



For Innovation

Consultation Paper

Consultation on Patent Office Forms



dti

A DTI SERVICE



PATENT OFFICE

A DTI SERVICE

The Patent Office is an Executive Agency of DTI and is responsible for the national framework of Intellectual Property rights, comprising patents, designs, trade marks and copyright.

We manage an intellectual property system that stimulates innovation and creativity, balances the needs of consumers and users, promotes strong and competitive markets and is the foundation of the knowledge based economy.

The DTI drives our ambition of “prosperity for all” by working to create the best environment for business success in the UK. We help people and companies become more productive by promoting enterprise, innovation and creativity.

We champion UK business at home and abroad. We invest heavily in world-class science and technology. We protect the rights of working people and consumers. And we stand up for fair and open markets in the UK, Europe and the world.

Contents

<u>Introduction</u>	Page 2
<u>Proposed changes</u>	Page 3
<u>Who is being consulted?</u>	Page 5
<u>How and when to respond</u>	Page 5
<u>Openness/Confidentiality</u>	Page 6
<u>Our Response</u>	Page 6
<u>Annex A</u> Individuals and organisations which have been sent this consultation document	Page 7
<u>Annex B</u> General Principles of Consultation Comments about the consultation process	Page 10 Page 10
<u>Annex C</u> Initial Regulatory Impact Assessment	Page 11
<u>Annex D</u> Consultation response form	Page 15

Consultation on Patent Office Forms

Introduction

1. UK intellectual property legislation requires the filing of forms for particular actions associated with patents, trade marks, registered designs and design right. This requirement is prescribed by statutory instrument, in particular the current Patent Rules 1995, the Trade Marks Rules 2000, the Registered Design Rules 1995 and the Design Right (Proceedings before the Comptroller) Rules 1989 as they have been amended. The forms themselves are set out in directions made by the Comptroller in patents and trade marks, whereas for registered designs and design right the forms are prescribed by statutory instrument. All current forms can be downloaded from the Patent Office website¹.
2. The Patent Office is undertaking a review of its statutory forms with a view to reducing the administrative burden on external users. We also want to make more forms available for electronic filing and case file management as part of the Office's e-Business and Information Systems Strategy. This review is limited to the forms themselves, and does not extend to considering any fees required on them. The Patent Office is performing a separate review of its statutory fees, and is proposing to consult, initially on an informal basis².
3. We are therefore interested in your views on our current forms. We have identified possible areas where changes could be made, and are seeking your comments on these ideas, but would welcome other comments. We are not so much interested in minor changes but significant ways in which the forms can be improved to reduce the administrative burden on the customer.
4. Following this consultation, the review will conclude by drawing up a set of recommendations of changes to the forms. These changes will be implemented at a later stage.

¹ <http://www.patent.gov.uk/patent/forms/index.htm> (patents)
<http://www.patent.gov.uk/design/forms/index.htm> (registered designs and design right)
<http://www.patent.gov.uk/tm/forms/index.htm> (trade marks)

² see <http://www.patent.gov.uk/about/consultations/live.htm> and <http://www.patent.gov.uk/about/consultations/writtenconsult.htm> for details of our current formal and informal consultations, respectively

Proposed changes

Merging existing forms

5. As forms are separated between patents, trade marks, registered designs and design right, a user currently requires separate forms for similar requests on different types of intellectual property. One possible area in which improvements could be made would be to merge the respective forms covering identical actions for patents, trade marks and registered designs to improve processing efficiency. In particular, we are considering creating single forms to notify the Office of each of the following types of action:

- a) Change of ownership
- b) Change of agent
- c) Change of name or address

For example, if a customer has a number of pending patent, trade mark and registered design applications and changes his name or address, he would currently be required to file patents form 20/77, trade marks form TM21 and designs form DF16A to cover all his applications. A merged form which could be used to make all these changes would reduce form-filling. Other forms that could be merged are those covering registering a change of ownership (patents form 21/77, trade marks form TM16 and registered designs form DF12A), and those notifying the Office of a change of agent (patents form 51/77, trade marks form TM33 and registered designs form DF1A).

