

1. Introduction

- 1.1 This document provides some basic information on the Trade Marks Registry, and an opportunity we expect to fully advertise in the Official Journal of the European Union (OJEU), to renew the Registry IT systems. The purpose of this Prior Indicative Notice (PIN) is to forewarn interested service providers of this potential requirement, and that we are planning to hold a Supplier Day for the purpose of market sounding and to enable the authority to describe in more detail our proposed requirements. We envisage that an OJEU procurement exercise will commence in February 2009, although we reserve the right to annul any procurement process and not award a contract.
- 1.2 More information on our processes and requirements will be provided at the Supplier Day and our team will be available for a question and answer session. Following the Supplier Day we will ask suppliers to complete a short template questionnaire, which will inform us on potential solutions and costs. However, as the Supplier Day is not part of the formal procurement process we will not use the information to assess suppliers, but simply to give an indication of potential methods and costs. Suppliers will therefore have the option to complete the questionnaire on an anonymous basis.

2. The Trade Marks Registry and its core activities

What is a Trade Mark?

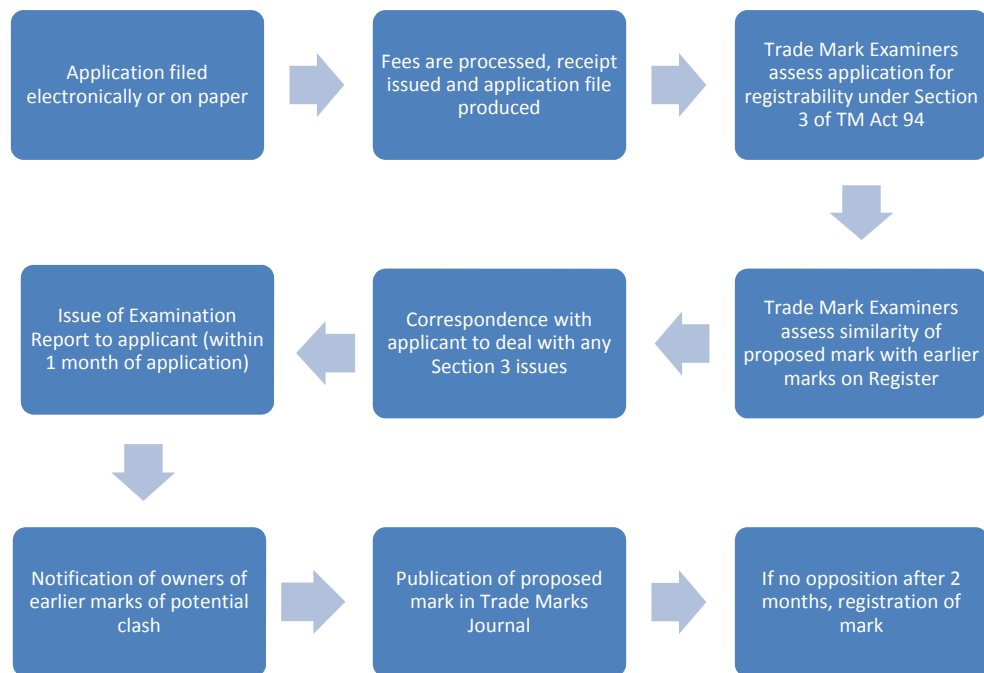
2.1 A trade mark is any sign which can distinguish the goods or services of one trader from those of another. A sign includes, for example, words, logos, pictures, or a combination of these. A trade mark is a badge of origin, used so that customers can recognise the product of a particular trader

2.2 The Trade Marks Registry (TMD) is a directorate of the UK Intellectual Property Office (UK-IPO). It has several functions, but the three core trade mark-related operations are described below.

