

The Trade Mark Rules 2008: all change please!



A new Statutory Instrument laid before Parliament on 8 July 2008 will bring into effect a raft of amendments to the workings of the UK Intellectual Property Office's Trade Marks Registry. The provisions affect owners of trade marks, anyone wishing to register a trade mark, and anyone dealing with owners of applicants for a registered mark.

Michael Barrett reports...

The updating process has not received as much attention as it might have, given the scope and importance of the amendments being made. A consultation paper on the future of the Trade Marks Rules 2000 (which currently govern Trade Marks Registry proceedings) and, in particular, on various draft amendments to a number of the present Rules, was published by the UK Intellectual Property Office in March 2008.

The consultation attached a full redraft of the Trade Marks Rules for comment. Practitioners were polled for their views on the paper/redraft of the Rules in the ensuing 12 weeks and, once this process was complete, the consultation closed on 27 May 2008.

A Response document published on 8 July 2008 has now indicated that the existing Rules (which came into force in 2000 and have been amended seven times since then!) will undergo a number of important changes. The Response sets these out in detail and the new Rules, the Trade Mark Rules 2008, come into effect on

1 October 2008 (and are available, together with an Explanatory Memorandum, published through OPSI under SI 2008 No 1797).

The purpose of the new statutory instrument is to consolidate existing changes to the 2000 Rules, bring into force the best practice on retrospective extensions of time required under the Singapore Treaty (which the UK adopted on 27 March 2006), to make the tribunal system more "flexible, efficient and proportionate" and to increase the speed and efficiency overall of proceedings before the Registry.

The key changes can summarised as follows:

1. Fast-track examinations

These changes were first introduced by the Trade Marks and Trade Marks (Fees) (Amendment) Rules 2008 and took effect on 1 April 2008. The provisions have now been introduced into the present Statutory Instrument as a consolidation of those Rules on "fast-track examination". Under the procedures (which the Registry brought into effect on 7 April) an

application for registration of a single trade mark (ie, not a series mark) can be "fast-tracked" if the applicant:

- files on-line through the UK IPO's website system; and
- pays in full, at the time of filing, the enhanced application fee (by debit/credit card or via a firm's deposit account with the UK-IPO).

For an "enhanced" fee of £300 (paid as a one-off fee in addition to the normal £200 application fee and £50 per class fee required for every class applied for beyond the first) the fast-track offers an applicant a right to receive an examination report from the Registry within ten business days. Rule 5 of the draft statutory instrument sets out the new position on the expedited examination procedure.

2. A reduction of the opposition period and changes to the cooling-off procedure

Currently third parties are allowed to oppose an application for registration of a trade mark in the three-month period following publication.

According to guidance issued by the UK IPO "more than 90% of trade marks face no opposition". OPSI's Explanatory Memorandum on the new Rules makes the same point, adding "This means the registration of these marks is delayed by three months unnecessarily". A decision has therefore been taken to reduce the opposition period to two months. This period is comparable to that offered by a number of other national trade mark registries in the EU such as France, Benelux and Spain (although, in the case of Spain, the period of opposition is timed to follow the completion of the registry's examination for formalities, and substantive examination only follows conclusion of the opposition period).

However, under the new UK Rules, a third party contemplating lodging an opposition against an application will be able to apply (during the initial two months allowed for raising opposition) for a (free) extension (of one month) to the opposition period. If extended, the opposition period therefore becomes three months (running from the date of publication) as at present.

If no notice of opposition is received by the Registry in the two-month period, the application will proceed immediately to registration.

Interestingly, the extension request shall need to be made via a “no cost” on-line filing of new Form TM7a (which the Response, at present, suggests will need to be copied to the applicant or his representative by the opponent). This, of course, means that applicants may receive notice of an imminent opposition in advance of an actual opposition notice being filed upon them.

The advantage for the bulk of applicants for UK trade mark registrations is that the new Rules will accelerate the registration process. Potential opponents should now gear themselves up to keep a more vigilant watch over new applications for registration of marks against which they might wish to object.

