
STATUTORY INSTRUMENTS

2004 No. 948

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

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

“Publication, notice of opposition and observations

10.—(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.

Opposition proceedings: filing of notice of opposition

10A.—(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)(1) 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(2) (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.

(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”.

Opposition proceedings: filing of counter-statement and cooling off period

10B.—(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

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

(2) 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.

- (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.

Opposition proceedings: application of the Trade Marks Rules 2000

10C.—(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.”.