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1 INTRODUCTION AND PURPOSE

The purpose of these instructions is to give details on Examination team procedures and to ensure consistent and uniform working procedures are adopted. It sets out the best working practice for the various procedures and duties undertaken and identifies the appropriate person responsible for carrying out those duties.

It is essential that all Examination teams follow these procedures to ensure consistency and there should be no deviation from these procedures unless there are compelling reasons.

2 ADMINISTRATIVE REFERENCING

2.1 Dictionary/Geographical/SAS/Quals

2.1.1 The Admin Support Team uses our standard reference systems to ascertain whether the mark is or contains a dictionary word, geographical indicator etc. A check is also made to ascertain whether the mark has been the subject of our Search Advisory Service. The Reference Search system accesses the following standard works and databases:

- Collins English Dictionary
- England, Scotland & Wales Index of Place Names
- Northern Ireland Census Information
- World Geographic Dictionary
- Refused Application
- SAS Applications
- Quality Standards

Any SAS file noted in the referencing as being required during the examination procedure should be retrieved by the Admin Support Team. An SAS search is considered relevant where marks are identical or feature the identical word element and the goods/services involved are identical or similar. SAS files are normally retained on the SAS team for up to a maximum of four months after issue of the report. Any files required which are more than four months old will normally be located in Nine Mile Point. If in doubt, check with the SAS first.

2.1.2 If the file is located in the SAS file store, the Admin Support Team must clearly indicate on the SAS file Shadow Card:

- The name of the team responsible for taking the file
- The number of the Trade Mark application the SAS file relates to
- The date the file was taken

2.1.3 The SAS file must then be attached to the Trade Mark application file and placed in the team Pre Examination file store ready for examination. It is imperative that SAS files are called for and attached to the new application where appropriate.

2.2 Examiner Research

The Examiner may wish to expand on the initial referencing, using electronic tools, their own knowledge or that of their colleagues. If this research is considered insufficient it may be prudent to consult a trade association or Patent Examiner. Language dictionaries may be inadequate so the Translation Service or language experts within the Patent Office may be consulted.

2.2.1 Types of Research

Referencing undertaken by the Examiner may involve a number of different methods. These would normally include the following:

- Credo
- Oxford Reference online
- Internet
- Patent Examiner
- Trade Association

Any research, no matter when it is carried out, should always be recorded on the ER2 by initialling and dating the ER2 to signify that research has been conducted.

If an objection is based on a hit from Credo, Oxford Reference Online or the Internet, then a copy of the relevant hit must be sent to the agent/applicant. The examination report needs to make reference to the enclosed hit.

A copy must always be placed on the right hand side of the file, immediately beneath the examination report or the relevant letter.

Failure to copy the reference to the agent/applicant may result in unnecessary delay and inconvenience should the basis for the objection require clarification.

However, Examiners may exercise discretion where well known words are involved. For example, it would not be necessary to send out references for the mark "Super Computer".

Where an Internet search is carried out and nothing to support an objection is found, an entry to this effect must be made on the ER2. If a more detailed explanation is required, for example, where Internet hits are found but are subsequently discounted because they show trade mark use, then the minute sheet should be used for this purpose.

Under no circumstances should Internet hits be placed on either the left or right hand side of the file if they are not being sent to the agent/applicant.

The Google UK site www.google.co.uk should always be used first for any Internet searches. Other search engines can also be used to supplement the above. On Google UK, the UK button should be selected, but searches can go wider, if thought appropriate.

3 EXAMINATION

3.1 Raising Classification Objections Prior to Full Examination

Where an application has a specification that makes classification/examination impossible, it will be necessary to write to the agent/applicant prior to a full examination being conducted. A standard letter may be located on the TERN system.

Once the letter is issued, the file may be placed in the Post Examination file store to await a response from the agent/applicant. The status of the application must remain as Pending on OPTICS.

Once the objection is overcome, the application may then proceed to full examination by the Examiner responsible for the case.

3.2 Examination of Series Marks

Applications purporting to be a series which do not constitute a series will only be fully examined if all the marks can be covered by one search. Where a number of marks in a series are included in a composite mark in the same series, the search of the composite mark will usually cover the individual marks included in it. In these circumstances the Examiner will fully examine the application.

However, if an Examiner is faced with the prospect of undertaking separate searches, a preliminary objection will be raised prior to the full examination of the application. The applicant will be required to overcome the series objection before the marks are examined on absolute and relative grounds.

Where a series objection is raised as a preliminary objection, or where it is the only (or only remaining) objection following full examination, the Registrar will, on request in the form of a Form TM5, issue a Statement of Grounds for the decision to refuse to accept the marks as a series, without refusing the application for registration.

This will allow applicants to appeal the Registrar's decision to refuse to accept the marks as a series without giving rise to the consequences that normally flow from a final refusal of the application. In particular, if the appeal is unsuccessful, this approach will leave applicants with the option of overcoming the series objection by deleting marks from, or dividing, the application.

The Registrar reserves the right, in appropriate circumstances, of dealing with a series objection through the process set out in Section 37 of the Act, which will result in any appeal against the decision being considered as the reason for the refusal of the application for registration.

3.3 Raising Series Objections Prior to Full Examination

If a decision is reached by the Examiner to raise a series objection prior to full examination, a letter should be issued to the agent/applicant. The Examiner must make clear the nature of the objection to the agent/applicant and advise which, if any, of the marks form a legitimate series for examination.

Once the letter is issued, the file may be placed in the Post Examination file store to await a response from the agent. The status of the application must remain as Pending on OPTICS.

Once the objection is overcome, the application may then proceed to full examination by the Examiner responsible for the case.

3.4 Search Requirement

The Examiner carries out a search of the Registry's databases, checking for earlier marks that may conflict with the mark/s applied for. Reserved words and Protected Emblems are also included on the databases and where the trade mark is considered to infringe the rights protected by the protected word/emblem they will be raised as objections.