Other minor changes (such as removal of the requirement to include, in a statement of grounds, the classes for which the earlier mark is registered) have been drafted into the new Statutory Instrument as well. Subject to the cooling off period (see below) the period now allowed to an applicant for registration of a mark to file a counterstatement has been reduced from three months to two months.

The other major change that has been made to the opposition process is a change in the length of the “cooling-off period” (the time allowed for the parties to arrive at a negotiated settlement after an opposition notice has been filed). The new Rules now set the cooling off period at nine months (initially) but allow for the possibility of an extension of the period to 18 months (with consent of the other party to the opposition). This falls short of the 24-month cooling off period allowed by the Community Trade Marks Office.

It will be a relief to professional advisers and their clients that the Registry’s initial proposals ((a) that there be confirmation by the parties that negotiations are under way by the time the “nine-to-18 months” extension request (on Form TM9e) is filed and (b) that the confirmation

be accompanied by a statement of truth) have now been narrowed so that a statement of truth is not a requirement.

3. Treatment of the preliminary indication in opposition proceedings

The new Rules seem to have “dropped” the present provision (in Rule 13B(4)(b)(ii)) allowing the applicant two months from the so-called “indication date” (the date that the Registrar sends to both parties his preliminary indication as to whether or not the mark should be registered) to limit his/her specification to goods/services which the Registrar deems acceptable for registration. Accordingly, the applicant’s options are now narrowed so that he/she has to file a notice of continuance and this must be filed within one month from the indication date. There are also technical changes (which cannot be dealt with here) concerning preliminary indications adverse to an opponent.

4. Time periods relating to other forms of opposition

The regulations contained in the Statutory Instrument propose corresponding reductions of deadlines (from three to two months) for filing oppositions to the following:

- amendment of the regulations governing a collective or certification mark (new Rule 30);
- alteration of registered trade marks (new Rule 32);
- removal of material from the Register (new Rule 33); and
- proposals for a change to classification (new Rule 35).

5. Periods for filing counter-statements including late filing

The period for filing counter-statements (presently three months for an opposition, but only six weeks for the proprietor in a post-registration invalidation or an action for revocation on grounds other than non-use) have been harmonised with the equivalent period proposed by the new Rules in opposition proceedings (see above) at two months. Thus, from October, two months will become the standard timeframe allowed for filing counter-statements (or “defences”) in

opposition, invalidation and revocation proceedings. In the case of revocation proceedings, the two-month time frame for filing of counterstatements will apply to all revocations brought under Section 46(1) of the 1994 Act (ie, to non-use revocations and revocations on grounds other than non-use alike).

There will also be a discretion available to the Registrar to allow defences to be filed up to six months late. New Rule 43 allows defendants (in opposition, invalidity and revocation proceedings) who become aware (in the six-month period following expiry of the deadline for filing a counterstatement) that an action has been brought against them (and who have consequently failed to file their defence “in time”) as a result of not having received notice of the proceedings, to apply for relief and have their late-filed defence admitted. The defendant will have to show the Registry that he/she acted “promptly” upon becoming aware of the original decision against him/her and the Registry will need to be satisfied that the applicant is not “prejudiced” by the late admission of the defence.

6. Evidence and case management

Under the new Rules, the Registrar is given express power to set a timetable for filing of evidence by the parties and to manage proceedings. He is also given power to decide which issues require evidence to be adduced, the sort of evidence that is to be adduced and the form in which it is to be adduced (new Rules 62 and 64).

7. Applications for revocation based on non-use

The Statutory Instrument appears to have “dropped” the need for a Statement of Grounds to accompany the initial application (on Form TM26(N)). The reason for this is that the Registry has been preparing a new form TM26(N) which will include fields to be completed by the applicant alleging periods of non-use in relation to particular goods/services in the registration. The form will also include a box inviting the applicant to state further grounds for non-use revocation.

Accordingly the only requirement under the new Rules will be to complete Form TM26(N), which will include all possible grounds that an applicant could wish to cite.

The next point to note is that the proprietor has two months (reduced from three months) from when he receives a copy of the TM26(N) from the Registrar to file a counter statement on Form TM8N (see above).

