



# **Trade Marks Registry**

## **WORK MANUAL**

### **CHAPTER 18**

### **EXAMINATION UNIT PROCEDURES**

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.

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## INTRODUCTION

1. This manual has been revised in order to provide consistent and uniform working procedures throughout all Examination Units in the Registry. It sets out best practice for the various duties performed and, whenever appropriate, identifies the appropriate grade responsible for carrying out those duties.
2. In order to ensure consistency, there should be no deviation from these procedures unless there are compelling reasons. Any departure must be agreed with the Grade 7 in charge of the Examination Units.

## PART 1 - FILE STORES AND FILES

### ORGANISATION OF FILE STORES

3. An Examination Unit has two different file stores, each containing applications at different stages. Singleton cases are allocated to rooms according to their class. Companion group cases are allocated to Units on the basis of the end digit of the lead file. A companion group of files consists of 2 or more applications filed in respect of the same mark by the same applicant on the same day in different classes. The file cover will indicate if the file is part of a companion group. Data capture will have noted the file cover with the other application numbers in the group. All files should be stamped with the Unit colour and number.

The file stores are as follows:

- |   |   |  |
|---|---|--|
| Pre-Examination File Store<br>(Including International Convention applications) | - | Contains new files received from Data Capture and those on which classification queries have been raised prior to examination (the latter will be found at the beginning of the Pre-Examination store).<br><br>New files applied for with a priority date under the International Convention will also be found at the beginning of the Pre-Examination store. |
| Main File Store   | - | Files which have been examined.  |

In addition there are two further stores, namely:

- |  |   |   |
|--|---|---|
| Pre-Advertisement Store<br>(Journal Run) | - | This store contains shadow cards belonging to files that have been passed to Journal Section for advertisement. These are filed separately in order to obtain statistics more easily for accrual accounting purposes. This file store is located in room 2.004, Government Buildings. |
| Registered User File Store (RU)          | - | The Orange Registered User files are located in Room 2.004, Government Buildings.   |

4. Each file contains a large white card known as a shadow card on which all file movements are recorded. When a file is taken from a file store for action the shadow card remains behind and should show where and when and to whom the file has been sent.

5. When an application is eventually registered, removed, refused or withdrawn the shadow card is removed from the file store and the file is sent to the file store at Nine Mile Point, known as BOXES. (So named because the files are stored in boxes). Shadow cards should be recycled where possible after the files have been sent to Boxes.
6. The booking out of files within a Unit is undertaken by AAs. However, staff from outside a Unit, when wishing to take a file, must contact the Unit's Managing Examiner who will arrange for the file to be booked out. The maintenance of the file store is ultimately the responsibility of the Unit's Managing Examiner.

Given the above, the Unit's Managing Examiner is the contact point for any person outside the Unit wishing to take a file. No file should be removed from the file store by a person from outside the Unit without the Managing Examiner (or, in his/her absence, a member of the Unit's clerical staff) being contacted.

It is essential to the smooth running of the Units that the following tasks are carried out accurately:

- (a) all files and shadow cards should be kept in strict numerical order
- (b) there should not be too many files in any one box, it should be easy to access the files in the box
- (c) as older files are registered etc and as newly examined applications are added, the file store should be re-arranged as necessary
- (d) all Units should have the same system of filing, that is, right to left. This is considered to be the best system as the application number is entered at the top left hand side of the shadow card as it is on the file.

It is the responsibility of the AAs to ensure that the file stores are properly organised.

### **RECEIPT OF NEW FILES**

7. New files are sent to the relevant Units by Data Capture. Each Monday (or as soon as possible thereafter) Data Capture will despatch to the Examination Units those new applications captured during the previous week. The batch will be numbered and the number of applications shown. The Unit AAs will check the number of applications and note any discrepancy. Batches received from Data Capture during the month will be recorded in the statistical return completed each month (on reverse of form). Any discrepancies with Data Capture figures should similarly be recorded and Data Capture notified. On receipt the following action should be taken: **(AA)**
  - (a) check the file details to ensure that it is proper to your Unit. If not send the file and shadow card to the correct Unit. The file cover will indicate if the file is part of a companion group. Data Capture will have noted the file cover with the other application numbers in the group. Record the batch number and the number of applications received for statistical purposes.
  - (b) check that each file has a shadow card. If it does not a shadow card should be raised
  - (c) place the files in numerical order in the Pre-Examination/International Convention store

- (d) some applications will arrive with an orange Registered User (RU) file attached. The trade mark file cover will have been stamped by Registered User Section "application made under S29(1)(b)". RU files are filed in the file store in Room 2.004, Government Buildings.

The only action necessary at this stage is to detach the RU file and file it in numerical order in the RU file run.

### **MOVEMENT OF FILES AND SHADOW CARDS**

8. Whenever a file is taken from a file store for any action (other than to answer a telephone call or for immediate purposes within the Unit, such as checking precedents) it is the responsibility of the AAs and AOs to note the following information on the shadow card:

- (a) the name of the person to whom the file is being sent/given
- (b) the section to which the file is being sent/taken
- (c) the date the file is sent/taken/passed to an officer on the Unit.

Where a Hearing Officer passes on a file, after a hearing, to anywhere other than the originating Unit, a Transit slip (Annex 1) is completed and sent to the Unit for the AAs to update the shadow card.

9. When a file is taken from the Pre-Examination/International Convention store for action the shadow card should be noted by the Examiner concerned who should sign and date it. The AAs should ensure that the shadow card is then transferred to the Main File Store. This should be done as soon as is practicable and shadow cards should not be left on desks overnight.
10. Shadow cards should never be taken from the Main File Store whilst the application is live. They may only be removed in the following circumstances:

When the application is:

- (a) transferred to the Journal Run, immediately after the case has been made ready for advertisement
  - (b) withdrawn – this must only be done as a result of a request from an agent/applicant
  - (c) removed from record/deemed abandoned
  - (d) refused
  - (e) transferred to another class belonging to a different Unit.
11. If a shadow card is missing the other file stores in the room should be checked. If it cannot be found a duplicate should be raised and clearly marked 'DUPLICATE'. This action should only be taken as a last resort and then only with permission from the Unit's Managing Examiner.

## FORMALITIES

12. These involve initial research relating to the mark applied for and are carried out on the new files in the Pre-Examination/International Convention File Store.

Chapter 8 of the Work Manual gives full details of what is required, but briefly the actions are:

- (a) checking relevant telephone directories to see if the mark is a surname and, if so, counting how many times it occurs. If the mark has a clear phonetic equivalent also checking whether this is a surname and, if so, how many times it occurs (AA)
- (b) checking geographical gazetteers to see if the mark is a geographical location. If the mark has a clear phonetic equivalent also checking whether this is a geographical location (AA)
- (c) looking up the mark in dictionaries and, if found, noting the meaning given. Also noting the meaning of any clear phonetic equivalent of a word mark (AA)
- (d) technical dictionaries are used to check meanings of words specific to the class, e.g. computer dictionaries are consulted for goods in Class 9 relating to computing products. The meaning of any clear phonetic equivalent must also be noted (AA)

Singulars and, if appropriate, plurals must also be searched and, if the mark clearly consists of two or more words, the mark should be split for referencing purposes. (AA)

If a companion group is involved the telephone, gazetteer and other appropriate references must be copied to all of the applications. (AA)

- (e) entering word mark and/or representation of device, if applicable, on the shadow card.
13. When formalities have been completed the files should be returned (following monitoring by the Managing Examiner) to the Pre-Examination/International Convention File-Store and a marker shadow card placed in the file store behind the last application completed. This will enable Examiners to see which cases ready for examination have had formalities completed and will show the AAs the point up to which they have referenced.

## EXAMINATION

14. Applications with International Convention claims must be given priority.
15. The examination of an application is the Examiner's responsibility. All aspects of the examination, including acceptance or the raising of objections, should be dealt with by the Examiner and cases need only be referred to the HEO or other senior officers where guidance is needed. The submission of cases to senior officers will obviously depend on the experience of the individual Examiner. Inexperienced Examiners should initially submit all cases to the HEO for checking until they have gained the necessary expertise. This period will be determined by agreement between the Examiner and the HEO. For experienced Examiners, however, the HEO will carry out a sample quality check.

## **DEVICE SEARCHING**

16. If the mark consists of a device or there is a device element in the mark a search for conflicting device marks must be carried out. This is done using the Trade Marks Imaging System (TRIMS). This task must be carried out by Examiners.

## **ACTION ON REGISTRATION**

17. When a file is sent to Journal Section, Room 2.004, Government Buildings for advertisement the shadow cards are immediately extracted from the Main File Stores and kept in a separate run (known as the Journal Run) (AO). This is done to simplify the job of removing the shadow cards of registered cases and for accrual accounting purposes.