Please note that when searching colour combinations which may resemble a flag, the website www.flags.net must be searched to ensure that marks are distinctive and not flags of other states etc.

Before a search is carried out it is essential to ascertain which classes of goods/services need to be searched. For this purpose the Guide to the Cross Searching of Trade Marks should be consulted. This indicates conflicts between classes in relation to goods/services covered by each class. It must be remembered that this document is not intended to be all encompassing in its scope but is only a guide as to where conflicts are most likely to be found.

3.5 Change to Earlier Right Practice from 1 October 2007

From 1st October 2007, we will no longer refuse trade mark applications on the basis of earlier registered or pending marks. Instead applicants will be able to decide if they wish their application to proceed, notwithstanding the earlier marks.

If an applicant decides to proceed, we will inform the owners of earlier conflicting trade marks identified, when the application proceeds to publication in our Trade Marks Journal. Owners of any earlier rights will then have the opportunity to oppose the application. UK right holders will be notified automatically. EU right holders will only be notified if they so request. Applicants must be aware that any opposition may result in adverse costs for them. Details of the Registrar's published scale of costs can be found on our website.

3.6 Applications Filed Following SAS Advice

It is essential to check the reference sheet to ensure that the SAS details are noted and the relevant file has been attached to the new application. For applications on which there has previously been an SAS search undertaken since 1st December 2003 for the same mark and the same goods or services, it will not be necessary to undertake a full search of the Register. Examiners should only conduct a "Search to Date", using OPTICS from the date the SAS search was carried out.

It is only necessary to conduct a full search on Marksman if there are any differences in the marks or if the goods or services listed in the application go wider than that previously searched by SAS. Examiners must always check the SAS file to ascertain the above information.

If any objections have been raised by the SAS Examiner, these should normally be included in the Examination Report. If Examiners are in any doubt they should consult their Team Leader.

3.7 Marks With Armorial Bearings, Heraldic Devices or Coats of Arms

Full details relating to the examination of armorial bearings, heraldic devices or coats of arms may be found in Chapter 3 of the Work Manual.

Essentially, where a trade mark consists of, or contains, armorial bearings, a copy of the mark must be sent to the Garter King of Arms who will then search his records and inform the Registrar of any armorial bearings which are identical to or resemble the arms. Where the applicant is based in Scotland, a copy of the mark should also be sent to Lord Lyon King of Arms. All further references to the Garter King of Arms should be taken to apply also to the Lord Lyon where he has also been asked to advise.

The examination guidelines set out the process to be followed on receipt of the Garter's advice. Sometimes, a line drawing of the arms may be required.

The Registry keeps a record of all line drawings previously requested and this must be checked to ensure that we do not already have the necessary artwork. As the fee varies depending on the complexity of the drawing, it will be necessary firstly to establish from the Garter King what the fee will be. Once this has been done, a letter should be prepared addressed to:

Garter King of Arms
The College of Arms
Queen Victoria Street
London
EC4V 4BT

requesting a copy of a line drawing of the coat of arms in question. The letter should be left on the application file and not sent out at this stage.

The application file should then be minuted to the Budget Manager via the Team Leader, explaining that a representation of the mark is required from the Garter King who requires a fee of £ (whatever the Garter King has advised).

The Budget Manager will authorise the request and send the file to Finance to authorise and issue the letter together with the fee. The file will then be returned to the originating section via the Budget Manager.

The Garter King will then send the line drawing to the originator of the request.

When the line drawing is received it should be checked to ascertain whether an objection should be raised and if it is, then a copy of the line drawing should be sent to the applicant or their representative.

3.8 Examination Report

The Examiner will decide whether the mark applied for is acceptable for prima facie registration, using the information provided on the referencing sheet and consulting Chapter 3 as necessary.

The Examiner will issue an examination report and the following points must be followed:

- If objections are raised, the Examiner must provide full details why the application is not considered acceptable and any reference relied on to support an objection must be sent with the report
- Where possible the examination report should also detail any suggestions for overcoming any objections raised

If the application is only to proceed by virtue of prior rights or on evidence of use of a previous application the evidence must be copied across once agreed with the applicant. Printouts of the relevant, prior applications must be attached to the file and the applicant advised of the circumstances by which the application may proceed. A copy of the printout must also be attached to the examination report.

3.9 Covering Letter

The letter accompanying the examination report includes the length of time allowed for response, this should be 2 months

No response date is required if the application is acceptable and is to proceed to publication

3.10 Conversion and Transformation Earlier Rights

Converted Community Trade Marks retain their initial filing date at OHIM as their filing date. Therefore, when a converted mark appears as a potential earlier right, Examiners should be aware that the filing date at OHIM, not the conversion date or date of receipt in the UK, is the relevant date for citing purposes.

If the converted mark included a claim to IC priority, it will of course be the priority date which is the relevant date for citing purposes.

Transformed International Trade Marks retain, as a filing date, the date on which the holder originally applied for protection in the UK. Therefore, when a transformed International mark appears as a potential Earlier Right, examiners should be aware that the date that the mark

was designated for protection in the UK is the relevant date for citing purposes.

If the transformed case has a valid priority claim, this will be the relevant date for citing purposes.

3.11 OHIM Earlier Rights Requiring Translation

If a similar or identical mark is identified in the search undertaken by the Examiner, it is possible that in the case of an OHIM mark, the specification of goods or services will not in English. It will therefore be impossible to judge whether there is conflict between the specifications of the application and the Earlier Right.

In these circumstances, the Examiner must raise the earlier case as an earlier right and request a translation of the goods/services listed in the specification. The translation will be forwarded to the applicant as soon as it is available.

Translations of OHIM cases may be requested by e-mailing the details including classes, to International Section using the e-mail address tmdtranslations. The request will be forwarded to the Translation Service who will deal with the query within the agreed timescale.

The Examiner, when issuing the Examination Report, must indicate to the agent/applicant that the earlier mark is being raised as a earlier right and that the matter will be reviewed once the translation is received.

