

2007 No. 2076

TRADE MARKS

The Trade Marks (Amendment) Rules 2007

<i>Made</i>	- - - -	<i>18th July 2007</i>
<i>Laid before Parliament</i>		<i>20th July 2007</i>
<i>Coming into force</i>	- -	<i>1st October 2007</i>

The Secretary of State makes the following Rules in exercise of the powers conferred by sections 76(1) and 78 of the Trade Marks Act 1994(a).

Citation and commencement

1. These Rules may be cited as the Trade Marks (Amendment) Rules 2007 and shall come into force on 1st October 2007.

Amendments to the Trade Mark Rules 2000

2. The Trade Marks Rules 2000(b) are amended as follows.
3. After rule 11, insert—

“Notifying results of search

11A.—(1) Where, following any search under Article 4 of the Trade Marks (Relative Grounds) Order 2007, it appears to the registrar that the requirements for registration mentioned in section 5 are not met, she shall notify this fact to—

- (a) the applicant; and
- (b) any relevant proprietor.

(2) In paragraph (1), “relevant proprietor” means—

- (a) the proprietor of a registered trade mark or international trade mark (UK) which is an earlier trade mark in relation to which it appears to the registrar that the conditions set out in section 5(1) or (2) obtain but does not include a proprietor who has notified the registrar that he does not wish to be notified; and
- (b) the proprietor of a Community trade mark or international trade mark (EC) which is an earlier trade mark in relation to which it appears to the registrar that the conditions set out in section 5(1) or (2) obtain and who has filed a request to be notified in relation to that mark in accordance with paragraph (4) below.

(a) 1994 c.26.

(b) SI 2000/136, amended by 2004/947; there are other amending instruments but none is relevant.

(3) References in paragraph (2) to the proprietor of a trade mark include a person who has applied for registration of a trade mark which, if registered, would be an earlier trade mark by virtue of section 6(1)(a) or (b).

(4) The proprietor of a Community trade mark or international trade mark (EC) may file a request to be notified in relation to that mark of the results of a notifiable search on Form TM6, which shall be filed electronically using the filing system provided on the Office website, or by such other means as the registrar may at her discretion permit in any particular case, and shall be subject to payment of the prescribed fee.

(5) In paragraph (4) a “notifiable search” means any search under Article 4 of the Trade Marks (Relative Grounds) Order 2007 conducted within the period of three years beginning with the date on which the request was filed.

(6) The filing of any request under paragraph (4) shall be subject to such terms or conditions as the registrar may specify generally by published notice or in any particular case by written notice to the person desiring to file the request otherwise than by electronic means.

(7) Rule 54 shall not apply to any decision made in pursuance of this rule.

(8) No decision made in pursuance of this rule shall be subject to appeal.”.

4.—(1) Rule 13 (opposition proceedings) shall be amended as follows—

(2) For paragraph (1) substitute—

“(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.

(1A) The time prescribed for the purposes of section 38(2) shall be the period of three months beginning with the date on which the application was published.”.

(3) Paragraph (2)(c) shall be omitted.

5. After rule 14, insert—

“Procedure for intervention

14A.—(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 she 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 13B, 13C, and 60 and shall be entitled to receive written notice of the decision of the registrar under Rule 14.

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

- (a) the licensee of an earlier trade mark included in the statement of the grounds of opposition; and
- (b) in the case of a collective mark or certification mark, the authorised user of an earlier collective mark or certification mark included in the statement of the grounds of opposition.”.

6. In rule 2(1), omit the entry for “proprietor”.

Transitional provisions

7. Rule 3 shall not apply to an application which was published before the coming into force of the Trade Marks (Relative Grounds) Order 2007^(a).

18th July 2007

Triesman
Parliamentary Under Secretary of State
for Intellectual Property and Quality
Department for Innovation, Universities and Skills

^(a) SI 2007/1976.

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Trade Mark Rules 2000 (SI 2000/136 as amended) (“the 2000 Rules”).

Rule 3 inserts a new rule 11A into the 2000 Rules. This new rule is consequential on the changes to the registration procedure under the Trade Marks Act 1994 (“the Act”) made by the Trade Marks (Relative Grounds) Order 2007 (SI 2007/1976) (“the 2007 Order”) under which the registrar shall no longer refuse to register a trade mark on relative grounds under section 5 of the Act unless the proprietor of the earlier trade mark or other earlier right objects on any such ground in opposition proceedings. Under this rule the registrar is required to notify the applicant and the proprietor of any earlier trade mark where it appears from a search of earlier trade marks that the requirements for registration under section 5 of the Act are not met. However, the registrar is not required to notify a proprietor of an earlier registered trade mark or international trade mark (UK) who has confirmed that he does not wish to receive notifications and is only required to notify a proprietor of an earlier Community trade mark or international trade mark (EC) if he has opted to receive notifications by electronically filing a request on form TM6.

Rule 4 amends rule 13 of the 2000 Rules and is consequential on the changes made by the 2007 Order. It also removes the requirement to specify in a notice of opposition (form TM7) the classes in respect of which the mark is registered.

Rule 5 inserts a new rule 14A into the 2000 Rules. This new rule permits the licensee of an earlier trade mark or the authorised user of an earlier collective mark or certification mark to apply to the registrar for leave to intervene in opposition proceedings where such proceedings are based on the relative grounds for refusal in section 5 of the Act.

Rule 6 deletes the definition of “proprietor” from the 2000 Rules so as to render references to the proprietor in the 2000 Rules consistent with its usage in the Act.

Rule 7 provides transitional provisions.

A full regulatory impact assessment of the effect that this instrument will have on the costs of business and the voluntary sector is available from the UK Intellectual Property Office, Room 2B36, Concept House, Cardiff Road, Newport, NP10 8QQ and is annexed to the Explanatory Memorandum which is available alongside the instrument on the OPSI website.

£3.00

© Crown copyright 2007

Printed and published in the UK by The Stationery Office Limited
under the authority and superintendence of Carol Tullo, Controller of Her Majesty's
Stationery Office and Queen's Printer of Acts of Parliament.

E1065 7/2007 171065T 19585