

Guidance notes on the Trade Marks Rules 2008

Introduction

The Trade Marks Rules are the main piece of secondary legislation governing the process and administration of the trade marks system. The current Rules came into force in 2000 and have been amended seven times since then. From 1 October these Rules will be replaced with the Trade Mark Rules 2008, this consolidation will make the rules more accessible and remove existing duplication and inconsistencies, in addition they will also include a number of policy changes.

What will change?

1. Opposition period

The process of application will be unaffected. The first and most significant change for most users is to the period following publication where a third party may oppose the registration of a trade mark. At present a fixed period of three months is allowed, however, more than 90% of trade marks face no opposition. We have therefore decided to change this period to two months initially, should a third party still be considering opposing an application at this stage they can apply for a free extension to the opposition period allowing them an additional one month in which to file their opposition. This change will accelerate the registration of most trade mark applications by one month.

2. Cooling off period

We currently provide a cooling off period of 12 months for parties to negotiate after an opposition to registration has been filed. Anecdotal evidence indicates that this cooling off period is effective as many cases are resolved in this period, however, for some cases 12 months is not sufficient, and for others it is longer than required. The new rules will split the cooling off period, allowing 9 months initially, with an option of extending the period to 18 months on request by both parties.

3. Extensions of time in matters before UK-IPO

The UK signed the Singapore Treaty on Trade Mark Law in 2006. This treaty sets out international best practice, which UK-IPO supports. In order to comply in full the new Rules provide trade mark applicants and proprietors with the right to a retrospective extension of time to complete an action before the UK-IPO, provided it is sought within two months of the end of the expired period. This will be a substantial benefit to users who miss deadlines in actions before UK-IPO.

4. Changes to other time periods for opposition

A number of other time periods for filing notices of opposition and counterstatements will also be changed from three months to two:

- i. Opposition to alteration of registered trade marks

- ii. Opposition to the removal of material from the register
- iii. Opposition to proposals for a change to classification
- iv. Opposition to the amendment of the regulations governing a collective or certification mark.

5. Change to period for filing counterstatements

At present three months is allowed to file a counterstatement in opposition periods, whereas only six weeks is allowed to file a comparable document in post registration invalidation. In order to bring greater consistency the new Rules will specify a period of two months for both of these actions.

6. Change to consequences of not filing a counterstatement

At present if an applicant fails to file a counterstatement in the period allowed their application is automatically refused. This is heavy handed. The new rules will therefore give the Registrar discretion to “direct otherwise” and consider a late defence.

7. Changes to Preliminary Indications

The Rules give the Registrar the discretion to give a preliminary indication as to the outcome of an opposition based on a conflict. At present the Registrar may give a preliminary indication (PI) as to the likely outcome of an opposition based on relative grounds where it is identical to the earlier mark and covers the same goods and services, or there is a likelihood of confusion with a similar earlier mark covering the same goods and services. If this PI indicates an unfavourable outcome for the opponent then the opponent must file a form TM53 or their opposition will be deemed withdrawn in its entirety even if there are other grounds for opposition. The new rules will change this so that only the relative grounds on which the PI gave an unfavourable result will be deemed withdrawn.

8. Changes to filing of evidence and case management powers

The 2000 Rules give fixed time periods for filing evidence in each and every type of proceeding. The new Rules will give the Registrar the power to set a timetable for parties to file evidence taking account of the circumstances of each case (see TPN 3/2008). The new Rules will also give the Registrar power to direct the issues on which evidence is required which will help focus evidence on relevant issues and reduce unnecessary evidence and associated costs.

9. Changes to evidence in opposition and invalidation proceedings

These changes will give the Registrar the power to specify periods for the filing of evidence or submissions. This will allow arguments to be submitted in circumstances where no evidence of fact is required.

10. Changes to evidence rounds in applications for revocation based on non-use grounds

At present a registered proprietor has two bites at filing evidence of use of his mark. This has resulted in much unproductive argument about whether the initial evidence filed by the proprietor in a particular case satisfies the first of two evidential hurdles. The new Rules will provide the proprietor with one opportunity to file the evidence they plan to rely on to defend the registration. This will mean a reduction in the usual number of evidence rounds from four to three.

11. Introduction of power to set aside decisions

The new Rules will provide the Registrar with the power to set aside decisions when the proprietor can prove they were unaware that their mark or application to register a mark was under attack. This will only be possible within six months of the decision to be set aside.

12. Changes to timing of procedural appeals which do not terminate proceedings

The new rules will only allow immediate appeals on procedural decisions at the discretion of the Registrar. These decisions will be open to appeal at the end of proceedings. This is in line with the Community Trade Mark Regulation 40/94 which appears to work satisfactorily in relation to Community trade mark proceedings.

13. Introduction of respondent's notice in appeals to the Appointed Person

This notice will provide a mechanism for respondents to appeal against the Registrar's decisions by requesting that the decision be upheld on additional or different grounds to those given by the Registrar. The Appointed Person has noted the absence of this provision in the current Rules.

14. Changes to published information

The new Rules will allow data provided only for information to be published on the Office's website and not in the Trade Marks Journal. This will reduce the administrative burden of creating the Trade Marks Journal and make this information more easily available to those who require it. The trade marks Forms will now be published on the Office's website instead of the Trade Marks Journal.

15. Changes to time periods for correcting deficiencies

The new Rules will reduce the period for correcting routine data on an application or paying the application fee to one month. This is in line with standard invoicing practice and accounts for more rapid communications. Other procedural deficiencies, such as complex classification of goods or services, will continue to allow two months for correction.

16. Changes to the process for verification of priority claims

Where necessary, the UK-IPO will verify claims for priority using a wider range of means and will no longer require formal certification for all claims. This is in line with the practice at OHIM.