STATUTORY INSTRUMENTS

1978 No. 1120

TRADE MARKS

The Trade Marks (Amendment) Rules 1978

Made - - - - -	28*th July* 1978
Laid before Parliament -	2*nd August* 1978
Coming into Operation—	
All Rules except Rule 3	8*th August* 1978
Rule 3 - - -	1*st November* 1978

Whereas, in pursuance of the requirements of section 40(3) of the Trade Marks Act 1938**(a)**, the Secretary of State has, before making the following Rules under that Act, published notice of his intention to make such Rules and of the place where copies of the draft Rules might be obtained by advertising such notice in the Trade Marks Journal and the Official Journal (Patents) on 5th July 1978 and 12th July 1978, being the manner which he considered most expedient so as to enable persons affected to make representations to him before the Rules were finally settled:

Now, therefore, the Secretary of State in exercise of powers conferred by sections 40 and 41 of the Trade Marks Act 1938 and now vested in him **(b)**, and with the sanction of the Treasury, hereby makes the following Rules:—

1. These Rules may be cited as the Trade Marks (Amendment) Rules 1978 and shall come into operation as respects rules 1, 2 and 4 on 8th August 1978 and as respects rule 3 on 1st November 1978.

2. The Interpretation Act 1889**(c)** shall apply to the interpretation of these Rules as it applies to the interpretation of an Act of Parliament and as if these Rules and the Rules hereby revoked were Acts of Parliament.

3. On 1st November 1978, for Schedule 1 to the Trade Marks Rules 1938**(d)**, as amended **(e)**, there shall be substituted the Schedule hereto and the Trade Marks (Amendment No. 3) Rules 1975**(f)** shall thereupon be revoked.

(a) 1938 c. 22.
(b) S.I. 1970/1537.
(c) 1889 c. 63.
(d) S.R. & O. 1938/661.
(e) The relevant amending instruments are S.I 1964/227, 1975/1532.
(f) S.I. 1975/1532.

4. Where on or after 8th August 1978 but before 1st November 1978 Form T.M. No. 11 is filed in respect of the renewal of registration of a trade mark or a series of trade marks the last registration of which mark or series of marks is due to expire on or after 1st November 1978, the fee payable in respect of such renewal shall be that which would be payable if the said form were filed on or after 1st November 1978 and rule 3 of these Rules had come into operation.

Stanley Clinton Davis,
Parliamentary Under-Secretary of State,
28th July 1978. Department of Trade.

We sanction the making of these Rules.

T. E. Graham,
J. Dormand,
Two of the Lords Commissioners
27th July 1978. of Her Majesty's Treasury.

SCHEDULE

List of Fees Payable

Matter or Proceeding	Amount	Corresponding Form
	£	
1 On application not otherwise charged to register a trade mark for a specification of goods included in one class	23·00	T.M.-No. 2 Textile-No. 2
1a On application to register a series of trade marks under section 21(2) for a specification of goods included in one class ...	23·00	T.M.-No. 2 Textile-No. 2
1b On application to register a defensive trade mark for a specification of goods included in one class	34·50	T.M.-No. 32
1c On application under section 37 to register a certification trade mark for a specification of goods included in one class ...	30·00	T.M.-No. 6
1d On applications made at the same time under section 37 to register one certification trade mark for specifications of goods not all included in one class— In respect of every class ... ... Total fee in no case to exceed £520 for any number of classes.	30·00	T.M.-No. 6