6. Any statutory requirements and fee levels for the merged forms would remain unchanged. Therefore, a merged form covering registration of an assignment would require a fee (currently £50) and a signature from both parties to the transaction if the assignment related to any trade marks, as required by Rule 41(2)(a) of the Trade Marks Rules 2000. On the other hand, if the form was used only for patent assignments, no fee would be required and if the assignment took place after 1 January 2005 only the signature of the assignor would be necessary. Also, the proposed merged form 20/77, TM21 and DF16A would require a fee (currently £55) if used to correct an error in association with a registered design, but no fee if used for other purposes.

Increasing options available on existing forms

7. We believe there is scope for some forms to allow for further requests to be made on the same form which currently require a further form to be filed. For example, the patents and designs forms to notify the Office of a change of ownership (forms 21/77 and DF12A) do not offer the possibility of making a permanent change of correspondence address, unlike the corresponding trade marks form TM16. We intend to allow for this option for patents and designs.

8. We intend to allow a permanent change of address to be made on patents form 12/77 in addition to the current option of supplying a different address for receiving the next renewal fee reminder. We would also welcome further suggestions to reduce form-filling.

Electronic processing of forms

9. A further objective is the development of our e-Business and Information System Strategy. We have made considerable progress towards meeting the Government's 2005 target for delivery of key electronic services to customers by offering electronic filing services for new applications in both patents and trade marks. In addition, it is possible to make renewals and access the register electronically for patents, trade marks and registered designs, and we make all our forms available to download through our website. Furthermore, some patents forms are now available in Microsoft ® Word XP format, and in trade marks, the main application form TM3, and the forms for requesting and terminating a cooling-off period TM9c and TM9t can be now completed on-line.
10. We are intending to extend electronic services for our forms to increase customer options. For example, we propose to make more forms available on our website in a word-processing format. We would welcome your comments on this and other aspects to improve the electronic service we offer with our forms.

Standardisation of forms

11. We are proposing to standardise the overall appearance of forms across different business areas adopting current best practices, and review the guidance notes on the forms. Wherever possible, future forms will indicate the fee required and the date the form was last revised. We also plan to drop the reference to secondary legislation on our patents and registered designs forms, following existing practice for trade marks forms.

Improving the usability of the forms

12. We also intend to improve sections of our forms which would benefit from clarification. For example, on patents form 1/77 we propose to ask the applicant to select between natural person and corporate body, and clarify the requirements of each.
13. In addition, we wish to clarify the wording for search options on forms 9/77 and 9A/77, which can currently cause confusion to some applicants. We would welcome any further suggestions you have for making the forms more straightforward to complete.

Who is being consulted?

14. Responses are welcome from anyone interested in the intellectual property system in the UK, but especially those who have been or expect to be users of the system. Comments from anyone who regularly completes Patent Office forms would be particularly useful to us. Copies of this consultation document have been sent to the individuals and organisations listed in [Annex A](#). Further copies, including large print versions, may be obtained from the Patent Office by contacting Jason Holmes, tel. 01633 814418, [email:jason.holmes@patent.gov.uk](mailto:jason.holmes@patent.gov.uk).
15. This consultation document has been prepared in accordance with the Government Code of Practice on Written Consultations. The code criteria are set out in [Annex B](#). An initial Regulatory Impact Assessment can be viewed in [Annex C](#).

How and when to respond

16. Please send your responses by **Wednesday 1st February 2006** to:

Lesley Evans
Trade Marks and Designs Directorate
Room 2G16
Concept House
The Patent Office
Cardiff Road
Newport
NP10 8QQ

Tel: +44 (0) 1633 811136
Fax: +44 (0) 1633 811176
E-mail: lesley.evans@patent.gov.uk

17. If you are responding on behalf of a representative group, please give a summary of the people and organisations you represent.
18. If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Coordinator, whose details are included in [Annex B](#).
19. You may use the Consultation Response Form in [Annex D](#) to respond to this consultation.

