

FOI Release
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Title: Registration of sub-licences of IP rights

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Information request:

I wonder if you could help me with regard to the registration of sub-licences of registered designs, patents and trade marks. I have looked on your website for relevant information. I appreciate this enquiry may need directing to the individual departments.

Registered designs

I note that section 19(1) of the Registered Designs Act 1949 dictates that whenever any person becomes entitled to an interest in a registered design they can apply for registration of that interest. Although sub-licensees are not specifically mentioned, the list of what is registrable is not exhaustive so I understand that it is assumed that they are also registrable. Please confirm that this is the case and whether Form DF12A is the appropriate form for doing so? I would also be interested to know how common it is for such sub-licences to be registered.

Patents

I note that a sub-licence of a patent or patent application is a registrable transaction under section 33(3)(c) of the Patents Act 1977. Please confirm that Form 21 is the relevant form for registering a sub-licence of a patent or patent application. I would also be interested to know how common it is for such sub-licences to be registered.

Trade marks

I note that a trade mark licence is a registrable transaction under section 25 of the Trade Marks Act 1994 and that licences are defined to include sub-licences in section 28(4). Please confirm that Form TM 50 is the relevant form for registering a sub-licence of a trade mark. I would also be interested to know how common it is for such sub-licences to be registered.

Information released:

I can confirm that the forms are the correct ones for registering sub-licences, i.e. Form DF12A for designs, Form 21 for patents and Form TM50 for trade marks.

Unfortunately we don't have a method for counting sub-licences within the trade mark or registered design databases, but I can say that there were 34 registrations of sub-licences for patents during 2014. Of course that figure only relates to transactions that were registered with the IPO; as you will be aware the registration of licences is voluntary so only a relatively small number come to our notice.