No longer need the trade mark proprietor lodge two copies of the evidence of use of his mark or, or in the alternative, reasons for non-use of the mark under cover of the Form TM8/counter statement. Instead the new Rules drop the need for the proprietor to file evidence with its defence. The proprietor will now be allowed a further two months (from the end of the two months referred to above for filing the TM8N – note the new denomination of this form!) to file its evidence. This effectively extends to four months the period allowed for filing of evidence pursuant to the defence. This will be welcome news to trade mark owners as previously the deadline was a (non-extendable) three months.

Another obvious change introduced by the statutory instrument is that the trade mark proprietor no longer enjoys the luxury of filing its evidence of use to support the existence of its trade mark at more than one stage of the proceedings. Under the old Rules the proprietor was the party first required to cite evidence of use/reasons for non-use. The applicant for revocation was then entitled to file evidence in support of its application to revoke. The proprietor then had a further opportunity to file evidence in support and, finally, the applicant for revocation was entitled to file further evidence strictly in reply to the proprietor's evidence.

Accordingly, the new Rules have abbreviated the four rounds of evidence previously available to the parties. From October, the trade mark owner has only one opportunity to file evidence of use in support of its defence, and the applicant has one opportunity to file evidence in reply (to be filed, according to the Registry, within one month of receipt of the

owner's evidence; there is no direct rule on this point but the right to file evidence in reply will fall within Rule 38(8): "The Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit").

The owner will have one further opportunity to file evidence (and, as above, this right will derive from Rule 38(8); according to the Registry's current proposals, this will have to be filed within a further one month).

More detailed rules on what may be called second and third rounds of evidence will be set out in due course in a Registry Practice Notice.

In summary, the maximum number of evidence rounds possible will be three (and not four as present) and the proprietor will be given the final say (so far as filing of evidence is concerned) and not the applicant, as at present.

8. Procedural appeals

From 1 October 2008, an appeal made prior to a "final decision" in contentious proceedings before the Registry may only be made with the leave of the Registrar. This is a change from the present position where an appeal may be lodged as of right from any (including any procedural) decision of the Registrar. New Rule 70 sets out the details and the Registry has indicated that the length and cost of proceedings should be reduced in the longer term.

9. Extension of time limits in ex parte proceedings and the Singapore Treaty

Under Article 14 of the Singapore Treaty (to which the UK acceded in March 2006 as one of the initial signatories), participating states were required to offer reliefs to those who failed to meet time limits in ex parte proceedings (not including appeals) before a Registry. Accordingly an applicant will have the right to an extension of time to complete an action begun before a Registry subject to (a) making an extension of time request (on Form TM9) within two months of the deadline expiring and (b) paying a £50 filing fee. New Rule 77 sets out the position.

10. Remedying deficiencies in an application for registration

This has been reduced from two months to "a period of not less than one month" determined by the Registrar. New Rule 13 clarifies the position.

11. Determination of classification

Representatives will be familiar with Rules 8A and 11 of the Trade Marks Rules 2000 which allow applicants for trade mark registrations a period of two months to respond to classification objections from the Registry under Rule 8. This will change from October. Under new Rule 9, any failure to provide the goods/services in the application and the class to which they belong or which fails to group the goods/services into relevant class numbers shall receive an objection. Under new Rule 9 the applicant must respond to such objection within a period of not less than one month as the Registrar shall specify.

12. Respondent's notice in appeals to the Appointed Person

The informal current practice of allowing the respondent to set out formal reasons why the Registrar's decision should not be overturned on appeal has been formalised in Rule 71.

13. Other minor amendments

These include changes to Rules governing evidence in support of a claim to priority (such that the UK-IPO shall soon be able to verify priority claims using means not previously allowed). Also (in line with OHIM practice) formal certification may not be required for all claims.

Proposed amendments not contained in the final form of the Statutory Instrument

Interestingly, one key proposal that has not made its way forwards from the draft consultation paper into the new Rules is a provision permitting addresses for service anywhere in the EEA and Channel Islands in respect of dealings (both contentious and non-contentious) before the UKIPO. It seems as if the objections of representatives have here, at least, carried the day!

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