Examination, Publication and Registration of UK Trade Marks

2.3 Businesses and individuals apply to the Registry to protect their trade marks (e.g. company or product names; logos; etc.) in the UK. These applications are examined to determine whether the marks are capable of being registered and to determine whether they are identical or similar to marks already registered or with an earlier date of application. Having been examined, acceptable marks are published in the Trade Marks Journal. When earlier marks are found the proprietors are informed of the application, and have the opportunity to oppose the registration. If there is no opposition after 2 months, the marks are then registered and placed in the Trade Marks Register.

Figure 1: High Level Process Map for Examination of Applications



A more detailed process map can be found at Annex A.

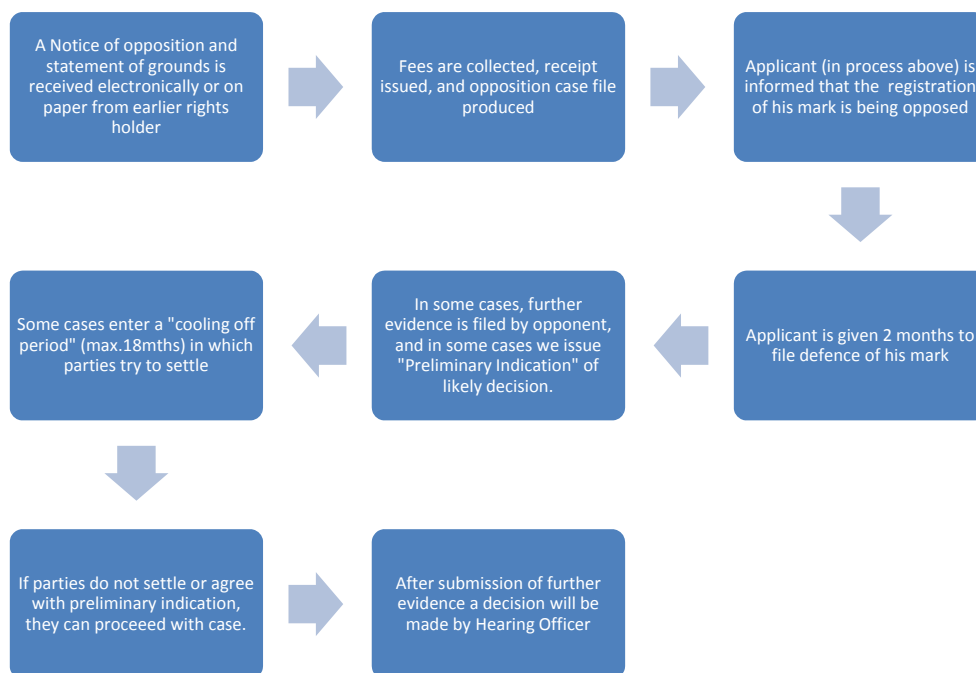
Examination of international applications in which applicant wants protection in UK as well as in other nations.

2.4 The UK joined the Madrid Protocol in April 1996. Since then, a holder of a Trade Mark registration in another country (which is a member of the Protocol) can apply through the World Intellectual Property Organisation (WIPO) to "designate" the UK for protection of that Trade Mark (the mark is examined in the UK for registrability in much the way described in Figure 1.

Operation of the Trade Marks Tribunal

2.5 When those businesses and individuals who own trade marks (registered or not) wish to oppose the registration of new marks in the UK, they can do so through the Trade Marks Tribunal operated by UK-IPO. The Tribunal Hearing Officers will hear evidence and arguments and decide on the case. The process for dealing with opposition cases is set out below.

Figure 2: High Level Process Map for Opposition Cases



A more detailed process map can be found at Annex B.

