
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.

Commencement Information

II [Rule 38](#) in force at 1.10.2008, see [rule 1](#)

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.

Commencement Information

I2 Rule 39 in force at 1.10.2008, see [rule 1](#)

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

40.—(1) Where the [^{F1}proprietor] 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.

Textual Amendments

F1 Word in rule 40(1) substituted (1.10.2008) by [The Trade Marks \(Amendment\) Rules 2008 \(S.I. 2008/2300\)](#), [rules 1, 2](#)

Commencement Information

I3 Rule 40 in force at 1.10.2008, see [rule 1](#)

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.

Commencement Information

I4 [Rule 41](#) in force at 1.10.2008, see [rule 1](#)

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.

Commencement Information

I5 [Rule 42](#) in force at 1.10.2008, see [rule 1](#)

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)^{[F2];}
- (c) the registration of a mark is declared invalid under rule 41(6) ^{[F3];} or
- ^[F4](d) the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent under rule 43A(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 ^[F5]beginning immediately after] 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 ^[F6], in the cases referred to in paragraph (1)(a) to (c),] 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 ^[F7]or the derogation notice] 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) ^{[F8];} Form TM26(I) ^[F9]or notification from the registrar under rule 43(4)(b) that the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM] (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.

Textual Amendments

- F2** Rule 43(1)(b): semicolon substituted for word by S.I. 2019/269, **Sch. 4 para. 10A(2)** (as inserted by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**)
- F3** Word in rule 43(1)(c) substituted for comma (31.12.2020) by S.I. 2019/269, **Sch. 4 para. 10A(3)** (as inserted by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**)
- F4** Rule 43(1)(d) inserted by S.I. 2019/269, **Sch. 4 para. 10A(4)** (as inserted by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**)
- F5** Words in rule 43(2) substituted (31.3.2013) by [The Trade Marks and Registered Designs \(Amendment\) Rules 2013 \(S.I. 2013/444\)](#), rules 1, 4, **Sch. 1** (with rule 8)
- F6** Words in rule 43(2) inserted (31.12.2020) by S.I. 2019/269, **Sch. 4 para. 10A(5)** (as inserted by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**)
- F7** Words in rule 43(3) inserted (31.12.2020) by S.I. 2019/269, **Sch. 4 para. 10A(6)(a)** (as inserted by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**)
- F8** Word in rule 43(3) substituted (31.12.2020) by virtue of S.I. 2019/269, **Sch. 4 para. 10A(6)(b)** (as inserted by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**)

F9 Words in rule 43(3) inserted (31.12.2020) by S.I. 2019/269, **Sch. 4 para. 10A(6)(c)** (as inserted by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), **11(c)**)

Commencement Information

I6 Rule 43 in force at 1.10.2008, see **rule 1**

[F10]Invalidation or revocation of Existing EUTM: Cancellation notice and procedure on application for derogation; Schedule 2A paragraph 21A

43A.—(1) A cancellation notice under paragraph 21A of Schedule 2A must—

- (a) identify the existing EUTM by the number under which the existing EUTM was registered in the EUTM Register immediately before IP completion day, together with a representation of the mark,
- (b) include the following details with regard to the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially)—
 - (i) the date of the decision (including any decision determined on appeal),
 - (ii) whether the revocation or declaration of invalidity related to all or part of the goods or services for which the existing EUTM was registered,
 - (iii) where the existing EUTM was revoked (whether wholly or partially) the date on which the revocation took effect,
- (c) be accompanied by a copy of the decision (including any decision determined on appeal) pursuant to which the existing EUTM was revoked or declared to be invalid, and
- (d) include a statement confirming that the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially) has been finally determined.

(2) Where a cancellation notice is submitted to the registrar by the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the cancellation notice must be accompanied by—

- (a) a notice (a “derogation notice”) in writing to the registrar that, based upon the provisions in paragraph 21A(4) of Schedule 2A, the comparable trade mark (EU) should not be revoked or declared invalid (whether wholly or partially), and
- (b) a statement of the reasons why paragraph 21A(4) of Schedule 2A applies (a “statement”) together with relevant supporting evidence (“supporting evidence”).

(3) Where the proprietor of a comparable trade mark (EU) submits a cancellation notice to the registrar but fails to send a derogation notice, a statement or supporting evidence, the registration of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice must be revoked or declared invalid to the same extent as the existing EUTM, unless the registrar directs otherwise.

(4) Where the registrar receives a cancellation notice submitted by a person other than the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the registrar must as soon as reasonably practicable after receipt of the cancellation notice—

- (a) send a copy of the cancellation notice to the proprietor of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice, and
- (b) notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM that based upon the revocation or declaration of invalidity of the existing EUTM, the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM.

(5) Where the registrar has become aware of the situation referred to in paragraph 21A(2)(a) of Schedule 2A otherwise than by a cancellation notice, the registrar must as soon as reasonably practicable after becoming aware of that situation, notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM in the terms provided in paragraph (4)(b).

(6) The proprietor of a comparable trade mark (EU) referred to in paragraph (4) and (5) must, within such period of not less than one month as may be specified in the notice referred to in paragraph (4)(b) and (5), send to the registrar a derogation notice accompanied by a statement and supporting evidence as referred to in paragraph (2), failing which the registration of the comparable trade mark (EU) must be revoked or declared invalid to the same extent as the corresponding EUTM, unless the registrar directs otherwise.

(7) The registrar must, in reaching a decision as to whether paragraph 21A(4) of Schedule 2A applies to a comparable trade mark (EU), have regard to the statement and supporting evidence filed by the proprietor of the comparable trade mark (EU) and must send written notice of the decision to the proprietor, stating the reasons for that decision.

(8) For the purposes of any appeal against a decision referred to in sub-paragraph (7), the date on which the notice is sent must be taken to be the date of the decision.]

Textual Amendments

F10 Rule 43A inserted by S.I. 2019/269, Sch. 4 para. 10B (as inserted by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), 11(c))

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.

Commencement Information

I7 Rule 44 in force at 1.10.2008, see rule 1

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.

Commencement Information

18 [Rule 45](#) in force at 1.10.2008, see [rule 1](#)

Changes to legislation:

There are currently no known outstanding effects for the The Trade Marks Rules 2008, Cross
Heading: Revocation, invalidation and rectification.