

**RESPONSE DOCUMENT**

**ON**

**A CONSULTATION ON FAST-TRACK PROCESSING**

**TRADE MARKS**

**Background**

1. In December 2005, the Chancellor of the Exchequer asked Andrew Gowers to conduct an independent review into the UK Intellectual Property Framework. The Review was published on 6 December 2006. One of the recommendations outlined in the Review focussed on the speed at which trade marks (and patents) are processed and suggested that fast track processing should be pursued in order to speed up the process when required by the applicant in a particular case. In the autumn of 2007 the UK Intellectual Property Office (UK-IPO) therefore carried out a public consultation on new fast-track services. Although the consultation made proposals in relation to both trade marks and patents, this response document deals only with the trade marks proposals. A separate response document dealing with the patents proposals will be published shortly.

2. In relation to trade marks, we proposed a new process whereby an applicant could request that their trade mark application be examined within 10 business days of it being filed. A fee of £300 (additional to the application fee and any class fees) was proposed for this fast-track service.

**Responses**

3. A total of 13 responses were received that commented on the trade marks proposals (please see Annex A for a list of these respondents). Responses were received from professional representative bodies and other interested representative bodies, firms of patent and trade mark attorneys, other interested firms, and from individual patent and trade mark attorneys.

4. The issues raised, together with our conclusions, are set out below.

## **Issues and conclusions – Trade Marks**

### General principle

5. In general terms, the majority of respondents welcomed the proposal to offer a 10 business day examination service subject to the payment of an additional fee. However, a number of respondents stressed the need to ensure that the offer of a new fast-track service would not have a detrimental effect on the speed or quality of the standard examination service.

### Conditions for applying

6. The majority of respondents agreed that the proposed conditions (online filing, fees being paid electronically up front, and limiting applications to only one trade mark) were not onerous and represented a workable balance. However, two respondents were disappointed that an application for a series of trade marks could not utilise the fast track service; it was argued that little additional work was required in relation to the examination of a series application and that series marks should be included, particularly given that a fee is to be charged.

### Level of fee and take-up

7. Most respondents agreed that the proposed fee of £300 would have the effect of balancing demand so that fast-track applications would not become the norm. This was important as a number of respondents stressed that the quality and speed of the standard service should not in any way decline when the new fast-track service is offered.

8. There appeared to be a general consensus that a balancing act was necessary to ensure that, on the one hand, the fee should not be too high (in order to ensure that smaller businesses could access the service if needed) against, on the other hand, ensuring that the fee was not too low (in order to deter larger businesses from using the service as a matter of course). The majority of respondents felt that the proposed fee (£300) was about right. Additionally, the fact that the standard service is already fast was highlighted by a number of respondents as another reason why fast-tracking would not be required often.

9. One respondent suggested that, as a general principle, the UK-IPO should offer fast services as a matter of course, and that fee reductions should be offered for those prepared to wait longer.

10. In terms of take-up, the respondents agreed with the UK-IPO's assumption that the service would not be required often and that the take-up would not exceed 10% of all applications. Indeed, there was a general feeling that the take-up would be less than 10%.

11. Informal opinions on the proposed service and the level of fee were also sought from customers and potential customers at, for example, business

meetings that the UK-IPO attends. The majority view supported the views expressed above, namely, that although the service would not be used often, it was a useful addition that may be used from time to time. Very few suggested that the fee was off-putting.

#### Other issues

12. Two respondents questioned the value of the service (one suggested there was no value at all) without an accompanying reduction in the 3 month opposition period. This observation was made because the time saving inherent in the proposed fast-track service was only a very small part of the overall length of time to secure a registration. One of these respondents made similar observations in relation to the time period that elapses between acceptance and publication.

13. Another respondent expressed the view that to maximise the value to the applicant, particularly given that a fee is charged, the UK-IPO should commit to undertaking other duties (such as responding to correspondence) more quickly.

#### Government response and conclusion

14. The views of all the respondents are fully appreciated and have been carefully considered. Given that the responses generally welcomed the proposal, and given that we still consider the proposal to have merit, we intend to proceed with a fast-track examination service.