3. Underlying Activities

3.1 We have a number of other activities to support the core Trade Marks process, an overview of the main processes follows:

Search – we maintain a search collection of all marks which have protection in the UK. With the exception of the final bullet, all information is sent to us electronically, with minimal manual updating. The types of trade mark are:

- UK marks
- Marks applied for under the Madrid Protocol which designate the UK
- Community Trade Marks
- Marks applied for under the Madrid Protocol which designate the EU
- Protected emblems (eg national flags) and words (eg registered geographical names such as “Stilton” for cheese)

Community trade marks and designations of the EU under the Madrid Protocol are dealt with entirely by the Community Trade Mark Office. As well as searching these marks, we need to be able to retrieve the details of them for onward transmission to applicants for UK trade marks and those designating the UK for protection under the Madrid Protocol. This is because an existing Community mark (or Madrid (EU) Mark) can block a later conflicting UK mark.

In addition, we must hold an internally updateable database of the key data relating to the types of marks processed by the UK Office – UK marks and Marks designating the UK under the Madrid Protocol. This includes the mark, the goods/services for which it is to be registered, owner details, legal representative’s details, description of mark, details of any priority date that the applicant may be entitled to under international law, whether the

application is pending, published, opposed or registered. For these categories of trade mark we must be able to:

View and print case details – for internal staff and external access to trade mark information.

Edit case information – to enable changes and corrections to be made to trade mark information.

Manage the Refusals process – marks may be refused during the Examination and Tribunal functions.

Process Forms – we envisage a generic function will be needed to support incoming forms, and correspondence whether received electronically or on paper. Processing is required to receive the incoming document, handle fees, update case information (specific to the transaction type) and issue appropriate receipts. Some examples of the functions that will be needed are:

- Add goods or services to an application for registration
- Divide an application into 2 or more separate applications
- Full & Part Transfer of ownership
- Merge trade mark applications together
- Process name and address changes
- Process Full & Part surrender of UK marks
- Record & amend information regarding certification & collective marks
(Our forms are available on the website www.ipo.gov.uk)

Produce the electronic Trade Mark Journal, containing all the marks we have accepted for registration and which are open to opposition from third parties.

Process post registration “challenges” - there are similar processes to opposition for handling post registration applications to cancel UK trade marks and protection of Madrid marks which have designated the UK for protection.

Process expiries, renewals and restorations - trade mark registrations can be renewed every ten years. The process for doing this is straightforward requiring handling of fees, but no new examination. Expiry occurs when the trade mark is not renewed and restoration is the process for late renewal.

Provide management information – is required to monitor performance, internal and against published targets.

Produce documents – to include outgoing correspondence and official documents such as a “Registration Certificate”. Some letters are customised before issue, others are generated automatically.

Provide data extracts – we sell our Trade Mark information, receive ad-hoc requests for information and send data electronically to other Trade Mark offices.

Respond to external expressions of interest in the progress and outcome of particular marks and seeking notification of any changes made in relation to it.

UK Trade Mark owners may apply to WIPO for protection in other countries. In these circumstances the applications are received and checked by the UK office (including fee

handling) before sending to WIPO. We are then obliged to monitor the UK “base” registration for a period of 5 years and notify WIPO of certain events relating to the UK mark.

In relation to UK marks and designations of the UK under the Madrid system, we wish to maintain electronic case files for holding the case data and associated documents. Thus we need to:

Manage digital case files, including scanning, indexing, storing, retrieval, searching of internal and external documents on ECFs, receive and process fax documents. We will also need the facility to:

- View and print stored documents
- Add case notes to documents
- Add confidentiality layers
- Copy documents to other ECFs
- Share access to case files with appropriate controls

Provide generic System Functions eg Work allocation, exception handling outside normal workflow, archiving cases, system administration and maintenance functions

Much of the information relating to designations of the UK under the Madrid system is sent to us electronically from WIPO. We must be able to process incoming transactions and send outgoing transactions according to defined standards.

5. Workload

Applications for Trade Marks

5.1 In 2006, 32,049 national/domestic applications were filed. 33,375 were filed in 2007. Some 7,455 applications designating the UK under the Madrid Protocol were filed in 2006, and 6,544 were received in 2007.

Opposition Cases

5.2 A total of 907 opposition cases were filed in 2006, and 1031 were filed in 2007. But as a result of some amendments of the Trade Mark Rules 2008 (secondary legislation), we expect to receive more opposition cases in 2008 and into the future.