Matter or Proceeding	Amount	Corresponding Form
	£	
2 On a request to the Registrar to state grounds of decision relating to an application to register a trade mark and materials used	10·50	T.M.-No. 5
3 On notice of opposition before the Registrar under section 18, for each application opposed, by opponent ...	10·50	T.M.-No. 7
3a On lodging a counter-statement in answer to a notice of opposition under section 18, for each application opposed, by the applicant; or in answer to an application under any of the sections 26, 27, 32 and 33, by the proprietor in respect of each trade mark; or in answer to a notice of opposition under section 35 or section 36, for each application or conversion opposed, by the proprietor	7·00	T.M.-No. 8
3b On the hearing of each opposition under section 18, by applicant and by opponent respectively; or on the hearing of an application under any of the sections 26, 27, 32 and 33, by applicant and by proprietor respectively; or on the hearing of an opposition under section 35 or section 36, by proprietor and by opponent respectively	10·50	T.M.-No. 9
3c On notice of opposition under paragraph 2(2) of Schedule 1 to the Act, for each application opposed, by the opponent ...	10·50	T.M.-No. 37
3d On lodging a counter-statement in answer to a notice of opposition under paragraph 2(2) of Schedule 1 to the Act, for each application opposed, by the applicant	7·00	T.M.-No. 38
3e On the hearing of each opposition under paragraph 2(2) of Schedule 1 to the Act, by applicant and by opponent respectively	10·50	T.M.-No. 39
4 For one registration of a trade mark not otherwise charged for a specification of goods included in one class	34·50	T.M.-No. 10
4a For one registration of a series of trade marks under section 21(2) for a specification of goods included in one class—		
For the first mark	34·50	T.M.-No. 10
And for every other mark of the series	1·20	
4b For registration under section 37 of a certification trade mark for a specification of goods included in one class ...	34·50	T.M.-No. 10

Matter or Proceeding	Amount	Corresponding Form
	£	
4c For registration upon applications made at the same time of one certification trade mark, under section 37, for specifications of goods not all included in one class—		
In respect of every class	34·50	T.M.-No. 10
Total fee in no case to exceed £600 for any number of classes.		
4d For one registration of a defensive trade mark for a specification of goods included in one class	39·00	T.M.-No. 10
5 Upon each addition to the registered entry of a trade mark of a note that the mark is associated with a newly registered mark	1·20	T.M.-No. 10
5a On an application to dissolve the association between registered trade marks ...	9·50	T.M.-No. 19
6 On application to register a registered user of a registered trade mark in respect of goods within the specification thereof ...	19·50	T.M.-No. 50
6a On application to register the same registered user of more than one registered trade mark of the same registered proprietor in respect of goods within the respective specifications thereof and subject to the same conditions and restrictions in each case—		
For the first mark	19·50	T.M.-No. 50
And for every other mark of the proprietor included in the application and statement of case	1·20	
6b On application by the proprietor of a single trade mark under section 28(8)(*a*) to vary the entry of a registered user thereof	19·50	T.M.-No. 51
6c On application by the proprietor of more than one trade mark under section 28(8)(*a*) to vary the entries of a registered user thereof—		
For the first mark	19·50	T.M.-No. 51
And for every other mark of the proprietor for which the same user is registered, included in the application	1·20	
6d On application by the proprietor or registered user of a single trade mark under section 28(8)(*b*), for cancellation of the entry of a registered user thereof ...	7·00	T.M.-No. 52

Matter or Proceeding	Amount	Corresponding Form
	£	
6e On application by the proprietor or registered user of more than one trade mark under section 28(8)(*b*), for cancellation of the entries of a registered user thereof—		
For the first mark	7·00	T.M.-No. 52
And for every other mark of the proprietor for which the same user is registered, included in the application	1·20	
6f On application under section 28(8)(*c*), to cancel the entry of a registered user of a single trade mark	7·00	T.M.-No. 53
6g On application under section 28(8)(*c*), to cancel the entries of a registered user of more than one trade mark—		
For the first mark	7·00	T.M.-No. 53
And for every other mark of the same proprietor for which the same user is registered, included in the application	1·20	
6h On notice under section 28(9) and Rule 112, of intention to intervene in one proceeding for the variation or cancellation of entries of a registered user of trade marks	10·50	T.M.-No. 54
7 On request to enter in the register and advertise a certificate of validity, under section 47 and Rule 88—		
For the first registration certified ...	5·00	T.M.-No. 49
And for every other registration certified in the same certificate ...	1·20	
7a On application under section 29(4) and Rule 76 for extension of time for registering a corporation as subsequent proprietor of trade marks on one assignment—		
Not exceeding two months	7·00	T.M.-No. 14
Not exceeding four months	12·50	T.M.-No. 14
Not exceeding six months	19·50	T.M.-No. 14
8 On application for certificate of the Registrar, under section 22(5) and Rule 79—		
For the first mark proposed to be assigned	12·50	T.M.-No. 40
And for every other mark of the same proprietor included in that assignment	1·20	

