



Trade Marks Registry

WORK MANUAL

CHAPTER 3 APPLICATION FOR REGISTRATION OF A TRADE MARK

This manual is intended for the guidance and instruction of the staff in the Trade Marks Registry. Its terms in no way fetter the discretion given to the Registrar under the Trade Marks Act 1938. All cases dealt with by the Registry will be decided under the Act on their own facts and within the guidance of the Courts and the Registrar's discretion, where appropriate.

CHAPTER 3

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CHAPTER 3

APPLICATION FOR REGISTRATION OF A TRADE MARK - DEFINITION

3-1 A trade mark is used by a manufacturer, or merchant, to identify his goods to the purchasing public. In other words, when the public order or ask, by means of a trade mark, for goods of a kind previously purchased, they expect to get goods of the same trade origin again, whether or not they know the name of the maker, or merchant. The trade mark is thus an important means of identification - in fact, it is often the only means of identification of the goods of a particular trader. The value of trade marks to those who own them, and in another sense to the buying public, is therefore obvious. Trade mark rights are something which traders are prepared to go to great lengths to preserve, and the Registry performs a valuable service to traders in general, and to the public at large, in carrying out its functions under the Act.

3-2 The question whether a mark is a trade mark and registrable as such is dealt with more fully in Chapter 9 of this Manual. The statutory definitions in Section 68 of the Act are as follows:-

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

"trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and ... in relation to a certification trade mark, a mark registered or deemed to have been registered under Section 37 of this Act. [Defensive trade marks should also be included in this definition].

3-3 Under the foregoing definition a trade mark can be registered only in respect of goods (see also Section 3 of the Act). Trade marks cannot at present be registered in respect of services such as clothes' repairs, laundries, insurance and so on. However the Trade Marks (Amendment) Act 1984 amends the Trade Marks Act 1938 to afford Registration of service marks with effect from 1 October 1987 unless bought in earlier by statutory Instrument. There are two exceptions as to the requirement that a trade mark must be used or proposed to be used. These are

"Defensive marks" (see Chapter 22) and "Certification trade marks" (see Chapter 23).

3-4. An interesting and helpful short summary of the history of trade marks registration, with some notes on other relevant statutory provisions, and on the use of trade marks in present day trading conditions is to be found in the "Mathys" Report (Cmd 5601 "British Trade Mark Law and Practice"), the report of a departmental committee set up in 1972 to consider whether any changes were needed in trade mark law and practice. One of the recommendations in the Report has resulted in the establishment of the Standing Advisory Committee on Trade Marks which advises the Department on matters in the trade mark field. Another useful publication is the book "A Century of Trade Marks 1876-1976" issued on the occasion of the Registry's Centenary and published in 1976 by HMSO.

3-5 to 3-9

APPLICATION FOR REGISTRATION OF A TRADE MARK - MANNER OF APPLICATION

3-10 An application for the registration of a trade mark (other than a textile mark) is made on a Form TM-No 2, accompanied by four Forms TM-No 4. An application for the registration of a textile mark is made on Form Textile No 2, accompanied by a duplicate Form Textile No 2 and by six Forms TM-No 4. Registration of a Certification trade mark is applied for on Form TM-No 6, accompanied by two duplicate Forms TM-No 6, or (if the mark is for textile goods) by three duplicate Forms TM-No 6, and also by six Forms TM-No 4. An application to register a "Defensive" trade mark is made on Form TM-No 32, accompanied by four Forms TM-No 4 or, if the Mark is for textile goods, by a duplicate Form TM-No 32 and by six Forms TM No-4.

3-11 The scale of trade mark fees, and the official forms to be used in various trade mark matters or proceedings, are set out in Schedules I and II, respectively, to the Rules (as amended from time to time).

3-12 Prior to March 1964, fees were paid by means of stamps embossed at Inland Revenue Offices. They are now all paid in cash on lodgment of forms with the Patent Office Cashier, with the Manchester Branch or with the Cutlers' Company, all of whom operate accounting machines to imprint on forms the amount of the fees paid. Remittances may be received by Postal Order, Money Order, Banker's Draft or Cheque. As regards cheques not covered by banker's reference or guarantee - see Chapter 4. Forms are occasionally received bearing postage stamps to the amount of the fee required. These may not in any circumstances be accepted. All forms are required to be accompanied by a Fee Sheet (Form FS1) listing the fees paid. The imprinted forms are passed to the Trade Marks Enquiry Office. Trade Marks Branch is responsible for verifying the fee paid and for taking action to rectify the matter if the payment is incorrect.

3-13 An official pamphlet "Applying for a Trade Mark" is available without charge to any member of the public making enquiries in the Registry (Chapter 4). Supplies are kept in the Enquiry Office, and further supplies are obtainable from the Stationery Section of the Patent Office. It shows, inter alia, how copies of official forms may be obtained and how they should be addressed when completed.

3-14 to 3-19

APPLICATION FOR REGISTRATION OF A TRADE MARK - PART A AND PART B OF THE REGISTER

3-20 The Register is in two parts, Part A and Part B; the statutory criteria being set out in Sections 9 and 10, respectively, of the Act. The protection afforded by registration in Part B is not so comprehensive as in Part A (see Section 5 of the Act). Enquiries from the public as to the difference between the two sets of criteria are dealt with by drawing attention to these Statutory provisions. The practice of the Registry in applying the relevant Sections, based on cases decided in the Courts and on long experience of examination and consideration of more than one million applications since 1876, is set out in Chapter 9 of this Manual, supplemented by "Section Records" and "Trade Mark Circulars" (see Chapter 1).

3-21 The criteria for registration in Part A of the Register are contained in Section 9 of the Act and for Part B in Section 10. These criteria are considered in detail in Chapter 9.

3-22 There is good ground for believing that the practical difference to the proprietor between registration in Part A and registration in Part B is small. Nearly all applications are made initially for registration in Part A but registration in Part B may be offered and accepted as an alternative when acceptance for Part A is not allowed by the Registrar, (Section 17(3) of the Act) and there is no great disposition thereafter on the part of proprietors to seek re-registration in Part A after the mark has been used and has become well known. (See paragraphs 116-118 of the "Mathys" Report referred to in paragraphs 3-4 above).

3-23 to end