Renewal of Trade Marks

5.3 A total of 30,091 registrations were renewed in 2006, and 33,481 were renewed in 2007.

6. Current IT infrastructure

6.1 The trade mark examination and oppositions processes are supported by a number of IT systems. These systems assist examiners and case workers carry out some of the tasks described above. But there is currently no electronic workflow management. The main systems and their uses are described below:

IBIS – an internal image search system, and the only system we have that holds details of all marks (UK and international), in one place. It is also the main processing system for the work we do on Community Trade Marks and certain international applications (Madrid EU). It is a

Documentum based system and uses a system developed by the Swedish office (Marksman) for word searching.

OPTICS is the key processing system for all UK trade mark applications and stores data on them. It was developed in the late 1980s and is built on an IDMSx database.

TMAD is the key system for processing certain international applications (Madrid UK) and was introduced around 1996. It is built on a Foxpro database.

TERN is our letter writing/examination report production system. To produce these it takes details from OPTICS and IBIS. It also automatically updates OPTICS.

LAWS – is a statistical system used in the Tribunal Section to keep track of cases there. It is based on Visual Foxpro.

QUALS is a lesser system used to generate data relating to quality standards and effectiveness of decision making.

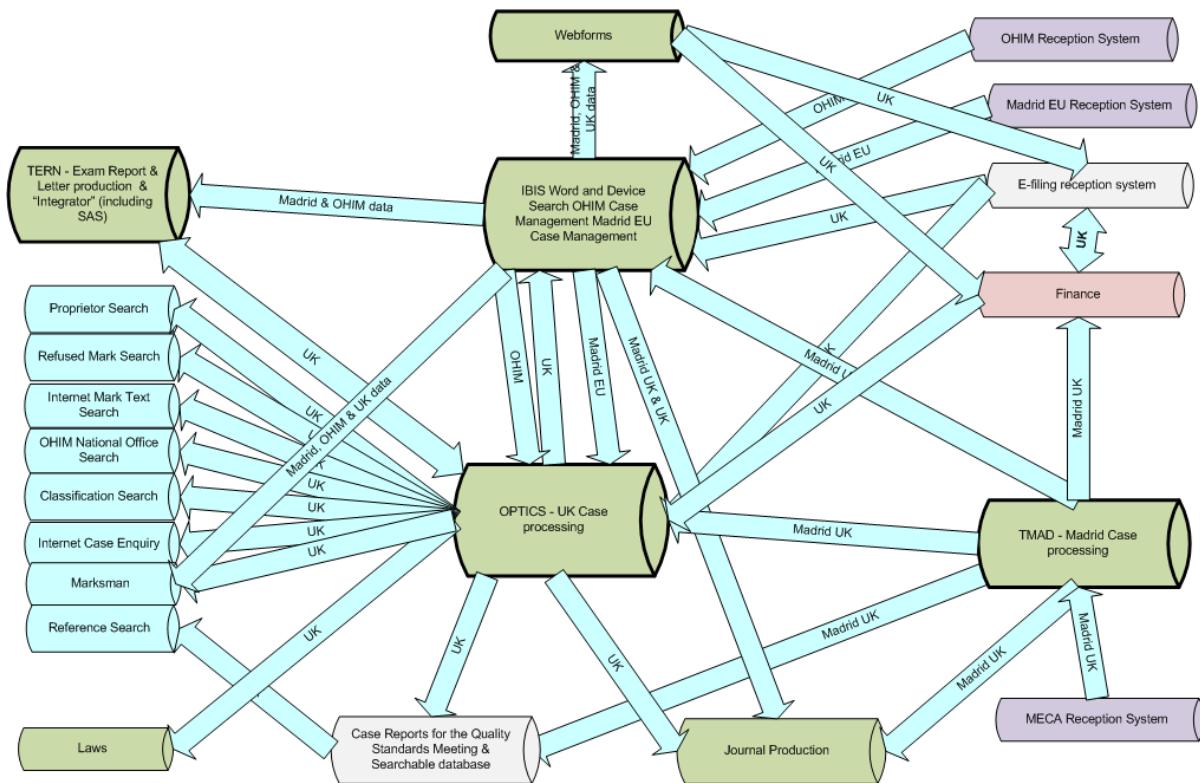
We have various PC based systems to support minor parts of the process (e.g. production of the Trade Marks Journal).

