

Chapter 6 Register Maintenance

- 1 Introduction**
- 2 Renewals**
- 3 Restorations**
- 4 Registrable transactions**
 - 4.1 Assignments**
 - 4.2 Licences**
 - 4.3 Other registrable transactions**
- 5 Other amendments to the register**
- 6 Certified copies**
- 7 Requests for information about applications and registered marks (Caveats)**
- 8 Supplying copies of the register and documents held in the Registry (Sales)**

1 Introduction

The Register Maintenance Section is responsible for:

- maintaining the register of trade marks, and its linked database of names and addresses, ensuring they are as accurate as possible; and
- supplying, and certifying where requested, information held on the register.

The register of trade marks is a legal document and may not be amended in any way other than by the correct processing of a valid request (usually on an official form), normally by the proprietor of a registration, or someone authorised by them.

Most requests are made by agents. We need proof of someone's authority to request a particular action only where:

- an agent is appointed for the first time during the course of proceedings;
- there is a change of agent during the course of proceedings; or
- there are any doubts about someone's authority to act, or that authority is challenged or questioned by someone else.

2 Renewals

References: Act: Sections 42-43 Rules: 27-29 Form: TM11 +fee

A trade mark is registered for ten years from the date of registration (*Section 42(1)*) which in effect is the date of filing of the application (*Section 40(3)*). At the end of this period, the registration may be renewed for further periods of ten years (*Section 42(2)*). The renewal date is calculated from the date that the trade mark application was originally filed even where the applicant may have claimed an international priority date, except for transformation applications under the Madrid Protocol and Community Trade Mark conversions which are deemed to have been filed on the date of designation of the UK or the CTM date respectively.

All 'old Act' marks which were renewed before 31 October 1994 and are still within a 14-year renewal period will continue as such. Their next renewal will be for a period of ten years, which will become the cycle after that.

We issue renewal reminder letters approximately three months before renewal is due (*Section 43(2) and Rule 27*). Registrations may be renewed by returning this letter, duly signed, or by filing form TM11, with the appropriate fee.

Multi-class registrations require a fee for each class to be renewed. A proprietor may choose to renew all, or only some, of the classes covered.

Late renewal

If a registration is not renewed by the renewal date, that fact will be published in the Trade Marks Journal. However, the mark may still be renewed within six months of that date on payment of the standard renewal fee **plus an additional renewal fee** (*Rule 29(1)*).

Late registration

If an application takes more than ten years to become registered, that is, after the first renewal date, the eventual registration may be renewed on payment of the standard renewal fee **plus an additional renewal fee** within six months of the actual date of registration (*Rule 29(3)*).

Effect of non-renewal

If a registration is not renewed by the appropriate date, it will be shown as 'Expired' on the register, with effect from the renewal date, and removed from the register six months after that. It is not possible to take any action, for example, assignment, licensing, merger, on a mark which is expired. It may be possible to restore a registration within a year of expiry (see next section).

We publish both the renewal and removal of marks in the Trade Marks Journal (*Section 43(6) and Rule 29(4)*).

3 Restorations

References: Act: Section 43 Rule: 30 Form: TM13 +fee

If a registration is not renewed within six months of its renewal date, the proprietor (who may not necessarily be recorded as the registered proprietor) may still apply for it to be restored to the register within the next six months, that is, up to one year after its renewal date. In addition to the Renewal Request (form TM11) and its fee, the proprietor will need to file a Restoration Request (form TM13) and its fee, **together with a full explanation of why the mark was not renewed within time.** The request to restore the mark will be considered by the Team Leader, who may restore the mark to the register and renew the registration **if, having regard to all the circumstances of the failure to renew, he is satisfied that it is just to do so** (*Rule 30(1)*).

In exercising this discretion, the Team Leader must have due regard to all the circumstances surrounding the failure to renew, for example, there should have been a continuing underlying intention to maintain the registration. A proprietor should not be refused restoration because of the failure of his appointed agent to ensure renewal.

If there has been a change of ownership of the mark since its last renewal, the current proprietor will need to demonstrate his right to ownership, for example, to establish the chain of title in the mark. In such circumstances, assignment action is also usually required, but this cannot take place until after the mark has been restored to record.

If the Team Leader declines to restore a registration, he should inform the proprietor in writing of his reasons for so doing, and offer a hearing. If, after a hearing, or in the absence of any response to that letter, the registration is still not restored to record, then **only the renewal fee will be refunded**, not the restoration fee.

The restoration of marks is published in the Trade Marks Journal (*Section 43(6) and Rule 30(2)*).

4 Registrable transactions

References: *Act: Sections 24-25 & 63 Rules: 40-41 Form: see below*

Anyone who claims to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction, or to be affected by such a transaction, may apply to have the details of that transaction entered in the register.

