
STATUTORY INSTRUMENTS

2008 No. 11

TRADE MARKS

The Trade Marks and Trade Marks
(Fees) (Amendment) Rules 2008

<i>Made</i>	- - - -	<i>8th January 2008</i>
<i>Laid before Parliament</i>		<i>10th January 2008</i>
<i>Coming into force</i>	- -	<i>6th April 2008</i>

The Secretary of State makes the following Rules in exercise of the powers conferred by sections 78 and 79 of the Trade Marks Act 1994⁽¹⁾ and of the power conferred on him by the Department of Trade and Industry (Fees) Order 1988⁽²⁾.

Citation and commencement

1. These Rules may be cited as the Trade Marks and Trade Marks (Fees) (Amendment) Rules 2008 and shall come into force on 6th April 2008.

Amendments to the Trade Marks Rules 2000

2. The Trade Marks Rules 2000⁽³⁾ are amended as follows.

3. In rule 5 (Applications for registration; s 32 (Form TM3)) after paragraph (1) insert—

“(1A) Where an application is for the registration of a single trade mark, an applicant may request the registrar to undertake an expedited examination of the application.

(1B) A request for expedited examination shall be made on Form TM3 which shall be filed electronically using the filing system provided on the Office website, or by such other means as the registrar may at the registrar’s discretion permit in any particular case, and shall be subject to payment of the prescribed fee.

(1C) Where an applicant makes a request for expedited examination, the application fee and any class fees payable in respect of the application shall be payable at the time the application is made and accordingly rule 11 shall not apply insofar as it relates to the failure of an application to satisfy the requirements of section 32(4).

(1) 1994 c. 26.

(2) S.I. 1988/93, as amended by S.I. 1990/1473, which was made under section 102 of the Finance (No.2) Act 1987 (c. 51)

(3) S.I. 2000/136, amended by S.I. 2004/947 and 2007/2076, there are other amending instruments but none is relevant.

(1D) In this rule and rule 11B a “request for expedited examination” means a request that, following an examination under section 37, the registrar notify the applicant within a period of ten business days (as specified in a direction given by the registrar under section 80) beginning on the business day after the date of filing of the application for registration whether or not it appears to the registrar that the requirements for registration are met.”.

4. After rule 11A, insert—

“Compliance with request for expedited examination

11B. Where the registrar receives a request for expedited examination under rule 5, the date on which the registrar shall be deemed to have notified the applicant whether or not it appears to him that the requirements for registration are met shall be the date on which notice is sent to the applicant.”.

Amendments to the Trade Marks (Fees) Rules 2000

5. The Trade Marks (Fees) Rules 2000(4) are amended as follows.

6. After rule 3, insert—

“3A. Where the registrar—

- (a) has received a request for expedited examination of an application for registration of a trade mark under rule 5(1A) of the Trade Marks Rules 2000 (“the Trade Marks Rules”), and
- (b) following the expiry of a period of ten business days (as specified in a direction given by the registrar under section 80) beginning on the business day after the date of filing of the application for registration, notifies the applicant, in accordance with rule 11B of the Trade Marks Rules, whether or not it appears to the registrar that the requirements for registration are met,

the registrar shall repay the fee specified in the Schedule in respect of a request for expedited examination.”.

7. The Schedule is amended by inserting after the entry “Form TM3 – Application for registration of a trade mark (rule 5) or a series of trade marks (rule 21)” the following—

<i>“Number of corresponding form</i>	<i>Item</i>	<i>Amount</i>
		<i>£</i>
	Request to the registrar for expedited examination of application for registration of a trade mark (rule 5(1A))	300”

8th January 2008

Lord Triesman
Parliamentary Under Secretary of State for
Intellectual Property and Quality
Department for Innovation, Universities and
Skills

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Trade Mark Rules 2000 (SI 2000/136) (“the 2000 Rules”) and the Trade Marks (Fees) Rules 2000 (SI 2000/137) (“the Fees Rules”).

Rule 3 amends rule 5 of the 2000 Rules to provide that the applicant for registration of a single trade mark (but not an applicant for registration of a series of trade marks) may request that the registrar notify him within a period of 10 business days beginning on the business day after the date of filing of the application (as defined in section 33 of the Trade Marks Act 1994 (“the Act”)) whether or not the requirements for registration under the Act or under the 2000 Rules are met. Such request must be filed electronically on Form TM3 and be accompanied by the application fee, such class fees as are appropriate and the prescribed fee of £300 (see Rule 7). In accordance with rule 70 of the 2000 rules, the directions which the registrar has given specifying the business days of the Office have been published in the Trade Marks Journal (supplement to Journal 6048 dated 31 October 1994) and are posted in the Office.

Rule 4 inserts a new rule 11B into the 2000 Rules. This new rule determines the date on which the Registrar shall be deemed to have given notice to the applicant as to whether or not the requirements for registration under the Act appear to have been met, which is relevant for the purposes of assessing whether the registrar has complied with the request for expedited examination within the period specified in rule 5(1D).

Rule 6 inserts a new rule 3A into the Fees Rules to provide that the fee payable in respect of a request for expedited examination will be repaid if the registrar notifies the applicant whether or not the requirements for registration appear to have been met following the expiry of a period of 10 business days beginning on the business day following the date of filing of the application.

A full impact assessment of the effect that this instrument will have on the costs of business and the voluntary sector is available from the UK Intellectual Property Office, Room 2B36, Concept House, Cardiff Road, Newport, NP10 8QQ and is annexed to the Explanatory Memorandum which is available alongside the instrument on the OPSI website.