We have some web based applications that provide for e-filing of applications for UK registrations; e-filing of intention to oppose the registration of a mark; registering an e-caveat (expressing an interest in a mark and seeking notification of any changes made in relation to it; and electronic subscription to our “notification” service in which we notify earlier rights holders of marks being applied for that may conflict with theirs. We also provide internet searches, by which the UK register can be searched.

We have an ORACLE financials system that processes applicant payments.

6.2 There is currently very little IT supporting the operation of the Trade Marks Tribunal. The majority of historic IT investment has been in providing support for the examination of applications for trade mark registration.

Figure 3: Current Trade Marks System Map



6.3 As Figure 3 very clearly demonstrates, there are currently too many systems used to support the trade mark examination process. There are also too many “point to point” connections. This complexity results in three things: i), changes to any part of the system can have unforeseen consequences to other parts; ii), inordinate time has to therefore be given to testing and managing system interdependencies; and iii), this makes change very expensive.

6.4 Some of the systems described above are old and have not been as reliable as we would have liked. This has had a detrimental impact on examination performance and staff morale.

6.5 The current systems have brought electronic processing to only parts of the examination flow process. We have a web-front end by which applicants can apply using e-application forms, and commence other activities using other e-forms. We clearly have a database containing detail of registered marks, and examiners use a search system to compare marks being newly applied for against older marks. They use TERN to generate their initial examination report, and certain stock letters. But there is no real electronic caseflow. All applications continue to be made into paper files which are then sent from administrative teams to examiners and back again.

7. Resources

7.1 Before commencement of this project, TMD had c.200 staff. Around 85 of these were Trade Mark examiners or opposition case workers, or Tribunal Hearing Officers. The remaining 130 fulfil administrative or managerial tasks.

7.2 Approximately £4m is spent every year in supporting/developing Trade Marks Directorate IT.

8. Performance

8.1 Despite the limitations imposed by our current IT, both in terms of coverage and reliability, the Registry is highly performing. It is regularly held up as being one of the best in the world. We have the following public targets. We are exceeding all of them

Targets		
To register 90% of processed Trade Mark class applications, to which no substantive objections have been raised or oppositions filed, within 7 months of application.	Make the correct decision on registerability in at least 98.5% of trade mark applications	To register 95% of correctly filed design applications within 2 months

9. The Trade Marks Business Review and IT Options Project

9.1 In May 2008 the Board of the UK-IPO agreed that there were several compelling reasons for reviewing trade mark business processes and IT provision:

- UK demand for trade marks and designs is fluctuating, and we need to ensure that our services remain those that customers want;
- there are inefficiencies and areas of latent risk embedded in the existing processes that ought to be removed to deliver value for money and good quality;
- a reduction in our fixed costs may be necessary to implement any changes that will be needed to ensure that we can continue to offer a competitive service; and
- we need to consider how the current costs and complexity IT systems used to support TMD can be reduced, and whether investment in new IT could enable better processing of applications.

9.2 With this project we intend to achieve a number of strategic objectives.

Modernising TMD

Identification of new services and amendments to our existing services that are desired by businesses, and their introduction by October 2009

Reducing the cost of our key business processes so as to be able to demonstrate an increase in efficiency. Further improving quality of services.

