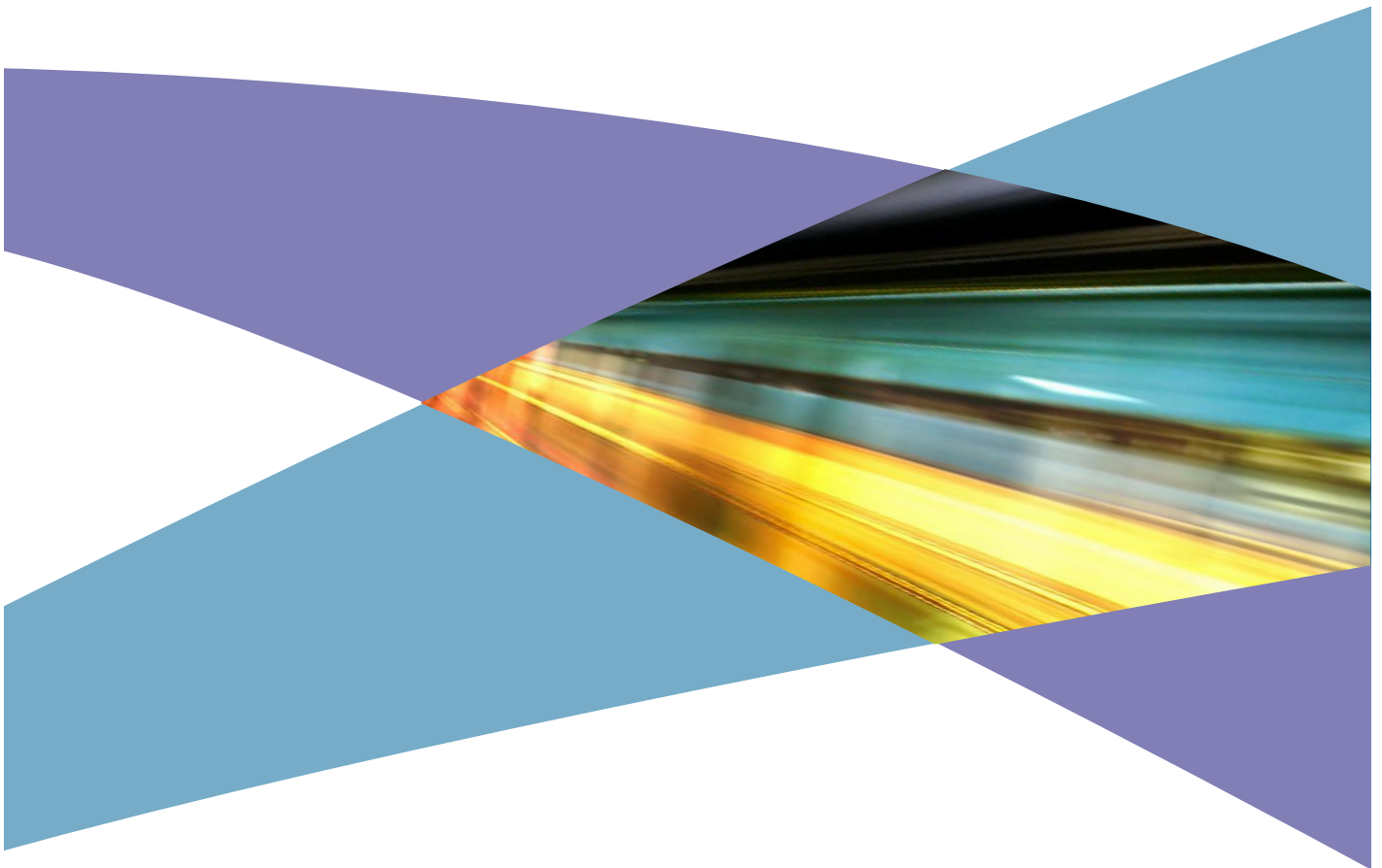




Intellectual
Property
Office

Fast Track Examination of Trade Marks





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Consultation on the Fast Track Examination of Trade Marks

Reason for consultation

The IPO is seeking views from users of the UK trade mark system on whether there is a need to reintroduce the fast track examination procedure.

Background

In December 2005, the Chancellor of the Exchequer asked Andrew Gowers to conduct an independent review into the UK Intellectual Property framework. The Review¹ 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. It suggested that fast track processing, subject to the payment of a higher fee, should be pursued in order to speed up the trade mark registration process when required by an applicant in a particular case.

