

Chapter 1

New Applications

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1 Introduction

The purpose of New Applications Section is to check that new applications are valid and, if they are, to:

- record the details of the application in the Registry's database so that it is available for search and examination purposes; and
- issue the applicant (or their representative) with a receipt confirming the application details.

We will also notify the applicant of any deficiencies including, for example, wrong payments. The Team Leader is authorised to refund overpayments.

We examine applications to make sure that they meet all the requirements for filing before we record the relevant information. We cannot give the application a filing date until all essential filing requirements (see paragraph 3.1 below) are met.

We transfer text into the OPTICS database and, if the application includes an image, we classify it according to the Vienna classification system and scan it into the IBIS database.

If an application contains a very long description of goods or services (the specification) we may contact the applicant to ask for an electronic copy of the specification. This saves us time in recording information and reduces errors, and does not affect the filing date of the application.

When we have recorded the information, we send the applicant a filing receipt showing what information we have recorded. It is important that the applicant checks the receipt and tells us of any errors so that we can correct them.

When we have recorded all information, we make up a file for the application and send it to a trade mark examination team.

2 How to send applications to the Office

2.1 In person to London or Newport

The Office is open for business Monday to Friday, between 9.00 am and 5.00 pm. Notices, applications and other documents may also be delivered up to midnight on Monday to Friday.

The Office is closed on Good Friday, Christmas Day, and on any bank holiday or any Saturday preceded by one of these.

Note The Office is currently proposing to consult interested parties on this policy with a view to making certain changes.

2.2 By post, or a commercial delivery service, to London or Newport

This includes the Hays DX (Document Exchange) service, for which the Office's number is:
722542 Cleppa Park 3.

The date of receipt in the Office, whether London or Newport (Rule 2(3)), will be used as the filing date of the application. No other treatment of post is authorised by the Trade Marks Act or Rules.

Note Rule 67 offers a discretion to allow the late filing of documents in particular circumstances, but this only applies to documents sent in the 'postal services' and which have to be filed 'within any period of time specified in the Act or Rules'. This latter qualification means that the rule therefore does not apply to new applications.

2.3 By facsimile transmission (fax) to Newport

We operate a fax filing facility. Fax machines in Document Reception can receive transmissions on a continuous basis (24 hours a day and seven days a week) and they automatically record the time and date of receipt of the documents.

The fax number for filing new trade mark applications is: 01633 817777

Applicants should not send applications to any other Office fax number because this may result in a delay in allocating a filing date. Applications for marks containing colour may be faxed, but the applicant should ensure that the elements in colour are clearly labelled and the colours defined using an internationally recognized colour identification system, such as Pantone®, Focoltone®, Munsell Color® or Toyo®.

2.4 Electronically

Applicants may use the on-line application form TM3 on our website. There is full information about what details are needed to fill in this form on the website.

Applicants can e-mail their applications direct to the Registry provided that they follow the correct file format.

3 Preliminary check of the application form

We check every application to make sure that it meets the requirements for filing stated in the Act and Rules. Some requirements are essential in order to obtain a filing date, as explained in paragraph 3.1 below. Others are not essential for filing date purposes but must still be met before we can send an application on to examination, as explained in paragraph 3.2. If the requirements have been met, the filing date is the date when we received the application. If the filing requirements have not been met, the filing date will be the date when we receive the last document which puts the application in order.

3.1 Essential requirements for filing date - Section 32(2) of the Act

We give an application a filing date as soon as all the essential filing requirements are met. These are as follows (the paragraph letter corresponds to that in Section 32(2)):

(a) a request for registration of a trade mark

A request for registration is generally taken to be the provision of form TM3 which in itself requests registration. However, if we get a letter which clearly states that a request for registration of a trade mark is sought, this would be sufficient to meet this requirement.

(b) the name and address of the applicant

The name and address of the applicant (who becomes the 'proprietor' once the mark is registered) must be supplied. The name of the applicant must be the correct legal name (particularly in the case of companies) and not a trading name or style. Further guidance on the acceptability (or otherwise) of certain types of applicant is given in paragraph 5 below.

(c) a statement of the goods or services for which it is sought to register the trade mark

An application must include a list, or statement, of all goods and services (the specification) for which an applicant uses or intends to use the trade mark. It is not essential to provide a class number in order to obtain a filing date, but this is a requirement which must be met before the application can proceed further. The specification will not be examined in any detail at this stage; a detailed examination will be made by a trade mark examiner, but if the specification is not clear we will contact the applicant to clarify the specification.