Matter or Proceeding	Amount	Corresponding Form
	£	
8a On application for approval of the Registrar, under section 22(6) or paragraph 2 of Schedule 3 of the Act, and Rule 79—		
For the first mark	12·50	T.M.-No. 41 or 42
And for every other mark of the same proprietor included in the same transfer	1·20	
8b On application for directions by the Registrar for advertisement of assignment of trade marks in use, without goodwill—		
For one mark assigned	7·00	T.M.-No. 43
And for every other mark assigned with the same devolution of title ...	1·20	
8c On application for extension of time for applying for directions for advertisement of assignment of trade marks in use, without goodwill, in respect of one devolution of title—		
Not exceeding one month	7·00	T.M.-No. 44
Not exceeding two months	12·50	T.M.-No. 44
Not exceeding three months ...	19·50	T.M.-No. 44
9 On application to register a subsequent proprietor in a case of assignment or transmission of a single trade mark—		
If made within six months from the date of acquisition of proprietorship	7·00	T.M.-No. 15 or 16
If made after expiration of six months but within twelve months from the date of acquisition of proprietorship	15·00	,,
If made after expiration of twelve months from the date of acquisition of proprietorship	25·00	,,
9a On application to register a subsequent proprietor of more than one trade mark standing in the same name, the devolution of title being the same in each case—		
If made within six months from the date of acquisition of proprietorship		
For the first mark	7·00	T.M.-No. 15 or 16
And for every other mark ...	1·20	
If made after expiration of six months but within twelve months from the date of acquisition of proprietorship		
For the first mark	15·00	,,
And for every other mark ...	1·20	
If made after expiration of twelve months from the date of acquisition of proprietorship—		
For the first mark	25·00	,,
And for every other mark ...	1·20	

Matter or Proceeding	Amount	Corresponding Form
	£	
10 On application to change the name or description of a proprietor or a registered user of one or more trade marks where there has been no change in the proprietorship or in the identity of the user—		
For each mark	2·30	T.M.-No. 21
11 For renewal of registration of a trade mark at expiration of last registration ...	84·00	T.M.-No. 11
11a For renewal of registration of a series of trade marks under section 21(2) at expiration of last registration—		
For the first mark of the series ...	84·00	T.M.-No. 11
And for every other mark of the series	1·20	
11b For renewal of registrations of the same certification trade mark with the same date for goods in more than one class—		
In respect of every class	84·00	T.M.-No. 11
Total fee in no case to exceed £1,460 for any number of classes.		
11c Additional fee under Rule 67	11·50	T.M.-No. 12
11d Restoration fee under Rule 68	29·00	T.M.-No. 13
12 On an application to the Registrar for leave to add to or alter a single registered trade mark	12·50	T.M.-No. 25
12a On an application to the Registrar for leave to add to or alter more than one registered trade mark of the same proprietor, being identical marks, the addition or alteration to be made in each case being the same—		
For the first mark	12·50	T.M.-No. 25
And for every other mark	7·00	
12b On notice of opposition to application for leave to add to or alter registered trade marks, for each application opposed ...	10·50	T.M.-No. 47
13 For altering one or more entries of the trade or business address of a registered proprietor or a registered user of a trade mark (unless exempted from fee under Rule 81)—		
For each entry	2·30	T.M.-No. 18
14 For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	7·00	T.M.-No. 48