A list of applications registered is printed each week in the back part of the published Trade Marks Journal. The AAs will remove the appropriate shadow cards from the Journal Run on a rota basis.

For statistical purposes a record should be kept of the number of shadow cards removed and the totals given to the appropriate Unit HEO at the end of the monthly statistical period.

## **APPLICATIONS ADVERTISED BUT NOT PROCEEDING**

18. Pending applications which have been advertised, but which do not proceed to registration, are also shown each week in the back part of the published Trade Marks Journal. The AAs will remove the appropriate shadow cards from the Journal Run on a rota basis.

Again a record of the number of these cases should be kept and the totals given to the appropriate Unit HEO at the end of the monthly statistical period.

## **STATISTICAL BOOKS**

19. Each Unit uses a book to record the number of files received from Data Capture and transferred to or from other Units. (AA)

## **FILE COVERS**

20. When a file is sent out of the Unit the cover should be clearly noted with the following details:

- (a) the name of the person to whom it is being sent
- (b) the room number
- (c) the location – if it is different from that of the sender
- (d) the date.

If the file is to be returned the sender should insert their own name and room number beneath that of the addressee.

e.g.: 1) Mr G Sprake 4.1.94  
Room 1.208

2) Mr P Lorimer  
Room 2.136

21. The person returning the file should delete their own name and room number and insert the date beside the name of the person to whom it is being returned.
22. When a file is passed to another person in the same Unit the file cover and minute sheet should still be noted with the recipient's name and dated. The shadow card does not require updating. However, if the file is moved outside of the Unit for any reason the shadow card must be marked. (see paragraph 8 of this Manual).
23. Forenames only must never be used to address files. Surnames and initials/forename of the addressee are to be used at all times.
24. When the space for recording transits is full a new marking sheet should be stuck onto the file cover. Entries should not be squeezed onto file covers which are full. Ensure that the file number is still visible.

### **PLACING OF DOCUMENTS ON FILE**

25. The documents held on each application must be in the following order:

#### Right Hand Orange Tag:

Forms TM2/3 and TM4 will be on this tag when the file is received from Data Capture section. Other official Trade Marks forms such as a TM20 should also be filed on this tag. The TM2/3 should always be left on top. It is important that nothing else (other than a Camera Ready Copy of the mark if appropriate) should be placed on this tag.

#### Left Hand Blue Tag:

A minute sheet will be on the left hand blue tag when it is received from Data Capture. When additional minute sheets are required they should be placed on the left hand tag and noted with the file number. Hearing Officers' reports (pink sheets) are also filed on this tag. The pink Hearing Officers' reports should be used as a continuation minute sheet and a line drawn through the previous minute sheet, if appropriate.

The top copies of OPTICS printouts for issue to the applicants with the examination report should be attached here prior to despatch. The blue ready for advertisement/proceed sheet (see Annex 2) should also be placed on this tag as should the Registered User documents, if appropriate.

Right Hand Blue Tag:

Top Document (if appropriate)  
Draft First Advertisement  
Post Examination correspondence (including submission sheet/s)  
ER1/CL (typed)  
ER1/CL (hand written)  
Pre-Examination Correspondence  
Precedents  
Search report/s  
Citation/s (including citations raised after examination)  
Yellow Association sheet  
Association/s (including associations raised after submission).  
ER2 (research report)  
Case Printout (from Data Capture)

**EVIDENCE**

26. Guidance on the receipt, storage and return of evidence is given in Chapter 12 of the Work Manual. However where the exhibits are small enough to be kept on file they should be placed in a large envelope which should be securely attached to the right hand side of the file. Where necessary the file should be secured with elastic bands or linen tape. The envelope should be clearly marked with the application number in case it should become detached. (AA)
27. The Statutory Declaration must always be detached from the exhibits and placed on file. (AA) The evidence summary sheet should be completed and placed above the Statutory Declaration. (AO)
28. If the evidence is too bulky to be placed on file it should be kept in large envelopes, clearly marked with the application number. It should be kept in a secure cupboard in strict numerical order wherever possible. Exhibits of value should be kept in a locked cupboard. (AA)
29. The front of the file should be stamped 'evidence in cupboard' or 'evidence on file'. The evidence cupboard should be weeded regularly and all evidence returned to the applicant or agent when all action has been completed on the file (registered or removed from record). (AA)

**MINUTES**

30. It is departmental practice that minutes are headed by the name and location of the recipient with the name and location of the sender beneath, followed by the date.

This practice should be followed on all minutes, i.e.:

3 (minute number)

To: J Keddilty  
White 10  
R 1.262

From: S Owen  
Yellow 8  
R 2.265  
x 2667  
4.1.94

31. All minutes should be numbered and signed at the end. Forenames alone must never be used even when the minute is to someone in the same Unit. Initials/forename and surnames should be used at all times.
32. Where a minute finishes at or near the end of a minute sheet the sender should attach a fresh sheet.
33. A minute will usually only relate to the file on which it is written. However, where appropriate, copies of minutes may be placed on other files. They should be clearly marked 'copy', to show which file they are from, and should be placed on the right hand blue tag. Minutes otherwise must remain on the left hand tag.
34. If the minute is for the attention of more than one person, each recipient should ensure that they initial and date it to show they have seen it.

For example:

To:

1. S Evans  
R2.203

*SE*  
*5-1-94*

2. R Dickinson  
R2.060

*R* *6/1/94*

From:

J Hamilton - Jones  
Red 2  
R2.108  
X 2776  
4.1.94

35. Where a 'Top Document' is attached to a file it must be kept at the top of the file. Post-it notes must never be used.

#### **DESPATCH OF INTERNAL MAIL**

36. Minutes or loose papers should be sent in transit envelopes. Files sent in bundles, or single files which contain loose documents or evidence which is likely to come adrift should, where possible, be secured by elastic bands or by linen straps. Used envelopes may be used as a last resort but should not be sealed or stapled.

#### **REQUISITION OF FILES FROM 'BOXES'**

37. The file store at 'Boxes' holds applications on which action is complete:

i.e.: registered files

cases removed, refused or withdrawn

Registered User (RU) files

rectification files

opposition files

- (a) voucher form RF2 (Annex 3), should be completed by the person requiring the form and sent to Boxes at Nine Mile Point. The top two copies of the voucher should be sent and the remaining copy retained. All forms RF2 in each Unit should be collated and sent in one transit envelope at the end of each day. (AA)
- (b) if an RU, rectification or opposition file is requested this must be clearly stated on the voucher
- (c) when a file is found at Boxes it will be returned with the top copy of the RF2 attached to the file. A copy of the RF2 is retained at Boxes in place of the file to show where it has been sent
- (d) If the recipient of a file from Boxes forwards it to someone else Boxes should be notified of its new location by means of a Transit slip (See Annex 1) in order for the staff in Nine Mile Point to update their records.
- (e) if the file cannot be found at Boxes the voucher will be returned marked "Search Failure". It will then be the responsibility of the person who requested the file to decide what further action is necessary
- (f) if the file is already booked out the voucher will be returned showing the name and location of the person to whom the file was sent
- (g) vouchers are sometimes sent to Boxes in an attempt to trace a missing pending file. This should only be done in accordance with the missing file procedures as laid down in paragraphs 49-60 of this Manual after other searches have been carried out
- (h) from time to time a file from boxes will be urgently required by staff. When a file is required urgently, staff should telephone Nine Mile Point giving the number of the file and the time or date by which it is required, and to whom it should be sent.

This arrangement is for use only when one or two files are required urgently and must not be used as an alternative to the routine vouchering system

- (j) when action has been completed on the file the form RF2 should be removed and destroyed and the file returned to Boxes.

## **WEEDING**

- 38. A regular programme of weeding should be carried out in each file store during which all files and shadow cards should be checked to see if they are still correctly filed in the store. The check should be instigated by the Unit's Managing Examiner and carried out by AAs/AOs
- 39. Statistics should be kept of the number of applications cleared up in weeding exercises. These statistics are required for accrual accounting purposes.

Besides checking that the files are in the correct store and that all applications are in correct numerical order, the following checks must be carried out:

### Weeding of Shadow Cards

- (a) check OPTICS to see if the case has been either registered, removed, withdrawn, refused, is awaiting advertisement, advertised or opposed
- (b) if the case is shown on OPTICS as pending or examined check the last shadow card marking. If it is within the last four months and is booked out to someone still in the Unit check no further and replace the shadow card
- (c) if the shadow card shows the file marked to someone within the Unit over four months ago check to see if they still hold it. If not, begin tracing action as per paragraphs 49–60 of this Manual.
- (d) if the file is marked to an officer outside the Unit check no further unless it was sent over four months ago. If this is the case check with the officer concerned to see if they still hold the file. If it is marked to the Hearings Clerk check no further unless it was sent over 6 months ago.
- (e) if a file is supposed to be travelling with another file (i.e. First Use) check the relevant file store if sent over 3 months ago.