(d) a representation of the trade mark

A representation of the mark (or marks in the case of a series) in the format that registration is sought must be provided. Further guidance on how to represent marks is given in paragraph 4.4 below.

3.2 Non-essential requirements for filing date

3.2.1 Use or bona fide intention to use - Section 32(3)

Every applicant must be either currently using the trade mark (or allowing someone else to use it with their consent) or have a *bona fide* (good faith) intention to use it in relation to the goods or services requested. The declaration on the application form, stating this, must be signed by the applicant or their representative.

3.2.2 Application fee and class fees - Section 32(4) and Rules 5 & 11

The applicant must pay a basic application fee covering the first, or only, class in the application. If further classes are requested, each extra class is subject to a class fee. As this requirement is not essential for filing date purposes, payment does not have to be sent with the application form.

3.2.3 Form TM3 to be used - Rule 5

If we get a request for registration of a mark which contains all the essential requirements for allocation of a filing date, we will allow two months for these details to be transferred to an official application form TM3, or an acceptable replica of that form (Rule 3(2)), and for this form to be returned.

3.2.4 Application to specify the class - Rule 8(2)

The application must specify the class of the Nice classification system, as set out in Schedule 3 of the Rules, to which it relates. This is used to allocate class numbers to the specification.

3.2.5 Address for service

If the applicant is not based in the UK, and not represented by someone based in the UK, they must provide an address in the EC or EEA with which we can correspond. Applicants based in the Channel Islands and the Isle of Man will not be asked to provide an address for service in the UK.

3.3 Dealing with deficient applications

If any filing requirements are not met, we send the applicant a letter, stating why the application is not acceptable and allowing two months to remedy the deficiency. This letter is issued under the provisions of Rule 11, or Rule 10(6) in the case of lack of an address for service in the UK.

If the deficiency is not remedied within the two-month period, the application will either be:

- deemed never to have been made, in respect of essential requirements; or
- treated as abandoned, in respect of requirements which are not essential for obtaining a filing date.

Note The two-month period runs from the date we issue the deficiency letter and cannot be extended (Rule 68(3)).

4 Other queries or objections raised at new application stage

4.1 Inconsistencies in the application form

We check to make sure that information on the application form is consistent and logical. Common errors include:

- number of marks in the series differs from the number of marks provided;
- inaccurate priority claim, for example. based on earlier UK filings;
- a statement that the mark is a certification or collective mark but does not appear to be so;
- obvious errors in the mark or specification; and
- mark type, if stated (see list at paragraph 4.2 below), does not match the mark.

We try to resolve most inconsistencies by a phone call, primarily as a matter of customer care, to the applicant or their representative. However, it is the responsibility of applicant to ensure that they have completed their application form correctly.

4.2 Mark type

We allocate a mark type to every application. This is an administrative action which aids the search for similar marks. If the mark type is unclear from the answer on the form, we will resolve this before we record the information on the application form. We may refuse requests by applicants to correct this information at a later stage.

If the application is for a series, we will allocate the mark type which describes the most complex mark in the series.

The mark types are:

WO Word only	A word or words with no particular form of presentation
SW Stylised word	A word or words presented in a particular manner
DO Device only	Solely device or pictorial marks
DW Device and word	A word or words together with a device or pictorial element
FO Form only	The shape or form of something
FW Form and word	The shape or form of something which has a word or words appearing on it
MO Miscellaneous only	Marks that do not fall into any of the above, for example, sound, smell, colour marks
MW Miscellaneous and word	As miscellaneous only but also including a word or words.

4.3 Graphical representation

The applicant must provide a representation of the mark in order to secure a filing date (Section 32(2)(d) refers). To be represented graphically, marks should be presented in a way that is 'clear, precise, self-contained, easily accessible, durable and objective' (see Sieckmann, ECJ case C-273/00). If this is not the case, we will raise this as a filing deficiency. If an acceptable

representation is filed within the prescribed two-month period, the filing date will be the date when we get the satisfactory representation. If the deficient mark is one of a series of marks, an instruction to delete the offending mark within the two-month period will allow the application to keep the original filing date. If the offending mark is not deleted, we will deal with the application as described in paragraph 3.3 above.