Openness/Confidentiality

- 20.** This is part of a public consultation exercise. As such, your response may be made public by The Patent Office. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in your fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.
- 21.** Information provided in response to this consultation, including personal information, may be subject to publication or disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want other information that you provide to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.
- 22.** In view of this it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. An automatic confidentiality disclaimer generated by your IT system will not, of itself, be regarded as binding on The Patent Office.
- 23.** The Patent Office will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.

Our response

- 24.** In accordance with our general principle of consultation we will produce a response document which will be made available at <http://www.patent.gov.uk/about/consultations/responses/index.htm>.
- 25.** Paper copies of the response document will also be made available at the same time, and can be obtained by contacting Jason Holmes, tel. 01633 814418, [email: jason.holmes@patent.gov.uk](mailto:jason.holmes@patent.gov.uk).

Individuals and organisations which have been sent this consultation document

ABPI
ACID
Agricultural Engineers Association
Allvoice
Anti-Counterfeiting Group
Arnander Irvine & Zietman
Ashurst Morris Crisp
Association of British Insurers
AURIL
Babcock International Ltd
Baker & McKenzie
Bar Council
Belron International
Beresford & Co
Berwin Leighton Paisner
Bharat Electronics Ltd
Biotechnology and BSRC
Boulton Wade Tennant
BPI
BPP Leeds IP Group
British Brands Group, The
British Generics Manufacturers Association Ltd
British Library
British Motorcyclists Federation, The
British Pharmaceutical Group Ltd
British Poultry & Meat Federation
British Retail Consortium
Bristows
Cardiff Law School
Chartered Society of Designers
Chemical Industries Association
CIMMYT
CIPA
Clifford Chance
Competition Law Association
Conde Ltd
Confederation of British Industry
Consumers' Association Ltd
Cranfield University
Crop Protection Association
Davenport Lyons
Deloitte & Touche

DTI
Dyson
EC Laws Committee - LES Britain & Ireland
Eureka Manufacturing Co. Ltd
Europe Analytica
Federation of the Electronics Industry
FICPI
Frank B Dehn
Freshfields
Gallfent & Co
Gill Jennings & Every
Greenpeace
Harbottle & Lewis
Howrey Simon Arnold & White
Incorporated Society of British Advertisers
Intellectual Property Administrators Group
International Chambers of Commerce
Inventorslink Inc
IPLA
ITMA
Jones Day
Lancaster University
Law Society of Scotland, The
Law Society, The
Linklaters & Paines
LinuxUser Magazine
Lodestar Translations
Lovells
Magister Ltd
Marketforce Communications
Marks & Clerk
Mewburn Ellis
Microsoft Ltd
Milbank Tweed Hadley & McCloy
Mishcon de Reya
MoD
Motorcycle Action Group
Norton Rose
Office of Government Commerce
Olswang
Pfizer Limited
Pilkington Technology Centre
PJB Publications
Practical Law Company
Preventative Medicines Tech Inc.
RWS Group

Saba & Co
SCRIPT
SIBLE University of Sheffield
Simmons & Simmons
SMMT
Society of Numismatic Artists & Designers
State Patent Bureau of the Republic of Lithuania
Tarlo Lyons
Taylor & Meyer
TMPDF
University of Alicante
University of Cambridge
University of London Queen Mary & Westfield College
University of Oxford
University of Strathclyde
Urquhart-Dykes & Lord
Vereenigde
Visteon Global Technologies
Wedlake Bell

General Principles of Consultation

1. This consultation is being conducted according to the Code of Practice on Written Consultation issued by the Cabinet Office (available from the Cabinet Office web site at <http://www.cabinetoffice.gov.uk/regulation/consultation/code.asp>). This recommends the following criteria:

1. Consult widely throughout the process, allowing a minimum of 12 weeks for written consultation at least once during the development of the policy.
2. Be clear about what your proposals are, who may be affected, what questions are being asked and the timescale for responses.
3. Ensure that your consultation is clear, concise and widely accessible.
4. Give feedback regarding the responses received and how the consultation process influenced the policy.
5. Monitor your department's effectiveness at consultation, including through the use of a designated consultation co-ordinator.
6. Ensure your consultation follows better regulation best practice, including carrying out a Regulatory Impact Assessment if appropriate.