If this is the only objection against the application then the case should be suspended pending receipt of the translation. If there are other objections then these should be dealt with so as not to delay the progress of the case unnecessarily.

If a case is to be suspended then the Examiner must set a Nil response date in TERN to generate the Covering Letter/Examination Report. The Examiner must then place the file in the team Diary tray so that a manual diary date may be entered on OPTICS. This will ensure that the case is brought forward to the Examiner to check if the translation has been received.

Once this information is received the Examiner must either:

- Formally raise the earlier mark as a Earlier Right and detail the area of conflict and provide a new date for response
- Waive the notification and allow the application to proceed to advertisement

If the earlier mark is formally raised as an earlier right, in addition to specifying the details of the conflict in a letter to the agent/applicant, the Examiner must attach a fresh print of case details to the correct part of the file and also manually insert on the Examination Report the details of the conflicting classes.

As the translated specification cannot be imported on to IBIS, it will be necessary to copy and paste any required information, where necessary, from the return e-mail.

3.12 Technical Earlier Rights

These will be treated as earlier rights and be will be notified of the later filed application.

3.13 Extension of Time Requests (EOTs)

EOT requests in respect of cases which have not been the subject of a hearing may be made on form TM9, by letter or by telephone. Requests must firstly be considered by the examiner responsible for the application. Any requests filed which would take the time allowed on an application in excess of 6 months from the date of response specified in the examination report, where a Section 3 objection was raised, must be approved by the Team Leader.

Although form EOT1 is now obsolete, pre-hearing requests using this form may also be accepted. Any request for an extension of time prior to hearing does not attract a fee.

All post hearing EOT requests must however be made on a form TM9 and must be considered by the hearing officer. The request cannot be considered unless the fee of £50

has been paid.

In assessing any EOT request, the person authorising the request must consider the amount of time previously allowed, what the applicant has done during that period, the reason for the request and what the applicant proposes to do during the period sought, the likelihood of further time resolving the outstanding objections, and whether there is any reason why a timely outcome to the application may be particularly important to the relevant trade, e.g. the registration sought would create a wide exclusive right in a highly descriptive term or in basic features of trade dress, such as a colour. Any reason provided which appears to be insufficient to justify the extension should be queried with the agent/applicant. If refusal of the extension is considered the Team Leader must be consulted.

Reasons such as, for example, awaiting client's instructions, are not to be considered as sufficient to justify an extension of time. However, the filing of evidence may be sufficient to justify granting further reasonable extensions of time. Should several such requests be received then we may require documentation showing progress is being made before allowing further time.

3.14 Extension of time requests for Section 5 issues

Where only Earlier Rights were raised in the examination report, a first extension of time for 2 months will be allowed where the applicant is pursuing consent. A final extension of 2 months should be supported by evidence to show that progress is being made e.g. copy of correspondence. No further EOTs should be allowed. The mark will proceed to advertisement and notification sent to the earlier right holder.

3.15 IC Documentation

If an International Convention priority date is claimed on the Form TM3, the documents to support the claim must be filed within a period of three months from the date of application. This date may be extended by the filing of an extension of time request.

Once the documentation is checked and confirmed as being acceptable, the Examiner must note the date claimed and the name of the country from which priority is claimed on the front file cover.

Unless the priority date is being relied on to overcome an Earlier Right under Section 5, the Registry will only perform a cursory check of the details. This will only include:

- The name and address of the applicant are the same as that shown in the IC docs
- The mark is also the same
- At least one class on the application form agrees with one class on the priority documentation
- The date of the earlier filing is the same as that listed as the priority claim on the TM3
- The priority claim listed on the TM3 is within six months of the date of filing the TM3

It is not necessary to request a translation of the documentation or inspect the full range of goods or services claimed unless it is to be relied upon to overcome an Earlier Right.

3.16 Camera Ready Copies

If the Examiner is not satisfied with the representation of the mark on IBIS then the Examiner must consult with the IBIS scanning team to ascertain if the mark can be improved by rescanning. Should this not be possible then the Examiner must request a Camera Ready Copy from the agent/applicant.

The Examiner should detail the reason why fresh artwork is required in order to ensure that the agent/applicant is fully aware of our difficulty in obtaining a satisfactory scan. If the agent/applicant has any technical queries relating to the production of the necessary artwork then the Examiner must consult with the IBIS scanning team.

The reason a camera ready copy is requested is because even though a mark may be clear on the form TM3 it may not be possible to scan it correctly onto our system.

Camera Ready Copies should not be requested to bring out detail not clearly displayed on the mark submitted on the form TM3. To do this would constitute amending the mark.

The Examiner must also ensure when a Camera Ready Copy is received that it does not differ from the mark applied for. Care must be taken to ensure that, in providing a clearer representation, that no matter appears which was previously unclear or illegible.

If a new colour representation is filed, the colours on the new artwork must be identical to those shown on the initial representation submitted on the TM3.

3.17 Updating of Applications

If an applicant agrees to limit a specification or delete marks in the series to overcome an objection, OPTICS must not be changed before the Ready For Advert stage.

An agreement to delete marks and/or goods/services must be unconditional.

The timing of all amendments requests must be considered by the Examiner. Some amendments should be actioned as soon as possible whereas others may be best recorded at the Ready For Advert stage of the proceedings. Typical amendments which may be recorded immediately include:

- Addition of class or classes via form TM3A
- Division of the application
- Change of name/address of the agent or applicant

3.18 Standard Computer Systems

The Examination teams have access to a number of applications in order to complete their work. These include the following:

- TERN, which is the application used to generate standard reports and correspondence
- IBIS, which allows the scanning, storage and search of image and/or word marks
- IBIS Database which receives and stores information on marks filed at the
- Community Trade Mark Office in Alicante
- MADRID Database, which receives and stores details of all applications filed under the Madrid Protocol
- OPTICS, the primary word search application for marks of three or less characters in length
- REFERENCE SEARCH, an application used to identify dictionary words, geographical locations etc
- CREDO and OXFORD ON-LINE, for the on-line research of mark text

Each of these applications has a specific training manual which details the method of operation and which should be referred to as and when required. To access the most up to date information relating to OHIM applications it will be necessary to refer to the OHIM website at www.oami.europa.eu

4 TM FORMS

4.1 TM3A – Addition of Class

A TM3A may be submitted by an applicant at any time prior to registration and is used to add classes where the original specifications included goods/services which did not correctly fall within any of the classes listed on the TM3. For example, it would not be possible to add class 19 to an application filed in class 6 for "building materials". That specification is correctly classified. However, if the original specification in class 6 was for "building materials; computers" it would be possible to add class 9 to the application as "computers" are clearly not proper to the original class.