4.4 Guidelines for particular types of mark

If an application is for a series of marks, each mark in the series should be numbered. These numbers should be used to identify a mark when answers to particular questions on the application form only apply to specific marks in the series.

4.4.1 Marks consisting exclusively of colour(s)

Marks consisting exclusively of a colour or colours may be represented by giving a written description of the colour(s), for example, dark blue and light green, in the box on the form, and by stating what those colours are, using an internationally recognized colour identification system, such as Pantone®, Focoltone®, Munsell Color® or Toyo®.

Where marks consist of a colour or colours applied to the goods or their packaging, or to other commercial items, an appropriate description should be included as part of the representation of the mark. Where colour is applied to the whole, or substantially the whole, surface of the item in question, a statement to this effect will suffice. In other cases a picture or diagram may be necessary to identify the area(s) of the item to which the colour or colours are applied.

Where marks consist of a combination of colours in the abstract, without contours, the representation must also include 'a systematic arrangement associating the colours in a predetermined and uniform way' (see *Heidelberger Bauchemie GmbH*, ECJ case C-49/02). So, for example, where a mark consists of colours used in various applications, but always as stripes, the representation of the mark should indicate that the colours (as properly defined) are used as stripes and must indicate the order in which the colours appear in the stripes, that is, blue, then red, then green.

4.4.2 Picture or device marks

If a mark is shown in colour, we will assume that the mark is to be registered in these colours unless the applicant states otherwise in the form. Other than in the types of trade mark described in paragraph 4.4.1 above, there is usually no need to provide a written description of the colours that appear in a trade mark consisting of a picture or a device (but see paragraph 2.3 above). If written colour identification codes are included in the application they will be recorded as part of the representation of the trade mark.

If a mark is shown in black and white, we will not consider these colours are a feature of the mark unless the applicant states otherwise in the form, in which case the trade mark will subsequently be published and registered with an indication that the colours black and white are a feature of the trade mark.

4.4.3 Three-dimensional marks

Applicants must state in the form if they are applying for a three-dimensional mark.

It is unlikely that a mere description of a three-dimensional article would ever be sufficiently precise to meet the requirements of the Act. Usually, we will not give a filing date to applications describing three-dimensional marks in words until a pictorial representation of the shape is supplied.

If the subject matter consists of the overall shape of the goods, or a container, it is difficult to represent the shape by a single front view which may not show whether it has a round profile or is four sided. Unless the subject matter can be demonstrated by a single perspective view, multiple views of the shape are necessary (no more than six as a general rule). The more complex the shape, the more likely it is that multiple views will be necessary. When multiple views are shown, each view should be named, for example, front view, side view.

Three-dimensional marks may be represented by a picture, or pictures, and words which describe the subject matter of the proposed registration. However, attempts to put forward pictures as mere examples of the shape described in words usually do not meet the requirement for 'a clear and precise' representation of the mark. In such cases, the application may be refused a filing date until any deficiency is corrected.

If the subject matter consists of only part of a shape (such as a lid for a container), or the position of something (such as a label) attached to a three-dimensional object, it will not usually be necessary for the representation of the mark to show more of the shape than is necessary to disclose the subject matter, in these examples, the shape of the lid or the position of the label.

If a three-dimensional mark is represented by a perspective or other view(s) which discloses the essential particulars of the shape in question, it will not usually be necessary to confirm that the shape appears the same from other views. The same applies to three-dimensional marks incorporating labels. It is assumed that only those features visible from the representation form part of the subject matter; whether a container has another label on the back is irrelevant.

4.4.4 Sound marks

Sounds must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically. Sound marks, like smell marks, are not in themselves capable of being perceived visually, but they must nevertheless fulfil the requirements of being represented graphically on the application form. The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. It is sufficient that the sign is easily intelligible, even if not immediately so. (See *Shield*, ECJ case C-283/01) To this end:

- applications for sound marks must clearly state that they are sound marks, otherwise the application will be examined as if it were a word and/or device mark (for example, in the case of musical notation); and

- graphic representation requirements are met by representation of the sign by a musical staff divided into measures and showing, in particular, a clef, musical notes and rests, indicating relative value, and sharps, flats and naturals (accidentals). This will render the timing and pitch intelligible.