It is only necessary to file original documentation to establish a registrable transaction if the appropriate signature(s) cannot be provided on the official form. This means the signatures of both parties to an assignment (*Rule 41(2)(a)*) or the signature of the grantor of the licence or security interest (*Rule 41(2)(b)*). Section 82 provides that anything required to be done by a person in connection with a registered trade mark may be done by an agent acting on their behalf. We take this to mean that an agent can sign any form on behalf of a person, including a registrable transaction.

The following are registrable transactions:

- the assignment of a registered trade mark or any right in it;
- the grant of a licence under a registered trade mark;

- the granting of a security interest (whether fixed or floating) over a registered trade mark or any right in or under it;
- the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it (an assent is a release by an executor or legatee); and
- an order of a court or other competent authority transferring a registered trade mark or any right in or under it.

In the case of pending marks, a request to enter particulars of one of the above transactions in the register is, under Section 27(3) of the Act, regarded as giving the Registrar notice of those particulars. This means the transaction does not take effect until the application is registered.

4.1 Assignments

References: *Act: Sections 24-25* *Rules: 40–41* *Form: TM16 +fee*

An assignment is the transfer of ownership of a mark from the registered proprietor to someone else. This includes changes of ownership such as company mergers, changes of partners in partnerships at will, and changes of trustees where the mark is registered in the name of trustees. The new owner must apply to the registrar for the assignment to be entered on the register.

An assignment request must be signed by, or on behalf of, **both parties** to the transaction (*Section 24(3) and Rule 41(2)(a)*). If one of the parties is in liquidation or receivership, for example, we will accept the signature of the liquidator or Official Receiver. If either (or both) party cannot sign the request, we require sight of satisfactory documentation (such as the deed of assignment) to verify the transaction (*Rule 41(2)*). Such documentation must corroborate the names of the assignor and assignee shown on the form TM16 and be signed by someone authorised to act in their name.

Rule 40(a) requires that the following shall be entered in the register:

- the name and address of the assignee;
- the date of the assignment; and
- in the case of a partial assignment (see below), a description of the right assigned.

If we are not notified of the transaction within six months of it taking place, we also record the date when we received such notification as the ‘effective filing date’ (*Section 25(4) refers*).

Partial assignment (also called ‘splitting’ a mark)

Section 24(2) provides for the partial assignment of a registered mark for:

- some but not all of the goods or services; or
- use of the mark in a particular manner or a particular locality.

It is not possible to split a series of marks.

Once a mark is split, each part becomes a registration in its own right, identified by a single-letter suffix, and must be separately renewed.

Stamp Duty

Assignments which took place before 28 March 2000 may be subject to Stamp Duty. Advice about whether Stamp Duty is applicable should be referred to the appropriate Inland Revenue Stamp Office (their Helpline is 0845 6030135).

4.2 Licences

References: *Act: Sections 25 & 28-31 Rules: 40-41 Form: TM50 TM51*

A mark may be used by someone other than the registered proprietor with the latter's agreement. The Act provides licensees with rights, in particular circumstances, to take action themselves against anyone infringing the mark. By registering licensees, the proprietor indicates who may use his mark and this information clarifies the position for third parties.

Limited licence

Section 28(1) provides for a licence to be limited, for example, in relation to:

- some but not all of the goods or services; or
- use of the mark in a particular manner or a particular locality.

Licences can be of three types:

Exclusive

An exclusive licence is a licence (which may be general or limited, as above) granted by the registered proprietor **to the exclusion of all others including himself**. An exclusive licensee has the same rights against any subsequent proprietor who is bound by the licence as he has against the person granting the original licence (*Section 29(2)*).

Non-exclusive

A non-exclusive licence is a licence (which may be general or limited, as above) granted by the registered proprietor to any number of other persons, permitting them to use the same mark.

Sub-licence

Where a licence so provides, a sub-licence may be granted by the licensee to a third party. References in the Act to a licence or licensee include a sub-licence or sub-licensee (*Section 28(4)*).

Rule 40(b) requires that the following shall be entered in the register:

- the name and address of the licensee;
- whether the licence is exclusive;
- whether the licence is limited, and what that limitation is; and
- the duration of the licence.

Form TM50 is used to record a licence, and form TM51 to amend or delete a licence.

4.3 Other registrable transactions

References: *Act: Section 25*

Rule: 40

Form: TM24

The following registrable transactions may also be entered in the register:

a) The grant of a security interest over a registered trade mark or any right in or under it

Rule 40(c) requires that the following shall be entered in the register:

- the name and address of the grantee;
- the nature of the interest (whether fixed or floating); and
- the extent of the security and the right in or under the mark secured.

b) The making by personal representatives of an assent in relation to a registered trade mark or any right in or under it

Rule 40(d) requires that the following shall be entered in the register:

- the name and address of the person in whom the mark or any right in or under it vests by virtue of the assent; and
- the date of the assent.

c) An order of a court or other competent authority transferring a registered trade mark or any right in or under it

Rule 40(e) requires that the following shall be entered in the register:

- the name and address of the transferee;
- the date of the order; and
- where the transfer is in respect of a right in the mark, a description of the right transferred.