### Weeding of Files:

Ensure that the application has a current diary or BF date indicated on the minute sheet and if so leave in the file store. If the date has expired, check the last correspondence to ascertain if there should be a new date entered. If there should, update the minute sheet (and OPTICS if necessary) accordingly and return the file to the file store. Otherwise, pass the file to the appropriate Examiner to consider what action is necessary.

### Weeding of Evidence Cupboard

- 40. A check should be carried out on the exhibits held in the evidence cupboard. The applications should be checked on OPTICS and if found to be registered, removed, refused or withdrawn the evidence should be returned to the applicants as per Chapter 12 of the Work Manual. (AA)

## **PART 2 - INCOMING CORRESPONDENCE**

### **THE IN TRAY:**

41. One of the main duties of the AA is to ensure that the IN TRAY is emptied promptly and that the correspondence and work therein is distributed as soon as possible. (AA)

The following are examples of what may be found in the IN TRAY:

- (a) correspondence – from agents or applicants
- (b) Trade Mark forms (e.g. requesting amendments to be made)
- (c) newsletters circulars (e.g. information for individual or general distribution)
- (d) periodicals
- (e) requests for extensions of time
- (f) files
- (g) requisition vouchers – attached to files  
– loose
- (h) personal letters/pay slips
- (j) transit envelopes addressed to individuals

Full details of action to be taken regarding the above are given in the following paragraphs.

### **COMPLAINTS PROCEDURE**

42. If a letter of complaint is received by the Unit it should be passed immediately to the Unit SEO for attention. Telephone complaints should be brought to the attention of the Unit HEO.

N.B. Staff should be aware of the official Box 49 procedure. For further details see Annex 4.

In addition, the Registry also monitors letters of praise. These should be copied to Central Unit, who will arrange for circulation to HEOs and above in TMD.

### **SUBSTANTIVE CORRESPONDENCE**

43. Substantive correspondence is essentially a reply, other than an EOT, from an agent or applicant to an official letter and should be counted for statistical purposes. EOTs should be counted separately. As figures are also collected of the amount of outgoing substantive correspondence it is important to note exactly what constitutes substantive correspondence. It is where a letter has been received from an agent or private applicant which requires consideration and a reply by an Examiner. (EO)

**The Registry's operational target is to respond to 95% of substantive correspondence within six weeks of receipt.**

Substantive correspondence does not include:

- a) extensions of time requests
  - b) hastener letters
44. It should be noted that all proceed letters are dealt with by AOs (see paragraphs 151–155 of this Manual)

## **CORRESPONDENCE AND FORMS**

45. These are sorted initially in the Public Enquiry Office according to subject matter. They are date stamped and forwarded to the relevant section. On receipt in the Unit the correspondence should be stamped with the Unit date stamp. (AA)
46. Letters are not generally acknowledged on receipt. The exceptions to this are specific forms and documents which will be acknowledged by the Public Enquiry Office.
47. The Managing Examiner is responsible for post. He/she will ensure that post is correctly and promptly linked and will monitor backlogs and assist with difficult cases. They will also ensure that references etc. quoted on all incoming post are checked for the following:
- (a) correspondence concerning opposition or threatened opposition to an advertised case should be forwarded by hand immediately to Law Section
  - (b) letters personally addressed to senior staff members but which refer to a case should be linked to the file and passed immediately to the appropriate Examiner who will consider the letter and write a minute with the recommended course of action to the person concerned.

If the file cannot be found the letter should be passed immediately to the appropriate Examiner, who will send it to the person concerned with a covering minute explaining that the file is not immediately available and requesting further instructions

- (c) letters from Members of Parliament, the media or representatives of foreign governments should be passed to the SEO manager without delay, who will then inform senior management
- (d) **correspondence relating to an advertised case or to a case awaiting advertisement may relate to a claim to prior use or an incorrect acceptance. These cases must be dealt with immediately and should be referred to the Unit SEO (TMC 27/91 refers)**
- (e) all letters of complaint should be linked promptly and passed to the appropriate Examiner, who should ensure that these are passed to the Unit SEO without delay. It may be necessary to attach priority labels to these cases. See also Complaints Procedure (paragraph 42 of this Manual).
- (f) correspondence not relevant to the Unit. This should be quickly re-directed to the correct section, or in the case of an Examination Unit, the appropriate Managing Examiner, using the correspondence re-routing slip shown at Annex 5

- (g) envelopes marked personal or staff in confidence should be handed directly to the person concerned
- (h) reminder letters seeking information about the progress of any matter should be dealt with by the relevant Examiner who should telephone the writer immediately.

However, if the reminder is unduly early, for example, if the enquiry relates to the progress of an application only a fortnight or so after it has been filed, it should be explained to the correspondent (which in this instance will usually be a private applicant) that all applications are dealt with in strict date order, and the application will be examined in due course. Cases needing more rapid treatment should have a priority label attached to the file. Where the letter is requesting that the application is answered out of turn (i.e. before earlier filed applications) it should be passed to the Unit SEO who will consult the Assistant Registrar. The only circumstances in which a reminder letter may be left unactioned on a file are when an official communication on the subject has crossed with it or when it is clear that such a communication will be despatched within the following two or three days. If a reminder letter is answered by telephone this must be noted on the minute sheet and signed by the officer who made the call. If the application cannot be located within a week the correspondent should nevertheless receive an interim reply, either by telephone (for subsequent noting on the minute sheet of the file) or by letter.

- (j) all Pre-Examination correspondence should be passed to the Managing Examiner before linking.
48. Once the above checks have been completed the AAs should look for the relevant files in the Unit file stores.

When found:

- (a) attach the correspondence to the top of the blue tag on the right hand side of the file or on the orange tag, again on the right hand side, if it is an official TM form
- (b) note the shadow card with the name of the person to whom the file is to be given and the date
- (c) enter the person's name and the date on the file cover
- (d) delete the diary entry from the OPTICS diary system.

#### **SEARCH FOR MISSING FILES (AA)**

49. If the last marking on the shadow card shows the file has been passed to someone in the Unit then they should be asked if they still hold the file. If not they may be able to suggest where the file is now held.
50. It is important to know what the mark is as Examiners will remember a mark rather than an application number. If the mark is not indicated on the correspondence or shadow card it can be obtained from OPTICS or TRIMS. (AA)
51. If the file still cannot be found or if there is no shadow card the following checks should be made:
- Call up the application on the OPTICS database under 'display case' to check :
- (a) that the application number is quoted correctly and refers to the mark and applicants referred to in the letter. It may be necessary to contact the applicants/agents for the correct reference

- (b) that the class quoted is correct. If not amend the letter and forward to the correct Unit if appropriate
  - (c) the status to see if the application is still pending. If it is shown as deemed abandoned, withdrawn, refused, RFR or registered then the file is likely to be in Boxes and it should be requested by voucher.
52. If the status is shown as advertised then the file may be in the Post Advertisement File Store (PAFS) located in Law Section.

If the file is located in PAFS take action as follows:

- (a) correspondence requiring action should not be sent to PAFS. Instead files should be collected from PAFS, signed for, and returned as quickly as possible if appropriate. A note should be put on the minute sheet of the file of the action taken and indicating that there is no outstanding correspondence for the file in the Examination Unit. This is essential as files returned to PAFS will be passed to New Registration Section at the end of the opposition period without any further checks
  - (b) any correspondence relating to late objections, e.g. prior use, should be retained by the Examination Unit and the file collected urgently, advising Law Section who will flag OPTICS as LATE OBJECTION. This will prevent accidental registration. The PAFS record should be marked accordingly
  - (c) correspondence not requiring action should be taken to PAFS and put on file. The correspondence should be clearly marked "No Action Required", signed and dated.
53. If the file is not held in PAFS it may have been passed to Registration Section and should be checked as before.
54. If the status on OPTICS is shown as 'Awaiting Advertisement' the file should be with Journal Section. If the file is located in Journal Section it should be collected and returned, if appropriate, by Unit staff. The Units have responsibility for correspondence and they must decide what action is necessary. The file should be referred to the relevant Examiner for action. Correspondence requiring action should not be sent to Journal Section.
55. If the status is shown as Advertisement Deleted it indicates that the file may have been returned to the Unit after Ready for Advertisement action has been completed.
56. If the status is opposed or late objection check to see if the file is with Law Section.
57. If the status is examined:
- (a) call up the relevant application under display case and check the indicators at the top right hand side of the screen to see if the hearing indicator (Hea) is marked Y (Yes). If so it shows that the file is awaiting a hearing and you should check with the Hearings Clerk to see if he or a Hearing Officer holds the file
  - (b) a check under display history or display diary may give details of who last actioned the case on OPTICS and this may assist in tracing the file
  - (c) check the application numbers, on OPTICS, on either side of the number you are looking for to see if they have the same mark and proprietor. This will show if the application is part of a companion group

- (d) if display history indicates that an assignment form TM16 has been filed check to see if the file is in Assignment Section
  - (e) check with all staff on the Unit.
58. If unsuccessful a voucher should be sent to see if the file has been erroneously sent to Boxes.
59. If the file cannot be found at the first attempt then checks of the file stores and the checks listed above should be repeated at regular intervals. A missing file checklist giving details of recommended procedures is at Annex 6.
60. It may be necessary for a Registry search to be undertaken but this should be determined by the Unit HEO. See file search form at Annex 7.