The Review stated that:

“5.38 In today’s fast moving business environment products are regularly launched within short timescales. The Patent Office recently consulted on ending the practice of refusing applications on the (relative) grounds that the mark applied for conflicts with an earlier trade mark. The review supports the proposal of the Patent Office to end such refusals and to continue searches for the purpose of notifying applicants and others. The Review also notes that this will potentially make it possible to speed up the processing of applications. The review proposes that a fast track system (in addition to the normal system) should be available to allow for trade marks to be examined and accepted within 10 days of the application being filed. Once the application is accepted it can be published and thereafter the 3 month opposition period would begin. This fast track system should be accompanied by a higher fee”.

Subsequently, in 2007, the Intellectual Property Office carried out a public consultation seeking views on the introduction of a new fast track application procedure. The consultation closed on 14 December 2007, and 13 responses were received. In general, responses received to the consultation were supportive of the intention to introduce a ‘fast track’ service; consequently, fast track processing of trade marks came into effect in April, 2008.

Throughout the lifetime of the fast track examination service the office received an average of 20 fast track applications per month (as compared to an average of 2600 standard applications at the time).

In 2009 a decision was taken to suspend the fast track service. This was partly due to the low take up of the procedure, and partly because of the fact that, at the time, the office was examining within 5-10 working days using the standard procedure. Consequently, it was difficult to justify the £300 premium for the accelerated service.

¹ The Gower’s Review, available online at: <http://www.official-documents.gov.uk/document/other/0118404830/0118404830.pdf>



The previous fast track examination procedure

Prior to the introduction of the fast track no form of accelerated examination of trade marks was offered by the Office. Applications were examined in the order in which they were received. The average time to first examination was 4-6 weeks from the time of filing, subject to the application being filed correctly and the fee being paid at the same time.

Whilst in many cases the length of the time to registration was sufficient to meet customer's needs, there were circumstances when more speedy registration was preferable. For example, businesses needing shorter timescales for product launch, legal proceedings, etc.

In the fast track the Office issued the results of the search for earlier conflicting marks, and any objections to the registration of the trade mark, within 10 business days of the receipt of the application. This 10 day period commenced on the business day following the day on which the application was received. The Office was deemed to have issued its examination report (and therefore meet the fast track obligation) on the day the report was sent to the applicant.

The Office also aimed to deal with correspondence following examination as quickly as possible and to arrange hearings in an expedited manner if one was requested, though this was not included within the official commitment.

A premium of £300 was charged to use the fast track procedure. This was in addition to the application fee (£200) and any additional class fees (£50 each).



Current question

In December 2012, the then Minister for Intellectual Property, Lord Marland, announced that the Office would consider a reintroduction of the fast track procedure as a further way to support business and encourage economic growth. The intention was to examine fast track applications in a period of 5 days, not 10 as per the original procedure.

However, circumstances have changed since this announcement. In April 2013, the introduction of a new electronic case management system resulted in applications being examined in approximately 10 working days, despite an increase in trade mark applications (+19% on the previous year).

Given the short time scales involved in the standard procedure and the higher cost (£300 premium) associated with the fast track procedure, the Office considers that it is appropriate to ask whether there would be a demand amongst users of the trade mark system for the reintroduction of the fast track system.

If the view of users is to reject the reintroduction of the fast track procedure at this time, the Office would of course keep the issue under review and reconsider the matter if the time for examination were to reach levels where a fast track procedure would be more attractive.

Specific Questions:

- 1.) Did you make use of the previous fast track application procedure for trade marks? If not, why not?
- 2.) If you used the fast track application procedure how many times did you do so/ how often in relation to use of the standard application procedure?
- 3.) If you used the fast track procedure in what circumstances (business or otherwise) were you prepared to pay a premium for a fast track application?
- 4.) Would you make use of a fast track procedure at 5 days for £300? If not, why not?
- 5.) If yes, in what circumstances (business or otherwise) would you be prepared to pay such a premium?
- 6.) The current examination procedure fluctuates based on demand between 10-20 days. What would you consider to be an optimum period for receiving the first examination report?

We would welcome your views on these points along with any other general comments you may have on the reintroduction of a fast track examination procedure.



Responding to the consultation

Please email your responses, including any answers to questions, and any other views you may have to fasttrackresponse@ipo.gov.uk.

Please let us have your comments by 15 April 2014

Responses are welcomed from any individual, organisation or company. Copies of this consultation are available from the contact address given above. It is also available on the Intellectual Property Office website at: www.ipo.gov.uk/consult-live.

Complaints

Any comments or complaints about the way this consultation has been conducted should be sent to:

John Conway
Consultation Coordinator
Better Regulations Team
Department for Business, Innovation and Skills
1 Victoria Street
London, SW1H 0ET

Email: john.conway@bis.gsi.gov.uk

Openness/Confidentiality

This is a public consultation, the results or conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in (for example) your email response or fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.

Information provided in response to this consultation, including personal information, may be subject to publication or disclosure in accordance to the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want other information that you provide to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals with, amongst other things, obligations of confidence.

In view of this, it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. The IPO will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.

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