The TM3A can only be delogged if the case itself has a status of "Examined" on the database.

The Examiner must ensure that the correct fee has been paid, the amendment is acceptable and that the TM3 is amended to reflect the change. The case may then be forwarded to the Admin Support Team via the Miscellaneous tray to update the OPTICS case details as instructed.

The fee for a TM3A is the class fee at the date of filing the TM3A and not the class fee at the date of filing the application.

The TM3A must be actioned and delogged using the Amend Class function on OPTICS to ensure that the Registry receives the fee payable for the action.

Once the details have been amended, a print of the case details should be placed on the file and the application returned to the Examiner for further consideration.

4.1.1 Searching Additional Classes

When OPTICS has been updated, the case should be returned to the Examiner to consider whether the goods or services in the added class or classes require an additional search.

For example, if an application is filed in respect of:

Class 3: Detergents for household and medical purposes

Which covers both class 3 and class 5 goods and the application, after the issue of the examination report, was extended to include class 5 it will be necessary to ensure the original search strategy covered all the relevant aspects of a class 5 search. The cross search of class 5 goods differs from that conducted for class 3 and unless the Examiner did cover the "medical" aspect of the goods at the time then a further search would have to be conducted.

The fresh search should only be up to and including the filing date of the application and not to the date of the class or classes being added to the OPTICS database. It is recognised that an applicant who may have filed an identical or similar mark for the same or similar goods subsequent to the date of application but before the date of the class or classes added will not be identified.

In the majority of cases, since similar goods will be involved, the likelihood of missing an Earlier Right is minimal.

If circumstances occur which result in a complaint by a party claiming that their application was not cited against a later filed application (because at the time of searching the earlier filed application did not contain a class which was subsequently added) the allegedly aggrieved party should be advised to oppose the later filed application at the time of publication.

4.2 TM5 – Statement of Grounds

Upon receipt of TM5 following the notice of refusal, the form will be linked to the file as a priority by the Admin Support Team.

If a TM5 is filed on an application that has not had a Hearing held on it, the file will be passed to the Team Leader for consideration. This will then be forwarded to the Head of Examination

via the Deputy Head of Examination for Domestic applications or via the Deputy Head of International Examination for International applications. Once the refusal has been agreed the Team Leader will write the Statement of Grounds.

If a Hearing has been conducted the TM5 must be passed to the Hearings Clerk by hand who will forward the file to the Hearing Officer via the Head of Examination. The Hearing Officer will then write the statement of grounds.

4.3 TM12 – Division

An applicant may request to divide an application using form TM12 and paying the appropriate fee

There are two types of division, attracting two different fees:

- Division of a specification (type "a" on TM12) which only attracts a divisional fee
- Division of a series of marks (type "b" on TM12) which attracts a divisional fee, plus an application fee in respect of each new application and class fees or any additional classes

These two types of division cannot be carried out on a single form. Separate forms must be filed if both types of division are required.

Division of a specification may take place at any point up to Registration. However, division of a series may only take place prior to preparation for publication of the application being completed.

4.3.1 Initial Examiner Action

The Division Checklist must be placed on the left-hand side of the file and completed by both the Examiner and administrator as the application is progressed through the division process.

The Examiner must check the division request is valid. In order to confirm this it is necessary to:

- Check the status of the application
- Check appropriate fee has been paid
- Check that the proposed division does not widen the specification or alter the marks applied for in any way

If IC priority is claimed on the original application the Examiner should check that the priority claim can extend to each divisional application or for only a part of the application

In dividing a series, all daughter applications must be acceptable under Section 41 i.e. any marks on any one daughter application must be a series with each other. The mother application can still contain a number of marks where a Section 41 objection remains.

Once these requirements are met, a copy of the TM3 must be made for each new application. The new form(s) TM3 must be amended to reflect the new position for each application and each must be clearly numbered with the appropriate letter suffix.

4.3.2 Division Numbering

The original application number will no longer be a live number on OPTICS but will become status "divided". The initial application will become suffix A and the other divisions suffix B,C,D etc. Each will have the same status as the original case.

It is possible to divide a case which has already been divided. This may occur for example if after a case is divided to overcome a series objection, the applicant then wishes to divide a specification in order to allow certain classes to proceed to advertisement whilst attempting to overcome objections raised against one or more classes.

If a divided case is again divided, the case number will become status "Divided" and the new divisions will begin with the next available suffix.

For example, if an application is initially divided into four cases, the suffixes allocated will be A, B, C and D, all with the same status as the original application. The status of the initial

application will then be changed automatically to Divided.

If application C is further divided in two, then the new cases will have the suffix endings of E and F whilst the C case will have its status changed to "Divided".

Once completed, the division must be communicated to the agent/applicant by the Examiner. An IBIS print of each new application should be forwarded for their records. This letter must only be issued once TERN has been updated with the correct images from IBIS.

If any or all of the applications are ready to proceed to publication, the Draft First Advert procedure must not be actioned until TERN has been updated.

4.4 TM17– Merging Applications

An applicant may request to merge applications or registrations, however, an application cannot be merged with a registration. Applications may only be merged prior to preparation for publication of the application being completed and only if all the applications have an identical filing date.

