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STATUTORY INSTRUMENTS

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**2000 No. 136**

**The Trade Marks Rules 2000**

***Publication, observations, oppositions and registration***

*Opposition proceedings; s. 38(2) (Forms TM7, TM8 & TM9c)*

**13.**—(1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicant.

- (2) Where the opposition is based on an earlier trade mark there shall be included in the notice:
- (a) a representation of that mark; and
  - (b) if registered, the classes in respect of which that mark is registered; and
  - (c) the goods and services in respect of which that mark is registered, or if not registered, used; and
  - (d) where the earlier mark is defined in section 6(1)(a) and (b),
    - (i) the application and/or registration number(s) of that mark, and
    - (ii) except in the case of a mark the subject of an application not yet published, the number of the publication in which it was published.

(3) Subject to paragraphs (4) and (5) below, within three months of the date on which a copy of the notice and statement is sent by the registrar to the applicant, the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(4) Subject to paragraph (5), at any time before the expiry of the period prescribed in paragraph (3) above for filing of Form TM8 by the applicant the registrar may, on request, grant an extension of three months to that period where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party (the “cooling off period”); the registrar may, on request, extend the cooling off period for a further three months where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party.

(5) Within one month after the expiry of the cooling off period the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within that one month period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(6) Where a notice and counter-statement are not filed by the applicant within the period prescribed by paragraph (3) or paragraph (5) as appropriate, he shall be deemed to have withdrawn his application for registration.

(7) Within three months of the date upon which a copy of the counter-statement is sent by the registrar to the person opposing the registration, that person may file such evidence as he may consider necessary to adduce in support of his grounds of opposition and shall send a copy thereof to the applicant.

(8) If the person opposing the registration files no evidence under paragraph (7) above in support of his grounds of opposition, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his opposition.

(9) If the person opposing the registration files evidence under paragraph (7) above or the registrar otherwise directs under paragraph (8) above, the applicant who has filed a notice and counter-statement under paragraph (3) or paragraph (5) as appropriate above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary to adduce in support of his application for registration and shall send a copy thereof to the person opposing the application.

(10) Within three months of the date upon which a copy of the applicant's evidence is sent to him under paragraph (9) above, the person opposing the application may file evidence in reply which shall be confined to matters strictly in reply to the applicant's evidence, and shall send a copy thereof to the applicant.

(11) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(12) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.