
STATUTORY INSTRUMENTS

2018 No. 825

The Trade Marks Regulations 2018

PART 3

Amendments to the Rules

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34. The Rules are amended in accordance with regulations 35 to 43.

Application for registration: section 32 (Form TM3)

35. For rule 5(6) substitute—

“(6) The Registrar may at any time—

- (a) suspend the right of applicants to file a request for expedited examination under paragraph (2) (“the expedited examination service”) for such period as the registrar deems fit; and
- (b) resume the expedited examination service.

(7) Where the registrar suspends or resumes the expedited examination service pursuant to paragraph (6), the registrar must publish a notice on the Office website—

- (a) of the date from which the expedited examination service is suspended;
- (b) of the date upon which the expedited examination service will resume.”.

Application may relate to more than one class and shall specify the class (Form TM3A)

36.—(1) Rule 8 is amended as follows.

(2) In paragraph (2)(b) omit “in such a way as to indicate clearly the nature of those goods or services” and insert “with sufficient clarity and precision to enable the registrar and other competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought”.

(3) After paragraph (2) insert—

“(2A) For the purposes of paragraph (2)(b) an application may specify the general indications included in the class headings of the Nice Classification or other general terms provided that they satisfy the requirement that the goods or services be described with sufficient clarity and precision referred to in paragraph (2)(b).

(2B) Where the specification contained in the application describes the goods or services using general terms, including the general indications included in the class headings of the Nice Classification, the application shall be treated as including only the goods or services clearly covered by the literal meaning of the term or indication.”.

(4) After paragraph (4) insert—

“(5) In this rule “economic operators” means any person or group of persons which, in the course of trade, manufactures, supplies, imports, exports or otherwise deals in goods or services.”.

Determination of classification

37. In rule 9(3)—

- (a) after “under paragraph (2),” insert “the registrar must reject”; and
- (b) omit “, shall be treated as abandoned”.

Opposition proceedings: filing of notice of opposition

38. In rules 17(5)(d) and 17A(6)(e) for “date of publication” substitute “date of application for registration or, if any, the date of priority”.

Division of registration

39. After rule 26 insert—

“26A Division of registration; section 41 (Form TM12R)

(1) The proprietor of a trade mark may send to the registrar a request on Form TM12R to divide the specification of the registration (the original registration) into two or more separate trade marks (divisional registrations), indicating for each divisional registration the specification of goods or services.

(2) Each divisional registration must be treated as a separate registration with the same date of registration as the original registration.

(3) No request under paragraph (1) may be granted in respect of the registration of a trade mark which is the subject of proceedings for its revocation or invalidation, where the request would introduce a division amongst the goods or services in respect of which the proceedings are directed.

(4) Where the original registration is subject to a disclaimer or limitation, the divisional registrations must also be restricted accordingly.

(5) Where the original registration has had registered in relation to it particulars relating to—

- (a) the grant of a licence;
- (b) a security interest;
- (c) any right in or under that original registration; or
- (d) any memorandum or statement of the effect of a memorandum;

the registrar must enter in the register the same particulars in relation to each of the divisional registrations into which the original registration has been divided.”.

Reminder of renewal of registration; section 43

40.—(1) Rule 34 is amended as follows.

(2) In paragraph (1)—

- (a) omit “at any time not earlier than six months nor later than one month” and substitute “at least six months”;
- (b) omit “(except where renewal has already been affected under rule 35)”.

(3) After paragraph (2) insert—

“(2A) The registrar is not subject to any liability by reason of any failure to notify the proprietor in accordance with paragraph (1) and no proceedings lie against any officer of the registrar in respect of any such failure.”.

Renewal of registration; section 43 (Form TM11)

41. In rule 35, after “expiration of the registration” insert “or following receipt of a notice from the registrar pursuant to rule 34(1)”.

Restoration of registration; section 43 (Form TM13)

42.—(1) Rule 37 is amended as follows.

(2) In paragraph (1) omit “if, having regard to the circumstances of the failure to renew, the registrar is satisfied that it is just to do so” and substitute “if the registrar is satisfied that the failure to renew was unintentional”.

(3) After paragraph (1) insert—

“(1A) Where a mark is restored to the register, the proprietor of the mark may not bring an action for infringement against a third party who, in good faith, has put goods on the market or supplied services under a sign which is identical with or similar to the mark in respect of the period beginning with the date of expiration of the registration and ending on the date its restoration is published in accordance with paragraph (2).”.

Entry in register of particulars of registered trade marks; section 63(2) (Form TM24)

43. In Rule 47, after paragraph (l) insert—

“(m) where the mark is a collective mark and amended regulations have been accepted by the registrar, that fact, including the date of that entry.”.