The request will normally be made following registration of previously divided marks, or companion groups (a 1938 Act term for applications filed on the same day for the same mark and in the same ownership, but in different classes). It is cheaper to renew a multi-class registration with several classes than to renew several single class registrations.

4.5 TM21 – Post Publication Amendments

For specification changes resulting from observations or examination errors, The team responsible for the observations or the error will deal with all aspects of actioning the TM21/letter. However, any case that has an opposition filed should be discussed with a Case Work Examiner in Law Section before any action is taken; this is done in order to decide if the following procedure should be departed from. Even if the procedure is to continue, a note should be made that when the amendment has been actioned and a letter sent to the applicant (see below) the case file should be referred to the Case Work Examiner in Law Section in order that they can inform the opponent of the amendment.

If the amendment stems from the raising of observations then the Team Leader will deal with this and correspond with the agent or applicant. If the amendment is allowed, the Team Leader should minute the case to the Examiner to amend the TM3 and OPTICS (the latter using the Change Journal function).

If the amendment relates to an error or oversight when the case was examined (e.g. classification errors identified by the Classification meeting) then the Senior Examiner will consider the request (in consultation with the Team Leader where necessary) and decide if the request can be allowed. The request must be refused if the amendment sought broadens the specification from that originally filed. If allowed, the Examiner will amend the TM3 and OPTICS.

If the only amendment required relates to the addition of a further class to correct an error of classification, filing a TM21 will not be necessary. All such amendments must be requested on form TM3A (please see Section 8.3 for further details).

As soon as the TM3 and OPTICS have been amended the Examiner must then record the AMENDMENTS AFTER PUBLICATION (AAP) in the back part of the Journal. This is done by accessing the "Back Part Editor" function and recording the amendment under the AMENDMENTS AFTER PUBLICATION heading. It is not necessary to record all of the resulting specification, a statement explaining what has changed is sufficient, for example:

- Class 25 has been amended by the deletion of the term "protective clothing"

When recording the AAP in the Back Part Editor a note should be made of the Journal Number that the AAP is to be recorded in. A letter should then be sent to the applicant (using the standard AAP letter on TERN) informing the applicant that the amendment has been made and providing the Journal details.

A one month opposition period follows the publication of the AAP. Only the amendment can be the subject of an opposition in respect of the AAP. However, the one month opposition

may run concurrently with the three month opposition period (if it is still on-going) relating to the application as a whole. A diary date should therefore be entered to expire 2 weeks after the end of the AAP's opposition period (therefore 6 weeks in total). The file should be retained in the post publication file-store until the expiry of the diary date.

On expiry of the diary date the file should be passed to the Examiner who should then check with Law Section to see if an opposition has been received in respect of the AAP. If no opposition has been received, the delayed status should be removed, the file should be returned to Nine Mile Point and the shadow card destroyed. In the rare event that an opposition has been received, the Senior Examiner should discuss with Law Section to decide what steps to take next.

4.5.1 TM21 After Registration

Any request filed on a TM21 which relates to a Registered case should be taken immediately to the Team Leader. The file must be requested from Nine Mile Point in the normal way and the letter linked to the file.

5 HEARINGS

5.1 After Hearing Outcome

The result of the Hearing will be indicated on the pink sheet by the Hearing Officer. A copy of which will be despatched to the agent by the Hearing Clerk. Any objections waived at the Hearing must be clearly noted on the examination report by the Hearing Officer.

5.2 Counsel Hearings

Any such requests must be sent to the Team Leader who must forward the request immediately to the Hearings clerk to make the necessary arrangements. Hearings where Counsel will attend are normally dealt with by either the Head of Examination or the Head of Practice.

6 CONFIDENTIALITY

Should an applicant wish any document, or part of a document, filed in support of an application to be treated as confidential, the request must be made at the time of filing or within 14 days of such date.

The Team Leader will decide the matter and issue a decision.

If confidentiality is refused, either the agent/unrepresented applicant will accept this and nothing further need be done, they may decide to withdraw the material in question or a Hearing may be arranged. Further information regarding confidentiality may be found in Chapter 6 of the Work Manual.

6.1 Confidential Documents on File

The following paragraphs list which documents are open to public inspection and which are confidential.

6.1.1 Examined Applications

Documents (other than application forms and amendments thereto) are not open to public inspection until the application has been published.

Forms 16, 21 and 33 are considered to be amendments to the application form and are therefore open to public inspection. Other forms are not.

6.1.2 Cases After Publication

All documents, other than Minute Sheets and documents which the Registrar has agreed may be kept confidential, are open to public inspection provided that they have been in the office for at least 14 days and any action required has been taken (for example assignment or licence recorded).

7 JOURNAL CLAUSES

There are a number of standard clauses that may accompany an advertisement as follows:

- Proceeding because of distinctiveness acquired through use.
- By consent of.....
- The mark consists of a three-dimensional shape
- The mark consists of a three-dimensional shape with the word(s)/device(s) INSERT appearing on it

The current correct wording for the clauses above must be adopted. The appropriate colour clause will depend on how the mark is filed

Any item in brackets must be amended to ensure the clause reads correctly. The standard clauses are stored in TERN under the Journal Paragraph and also stored as function keys on OPTICS.

8 PUBLICATION OF AMENDMENTS AND CORRECTIONS

All correspondence received in relation to cases which have been advertised with the exception of oppositions must be directed to the designated Senior Examiner who must place a Delayed status on OPTICS.

8.1 Incorrect Classification

Specifications published in the Journal are reviewed by the Classification Group. A list is prepared detailing items which either require action or should be noted for information purposes. There are three categories that are highlighted in the Group's report, namely:

8.1.1 Category 1

Applications with specifications on which it is mandatory to revert to the agent/applicant:

This category includes items which are clearly incorrectly classified and other items such as terms which are against practice, e.g. "supply of vending machines" which would be against the Retail practice. Specifications which should have been subject to an objection under Rule 8(2)(b) at the examination stage may be reported under this category if the degree of uncertainty created by the proposed registration is considered intolerable.