Comments about the consultation process

2. If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Co-ordinator, who is:

Debbie Cooke
Consultation Co-ordinator
The Patent Office
Concept House
Cardiff Road
Newport
NP10 8QQ

Tel: +44 (0)1633 813741

Fax: +44 (0)1633 814509

E-mail: Debbie.Cooke@patent.gov.uk

Initial Regulatory Impact Assessment

1. Introduction

1.1 This Regulatory Impact Assessment (RIA) is being issued with the Consultation on Patent Office Forms. The RIA is produced in accordance with Cabinet Office RIA Guidelines. Interested parties are asked to comment on the proposals and the alternative options identified. The consultation paper, including RIA is available in paper form by contacting:

Jason Holmes
Trade Marks and Designs Directorate
Room 2R92
Concept House
The Patent Office
Cardiff Road
Newport
NP10 8QQ

Tel: +44 (0) 1633 814418
Fax: +44 (0) 1633 811176
E-mail: jason.holmes@patent.gov.uk

2. Purpose and Intended Effect

Issue and Objective

2.1 The Patent Office is reviewing its statutory forms which are required by UK intellectual property legislation. The intention of this review is to reduce the administrative burden on external users, and make more forms available for electronic filing and case file management.

2.2 As part of this review, the idea of merging respective forms covering identical actions for patents, trade marks and registered designs has been identified as a measure to improve processing efficiency. For example, if a customer has a number of pending patent, trade mark and registered design applications and changes his name or address, he would currently be required to file patents form 20/77, trade marks form TM21 and registered designs form DF16A. Making a merged form available to allow all of these changes would therefore reduce form-filing.

Background

2.3 At the moment, a holder of different intellectual property rights in patents, trade marks and registered designs would be required to use a separate form for each area of intellectual property if he intended to make particular changes affecting all of his rights. For example, if he intended to change his name or address, he would have to file one form to cover patent rights (patents form 20/77), one to cover trade mark rights (trade marks form TM21), and one to cover registered designs (registered designs form DF16A).

Risk Assessment

2.4 In the above scenario, there is a slight possibility that a proprietor may unintentionally fail to apply the changes to all his intellectual property rights or pending applications if he is not aware that a separate form is required for each type of intellectual property right. This could, for example, result in correspondence on an application being sent to the wrong address, which could have adverse consequences such as refusal of an application due to failure to fulfil a time limit. Although the risk is small, the proposal would remove this risk.

3. Risks and Benefits Options

3.1 The options and associated costs and benefits are set out below:

Option A - Creating a merged form for a particular action in replacement of the separated existing forms

Risks: Users will have to adapt to using a single form instead of the separate forms currently in use. This would require some adaptation of working practices for those filing forms, but is expected to involve minimal costs since forms are available free of charge, for example, from the Patent Office website. Users might continue to file the superseded forms instead of the new forms, but as the comptroller has powers to accept any form that contains the information required by the new form, old forms would continue to be accepted, and there is therefore no risk associated with using the superseded forms. A further confusion could be caused if a merged form requires a fee in some cases but not in others. For example, for registering a change of ownership, a £50 fee is required for filing trade marks form TM16, but no charge is necessary for this action in patents (form 21/77) or registered designs (form DF12A). As it is not intended to change these fees, customers may not understand when a fee is required on the merged form. If a fee is overpaid, it is normal practice for the Patent Office to issue a full refund, so the impact on customers of fee differentials is small.

Benefits: Administrative burden is reduced by having a single form that can be filled in for a change common to different types of intellectual property rather than separate forms.