### **DUPLICATE FILES**

61. If after the extensive searches (detailed at paragraphs 49–60 of this Manual) the file cannot be found, the creation of a duplicate file may be authorised. To ensure consistency authorisation must come from the Unit's Managing Examiner.
62. The agent/applicant should be advised of the position by telephone and a letter should be sent to confirm that the file has been lost. Bespoke letters should be sent and signed by the Managing Examiner. Pro-formas must not be used. The agent should be asked to forward copies of all correspondence relating to the file including copies of forms TM2/3, TM4 and the examination report. **(EO)**
63. A duplicate file should be made up. The file cover should be completed and clearly marked **DUPLICATE** in red ink beside the application number. **(AA)**
64. The documents involved in the tracing action and the 'missing file checklist' should be placed on file as the first document on the right hand blue tag and the letter requesting duplicate papers should also be attached to this tag. The file should then be brought forward to await the duplicate documents. The shadow card should be marked 'duplicate file raised' in red ink. When the new documents are received each piece should be marked "duplicate".
65. If the original file should subsequently be traced the two files must be amalgamated immediately and referred to the Examiner to coordinate action.

### **LETTERS WITHOUT REFERENCES**

66. TMD's outgoing correspondence requests agents to quote our reference. However some letters will be received bearing no reference. These fall into two categories:
- (a) letters which relate to a specific application
  - (b) letters of a "miscellaneous" character (for example, enquiries about registration procedure, the classification of goods, ownership of specific marks, foreign legislation and general enquiries regarding Registry practice).
67. The search for the file for a letter which relates to a specific application is dealt with by the AAs. An attempt should be made to trace the reference number from information in the letter; e.g. if the Mark is named, the application number should be traced by means of the OPTICS search facilities. **(AA)**

68. If unsuccessful, the writer of the letter should be contacted, preferably by telephone and further information requested. (AA)

Letters of a miscellaneous nature should be passed to the Managing Examiner to deal with.

#### **EXTENSIONS OF TIME REQUESTS (EOTs)**

69. These should be linked to the file in the same way as a letter and the diary date deleted from the OPTICS diary. They should then be dealt with by the AAs, or passed to the Managing Examiner for action if the EOT requests total more than 6 months from the date of the last official letter. (AA/ME) (see also paragraphs 174 and 178 of this Manual). Before issuing the EOT slip or letter, the file should be passed to the Managing Examiner for sampling.

#### **FILES**

70. When a file is received marked to an individual the AA should note the shadow card with the date and the person's name before passing the file to the officer concerned.
71. Files received from Boxes should be passed to the person who completed the requisition voucher.
72. Where a transit envelope is received addressed to an individual it should be passed directly to the person concerned. If it contains a file, the AA should remove the file and mark the shadow card in the normal way.

#### **MISCELLANEOUS ITEMS FOR CIRCULATION**

73. Items for general distribution (see below) arrive in the Units in blue wallets addressed to the HEO. They are then responsible for ensuring that the appropriate staff get to see all the relevant notices.

Notices relating to promotion boards must be circulated individually. For destruction of older notices see 'The Guide' or consult the Unit HEO. See 'The Guide' for further information regarding internal publications

The Link

Staff News

DTI Office Notices

Patent Office Notices

Monthly Statistics

Monthly Work Summaries

Vacancy Notices

Trawl Notices

Periodicals

## SUBMISSIONS

74. The filing of an amended mark can be made either before or after a hearing has taken place. If the original mark has been objected to the applicant is allowed to submit up to two amended marks. The mark should be examined as if it were an original mark (see also Chapter 9 of the Work Manual, paragraphs 9-530 to 9-538.).
75. If the mark is amended by the addition of an equity (existing registration) ensure that:
- (a) the whole registered mark is added. **Addition of part of an equity is not allowed**
  - (b) the final specification of goods is within the scope both of the equity specification and of the original claim
  - (c) the equity is added to the Association Report. (Raise an Association Report if one is not already on file)
  - (d) any disclaimed element in the equity is also disclaimed in the amended mark.
  - (e) if the equity mark is in Part B the application can only proceed in Part B.
76. When an amended mark is filed, a green submission sheet must be prepared. The amended mark must be entered at the top of the form – if a stylized word, device mark or word and device mark is involved a photocopy should be attached. **(EO)**
77. Except where an equity has been added formalities should be completed on any additional parts of the mark not included in the mark on form TM2/3. Details should be entered on the reverse of the submission sheet.
78. After consideration in accordance with Chapter 9 of the Work Manual, Examiners should complete the front of the submission sheet with their recommendations and pass the file to the Hearing Officer if a hearing has previously been held. Experienced Examiners may take the decision themselves in other cases. If they require advice the file, together with their recommendation, should be sent to the Unit HEO. Inexperienced Examiners should seek advice in each case. If the amendment consists of the addition of an equity from a previously registered mark then an OPTICS print out of the appropriate registration should be filed behind the association sheet and, if appropriate, a representation of a stylized word/device mark/word and device mark should also be attached. **(EO)**
79. When an amendment is approved action should be taken as per paragraph 153 of this Manual.

## FORM TM1 - AGENT'S AUTHORISATION

80. Current requirements as regards agent's authorisation were carried forward from the 1982 Rules amendment into the Trade Mark and Service Mark Rules 1986. Authorisation is only required by the Registrar in the following specific instances:
- (a) where there is a change of Agency during the prosecution of proceedings before the Registrar
  - (b) where an agent is appointed for the first time, during the prosecution of proceedings before the Registrar. (This normally happens when a private applicant lodges an application and then decides to have it handled professionally)

- (c) where the Registrar has real doubts about the agent's authority to act or that authority is challenged or questioned by another party.
81. When a form TM1 is received, the following action should be taken:
- (a) if the TM1 includes both pending and registered marks, Register Maintenance will update all of the cases on OPTICS and advise the old agent accordingly. The Examination Unit(s) will then be passed a copy of the form TM1 which should be placed on the relevant file. The Unit will need to amend the form TM2/3 to reflect the change and initial and date the form accordingly. (AO)
- (b) if the TM1 includes only pending marks, the form will be sent to the Unit with the lowest application number (assuming there is more than one application specified). It will then be that Unit's responsibility to change the details of all the cases on the form TM1, on the OPTICS database and notify the old agent accordingly by sending a copy of the form TM1 together with a covering letter. Copies of the form TM1 together with a copy of the covering letter must be copied to all the files concerned. As in (a) above, the receiving Unit should effect the changes to form TM2/3. (AO)

If the ADP number is not shown on the TM1 the AO should check the list of ADP numbers. Care should be taken to select the correct number from the list as agents with a number of offices have a different number for each address.

#### **FORM TM20 - AMENDMENTS**

82. Form TM20 may be used to correct a clerical error or to amend an application. Procedures to be followed when a TM20 is received for a pending application are detailed below. Generally a TM20 is not required if the correction or alteration is required by the Registry.

N.B. It is worth noting that no fee is charged in respect of a TM20. Thus if a request for change is requested by letter from a recognized firm of agents there is no need to write to them asking for a TM20 to be filed. The letter is sufficient authority and should be actioned in the same way as a TM20.