8.1.2 Category 2

Applications against practice:

This category includes items which are against practice but not likely to seriously affect the registration rights.

8.1.3 Category 3

Applications including new terms of descriptions of goods/services, which are acceptable in the published class.

These are reported only for information purposes.

The lists are distributed via e-mail to members of the Classification Group, Team Leaders and designated Senior Examiners who will be responsible for any further action required.

Where a category 1 error has been identified, the designated Examiner must recall the file from Nine Mile Point and place a Delayed status on OPTICS to ensure the case is not Registered in error. It is necessary to resolve the matter by contacting the agent/applicant using the standard letters on TERN.

The options available to the applicant are that they may:

- Clarify the wording of an unclear description (provided that this does not have the effect of introducing a new item into the specification)
- Add a class or classes via form TM3A to cover items specified for which no class currently exists
- Remove the goods/services from the application

If the agent/applicant agrees to change the specification then the Examiner will need to determine how to carry out the amendment.

8.2 Deciding Between Errata and Re-Advertisement

Should an error come to light after the application has been published the first action is to decide on the severity of the error. Errors such as spelling mistakes, an incorrect agent listed etc will be remedied with an erratum. Major errors, such as goods omitted from the specification, an error in the mark itself etc, will need to be remedied with a re-advertisement. Errors such as goods or services appearing in the incorrect class will be remedied by an "Amendment After Publication".

The decision as to whether an erratum or a re-advertisement is required must be taken by the designated Examiner in consultation with the Team Leader when necessary.

When deciding if the problem requires an erratum or a re-advertisement, the salient point to consider is if third parties can make an informed decision on whether to oppose the application from the original advertisement. If the original advertisement is considered to be unclear because of an error that has been identified, then it can be presumed that third parties will not be able to make an informed decision. This is, therefore, a serious matter and will require re-advertisement.

If, on the other hand, it is felt that the error is only a minor one and that third parties can make an informed decision without being misled by the error, an erratum will suffice.

The validity of the registration should also be borne in mind. If a mark has not been properly advertised, it may not be a valid registration.

Always check with a Team Leaders in Law Section to ascertain if an application has been opposed before taking any action in relation to re-advertisement. An opposition may have been received but not yet recorded on OPTICS.

8.3 Errata Procedure

If an erratum is required, the file must be requested from Nine Mile Point and the following procedure should be adopted:

- The agent/applicant must be contacted by telephone to inform them of the need for the erratum (unless they have specifically requested the erratum)
- If the erratum is in respect of the quality or positioning of the image, the file should be sent to Journal Section to deal with
- If an erratum is in relation to an applicant's name and/or address the letter and file should be sent to NAS who will action the amendment on OPTICS and advise Journal Section to issue an erratum
- All other errata should be dealt with by the appropriate examination team
- OPTICS should be corrected and an erratum published in the Journal using the Journal Back Page Editor function

To action the erratum, access the Journal Back Part Editor Function (available to designated staff). The following details must be entered:

- The applicant's name
- The erratum text
- The application number and class
- The original Journal details

The Journal number that the erratum will appear in will be shown as you enter the Journal Back Part Editor Function and at the top of the errata template.

Once the erratum has been actioned, a letter should be written to the agent/applicant informing them accordingly. The letter should apologise for the error that has been made and also advise in which Journal the erratum will be published. The letter to be used can be found on TERN.

The OPTICS record must be updated using the Change Journal (for advertised marks) or Change Case functions (for registered marks). The history text should read:

"Errata in Journal no.xxxxxxxx (together with the reason for the erratum)".The error that has been corrected with the erratum must now be amended on OPTICS.

The Delayed status must then be removed from Optics and the file returned to Nine Mile Point. If, however, the agent has requested an erratum in respect of a registered mark, the file should be forwarded to Journal/New Registrations Section with instructions to issue a new certificate. The original certificate must be requested from the agent if not already returned.

8.4 Re-Advertisement Procedure

As soon as the need to re-advertise has been identified, the status of the mark should be

changed to Delayed using the Record Delay function on OPTICS. This ensures that the case is not registered before the re-advertisement takes place.

A check must be made, as a matter of priority, with one of the Team Leaders in Law Section to ascertain if an application has been opposed before taking any action in relation to re-advertisement. It may be that an opposition has been received recently by Law Section but not yet recorded on OPTICS. If no opposition has been received the re-advertisement action should be carried out immediately.

In all instances where an application is to be re-advertised the agent/applicant must be advised by telephone followed up immediately by confirmation in writing. We should apologise if the error was caused by the Registry. We should also advise in which Journal the re-advertisement will be published. The letter to be used is on TERN.

If the agent/applicant contests the need to re-advertise the mark, the case should be referred to the Team Leader who may wish to consult with senior officers.

If the re-advertisement is in respect of the quality of, or error in, the representation of the mark, it will be dealt with by the appropriate Examination team in consultation with IBIS Rescan Section and Journal/New Registration Section depending on the circumstances that led to the re-advertisement being necessary.

The case details that need to be amended for the re-advertisement should be amended on OPTICS using the Change Journal function. If the re-advertisement is in relation to a problem with the representation of the mark, the file should be taken to the IBIS Rescan team in order to determine whether the problem can be resolved through a re-scan of the available image. When the file is returned, the re-scanned image should be checked to ensure that it is satisfactory for the re-advertisement. If a re-scan will not solve the problem the applicant/agent should be contacted and asked to provide a representation of the trade mark that is suitable for publication.

Once a satisfactory image of the mark has been obtained the case can then be readvertised using the Readvertise Mark function on OPTICS. The previously published text is added to OPTICS at this stage. The Disregard Notice should now be completed as an erratum via the Journal Back Part Editor Function. This must be done on the same day the case is made readvertised on OPTICS to ensure that the re-advertisement and the Disregard Notice are published in the same Journal.

