

# hallmark ip

## Newsletter October 2008

### Changes in UK Practice

New UK Trade Mark Rules came into effect on 1 October 2008. The most important changes are as follows:

#### Formalities

The time period allowed for responding to formalities queries including queries regarding classification, name and address, the representation of the mark and payment of fees, has been reduced to **one month**.

#### Priority Claims

A print out from the relevant Trade Mark Office website will be sufficient to support a priority claim. The relevant documents must be filed with the application or within **one month**.

#### Extensions of Time

It is now possible to request a retrospective extension of time in application proceedings if a deadline has been missed. The request must be made within **two months** of the expiry of the time period.

#### Opposition

The opposition period has been reduced to **two months** although a **one-month extension** of the opposition period can be obtained as of right.

The period for filing a counterstatement has also been reduced from three to **two months**.

The cooling off period has been reduced from twelve to **nine months**. However this is now extendible by a **further nine months** with the agreement of both parties.

#### Revocation/Invalidity Actions

The time limit for filing counterstatements in revocation or invalidity proceedings has been increased from six weeks to **two months**.

In non-use revocation actions the trade mark owner will only have one opportunity to file evidence of use; until now brief evidence could be filed initially, with detailed evidence being filed at a later stage.

#### Evidence / Case Management

The new rules identify the situations where evidence of fact is required. Unless proof of use is requested no evidence is required to support an opposition based on S5(1) or 5(2).

The applicant is not required to file evidence in a non-use revocation action.

Arguments /observations may now be filed as written submissions rather than by way of a Statutory Declaration or Witness Statement.

The Registrar may set time periods for filing evidence in each case and may direct the issues to be covered by the evidence and the way it is presented.

The Registrar will now have an express power to consolidate and stay proceedings.

If you require further advice please contact your attorney or e-mail HallMark at [info@hallmark-ip.com](mailto:info@hallmark-ip.com).