83. The following are the most common amendments/corrections requested.

request to amend/correct:

applicant's name/address

agent's name/address

specification

class

mark

date of application/International Convention date

other matter, for example disclaimers, translations, etc

84. When any amendment has been agreed the TM2/3 should be amended in red ink. By the side of the amendment note the document of authority (ie the TM20) and date and initial the amendment. The

TM20 should also be initialled and dated to show that any action requested has been dealt with. If NAFS are to action the amendment the minute sheet should be noted with the instructions. (AO)

85. The action requested by a TM20 should be taken within 1 week of receipt of the TM20 in the Examination Unit. It is important that the amendment is made as quickly as possible because in the past, marks have been registered before a requested amendment has been made, causing serious legal problems. If the file cannot be traced within a week the Unit Managing Examiner should be consulted. (AA/ME)
86. Examination Unit staff must never take TM20 action on registered marks. This applies even if an application is only registered between the date the TM20 is received in the office and the date that it is matched up with the file. If such a situation does arise the file must be passed to the EO in charge of Register Maintenance Section.
87. Examination Units must not instruct Journal Section to advertise an amendment to a registered mark.
88. Requests to amend details of advertised but not yet registered marks should be handled with particular care and the advice of an HEO sought if there is any doubt as to how to proceed. The main consideration is that any change to the details of an advertised mark must itself be advertised. This is normally carried out in one of the following ways:
  - (a) a notice in the "Errata" section of a subsequent Journal. This is appropriate when a minor error of a clerical nature has occurred in the original advertisement
  - (b) a notice in the "Applications Amended after Advertisement" section of a subsequent Journal. This is published when there has been a limitation of the specification (for example, as a result of threatened opposition) or when, for example, the applicant company has changed its address
  - (c) re-advertisement of the mark. Chapter 24 of the Work Manual paragraph 24-19 gives further details. See also paragraph 140 of this Manual. (ME)

#### **FORM TM20 - CASES OPPOSED OR UNDER THREATENED OPPOSITION**

89. A TM20 relating to an advertised application which is under opposition or threatened opposition should be taken by hand to Law Section for action. (AA)

#### **FORM TM20 - AMEND/CORRECT APPLICANT'S NAME**

90. When a TM20 informs us of a change to the applicant's name the Registrar must ensure that it is a genuine change of name and not a change of ownership between different legal entities (i.e. an assignment).

The name of the applicant can only be changed if:

- (a) there was a clerical error in completing the application form or
  - (b) the applicant has changed his name.
91. If the change is to correct a clerical error then provided that the change is minor e.g. a slight mis-spelling, then the change may be accepted without query. Additionally a change from Limited (Ltd) to Public Limited Company (plc) is permissible. (AO)

92. If there is a new name which shows some similarity to the old name or where there is a link between the two entities eg associated companies, within a group of companies, then the change may be accepted provided a declaration is entered on the TM20 to the effect that there has been no change in ownership of the mark and that the original applicants name was entered in error. Consideration should be given to the likelihood of this by comparison of the two names. If in doubt a Statutory Declaration (see below) should be requested. **(AO)**
93. If a complete change of name is involved the TM20 must be accompanied by a Statutory Declaration explaining how the error occurred and any decision to allow such a change must be made at HEO level or above.
94. Foreign corporate bodies may be asked for authoratative official evidence confirming their change of name. This evidence will take the form of certified extracts (with translations) from the appropriate commercial register of the country of incorporation. **(AO)**
95. When an individual applicant has changed his name by deed poll a copy of the deed poll should be provided for inspection.
96. If a TM20 is filed with the purpose of deleting or adding the name of a partner from a partnership or an unincorporated body the amendment cannot be allowed unless it can be shown that an error occurred in completing the application form TM2/3.

The change would constitute a change in ownership of the application and must therefore be treated as an assignment. Unless the provisions of Rule 62(2) apply the application will have to proceed in the name of the original applicants and be assigned after registration. Cases of this nature should be dealt with by the Examiner. **(EO)**

97. If the purported change of name eventually turns out to be a change of ownership i.e. an assignment, the application should be referred to the Examination Unit HEO to consider in consultation with Assignments Section whether Simultaneous Registration and Assignment (SIM TIM) action is appropriate. If SIM TIM is not appropriate the applicant requesting TM20 action should be advised that the mark will be advertised and registered with the name on the application form, and that a form TM16 should be filed after registration to record the assignment. If the assignment is not from the applicant but from some other party such as the Treasury Solicitor, particular care is required and senior officers should be consulted.
98. If the change is considered acceptable take the following action: **(AO)**
  - (a) minute the file to Name and Address Function Section (NAFS) who will amend the OPTICS database
  - (b) amend the TM2/3. Sign and date the amendment
  - (c) change front of file to record new details.

#### **FORM TM20 - AMEND/CORRECT APPLICANT'S ADDRESS**

99. Action as per paragraph 98 of this Manual.

**FORM TM20 - AMEND/CORRECT AGENT'S NAME AND/OR ADDRESS**

100. If the change involves a complete change of agent then a form TM1 is required.

However if the TM20 is to correct errors in the agent's name or address on the TM2/3:

- (a) amend TM2/3, sign and date
- (b) check OPTICS to see if the name and address is correct on the database. If so, note 'actioned' on the TM20. If not, minute the file to NAFS for amendment.

**FORM TM20 - REQUEST TO AMEND/CORRECT SPECIFICATION**

101. A request on a TM20 to change a specification in any way must be referred to an Examiner, or above, for authorisation. In no circumstances can a specification be extended to cover goods or services not within the original claim.(EO)

If the change request is approved action as follows:

- (a) amend TM2/3, sign and date
- (b) enter the changes on OPTICS under 'change application'
- (c) write 'actioned' on the TM20, sign and date
- (d) if the application has been advertised the amendment will have to be published in the "Applications Amended after Advertisement" section of the Journal. Journal Section are responsible for this action.

**FORM TM20 - CHANGE OF CLASS**

102. All such requests should be referred to an Examiner for consideration - who will need to seek the agreement of the "importing" Unit HEO before transfer. If agreed action as follows: (AO)

- (a) amend TM2/3, sign and date
- (b) enter change on OPTICS under 'change application'
- (c) if the mark is anything other than word only notify the Public Enquiry Office (PEO) in order that the TRIMS record can be amended
- (d) amend front of file and shadow card
- (e) write 'actioned' on TM2/3, sign and date.

103. If the new class is dealt with by a different Unit the file and shadow card should be forwarded with a minute on the file explaining the situation and detailing the next action required or in which file store it is to be placed.

If the application has a current OPTICS diary date it will have to be deleted from the old Unit's diary and re-entered by the new Unit.

A record should be kept of cases transferred out or received in this way and the details given to the Unit HEO when the monthly statistics are completed (see paragraph 19 of this Manual).

#### **FORM TM20 - AMEND/CORRECT A MARK**

104. A request on a TM20 to amend or correct a representation of a mark must be approved by an Examiner or above. (See Chapter 9 of the Work Manual). Any amendment to a mark should be considered carefully. The request for the change may be as a result of an error in filing the application or may be a submission. All types of amendment should be considered according to the criteria laid down at Chapter 9 of the Work Manual paragraph 9-530.

105. If the change is approved take the following action:(AO)

- (a) if the change can be made easily and clearly then the TM2/3 and TM4's should be amended. It may be necessary to request fresh TM4s bearing the new representation where a device or composite mark is concerned. Staff should avoid pasting over the old representation when affixing the new version.

If the TM2/3s and TM4 are changed by hand the amendment should be signed, dated and noted 'see TM20'.

- (b) record the change on OPTICS under 'change mark'. If the change involves a change in the mark type e.g. if a device has been added to a word mark, then it should also be recorded under 'change application'

- (c) where a device mark is involved notify the Public Enquiry Office (PEO) of the change. If new representations have been filed one copy of the TM4 must be sent to the PEO for updating of the TRIMS record.

- (d) write 'actioned' on the TM20, sign and date.

106. In accordance with paragraph 88 of this Manual any amendment to an advertised mark must also be advertised. However, because of the serious consequences that might result from amendments to the representation of an advertised mark consideration should be given to the need to completely re-advertise the mark. Complete re-advertisement must be authorised at HEO level or above. Chapter 24 of the Work Manual paragraph 24-19 gives further details. See also paragraph 140 of this Manual.

#### **FORM TM20 - AMEND/CORRECT DATE OF APPLICATION**

107. All requests under this heading should be passed to the HEO in charge of the Public Enquiry Office who will consider the matter.

#### **HANDLING OF FORMS TM20**

108. TM20s are filed to either record a change of applicant's name, or correct a clerical error in the original application.

If the TM20 refers to a change of name ensure that either:

- (a) a change of name certificate is attached or
- (b) a statement appears on the form confirming that there has been no change in the ownership of the mark.

If the TM20 refers to a correction of the applicant's name action may be split into two categories:

- (a) if the correction is slight, e.g. a spelling or typing error, or the name of one member of a group of companies is to be substituted for another, then a statement that there has been a clerical error and that there has been no change in the ownership of the mark will usually be accepted without further evidence or explanation
- (b) in other circumstances the TM20 should be accompanied by a statement from the applicant, or his/her agent, confirming the facts and setting out the circumstances leading to the error. In cases of doubt a Statutory Declaration should be requested confirming the facts.

TM20s which do not refer to a change of the applicant's name or the correction of a clerical error should be queried.

TM20s submitted to change the name simply from e.g. Limited to Plc may be accepted at face value.

The substitution or deletion of partners' names (unless the correction of a clerical error) are not allowed unless covered by the provisions of Rule 62(2).