An e-mail advising of the re-advertisement should be sent to Law Section (in case a third party opposes the mark following the initial advertisement) and Register Administration (to check if a caveat has been filed). This should be done by using the public group called Re-Advert. A copy of the e-mail should be placed on the application file.

The file can then be returned to Nine Mile Point.

9 LATE OBJECTIONS

Late objections may be raised by the Registrar either pre-advertisement or post-advertisement. All such objections must be considered by or referred to Team Leader level or above.

9.1 Pre-Advertisement

If, after the acceptance of an application, a matter comes to the Registrar's attention because of an objection raised against a related application, the applicant should be contacted and given the option of dealing with the matter (as a late objection) during examination or after publication.

9.2 Observations

Third party observations (whether received pre or post publication) are always urgent and must go straight to the Team Leader.

Under Section 38(3), Observations about published applications can be raised by third parties. However, complaints about missed Earlier Rights cannot be considered outside formal opposition proceedings.

Upon receipt of the observation the letter will be passed immediately to the Team Leader whilst the file will be requested from Nine Mile Point by the Admin Support Team. The Team Leader must place a Delayed status on OPTICS to ensure the case does not proceed to registration.

The Registrar can refuse to register a mark after publication under Section 40 as a result of a matter which has come to his notice since he accepted the application.

When Observations are made, it is essential that the observer is told they must oppose if they wish to become party to the proceedings. On no account should a potential opponent be told that they do not need to oppose because the Registrar intends to raise a Late Objection.

Even if the Registrar initially takes the view that the application has been accepted in error this may change, for example, after Hearing, consideration of further evidence or in the light of some restriction of the applicants specification.

It is essential that a potential opponent is not misled into believing that the Registrar's initial response to an observation is a final one or that they will be given a further opportunity to oppose if the Registrar subsequently decides to register the application.

Any observation filed (including any received prior to publication) must be copied to the agent/applicant.

If the file is to be kept on the team pending a response from the agent, the Team Leader must pass the file to the Admin Support Team who will be responsible for storing the file and new shadow card in the Post Publication file store.

9.3 New Information

If new information comes to light the applicant must be told:

- What the new matter is
- That the Registrar does not intend to register the mark as matters stand
- Whether there appears to be a way of overcoming the objection
- That a reply is required by the end of the opposition period plus two weeks or within one month of the Registry's letter; whichever is later
- That he is entitled to a Hearing

The Examiner initially responsible for the case should be informed that a Late Objection is being raised and the reasons for the objection. In order to ensure that the application does not proceed to Registration in error, a Delayed status should be put onto OPTICS.

9.4 Application Allowed to Proceed Without Amendment

If following an observation the application is allowed to proceed without amendment there is no need to republish the application and the normal 3 month opposition period is not extended or reopened.

9.5 Application Allowed to Proceed Subject to Amendment

If the application is amended in any way, for example, the specification is amended (other than simple deletions), the amendment (and only the amendment) must be published in the back part of the Journal for opposition purposes.

There is a separate opposition period of a non-extendable one month period from the date of the publication in respect of the amendment. This period may run concurrently with the normal opposition period.

Simple deletions of descriptions or goods/services are not regarded as amendments to the application and there is no need to publish an amendment after publication where the only change is the straight deletion of items from the published specification.

In the case of a specification amendment, the request must be made on form TM21. Once this form is received the amendment should be considered by the designated Examiner to make sure that it is acceptable. If it is, the file should be minuted to Law Section indicating that the amendment is acceptable and asking them for the amendment to be re-published.

Once the separate opposition period has expired the Delayed status must be removed from OPTICS by Law Section.

9.6 Refusal of the Application (Post Publication)

If it is considered that the information justifies preventing the application proceeding, the Registrar must inform the agent/applicant that he does not intend to register an application using the standard letter on TERN. If no response is received to the Registrar's letter or the objection raised is maintained following correspondence or Hearing, the application should be refused in the usual way.

10 REMOVAL FROM RECORD

10.1 Withdrawals

An application can only be withdrawn when a written instruction is received from the applicant/agent. If a request is made to withdraw an application the letter may be dealt with by the Admin Support Team who will

- Link the request to the file
- Remove the diary date from OPTICS

The Admin Support Team will action the request on OPTICS using the Record Death function. The history text should indicate that the application has been withdrawn at the agent's/applicant's request.

A print showing the status of the mark must be placed on top of the right hand side of file and the file may then be forwarded to Nine Mile Point.

The recordal of the Withdrawn status on OPTICS will cause the automatic overnight generation of a letter confirming the withdrawal. No action is required by the Admin Support Team in respect of this letter unless for some reason it is not to be issued.

10.2 Partial Refusal

Where objections have been raised on an application that do not apply to all the goods/services listed, a partial refusal may be appropriate. The examiner must specify to the agent/applicant both those goods/services for which the mark is to be refused and also those for which the mark is to proceed.

If this was not specified in the examination report, a letter must be generated on TERN to inform the agent/applicant of our intentions. This letter will also allow a period of one month in which the decision may be appealed. If no response is received, the examiner will arrange for the application to be amended using the Partial Refusal checklist.

If the case has been the subject of a hearing, the Hearing Officer responsible for the case must clearly identify those items which are considered acceptable and those items for which the case has been refused. The Hearing Officer is responsible for confirming the exact wording of the specification.

In order to record the details of the exact items for which the mark is to be refused, it will be necessary to perform an Administrative Division. This differs from a normal Division in that:

- There is no fee payable by the applicant
- No physical division file needs to be created

10.2.1 Initial Examiner Action

- The examiner must copy the specification on the form TM3 before amendment
- The original TM3 must be amended to show the goods/services which are to be deleted under partial refusal, leaving only the acceptable terms
- The copy TM3 specifications must then be amended to show only those goods/services which are to be refused and must be attached to the Partial Refusal Checklist

The File may then be passed to the Clerical Support Team for further action.