Option B - Creating a merged form for a particular action as an additional alternative to the existing forms

Risks: Similar to Option A, although as the separate forms would continue to exist on a statutory basis, users would have the option of changing to a single form or maintaining their current practice filing separate forms, therefore reducing the small risks of changing to a new system for completing these forms even further. However, under this option, there is a further risk of having two types of form publicly available for the same action. This might cause confusion where users are unsure of whether to file merged or separate forms.

Benefits: In addition to the benefits of Option A, the user would have the choice of selecting separate or merged forms according to his needs.

Option C – Do nothing

Risks: Retaining the requirement for separate forms for a particular action on different intellectual property rights could mean that a proprietor may not cover changes for all his intellectual property rights or pending applications if he is not aware that a separate form is required for each type of intellectual property right. This could, for example, result in correspondence on an application being sent to the wrong address, which could have adverse consequences such as refusal of an application due to failure to fulfil a time limit. However, this risk is only slight.

Benefits: Many users are used to the present system of filing separate forms for different intellectual property rights and doing nothing would avoid any problems that could arise in the transition if options A or B are adopted.

Business sections affected

3.2 Organisations and individuals in all business sectors are likely to be affected by the proposed changes.

Costs

3.3 No compliance costs have been identified for the proposal.

4. Small Firms' Impact Test

4.1 We have not considered it necessary to take initial soundings from small businesses as the proposals will have no adverse impact on such business or any business.

5. Enforcement and Monitoring

5.1 There is no obligation on anyone to apply for the grant of a patent or the registration of a trade mark or design. Therefore there is nothing to be enforced in respect to the filing of such documents at the Office. However, the Office requires certain information from an applicant or rights holder such as a name and address for correspondence. The proposal of merging forms facilitates users to provide this information when it changes, and therefore reduces errors occurring on applications and helps keep the details of rights holders up to date on the registers associated with the intellectual property rights kept by the Patent Office.

5.2 The Patents and Trade Marks Directorates each have a forms co-ordinator, who review the functionality of statutory forms.

6. Consultation

6.1 A list of those organisations to which the consultation document has been sent is at Annex A. The documents have also been copied to a number of individuals.

Consultation Response Form

We would appreciate any comments or observations you may have. Please complete this consultation response form and send it to:

Lesley Evans
Trade Marks and Designs Directorate
Room 2G16
Concept House
The Patent Office
Cardiff Road
Newport
NP10 8QQ

Tel: +44 (0) 1633 811136
Fax: +44 (0) 1633 811176
E-mail: lesley.evans@patent.gov.uk

Name:
Organisation:
Address:
Country:
Post/Zip Code:
Phone:
Email Address:

If you are replying for a representative body, please tell us in a few words what your organisation does:

--

Are you: an intellectual property professional?
 an unrepresented applicant?

Question 1

Are you in favour of the idea of merging the separate forms that exist in patents, trade marks and registered designs for a given action into a single form? Apart from the forms covering change of ownership, change of agent and change of name and address, what other forms do you consider would be beneficial to combine?

Question 2

Would you welcome the Patent Office making more forms available that can be completed and submitted online, and if so, could you identify particular forms you think this service should be extended to? Do you have any further comments on how we make our forms available electronically?

Question 3

Do you have any comments on our proposals to standardise the appearance of forms across different areas of intellectual property?

Question 4

Are there any forms that you feel could be significantly improved or simplified to make their completion more straightforward? If so, please tell us what those improvements are.

Question 5

Do you have any other comments?

The Patent Office,
Concept House,
Cardiff Road,
Newport,
NP10 8QQ

Tel: 08459 500 505
Minicom: 08459 222 250
Fax: 01633 813600.

www.patent.gov.uk
www.intellectual-property.gov.uk

For copies in alternative formats,
please contact our Central Enquiry Unit.

Revised: January 05



CUSTOMER SERVICE EXCELLENCE



INVESTOR IN PEOPLE

DDU/T200/11-05