Staff should not commit the Registry to action a change of name. Although the decision to accept a TM20 rests with Examination Unit staff, NAFS will query proposals which clearly fall outside the parameters set out above.

109. Because it is the Registry's practice to alter all the records in the name of a proprietor when a TM18 or TM21 is filed, it sometimes occurs that the name and/or address on OPTICS can differ from that shown on a pending application form TM2/3.

Before making such cases Ready for Advertisement, the files should be sent to NAFS. NAFS will either:

- (a) confirm that the applicants/agents agreement to alter the details of the pending application has been received or
- (b) clarify the position with the agent and return the file to the Unit with the discrepancy with OPTICS resolved.

Before taking action as above, Examiners should first satisfy themselves that the discrepancy is not the result of an assignment of the pending application under Rule 62(2). This will be evident from the DISPLAY HISTORY Screen.

## **REQUEST TO ADD DETAILS NOT PREVIOUSLY MENTIONED**

110. All such requests should be referred to the Examiner responsible for the application.

## **CASES WITHDRAWN OR REMOVED FROM RECORD**

111. If the applicant no longer wishes to pursue the application a letter will be sent to the Registry advising that the application should be withdrawn. Alternatively if a reply is not received by the Registry within the allocated time, and the case is not a hearing case, the application is deemed to be abandoned and may be removed from record only after authorization from the Examiner concerned (it is at the discretion of the Examiner as to whether a one month reminder letter or reminder telephone call should be sent/made). Hearing cases cannot be refused until notice of refusal has been issued and time for appeal allowed (see paragraphs 178 and 190 of this Manual)

However, if evidence of use is on file the applicant must be contacted before the application is removed to ensure that it is not intended to pursue the application. If no reply is received within the allocated time after a hearing has been held, the application should be referred to the appropriate Hearing Officer for his/her agreement to the applications refusal or other decision.

112. **Removal action** for files where agents have not replied (after authorization from the Examiner following consultation with the Hearing Officer, if appropriate): **(AA)**

- (a) check for unlinked correspondence
- (b) if there are any "Top Documents" take action as directed on the document
- (c) if the file cover is stamped "Application made under Section 29(1)(b)" obtain the Registered User file and if it does not relate to other applications send it to Boxes. If it relates to other applications check to see if they are still pending. If so note the RU file with the details of the removed case and return it to the RU store. If the other applications are no longer pending, note the RU file accordingly and note details of the case to be removed then send it to Boxes. Do not attach it to the file being removed
- (d) record removal on OPTICS under 'record death of an application' giving the reason as removed this will change the status of the application to "Deemed Abandoned"
- (e) check whether the file cover or any minute sheets are stamped "opposition" or "threatened opposition". If so refer the file to Law Section to note their records. This is not applicable where the file shows that the opposition has been overcome. In these cases the file will be stamped "clear of threatened opposition"
- (f) check to ensure that form TM2/3 is on file - if not request it by telephone, or letter if necessary, from the agents/applicants. However removal action should not be delayed to wait for return of the form
- (g) check to see if the file contains a Statutory Declaration, an evidence summary sheet or exhibits. If so the Statutory Declaration and summary sheet must be retained on file and the exhibits returned to the agents as per Chapter 12 of the Work Manual

If there is a Statutory Declaration or summary sheet on file but no exhibits check the Unit evidence cupboard to see if the evidence/exhibits are held. If found return to the agents as above

- (h) note or stamp the minute sheet and file cover "removed from record", sign and date, and mark file with BOXES stamp
- (j) send the file to Boxes. Extract the shadow card from the file store and recycle where possible
- (k) statistics should be kept of all applications removed, split into cases removed before examination and cases removed from the main file store. The details should be given to the Unit HEO at the end of the monthly statistical period.

## **WITHDRAWALS**

113. An application can only be withdrawn at the request of the agent or applicant. When a request is received take the following action:

See removal action paragraph 112 steps (b), (c), (e), (f), (g), (j), (k)

In addition

record the withdrawal on OPTICS under "record death of an application" given the reason as "Withdrawn"

note or stamp the minute sheet "Withdrawn", sign and date

stamp the file cover with the "Withdrawn" and "Boxes" stamps

## **RESTORATION TO RECORD**

114. It sometimes happens that a pending or examined application comes to be removed from record unintentionally and an agent will request that it be restored. Restoration in such cases is at the discretion of the Registrar who must bear in mind that other persons may be aggrieved by the restoration. All requests for restoration must be referred to an officer of at least HEO level. Where the period of removal has been in excess of six months the relevant SEO should be consulted. If the period of removal has been in excess of twelve months the SEO should, depending on the circumstances of the case consider consulting a Grade 7 or Grade 6 officer. The procedures for dealing with restoration of lapsed registered cases are covered by PAC 19/93 and Chapter 10 of the Work Manual paragraphs 10-134 to 10-141.
115. All cases which show they have been involved in opposition or threatened opposition should be referred to the HEO in charge of Law Section who will consult with senior management.
116. When considering restoration the Registry must take account of the following:
- (a) whether, during the time the application has been off record a similar mark has been applied for by a different applicant in respect of the same or similar goods/services
  - (b) whether, during the time the application was on record a similar mark was filed by a different applicant in respect of same or similar goods/services which attracted the application as a Section 12(3) citation and which has been informed that the citation has gone off record and has been allowed to proceed

These cases can only be found by carrying out a search of applications filed since the date of filing of the removed application. Where the application was removed as a result of a Managing Examiner refusing an EOT, the Managing Examiner should carry out the search to date. Otherwise the search to date should be carried out by the Examiner who dealt with the case. If a confusingly similar mark with same or similar goods is found the file will have to be checked to see if the removed case was cited against it (EO)

- (c) how long the case has been off record and the circumstances of the removal.

Points (a) and (b) above, therefore, require that each case be searched from the date of application to the current date.

117. When an application to restore is received the Managing Examiner or Examiner should carry out the searches detailed above and attach all relevant details to the file i.e. OPTICS/TRIMS printouts, copies of Journal advertisements, etc. The file should then be minuted, setting out the facts, to the appropriate officer.

### **CASES WITH NO CONFLICTING MARKS**

118. If no conflicting marks are found by the searches detailed above then the decision on whether to restore rests on the length of time the application has been off record, the original reason for removal, and any other relevant facts which come to light.

Examiners must consider whether removal was as a result of a Registry error and if so must treat it sympathetically. This does not mean that restoration should be automatic. We must still look at the length of time off record and consider whether the agent could have queried the case earlier. This also applies to cases removed after no reply was received to an official letter but where the agent now submits a copy of a timeous reply which is not on file.

If the application was removed because no reply was received to an official letter or as a result of an agent's error, then we must consider whether the case could have been queried earlier. Each case must be considered on its merits but where it has been off record for over a year we should consider requesting a Statutory Declaration setting out the facts.(EO)

### **CASES WITH CONFLICTING MARKS**

119. If the search brings to light a later filed similar mark covering the same or similar goods/services and/or shows that a mark previously cited against the removed case has been informed of removal and allowed to proceed then the decision on whether to restore is based on the degree of similarity in the same way as a normal Section 12 conflict. However in this situation the later filed application has priority.
120. If there are no confusingly similar marks then restoration should be determined in accordance with paragraph 118 of this Manual. If the marks are confusingly similar the matter should first be considered as per paragraph 119 of this Manual and if there are grounds for restoration the Examiner should consider whether the clash can be overcome by other means such as limitation of the specifications.

If the clash cannot be overcome in this manner then the application cannot be restored. However if this applies to a case removed as a result of a Registry error or where an agent's timely reply has not been received the file should be referred through the SEO to the Grade 7 for further consideration.

Even if there are good grounds for restoration no action should be taken without advising the other party and seeking their comments. In some cases a joint hearing may be necessary. If it is decided that the application can be restored to record take action as follows: (AA)

- (a) record restoration on OPTICS under "restore application"
- (b) prepare and date a new shadow card.
- (c) delete removal stamps from the file cover and minute sheet but ensure the details are still visible
- (d) note the minute sheet "restored to record", sign and date
- (e) inform the applicant: "The Registrar has in the circumstances restored your application to record and this will not now be removed before [date] to give you a further opportunity of dealing with the outstanding matters. You are informed that if the application is allowed to lapse again no further request for restoration can be considered". If the error was caused by the Registry an apology should be made and the tone of the letter changed accordingly
- (f) if the application is stamped "application made under Section 29(1)(b)" check to see if the RU file is in the RU store, if not retrieve the registered user file from Boxes
- (g) refer to the appropriate Examiner for further action or return to the file store if a new date for reply has been given.

### **PART 3 - DEALING WITH CORRESPONDENCE**

The Registry has a customer service target to reply to 95% of substantive correspondence within six weeks of receipt. If it becomes apparent that a reply will not be sent within this time an acknowledgment card should be sent to let the agent/applicant know when they can expect a reply.