Form TM24 may also be used to record, cancel or amend a memorandum or statement relating to a mark (*Rule 39(g)*). It must not be used to record assignments or licences (see above).

5 Other amendments to the register

The section is also responsible for the following register maintenance functions:

Recording voluntary disclaimers or other limitations

References: *Act: Section 13*

Rule: 24

Form: Not applicable

The proprietor of a registered mark may:

- disclaim any right to the exclusive use of any specified element of the mark; or
- agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

by giving us notice in writing.

Although disclaimers and limitations are voluntary, we have a responsibility to ensure that the proposed entry in the register is:

- (a) not so ambiguous as to give rise to serious legal uncertainty – in other words, it must be possible to understand what is being disclaimed or what limitation of rights is being introduced;
- (b) a disclaimer or limitation of rights and not something else, such as an amendment of the registered trade mark (in this connection, see the [judgment of the Court of Appeal](http://www.hmcourts-service.gov.uk/HMCSJudgments/View.do?id=2716&searchTerm=nestle&ascending=false&index=0&maxIndex=0) [link to <http://www.hmcourts-service.gov.uk/HMCSJudgments/View.do?id=2716&searchTerm=nestle&ascending=false&index=0&maxIndex=0>] in *Nestle v Mars (POLO mint)*, reported as [2005] RPC 5, page 77).

We will make the appropriate entry in the register and publish such disclaimer or limitation.

Merging applications or registrations

References: *Act: Section 41(1)(b)* *Rule: 20* *Form: TM17*

It is possible to merge completely separate applications if the marks:

- are the same, that is, identical; and
- are in the same ownership; and
- have the same filing date,

but applications cannot be merged after preparation for publication and before registration.

It is possible to merge completely separate registrations or split marks (see paragraph 6.1 above) if the marks:

- are the same, that is, identical; and
- are in the same ownership.

If the registrations to be merged have different dates, the merged registration will take the date of the **latest** registration.

Because it is cheaper to renew a multi-class registration than separate single class registrations of the same mark, proprietors frequently apply to merge registrations when they renew their marks. We **strongly recommend** that they apply to merge marks at least a month before renewal is due, so that we have enough time to complete our computer and manual checking processes.

Altering a registered mark

References: *Act: Section 44* *Rule: 25* *Form: TM25*

A mark may only be altered if:

- it includes the proprietor's name or address; and
- the alteration is limited to alteration of that name or address; and
- the alteration does not substantially affect the identity of the mark.

This means, for example, that a mark cannot be altered if it consists only of the proprietor's name or address; there must be other elements in the mark for an alteration to be allowed.

Examples

1. A pictorial mark of a Scottish rural scene, such as a whisky label, including the address 'The Old Distillery, Aberdeen' in small print could be changed to 'The New Distillery, Glasgow', because the mark **includes** an address and the alteration would not substantially affect the identity of the mark.
2. If a proprietor called CRABTREE EVELYN changed their name to CRABTREE & EVELYN and wanted to change their mark 'CRABTREE EVELYN Song de Chine' to 'CRABTREE & EVELYN Song de Chine', this could be allowed because the mark **includes** the proprietor's name and that name would still be seen as two separate surnames. The addition of the ampersand emphasises this but would not substantially affect the identity of the mark.
3. However, if the mark had been 'EVELYN CRABTREE Song de Chine' and the request was to alter it to 'EVELYN & CRABTREE Song de Chine', this would **not be allowed** because the original mark would be seen as containing a person's name, whilst the altered mark would be clearly seen as two surnames. In this case the alteration would substantially affect the identity of the mark.

Surrender, or partial surrender, of a registration

References: *Act: Section 45* *Rule: 26* *Form: TM22 (Full)*
TM23 (Partial)

A proprietor can give up their rights in a trade mark, either in its entirety or in part. They must tell everyone who has an interest in the mark, for example, any licensees, that they intend to do so three months before they apply to surrender and declare that they have done so on the form.

Once a mark has been surrendered, it cannot be restored to the register.

Rectification or correction of the register

References: *Act: Section 64(1)* *Rule: 34* *Form: TM26(R)*

Law Section checks all rectification requests and processes those made by someone other than the proprietor of the mark, or where there is an issue concerning ownership of the mark. All other requests, such as correcting simple errors or name or address details, are processed by Register Maintenance Section. Rectification does not include correcting irregularities in procedure in the Office, such as omitting goods from a registration, which are dealt with under Rule 66.

