
STATUTORY INSTRUMENTS

2008 No. 1797

The Trade Marks Rules 2008

Revocation, invalidation and rectification

Application for revocation (on the grounds of non-use); section 46(1)(a) or (b) (Forms TM8(N) & TM26(N))

38.—(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N).

(2) The registrar shall send a copy of Form TM26(N) to the proprietor.

(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

(4) Where the proprietor fails to file evidence of use of the mark or evidence supporting the reasons for non-use of the mark within the period specified in paragraph (3) above the registrar shall specify a further period of not less than two months within which the evidence shall be filed.

(5) The registrar shall send a copy of Form TM8(N) and any evidence of use, or evidence supporting reasons for non-use, filed by the proprietor to the applicant.

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.

(7) Where the proprietor fails to file evidence within the period specified under paragraph (3) or any further period specified under paragraph (4), the registrar may treat the proprietor as not opposing the application and the registration of the mark shall, unless the registrar directs otherwise, be revoked.

(8) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

Application for revocation (on grounds other than non-use); section 46(1)(c) or (d) (Forms TM8 & TM26(O))

39.—(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(c) or (d), shall be made on Form TM26(O) and shall include a statement of the grounds on which the application is made and be accompanied by a statement of truth.

(2) The registrar shall send a copy of Form TM26(O) and the statement of the grounds on which the application is made to the proprietor.

(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(O) and the statement by the registrar, file a Form TM8 which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and the registration of the mark shall, unless the registrar directs otherwise, be revoked.

(4) The registrar shall send a copy of Form TM8 to the applicant.

Application for revocation (on grounds other than non-use): evidence rounds

40.—(1) Where the applicant has filed a Form TM8, the registrar shall specify the periods within which further evidence may be filed by the parties.

(2) Where the applicant files no further evidence in support of the application the applicant, shall, unless the registrar otherwise directs, be deemed to have withdrawn the application.

(3) The registrar shall notify the proprietor of any direction given under paragraph (2).

(4) The registrar may, at any time give leave to either party to file evidence upon such terms as the registrar thinks fit.

Application for invalidation: filing of application and counter-statement; section 47 (Forms TM8 & TM26(I))

41.—(1) An application to the registrar for a declaration of invalidity under section 47 shall be filed on Form TM26(I) and shall include a statement of the grounds on which the application is made and be accompanied by a statement of truth.

(2) Where the application is based on a trade mark which has been registered, there shall be included in the statement of the grounds on which the application is made 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 goods and services in respect of which—
 - (i) that mark is registered, and
 - (ii) the application is based; and
- (d) where neither section 47(2A)(a) nor (b) applies to the mark, a statement detailing whether during the period referred to in section 47(2B)(a) it has been put to genuine use in relation to each of the goods and services in respect of which the application is based or whether there are proper reasons for non-use (for the purposes of rule 42 this is the “statement of use”).

(3) Where the application 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 on which the application is made a representation of that mark and those matters set out in paragraph (2)(a) to (c), with references to registration being construed as references to the application for registration.

(4) Where the application is based on an unregistered trade mark or other sign which the applicant 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 on which the application is made a representation of that mark or sign and the goods and services in respect of which such protection is claimed.

(5) The registrar shall send a copy of Form TM26(I) and the statement of the grounds on which the application is made to the proprietor.

(6) The proprietor shall, within two months of the date on which a copy of Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.

(7) The registrar shall send a copy of Form TM8 to the applicant.

Application for invalidation: evidence rounds

42.—(1) Where the proprietor has filed Form TM8, the registrar shall send notice to the applicant inviting the applicant to file evidence in support of the grounds on which the application is made and any submissions and to send a copy to all the other parties.

(2) The registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(3) Where—

- (a) the application is based on an earlier trade mark of a kind falling within section 6(1)(c); or
- (b) the application or part of it is based on grounds other than those set out in section 5(1) or (2); or
- (c) the truth of a matter set out in the statement of use is either denied or not admitted by the proprietor,

the applicant shall file evidence supporting the application.

(4) Where the applicant files no evidence under paragraph (3), the applicant shall be deemed to have withdrawn the application to the extent that it is based on—

- (a) the matters in paragraph (3)(a) or (b); or
- (b) an earlier trade mark which has been registered and is the subject of the statement of use referred to in paragraph (3)(c).

(5) The registrar may, at any time give leave to either party to file evidence upon such terms as the registrar thinks fit.

Setting aside cancellation of application or revocation or invalidation of registration; (Form TM29)

43.—(1) This rule applies where—

- (a) an application for registration is treated as abandoned under rule 18(2);
- (b) the registration of a mark is revoked under rule 38(6) or rule 39(3); or
- (c) the registration of a mark is declared invalid under rule 41(6),

and the applicant or the proprietor (as the case may be) claims that the decision of the registrar to treat the application as abandoned or revoke the registration of the mark or declare the mark invalid (as the case may be) (“the original decision”) should be set aside on the grounds set out in paragraph (3).

(2) Where this rule applies, the applicant or the proprietor shall, within a period of six months beginning with the date that the application was refused or the register was amended to reflect the revocation or the declaration of invalidity (as the case may be), file an application on Form TM29 to set aside the decision of the registrar and shall include evidence in support of the application and shall copy the form and the evidence to the other party to the original proceedings under the rules referred to in paragraph (1).

(3) Where the applicant or the proprietor demonstrates to the reasonable satisfaction of the registrar that the failure to file Form TM8 within the period specified in the rules referred to in paragraph (1) was due to a failure to receive Form TM7, Form TM26(N), Form TM26(O) or Form TM26(I) (as the case may be), the original decision may be set aside on such terms and conditions as the registrar thinks fit.

(4) In considering whether to set aside the original decision the matters to which the registrar must have regard include whether the person seeking to set aside the decision made an application to do so promptly upon becoming aware of the original decision and any prejudice which may be caused to the other party to the original proceedings if the original decision were to be set aside.

Procedure on application for rectification; section 64 (Form TM26(R))

44.—(1) An application for rectification of an error or omission in the register under section 64(1) shall be made on Form TM26(R) together with:

- (a) a statement of the grounds on which the application is made; and
- (b) any evidence to support those grounds.

(2) Where any application is made under paragraph (1) by a person other than the proprietor of the registered trade mark the registrar—

- (a) shall send a copy of the application and the statement, together with any evidence filed, to the proprietor; and
- (b) may give such direction with regard to the filing of subsequent evidence and upon such terms as the registrar thinks fit.

Procedure for intervention

45.—(1) Any person, other than the registered proprietor, claiming to have an interest in proceedings on an application under rule 38, 39, 41 or 44, may file an application to the registrar on Form TM27 for leave to intervene, stating the nature of the person's interest and the registrar may, after hearing the parties concerned if they request a hearing, refuse leave or grant leave upon such terms and conditions (including any undertaking as to costs) as the registrar 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 38 to 40, 41 and 42 or 44 (as appropriate) and rules 62 to 73.