#### **CORRESPONDENCE RELATING TO MATTERS RAISED IN EXAMINATION REPORTS**

121. Although many examination reports containing objections result in requests for hearings without any attempt at argument by correspondence, many agents/applicants submit written observations in reply. All such letters should be considered by Examiners. If no point of substance arises and the original objection is considered to be soundly based, the reply should briefly explain why the objections are maintained and reiterate the offer of a hearing within a specified time. However, there may be cases where it would be appropriate to expand the reasons for the objections raised, and in such cases the Examiner should ensure that all the relevant points are covered.(EO)
122. Wherever possible the Examiner should suggest ways in which the objections may be overcome (after referral to the HEO or SEO if necessary).
123. The various ways in which objections can be resolved are set out in Chapters 9 and 10 of the Work Manual dealing with the Rule or Section under which objection has been taken, although because of the variety of situations that can arise each application must always be dealt with on its own merits.
124. If there is not a conclusion or clear sign that a conclusion is imminent after two official letters then the cases must be closed off using one of the 'closing off' paragraphs.

When using the 'closing off' paragraphs Examiners must answer any points made by the agent in his most recent letter and give a brief explanation as to why the informal correspondence is being concluded.

125. If the applicants arguments have merit or it is considered that the objection could be waived altogether or on conditions, the case may be dealt with by an experienced Examiner.

Where the objection can be overcome without undue complication more experienced Examiners may waive objections on their own initiative. When an Examiner needs confirmation of a particular decision or guidance in more difficult cases the application may be submitted to the Unit HEO.

126. In many cases, Examiners can resolve problems by discussing cases with a senior officer. However, when submitting a case in writing to a senior officer for guidance:
  - (a) briefly state all the relevant facts
  - (b) quote precedents where appropriate
  - (c) make your recommendation
  - (d) attach any relevant files.
127. An applicant may submit an amended mark in an attempt to avoid the objections raised. The procedure to be followed in such cases is set out in Chapter 9 of the Work Manual paragraphs 9-88 to

9-93, but whatever the verdict on the proposed amended mark, the applicant is still entitled to a hearing on either the amended mark or the original mark if he desires.

128. If the objections raised are under Section 11 of the Act, the applicant may submit a limited specification or propose a condition of registration or a variation clause with a view to overcoming the objection raised.
129. Where the objections raised are taken under Section 12 of the Act there are various methods of resolving the objections (see Chapter 10 of the Work Manual paragraph 10-154). Examiners should be as helpful as possible and always try to suggest ways of overcoming objections, consulting with senior officers where necessary.

#### **CANCELLATION OR PART-CANCELLATION OF CITED REGISTRATIONS (RECTIFICATION)**

130. On receipt of a form TM23 Register Maintenance Section will forward the registered file to the HEO in charge of Classification Section. The proposed part-cancellation will be checked by the HEO (or an Examiner in the Classification Section) to ensure that the proposed part-cancellation is acceptable from a classification point of view (see Chapter 7 of the Work Manual).

If it is not, the HEO or Classification Examiner will contact the agent by telephone to establish the details of any conflicting application which may have given rise to the proposed part-cancellation. When the details are obtained the corresponding file(s) should be checked. The Classification Examiner will then liaise with either the Examiner or Hearing Officer dealing with the pending application to establish a wording for the part-cancellation which is acceptable and which overcomes the clash with the pending application.

131. If an acceptable form of words can be agreed with the agent for the registered mark, the TM23 may be amended in the office and a note made on the minute sheet. The file should then be returned to Register Maintenance Section for action.
132. Register Maintenance Section should also be advised if the original wording is acceptable or if the part-cancellation cannot proceed because of insurmountable classification problems.

#### **ASSIGNMENT - CHANGE OF OWNERSHIP**

133. In an attempt to overcome a Section 12 objection an applicant may acquire ownership of a cited mark. Alternatively the application may be assigned to the owners of a cited mark.

#### **ASSIGNMENT OF SECTION 12(1) CITATION**

134. Where a Section 12(1) citation is to be assigned to the applicants they will forward form TM16 which on receipt will be directed to Assignments Section for action. When the Unit is informed of this course of action they should:
  - (a) ensure that a TM16 has been filed by checking the OPTICS history record (DISPLAY HISTORY) of the application to be assigned. The history record will show if a TM16 is held by Assignments Section

If not query with agents, if so:

- (b) if there are no other objections to be overcome the application in the Unit should be brought forward for 2 months on the OPTICS diary to await completion of the assignment.

Once the assignment is complete and ownership of the cite is transferred the Section 12(1) objection falls away and the assigned mark will need to be associated and an association sheet raised.

### **ASSIGNMENT OF SECTION 12(3) CITATION**

135. An attempt to overcome a Section 12(3) objection by assigning the cited pending mark to the applicants can only be permitted in specific circumstances.

Rule 62(2) of the Trade Mark and Service Mark Rules 1986, which came into force on 1 October 1986, permits the assignment of pending applications in certain special circumstances. These are:

- (a) if the pending mark(s) form part of an assignment which includes registered marks, AND  
(b) the goods or services included within the specification(s) of the pending mark(s) are the same goods (services) or goods (services) of the same description as at least one of the registered marks, AND  
(c) all the marks (both pending and registered) belong to the same proprietor and are being transferred to the same new owners.

The Registry has asked practitioners to highlight which mark(s) listed on the application to record the assignment (form TM16) are pending marks and, if possible, indicate which registered mark(s) provided equities for the inclusion of the pending mark(s) in the assignment.

On completion of the examination of the assignment the transfer of the pending mark(s) will be included in the advertisement of the assignment in the Trade Marks Journal in the normal way and the OPTICS and TRIMS databases will be amended accordingly. The name of the new applicant will be recorded on the application form TM2/3 and the mark will proceed to advertisement and registration in the new name. There will be no mention of the assignment on the Register – only on the application form and on the file. The front cover of the file should be amended. (AO)

The handling of an assignment involving pending marks will involve administrative decisions depending on the stage reached by the pending mark. For example, if advertisement has occurred and registration is expected shortly then it might be appropriate to complete the registration process and then deal with the recordal of the assignment. In other cases where opposition is threatened or launched and registration is likely to be delayed then it might be appropriate to complete the assignment action. The object in every case will be to process the applications in the quickest and most efficient way possible.

### **ASSIGNMENT TO OWNERS OF CITED MARK (SIM TIM – SIMultaneous TIMed registration and assignment)**

136. A pending application can only be assigned in the circumstances described as in paragraph 135 of this Manual. Therefore, unless those circumstances apply, a proposal to overcome a Section 12(1) or 12(3) objection by assignment of the application to the owners of the cited mark can only be achieved by simultaneous registration and assignment. (SIM TIM).

The Trade Marks Act states that an application may not proceed to registration with a Section 12 objection outstanding. However an application may be advertised with a Section 12 objection outstanding on the condition that assignment to the owners of the cited application takes place at the same time as registration so that the mark is registered in the name of the new owners.

When an application is allowed to proceed in this manner it is therefore essential that the application is not allowed to proceed to registration in the name of the original applicants with the Section 12 objection still outstanding. To avoid this the file must be boldly marked SIM TIM. This will bring the file to the attention of New Registration Section who will send the case to Assignments Section for action.

The SIM TIM procedure should normally only be used as a means of overcoming Section 12 objections. It should not be used where a mark is simply to be assigned to new owners. In such cases the mark should be assigned after registration.

An exception to this is the situation where the pending mark has encountered Section 9 and 10 objections and the owners wish to assign their mark to new ownership in order to take advantage of an equity that the new owner possesses. This most commonly happens when several companies are in the overall ownership of a parent company. In these circumstances we should first ensure that the appropriate assignment documents have been filed with the Registry. The equity is then associated with the pending mark and the objectionable matter disclaimed. The amended mark proceeds to advertisement – Advertised before acceptance by reason of special circumstances. Section 18(1) (proviso) – and SIM TIM

An application to proceed by means of simultaneous registration and assignment must be approved by an HEO or above.

If approved, the Examiner should:

- (a) ensure that the TM16 has been filed by checking the history record of the case

If not, query with the agents, if so:

- (b) mark the file cover boldly and in red 'SIM TIM'
- (c) allow the application to proceed in the usual way.

### **ASSOCIATED MARKS WITH DIFFERENT NAME**

- 137. In some cases it transpires that the cited mark in fact belongs to the applicant under a different name (not to be confused with a different legal entity) and in such cases the name of the owner of the cited mark has to be brought up to date by means of a form TM21 to bring it into line with the correct name of the owner of the pending application.(AO)

### **ASSOCIATED MARKS WITH DIFFERENT ADDRESS**

- 138. In other cases a registration due to be associated may show a different address from that shown on form TM2/3 of the pending application. In such cases take action as per Chapter 10 of the Work Manual paragraph 10-113.