Changes of name or address of proprietor

References: *Act: Section 64(4)* *Rule: 44(1)* *Form: TM21*

Changes in the proprietor's name or address should be requested on form TM21; changes in the ownership of a mark must be recorded as an assignment (form TM16). We will query where we believe a form TM21 has been filed by mistake in such circumstances, for example, changing from an individual to a company name, and *vice versa*. Changes will normally affect all marks

owned by the proprietor, though we recognise that, in some circumstances, a request may be made to change only some of the marks owned.

We will also query changes to an applicant's name, and may require the person making the request to provide a witness statement to justify their request.

Note: Form TM21 may also be used to request other changes to an application after publication; in these circumstances, the form is processed by Law Section.

Changes of name or address for service

References: *Act: Section 64(4)* *Rule: 44(2)* *Form: TM33*

An applicant or proprietor may appoint or change an agent, or simply change their address for service, at any time during the prosecution of an application or after the registration of a mark. They should notify us of the marks affected, using form TM33.

Where a firm of agents or attorneys changes its name or address and wants all the records for which it is the address for service altered, they should write and tell us by letter rather than use multiple forms TM33.

6 Certified copies

References: *Act: Section 63(3)* *Rule: 43* *Form: TM31R +fee*

We may issue a certificate verifying the details of applications or registrations. These are known as certified copies. If a certificate needs to be legalised by the Foreign Office for use in a particular country, this should be stated on the form.

Certified copies may be requested for various reasons, the most common being:

- for use in obtaining registration abroad;
- to provide proof of ownership or licensing, perhaps in legal proceedings;
- to provide proof of registration, renewal, assignment, etc. for foreign registries.

If anyone wants such details, but does not need to have them certified, it may be easier for them to use our internet search pages, where the register is freely available and may be printed out.

We cannot certify the details of applications for, or registrations of, Community or international marks. This can only be done by OHIM or WIPO respectively. However, we are prepared to issue a notice setting out what we believe is protected under an international registration for the purposes of the UK, which may help applicants in obtaining registration in some former UK territories which appear to have difficulty in accepting WIPO certificates.

7 Requests for information about applications and registered marks (Caveats)

References: *Act: Section 67*

Rule: 48

Form: TM31C +fee

Anyone can ask for information about an application or registration, or to be advised when a particular event takes place in the life of an application or registration.

Information may be requested under the following categories:

CATEGORY	EVENT
A	Application is published or withdrawn, refused or deemed abandoned before publication.
B	Current or future formal opposition is filed against an application.
C	Application is registered or withdrawn, refused or abandoned after publication.
E	Registration is renewed or removed.
F	Full surrender or successful revocation results in the removal of a mark from the register.
G	An assignment application is received.
H	A mark is fully or partially assigned. Any other event takes place.

Each category requires a separate fee to be paid. When the specified event takes place, we will notify the person who made the caveat request.

These events can also be checked on the register available on our internet search pages.

We also provide a [free electronic caveat service](#) on our website. After registering, and saying which UK case or cases you are interested in, we will send an e-mail whenever any changes happen to the case. We will say when the case changes and what the reason for the change is. We cannot tell you when the case changes for a particular reason. If you want to know that, then you should continue to use form TM31C and the paid-for service described above.

8 Supplying copies of the register and documents held in the Registry

References: *Act: Sections 63, 67 & 76(1) Rules: 42 & 50*

Form: Not applicable +fee

You may inspect the [register of trade marks](#) on our website. You may also inspect all documents filed at the registry after 31 October 1994 in relation to:

- an application filed on or after that date which has been published; or
- a registered mark.

However, some documents may be excluded from this provision under the terms of [Rule 50](#), which provides a full list of excluded documents. These provisions take precedence over the disclosure provisions of the [Freedom of Information Act 2000](#), as they are one of the exemptions under section 44 (1)(a) of that Act.

To view documents

Files may be viewed in London or Newport, but requests should be made through the Central Enquiry Unit. Adequate notice of personal visits should be given, to allow files to be retrieved. There is a handling charge for each file requested, which includes the cost of any copies taken.

To obtain copies of documents

Copies of the above documents may be provided in response to requests by:

- Letter to: Trade Marks Sales
The UK Intellectual Property Office
Cardiff Road
NEWPORT
NP10 8QQ
- Phone 01633 811191
- Fax 01633 811415
- E-mail tmsales@ipo.gov.uk

If a request for copies of documents is made by an agent who takes over a pending application, we will ask the new agent to provide the **applicant's written specific approval** to release copies of correspondence between the registry and the former agent. We do not charge for copying in these circumstances.