makes observations does not thereby become a party to proceedings in relation to the request for protection.

**10A Opposition proceedings: filing of notice of opposition**

(1) Notice of opposition to the conferring of protection given under article 10(2) shall be on Form TM7 which shall include—

- (a) a statement of the grounds of opposition; and
- (b) an address for service in the United Kingdom.

(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 the notice was published under article 10(1), a statement detailing whether during the period referred to in section 6A(3)(a)(a) it 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(b) (which has effect by virtue of article 10C(2)) 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.

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

(b) Rules 13 to 13C were inserted into the Trade Marks Rules 2000 (SI 2000/136) by rule 7 of the Trade Marks (Amendment) Rules 2004.

(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 of opposition a representation of that mark or sign and the goods and services in respect of which such protection is claimed.

(5) Where notice of opposition has been given, the registrar shall, within four months of the notice being published under article 10(1), give notice of provisional refusal to the International Bureau stating the grounds on which the opposition to the conferring of protection is based.

(6) The registrar shall send a copy of Form TM7 to the holder and the date upon which this is done shall, for the purpose of article 10B, be the “notification date”.

### **10B Opposition proceedings: filing of counter-statement and cooling off period**

(1) The holder shall, within the relevant period, file a Form TM8 which shall include—

- (a) a counter-statement; and
- (b) an address for service in the United Kingdom,

otherwise the registrar shall notify the International Bureau that the provisional refusal has been upheld.

(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 holder and the person opposing the conferring of protection 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 is filed on Form TM9t by the person opposing the conferring of protection,

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 conferring of protection 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.

### **10C Opposition proceedings: application of the Trade Marks Rules 2000**

(1) The registrar shall send a copy of Form TM8 to the person opposing the conferring of protection and, unless rule 13B (preliminary indication) applies (by virtue of paragraph (2)), the date upon which this is sent shall, for the purposes of rule 13C (evidence rounds) (which applies by virtue of paragraph (2)), be the “initiation date”.

(2) Section 6A (raising of relative grounds in opposition proceedings in case of non-use) and rules 13B, 13C, 14 (decision of registrar in opposition proceedings), 36 (case management conference) and 37 (pre-hearing review) shall apply to the proceedings relating to the opposition to the conferring of protection as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

- (a) any reference to the applicant shall be construed as a reference to the holder;
- (b) any reference to the person opposing the registration shall be construed as a reference to the person opposing the conferring of protection;
- (c) any references to registration shall be construed as a reference to the conferring of protection;
- (d) any reference to the publication of the application shall be construed as a reference to publication of the notice under article 10(1);
- (e) any reference to an application for registration being deemed or treated as withdrawn shall be construed as meaning that the registrar shall notify the International Bureau that the provisional refusal has been upheld.”.

6. In article 11(4) (notices of provisional refusal) for the words “ or 10(3)” there shall be substituted “, 9A(1) or 10A(5)”.

7.—(1) Article 13 (revocation and invalidity) shall be amended as follows.

(2) After paragraph (1) there shall be inserted—

“(1A) An address for service in the United Kingdom shall be filed by—

- (a) every applicant applying to the registrar for an international trade mark (UK) to be revoked or to be declared invalid; and
- (b) the holder of a protected international trade mark (UK) which is subject to such proceedings.”.

(3) For paragraph (4) there shall be substituted—

“(4) The provisions of—

- (a) rules 31 to 31B apply in relation to the procedure on application for revocation on grounds of non-use;
- (b) rules 32 to 32B apply in relation to the procedure on application for revocation on grounds other than non-use; and
- (c) rules 33 to 33B apply in relation to the procedure on application for a declaration of invalidity;

save that any reference to the proprietor shall be construed to be a reference to the holder.”.

### **Transitional provisions**

8.—(1) Any proceedings commenced under article 10 of the unamended Order where the holder—

- (a) has not filed Form TM8 before 5th May 2004—
  - (i) shall proceed under the unamended Order until the date upon which Form TM8 is filed by the holder; and
  - (ii) shall proceed, subject to paragraph (2), under the amended Order from the point in time immediately after Form TM8 is filed;
- (b) has filed TM8 before 5th May 2004 shall proceed under the unamended Order; but where a new step is taken under such Order on or after 5th May 2004, the amended Order, subject to paragraph (2), shall apply to proceedings from the point in time immediately after that step is taken.

(2) Article 10C(2) shall not apply rule 13C(1)(b) of the Trade Marks Rules 2000 to any proceedings commenced before the coming into force of this Order.

(3) In this article—

“the unamended Order” means the Trade Marks (International Registration) Order 1996 in the form it was immediately prior to this Order coming into force;

“the amended Order” means the Trade Marks (International Registration) Order 1996 in the form it is after this Order has come into force.

28th March 2004

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

## **EXPLANATORY NOTE**

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

This Order amends the Trade Marks (International Registration) Order 1996 (SI 1996/714) (“the 1996 Order”). That Order gave effect in the United Kingdom to the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27th June 1989 which the United Kingdom ratified on 6th April 1995.

Article 3 of this Order amends article 3 of the 1996 Order. This amendment is consequential on the insertion of a new rule 8A into the Trade Marks Rules 2000 (SI 2000/136) (“the 2000 Rules”) by the Trade Marks (Amendment) Rules 2004 (SI 2004/947) (“the 2004 Rules”).

Article 4 of this Order inserts a new article 9A into the 1996 Order. The effect of this new article is to allow the registrar to give notice of provisional refusal to the International Bureau where any term used to indicate any of the goods and services in the International application is vague, incomprehensible or linguistically incorrect.

Article 5 of this Order substitutes new articles 10 to 10C for article 10 of the 1996 Order. The amendments reflect changes made to the opposition proceedings in respect of domestic applications for the registration of a trade mark by rules 13 to 13C of the 2000 Rules which were substituted for the previous rule 13 by the 2004 Rules.

Article 6 of this Order amends article 11 of the 1996 Order. This amendment is consequential on other changes made by this Order.

Article 7 of this Order amends article 13 of the 1996 Order. These amendments add a requirement for an address for service to be filed in invalidity and revocation cases. Further, they change references to the 2000 Rules so as to reflect the substitution of rules 31 to 33B of the 2000 Rules by the 2004 Rules.

Article 8 of this Order provides transitional provisions.

The Madrid Protocol is published as Cm 1601 Miscellaneous Series No. 14 (1991).

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.



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STATUTORY INSTRUMENTS

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