15. We have considered whether any changes to the proposed system are needed on the basis of the issues identified above. In relation to the conditions for applying for fast-track examination, at this time we intend to retain the condition that only a single trade mark (not a series of marks) can make use of the service. Even for a series of trade marks that does meet the requirements of Section 41(2) of the Trade Marks Act, some additional work is necessary in the examination of the series aspect of the application. However, many series applications fall foul of Section 41(2) at examination stage and this creates even further work as, effectively, each mark in the series has to be examined independently of each other as they will be different in their material particulars. All of this creates a more complicated examination procedure. The other conditions did not attract any criticism.

**Conclusion - an application for expedited examination must be filed on-line through our web-site system, must be paid for in full at the time of filing (debit/credit card payment or via a deposit account) and can only relate to a single trade mark.**

16. In relation to the turnaround time, namely, to offer a 10 business day service, no adverse comments were received (other than from the respondent who said that the whole service had no value). 10 business days will, therefore, be the offered turnaround time. The 10 business day period will begin on the business date immediately following the filing date of the

application. The Office will be deemed to have met its obligation on the day that it sends (normally by e-mail or fax) the examination report to the applicant or his representative. If the date the examination report is sent is outside the 10 business day period then the fast-track fee of £300 will be repaid. Business days for conducting examination work are Mondays to Fridays (excluding Bank Holidays) as per the directions published and posted in the Office under Rule 70 of the Trade Marks Rules.

**Conclusion - the service offered will be that the UK-IPO will send the examination report to the applicant or their representative within 10 business days following the filing date of the application.**

17. In relation to the fee, again, there was little adverse comment. A small minority of respondents felt that the fee was high, but most appreciated that a balance needed to be struck between affordability and demand. We are content that the right balance has been struck. It is a fundamental requirement of our business plan that our standard service continues to lead the way in terms of both speed and quality and that fast-track examination should not be requested as a matter of course and should, therefore, only be required if a real business need emerges. The fee, in our view, is unlikely to deter a business of any size from requesting fast-track examination if a business need arose; most respondents agreed with this. We will therefore proceed with the proposed fee, but, we will also carefully monitor the system to ensure that the right balance has indeed been struck. If it has not, consideration will be given to changing the fee.

**Conclusion – the fee for fast-track examination will be £300.**

18. In relation to the ability of the office to speed up other functions such as dealing with correspondence more quickly, proceeding swiftly to publication once a mark has been accepted, and introducing mechanisms to reduce the length of the opposition period, the following observations are made. Firstly, in relation to the opposition period, the UK-IPO will shortly be conducting a consultation on whether changes should be made to the opposition period for all applications, whether or not they have been fast-tracked. Secondly, the IT systems that allocate accepted marks to the Trade Marks Journal are also being looked at, and, in due course, this time period will be reduced; further work will then be undertaken to ascertain whether further reduction is possible. In relation to the processing tasks carried out by the Registrar's Examiners, whilst we do not consider it right to specifically legislate for this activity, Examiners will, nevertheless, do their utmost to ensure that fast-track applications are dealt with and processed as quickly as possible. This will also include arranging and conducting hearings more quickly.

### **Next Steps**

19. The amendments necessary to the Trade Mark Rules 2000 and the Trade Marks (Fees) Rules 2000 to bring the fast-track system to fruition will be made shortly and will be publicly available thereafter. Further and more detailed

guidance on the new fast-track system will also be available on the UK-IPO web-site in due course. The new system will come into force on 6 April 2008.

## **Annex A**

### **List of respondents (trade marks proposals)**

Chartered Institute of Patent Attorneys  
Trade Marks, Patents and Designs Federation  
Franks and Co Limited (Patent and Trade Mark Attorneys)  
BBC (Litigation and Intellectual Property Department)  
Barbara Cookson  
Ideas 21  
Law Society of Scotland  
Licensing Executives Society  
NESTA  
Institute of Physics  
Mewburn Ellis (Patent and Trade Mark Attorneys)  
Microsoft  
NHS Innovations South East