EXPLANATORY MEMORANDUM TO

THE TRADE MARKS AND REGISTERED DESIGNS (AMENDMENT) RULES 2013

2013 No. 444

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) (AMENDMENT) ORDER 2013

2013 No. 445

1. This explanatory memorandum has been prepared by the Department for Business, Innovation and Skills and is laid before Parliament by Command of Her Majesty.

2. Purpose of the instruments

2.1 These instruments amend the drafting relating to various prescribed periods contained in three existing instruments, in order to correct defects in the drafting. The existing instruments relate to intellectual property rights, and are the Trade Marks Rules 2008 (SI 2008/1797), the Registered Designs Rules 2006 (SI 2006/1975) and the Trade Marks (International Registration) Order 2008 (SI 2008/2206). A similar amending instrument has already been made in relation to the patent rules. See the Patents (Amendment) Rules 2011 (SI 2011/2052). Since these instruments correct a defect in these previous instruments, the procedure for free issue has been applied.

3. Matters of special interest to the Joint Committee on Statutory Instruments

3.1 The amendment to Rule 23 of the Registered Designs Rules 2006 corrects an error identified by the Joint Committee in its 37th Report of Session 2005-06.

4. Legislative Context

4.1 The principal statute on trade marks is the Trade Marks Act 1994. The principal statute on registered designs is the Registered Designs Act 1949, as amended ("the Acts").

4.2 The Trade Marks Rules 2008 ("The 2008 Rules"), the Registered Designs Rules 2006 ("the 2006 Rules") and the Trade Marks (International Registration) Order 2008 ("the Order"), are the main pieces of legislation made under the Acts, and they regulate the business and procedure of the statutory body called "the Patent Office", which uses as an operating name "the Intellectual Property Office". Amongst other things, this Office examines trade mark and design applications, registers trade marks and designs and is a quasi-judicial body with jurisdiction over certain legal proceedings concerning those

rights. The 2008 Rules and the 2006 Rules prescribe many periods in connection with the processes for applying for and maintaining trade marks and designs, and for resolving disputes over those rights. The Order applies various provisions of the Trade Marks Act 1994 and the 2008 Rules to International Trade Marks (UK).

5. Territorial Extent and Application

5.1 These instruments apply to all of the United Kingdom.

5.2 The provisions of the Acts extend to the Isle of Man (subject to modifications made by Order in Council). These instruments therefore apply to the Isle of Man, although the provisions they contain relate solely to procedures at the Office.

6. European Convention on Human Rights

As the instruments are subject to negative resolution procedure and do not amend primary legislation, no statement is required.

7. Policy background

- **What is being done and why**

7.1 The 2008 Rules, the 2006 Rules and the Order were a wholesale modernisation and consolidation of previous legislation. During the drafting of those instruments, certain time periods were reformulated using wording "X days/months/years **beginning with**" or "**beginning on"** a particular date or event. The new wording was used to replace periods which had been drafted using the formulation "X days/months/years **from**" a particular date or event (or using a variety of wording with the same effect). The intention was to bring consistency to the wording but not to change the method of computation of the various prescribed periods. Guidance published at the time confirmed this intention, and the Office and its users maintained the view that this was what the wording had done.

7.2 However, there is established case-law that the "beginning with" formulation defines a period which ends one day sooner than the "from" formulation. The former case (the so-called "inclusive rule") includes the defining date when computing the prescribed period whereas, in the latter case, the prescribed period does not start until the day after the defining date (the "exclusive rule"). The purpose of these instruments is therefore to correct the wording used to prescribe the periods so that they all follow the exclusive rule (save with the limited exception of rules 5(5), 14(5) and 63(2) of the Trade Marks Rules 2008 where it is intended to retain the "beginning on/with" formulation). In practical terms, this means that where a rule requires a document to be filed within one month of an event and the relevant event occurs on 1st March, then the document must be filed on or before 1st April. This will restore the drafting to that which appeared in the instruments prior to their modernisation/consolidation and accords with the practice of the Office and the expectations of its users.

7.3 The second purpose of the Trade Marks and Registered Designs (Amendment) Rules 2013 is to correct an error in Rule 23(2)(a) of the 2006 Rules.

- **Consolidation**

7.4 No consolidation of the amended instruments is planned at present. Informal consolidated texts of the 2008 Rules and the 2006 Rules are available to the public for free on the Office's website at www.ipo.gov.uk.

8. Consultation outcome

8.1 To the extent that these instruments correct drafting defects, no formal consultation has taken place. However, the main organisations representing users of the trade marks and registered designs system were made aware informally that this correction would take place, and were content.

9. Guidance

9.1 The Office will publicise that these corrective instruments have been made through its website, in its official journals and also by notifying users directly – for example by placing notices in their various professional journals.

10. Impact

10.1 The impact on business, charities or voluntary bodies is none.

10.2 The impact on the public sector is none.

10.3 An Impact Assessment has been prepared for these instruments and their effect has been classified as negligible.

11. Regulating small business

11.1 These instruments apply to small business but, as for other sectors, they have no impact because they make corrections so that existing legislation has the effect which the Office and users already understood it to have.

12. Monitoring & review

12.1 No review of the correction is envisaged.

13. Contact

Allan James at the IPO/Patent Office (an executive agency of the Department for Business, Innovation and Skills) can answer any queries regarding the instruments.
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