10.2.2 Clerical Action

- Divide the case on OPTICS as normal with the "Form Override" indicator set to "Y"
- Do not create a physical duplicate file
- Place print of case details for both parts of the division on the right hand side of the file
- Add the following history text using CHA APP on OPTICS to the division containing the refused terms: "Partial Refusal Division"

The file may then be returned to the examiner.

10.2.3 Further Examiner Action

- Check the print of case details for both parts of the division
- If the division has been correctly recorded, the application containing the accepted terms may be prepared for advertisement using the new "Pre-Publication Check Domestic" form
- The "Partial Refusal Approved" box must be ticked to confirm to the Clerical Support Team that the division is correct and that status of the division must be changed to "Refused"

10.3 Total Refusals

Applications must be refused in totality if:

- There is no response to an examination report or correspondence and the objections remain valid
- The objections have been the subject of correspondence or a Hearing and a decision has been made that the objection must be maintained

All cases must be reviewed by:

- The Examiner responsible for the application
- The Team Leader if the case was subject to a Section 40 objection
- The Hearing Officer (via the Examiner) if the case was the subject of a Hearing

Cases due for refusal should be reviewed as to the status and ownership of Earlier Rights, practice changes etc before refusal.

Before any refusal action is taken on any case where there has been no response, a thorough search must be made to ensure that there is no unlinked correspondence relating to the application.

Upon receipt of the diary print the file will be moved from the post examination run, the diary date removed from OPTICS and file passed to the Examiner with a label attached asking for authorisation to refuse the application. The Examiner must detail the appropriate reasons for the refusal i.e. whether the case is to be refused on absolute grounds, relative grounds or both.

If a hearing has been held the Examiner must liaise with the Hearing Officer prior to completing the label to ensure that the Hearing Officer is content that the objections are valid and that the RAPP 12 letter may be issued.

The Examiner must review the file to ensure that all remaining objections are valid and that where Earlier Rights have been raised at least one is registered. Cases must not be refused where the only objections remaining relate to pending Earlier Rights. If the objections are still valid the Examiner should clearly indicate on the label the basis for refusal.

It may be appropriate for the Examiner to telephone the agent/applicant to advise that there may have been a change of practice or where only minor queries remain which may be overcome.

Please note that an application cannot be refused if only the following have been requested:

- A Camera Ready Copy
- A minor specification amendment
- A Journal clause

If the only problem is that a Journal clause has been proposed and the applicant has not responded, the case should be passed to Journal for publication with the clause previously put to the applicant.

If a minor specification amendment has been proposed, it should be established whether it is absolutely necessary. If it is then the goods/services affected by it should be struck out and the mark published for any remaining goods/services.

If all that is required is a Camera Ready Copy, it should be established whether one is

absolutely necessary. If it is, the Examiner should write to the agent/applicant again detailing that a CRC is required before we can publish the application. The letter should say that the application has been suspended pending receipt of the Camera Ready Copy.

10.3.1 RAPP 12 Letter

Should Refusal be appropriate, the file should be returned to the Admin Support Team for generation of the RAPP12 letter in TERN. The label on file must be completed and indicate whether the refusal is in relation to absolute grounds, relative grounds or both.

The letter must be amended in Word by the Admin Support Team to ensure that contains the details (name/reference etc) of the Examiner responsible for the case. The letter is signed by the Admin Support Team on behalf of the appropriate Examiner.

The file may then be placed in the file store for one month to allow the agent/applicant time in which to file a TM5 to request a Statement of Grounds on the case.

10.4 Restoration to Record

All applications for restoration must be considered at Team Leader level. Restoration of an application can only be considered if it can be proved that the Registrar refused the application in error. If the status has not been changed on OPTICS then a search to date will be unnecessary but if the status is Refused then a search to date must be undertaken.

If a search reveals a later filed mark, covering the same or similar goods/services and/or shows that a mark previously cited against the refused case has been informed of the refusal and allowed to proceed, then the relevant Examiner(s) must be informed and the case raised as a Section 5 conflict.

If an application is to be restored then the following action must be taken:

- Record restoration on OPTICS using the Restore Application function
- Prepare and date a new Shadow Card
- Note the minute sheet restored to record and sign and date
- Refer to the appropriate Examiner, who will write to the applicant/agent apologising for the error in refusing the case and giving a new date for reply

The file may then be placed in the Post Examination file store to await a response.

11 REFUNDS

11.1 General Guidelines

The Rules specify that:

"Where a fee has been paid in error, the registrar shall repay the same; and where a fee is paid in excess of the amount specified hereunder, the registrar shall remit the amount paid in excess".

A refund can therefore only be granted if:

- A fee has clearly been paid in error, e.g., duplicate payment, out of time filing, overpayment, fee paid when none is required
- A form has been filed by mistake, the error is quickly identified and no official action has commenced

A refund cannot be paid on the grounds that the application has been withdrawn, abandoned or refused in accordance with the Act or Rules, where an applicant has simply changed his mind or decided, for instance, not to proceed with some of the classes in a multi-class application.

Whilst refunds are not ruled out just because official action has commenced, in practice a detailed and convincing explanation should be requested in circumstances where an applicant/agent has filed a form by mistake. Any request for a refund must be considered by the Examiner and a recommendation made to the Team Leader.

All authorisation for refunds must be made at Team Leader level or above. If a refund is agreed the reason for the refund should be clearly indicated on the minute sheet and the file passed to the Admin Support Team.

The Admin Support Team will attach a label detailing the amount to be refunded, to whom the refund is payable and the reason for the refund. The file will then be passed to Registry Administration who will liaise with Cashiers Section to refund the money. Once actioned, the file will be returned to the Examiner for any further action required.

11.2 Ex Gratia Payments

A decision may be made to make an ex gratia payment to an applicant/agent. Such action must be agreed by the Head of Trade Marks. The file must be noted and approved by senior officers as follows

- Team Leader
- Deputy Head Examination
- Head of Examination
- Director of Trade Marks

Once approved by the Director of Trade Marks, the file will be returned to the Deputy Head of Examination who will liaise with the Team Leader to carry out the payment.