The requirements of Section 1(1), and therefore Section 3(1)(a), are not met by a written description of the sound, for example, that the sign comprises a particular piece of music, or a list of the notes of which it is comprised, or the sound an animal makes. Simple sequential musical notation without indications as to timing and pitch, will also not meet the necessary requirements. If the musical instrument used to produce the sound forms part of the mark this should be stated.

The Registrar has not taken a position on sonograms and their acceptance is dependent upon whether they can be properly regarded as analogous to musical notation, particularly when it comes to the ease of reproducing the sound accurately from the sonogram.

4.4.5 Moving images

Movement marks require the same degree of clarity of representation as any other application, that is, the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (Sieckmann criteria, see paragraph 4.3 above).

Movement marks can be graphically represented by a series of still images and each case may have its own individual requirements, but the representation of the mark should include:

- that the mark is a moving image;
- what the image depicts, that is, what the change in appearance is;
- how many images are involved in the complete sequence of movement;
- what the sequential order is of the images; and
- that there is a single sequence of movement (not variable).

4.4.6 Holograms

For multiple feature hologram marks to meet the graphical representation requirements, the application form must contain representations of each of the various views depicted in the hologram. This will ensure that third parties can clearly see all the material features of the mark. For a very simple image, where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable.

4.5 Quality of representation filed

Care should be taken when filing the representation of a mark to ensure that it is of good quality. The applicant may file a camera ready copy (CRC) which improves the quality of a representation at a later date but we will only accept it if the clearer representation merely removes minor imperfections. If the CRC looks substantially different we will not accept it.

A CRC is a representation of the mark which has been produced to be scanner ready. CRCs are often produced by firms of professional printers or artwork providers and are commonly provided on bromide paper. A CRC is easier for us to use when the representation has to be scanned.

In line with International trade mark applications, for example, Madrid and OHIM, form TM3 has a box measuring 8cm by 8cm in which the applicant should place a representation of the mark. If the mark will not fit in this box then it may be attached on a sheet of paper no larger than A4 size. If the application covers a series of marks which cannot fit in the box, it helps (though it is not a formal requirement) if all the marks forming the series are placed on one sheet of paper no larger than A4.

5 The applicant

A registered trade mark and an application for registration are both personal property (Sections 22 and 27 refer). This means that an applicant must be an individual (a natural person) or some sort of legal person, capable of owning property in their own name.

Where there appears to be some doubt as to an applicant's legal status, we may ask for confirmation that the applicant has the necessary standing to hold property. If the application is made on behalf of an unincorporated association, it is important to remember that the association as such may not be capable of owning the application or the trade mark: unless the association is in the nature of a partnership, this can only be done by specified persons acting as trustees for the association. Similarly, an application on behalf of an unincorporated charitable trust must be made by the trustees. An application in the name of a body calling itself a 'trust' or a 'club' is liable to give rise to such a request for clarification.

We use the following guidelines when considering whether to question the legal status of an applicant:

Companies/corporate bodies

Any form of company, that is, a business incorporated into a legal entity as distinct from its members or directors, is capable of holding property in its own name.

Partnerships

Partnerships (including limited liability partnerships, partnerships governed by an agreement and partnerships at will) are allowed to be recorded as applicants. If the applicant is a partnership, we will require that this be stated in the application, after the name of the partnership, for example, 'Boggles (a partnership)'. In the case of a partnership at will, it is necessary to list the partners who make up the partnership because (in the absence of an agreement) the legal personality of the proprietor will change every time a partner changes.

Other unincorporated bodies

Other unincorporated bodies may not have the capacity to hold property in their own name.

Trustees

Where an application is made by a trustee or trustees, for the benefit of another person (or body of persons), it should be noted that only the name of the trustees will be entered on register. That is because Section 26 prohibits the entry of merely beneficial interests. Accordingly, the register will contain only the name of the legal owner of a mark, even where the beneficial owner is another person or body. Furthermore, that will still be the case, even where the beneficial owner is itself a person capable of owning property in its own right. Thus, wherever it is intended that the trade mark is to be held on trust for someone other than the legal owner, that legal owner (the trustee), rather than the beneficial owner (the person for whom the property is held), should be listed as the applicant.

Registered charities

The mere fact that an organisation is a registered charity may not entitle the organisation to hold property; some other form of legal personality may be needed before it possesses property holding powers. However, the Registrar will accept an assurance from the filer that a registered charity has the necessary status to hold property in its own name.