Replacing our current IT with a system or systems that will cost less to change and maintain; will allow electronic case management; and will reduce complexity of current provision

10. What do we want new IT to do?

10.1 We want to work with a supplier to develop a new system (or adapt an existing system) to replace most of the legacy systems on which Trade Marks Directorate relies. In detail this will involve providing a system that:

- links with our existing web based services by taking in e-applications and creating an electronic case files in the Examination and Tribunal Sections;
- will replace IBIS, OPTICS and TMAD and TERN by providing a database; workflow; and electronic correspondence;
- enables scanning and indexing of incoming paper;
- generates letters some of which will then be customized by the user (e.g. the initial examination report) and some which will not (e.g. renewal reminders), and allows for outgoing correspondence to be electronic or on paper;
- provides management information. Precise requirements have to be defined.
- will link to our existing ORACLE financials system.
- in addition to optimizing our existing core services, new IT support will also be required for new services for customers that we expect to introduce in October 2009. At this stage it is difficult to say for certain what precisely will be required, but our assumption is that there will be a new pre-application service that it is likely to add another step in our flow process for examination. This is not fully mapped however as customer research has not yet been completed. Tribunal Section activities are more fixed and are unlikely to radically alter in the next few years.

11. What will the Registry look like after the business review and IT project?

11.1 The bullets below set out some of the detailed changes we expect to make using the project:

Services

- Most applications (80%) for trade marks will be e-applications. While we will continue to allow paper applications, we will disincentivize their use. Most requests for other services (e.g. commencing an opposition, seeking invalidation etc) will also be by e-forms. We will have increased the number of our services that can be applied for on-line.
- We will have improved our web services to allow the use of pick lists for certain parts of the application form (e.g. selecting the right classification of goods and services), and we will have incentivized their use.

- A degree of customer self-service will have been delivered for minor services.
- We will provide electronic communication for customers; this means that customers will be able to correspond using telephone, paper, fax and e-channels.
- Having applied, whether on paper or electronically, businesses and individuals will be able to check the status of their application or request for other service via our website.
- The Registry will continue to be accessible to applicants, but queries relating to the handling of applications and requests for other services will be dealt with in a greater number of ways. Applicants will continue to be able to talk to examiners direct, but we will also promote use of email queries directed to a central Registry point. Such queries will be indexed and routed to the right people. We may also have an initial call screen that is used to prevent generic queries being directed at examiners and opposition case workers.
- Paper case files will have been replaced with electronic case files. Rules will ensure that they are routed to the right people (administrative staff and examiners, and in the case of Tribunal Section, admin staff and opposition case workers) at each stage of consideration and registration.
- We will operate a new application support service providing advice to applicants prior to the formal filing.
- We may offer more methods by which applications can be paid for. For example we may offer a service in which part of the fee is paid for on application, and another part paid (assuming the applicant wishes to continue with the application) after the initial examination stage.
- There is likely to be an increase in remote working.

Quality

- Electronic case working will allow us to operate “rules” that will ensure that certain cases are subject to certain approvals, and that are capable of being changed in the light of experience. Discussion of cases (between peers or with a manager) in electronic forum will be an option.
- Electronic caseload will allow us to “Fast Track” particular applications.
- Electronic case working will enable us to use management information to understand the number of cases at each key examination/opposition stage; the provenance of applications; and the performance of Registry workers. It will also generate the key statistics we need to demonstrate performance against Agency targets.
- We will implement a recognized quality accreditation system.

Performance

- We are not expecting electronic caseload to dramatically improve the speed of processing for either applications or oppositions. We expect to continue to meet Agency targets.

Efficiency

- We do expect removal of paper case files and their manual handling to allow reduction of our administrative staff in both Examination and Tribunal Sections.
- There may be scope as a result of marginal savings in examiner time, to make reductions in their numbers.
- As part of our business review we will have identified some activities that we can stop doing, and will have improved the execution of others.
- We will have reduced the sum that we spend on supporting TMD IT. We will have reduced the numbers of staff working on support and development of TMD IT.
- Overall a 20% efficiency will have been achieved.