Matter or Proceeding	Amount	Corresponding Form
	£	
15 For cancelling the entry of a trade mark upon the register on the application of the registered proprietor of the trade mark	—	T.M.-No. 22
15a For striking out goods from those for which a trade mark is registered on the application of the registered proprietor of the trade mark	1·80	T.M.-No. 23
16 On application under any of the sections 26, 27, 32 and 33, for rectification of the register or removal of trade mark from the register	12·50	T.M.-No. 26
16a On application for leave to intervene in proceedings under any of the sections 26, 27, 32 and 33, for rectification of the register or removal of trade mark from the register	10·50	T.M.-No. 27
17 On request, not otherwise charged, for correction of clerical error or for permission to amend application ...	4·00	T.M.-No. 20
18 On request by registered proprietor of a trade mark for entry of disclaimer or memorandum in the register	4·00	T.M.-No. 24
19 On application under Rule 93 to expunge or vary the registration of a certification trade mark or to vary the deposited regulations of a certification trade mark or of certification trade marks of the same registered proprietor where the regulations are substantially the same ...	12·50	T.M.-No. 36
19a On request by the registered proprietor of a certification trade mark to permit alteration of the deposited regulations thereof—		
For the regulations of one such registration	12·50	T.M.-No. 35
For the same or substantially the same regulations of each other registration proposed to be altered in the same way and included in the same request	1·20	
20 On application by registered proprietor under Rule 6, for conversion of specification	2·30	T.M.-No. 45

Matter or Proceeding	Amount	Corresponding Form
	£	
20a On notice of opposition to a conversion of the specification or specifications of a registered trade mark or registered trade marks—		
For one mark	10·50	T.M.-No. 46
For every other mark of the same proprietor having the same specification	1·20	
21 On appeal from the Registrar, otherwise than to the Court, in respect of each decision appealed against, by Appellant	10·50	T.M.-No. 30
22 For a search under Rule 127 in respect of one class—		
Without application for the Registrar's advice under Rule 20 ...	12·50	T.M.-No. 28
With application for the Registrar's advice under Rule 20	16·00	T.M.-No. 28
23 On request for the Registrar's preliminary advice under Rule 20, for each trade mark submitted in respect of one class ...	3·50	T.M.-No. 29
24 For certificate of the Registrar (other than certificate under section 19(2)) of the registration of a trade mark	3·50	T.M.-No. 31
24a For certificate of the Registrar (other than certification under section 19(2)) of the registration of a series of trade marks under section 21(2)	3·50	T.M.-No. 31
25 For certificate of the Keeper of an entry in the Manchester Record relating to one trade mark	3·50	Textile-No. 5
25a For certificate of the Keeper of an entry in the Manchester Record relating to a series of trade marks under section 21(2)	3·50	Textile-No. 5
26 For the continuance of a Cotton Mark in the Collection of Refused Marks—		
For each mark in each class at the end of each period of fourteen years after date of application	29·00	Cotton-No. 6
27 For cancelling or making one or more entries of an address for service of a registered proprietor or a registered user of a trade mark, on application made after the registration in each case—		
For each entry	1·20	T.M.-No. 33

Matter or Proceeding	Amount	Corresponding Form
	£	
27a For altering one or more entries of an address for service in the register—		
For each entry	1·20	T.M.-No. 33
Total fee in no case to exceed £70 for any number of entries included in one application for alteration, where the address and the alteration in each case are the same.		
28 For inspecting register or Manchester Record, or notice of opposition, counter-statement or decision in connection with any opposition or application for rectification of the register relating to any particular trade mark, for every quarter of an hour	·35	—
29 For permission to search amongst the classified representations of trade marks, for every quarter of an hour	·35	—
30 For certifying office copies, MSS., or photographic or printed matter each	1·80	—
31 For extra space in the Journal advertisement, in cases where the printing block for the trade mark exceeds 50 mm in breadth or depth, or in breadth and depth—		
For every 25 mm or part thereof over 50 mm in breadth	·70	—
For every 25 mm or part thereof over 50 mm in depth	·70	—

The fees to be paid on any proceeding at the Manchester Branch and at the office of the Cutlers' Company shall be the same as for the similar proceeding at the Office.

For the purpose of these fees (except as specially provided above) every mark of a series under section 21, or any preceding similar enactment, shall be deemed to be a mark separately registered.

EXPLANATORY NOTE

(*This Note is not part of the Rules.*)

These Rules further amend the Trade Marks Rules 1938 so as to increase certain fees payable under them. The new fees become payable on or after 1st November 1978, except in the case of renewal fees paid in advance in respect of any period beginning on or after 1st November 1978, which are increased with effect from 8th August 1978.

SI 1978/1120
ISBN 0-11-084120-4