## **REFUND OF FEES**

139. Where a refund of fees is requested the Examiner should detail the reasons for the request and pass the file to the EO in charge of Register Maintenance via the Unit HEO.

Chapter 21 of the Work Manual deals with refunds.

## **POST-ADVERTISEMENT CORRESPONDENCE (from applicant)**

140. In the event that a notification is received (either by telephone or in writing), to the effect that an advertised mark requires additional action, the following procedure should be adopted:

- (a) the advertised file is collected from PAFS by a Unit AA who MUST update the PAFS record accordingly
- (b) the AA then passes the file to the Unit's Managing Examiner who reviews the case and decides which option is the most appropriate. If the mark simply requires an erratum (as is more often the case) or needs to be Amended After Advertisement (AAA) the Managing Examiner will minute the file accordingly and ensure that the file is taken to Journal Section for action.

However, if the letter merely advises of a minor error in a Journal advertisement (e.g. a mis-spelling in the specification) there is no need to publish an erratum. It is not considered cost effective to do so and the registration of the mark will be delayed while the file remains in Journal Section. However, the agent concerned should be advised. If they insist on having the erratum published in spite of the delays, then we should comply with their wishes. The file must then be returned to PAFS by a member of Journal Section.

- (c) if, however, the Managing Examiner feels the mark requires a re-advertisement, the file should be passed to the unit HEO for consideration. The HEO is required to authorize all cases requiring re-advertisement.

If it is felt that a re-advertisement is necessary, on return from the HEO, the Managing Examiner will minute the file accordingly. The file should be sent to Journal Section who will flag the case Late Objection and then take the necessary action.

- (d) if the file is to be retained on the Unit following advertisement, the Examiner concerned must ensure that the status on OPTICS is updated accordingly.

## **POST ADVERTISEMENT CORRESPONDENCE (from third parties)**

141. A request may be made by a third party for acceptance to be withdrawn. The most common reasons for such a request are:

- (a) that the writers own an identical or similar mark
- (b) that they have a pending application for an identical or similar mark with a later filing date but on which they are claiming prior use over the advertised mark
- (c) that the mark is a generic term and section 9, 10 and 11 objections should have been raised.

Guidance on the action to be taken is given in Chapter 10 of the Work Manual paragraph 10-65 and TMC 27/91. All such correspondence should be passed to the Unit SEO.

#### **PART 4 -OUTGOING CORRESPONDENCE**

142. Every writer of a letter to the Trade Marks Registry is entitled to expect an accurate, full, clear, polite and prompt reply which quotes both theirs and the office's reference. In addition, the legal aspect must always be borne in mind. Letters issued by the Trade Marks Registry can be publicised in the Courts and it is particularly important that the phraseology used is unambiguous.
143. In cases where an agent is acting for the applicant it is usual for the correspondence to be addressed to the agent. Check that the correct reference for the agent is given.

#### **DRAFTING PROCEDURES**

144. Many of the letters issued by the Registry are of a standard nature, and for the sake of legal correctness, uniformity and economy most of these are now on word processor either as letters in their entirety or in the form of standard paragraphs which can be incorporated into a letter.
145. Examiners should be careful to ensure that the correct wording is used, e.g. clauses, disclaimers, conditions etc.
146. When an examination report is issued, and where it is necessary to amend the application form the form TM2/3 should be returned. If there are any objections which have to be resolved by correspondence then the TM2/3 remains on file until these have been resolved .

#### **PREPARATION OF CORRESPONDENCE FOR TYPING**

147. The correct preparation of correspondence is important, and the rules listed below should be observed:
- (a) any reference given by the correspondent must be quoted, if none is given we should state "no reference supplied"
  - (b) 'our reference' must always be quoted. Usually this will be the full application number of the file followed by the Unit or section reference. eg. 1234567/Pink 12 plus the initials of the writer
  - (c) the writer's telephone number should be entered in the heading of the letter
  - (d) the writer's name and title should be typed below the signature.
148. Units will have a typing box or tray where files for typing can be placed by all staff. The files must be listed in a typing book.

#### **CHECKING AND DESPATCH OF CORRESPONDENCE**

149. On return from the typists all letters must be checked against the draft. Typing, including correspondence and examination reports should be checked by AOs. This should ensure the correct wording of technical formalities such as disclaimers, colour limitations, conditions of registration etc. It is important that typing is checked carefully.

The person who signs the letter takes the responsibility for the accuracy of the letter against the draft copy (AO)

## Outgoing Correspondence

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Typing should be checked and dealt with as follows:

- (a) check the typed copy against the draft for errors or omissions. Minor errors may be corrected neatly using correction fluid
- (b) check that the Registry's reference and the agent's/applicant's reference are correctly shown plus the writer's telephone number

When the letter is ready for issue:

- (c) sign on behalf of the Examiner (pp) and date the letter
  - (d) any enclosures must be securely attached to the letter
  - (e) the file copy should be attached to the right hand side blue tag.
  - (f) where a letter relates to more than one application the letter and draft should be photocopied and attached to each file
  - (g) copies of letters not sent may be retained on file for historical purposes if necessary but should be clearly marked "not sent"
  - (h) if copies of a letter or a document without a covering letter are issued a compliment slip should be attached showing the senders name and address. The file must record the names of the recipients of copies of letters
  - (j) when an examination report is sent to a private applicant a copy of the private applicants notes should always be attached
  - (k) when correspondence is ready for despatch the file and both copies of the letter should be passed to the Managing Examiner for sampling
  - (l) the Interdepartmental Despatch Service (IDS) is used to transport letters between government offices. The Post Room holds timetables of all the van services. These van services are much faster and cheaper than the post, and they should always be used for post between Government offices. Papers should be enclosed in an unfranked envelope (or a used envelope sealed with an unfranked label) marked 'by van'. Ordinarily, the envelopes can be placed in the out tray for collection by the messenger service; in cases of urgency, correspondence intended to catch a particular van should be taken to the Post Room by hand at least 15 minutes before the scheduled time of departure.
150. When the correspondence has been despatched the AO should diary the file on OPTICS accordingly and return the file to the file store.

### **PROCEED LETTERS**

151. A proceed letter is issued when all objections have been overcome. It gives the precise details and condition of how an application may proceed to advertisement and requests any necessary amendments to form TM2/3.(AO)
152. Proceed letters can be issued:
- (a) after a hearing on the instructions of the Hearing Officer, where the TM2/3 has not been amended at the hearing

## Outgoing Correspondence

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- (b) after correspondence with the agents/applicants on the instructions of an Examiner or Unit Manager
  - (c) when an agent writes and agrees to the amendments and requirements specified in the examination report and where the TM2/3 needs amendment.
153. Where a proceed letter is to be issued the Examiner will complete a blue proceed sheet (Annex 2), detailing precisely the information that is to be contained in the letter. The Examiner should keep a record of the number of blue sheets completed for statistical purposes.

The AO will then complete the proceed letter form (PL1) for the production of the letter by word processor. The draft proceed letter should be passed to the Managing Examiner for sampling.

The PL1 is a series of numbered boxes which relate to wordings shown in the Typists paragraphs/notes for proceed letters and this should be referred to when completing the form.

There is also provision for entering non-standard text specific to the application.

154. When proceed letters are to be issued, particular attention should be paid to the following:

(a) Specifications

The specification should be copied in full onto the proceed letter. Care should be taken to ensure that the punctuation and spelling are correct. Handwriting should be legible to ensure that the typists can clearly see what should be typed

(b) Associations

Details of marks to be associated are found on the yellow association report form AR1.

(c) Registered Users

If the file cover shows the application has been applied for under Section 29(1)(b) the registered user file should be obtained. If the registered user documents are not on file they should be requested in the proceed letter. When received the registered user documents should be checked as detailed in Chapter 29 of the Work Manual

(d) International Convention Dates/International Priority Dates (IC/IP date)

If a priority date is claimed under the convention (this will be shown at Box 8 of the TM3, Box 11 of the TM2) check to see if the certificate of application, with translation if appropriate, is on file.

If the documents are on file the International Convention stamp should be placed on the file cover and completed to show the date claimed and the country

(e) Conditions, Disclaimers, Advertised before Acceptance, Translations etc

There are specific paragraphs in the proceed letter relating to all these requirements and care should be taken to ensure that the wording used is exactly as requested on the blue proceed sheet.

(f) There are a number of standard wordings for these requirements which are given at Annex N of Chapter 9 of the Work Manual. However, the most frequently used clauses are at Annex 8.

(g) Top Documents

Before the proceed letter is issued check to see if there are any Top Documents on file which request action at proceed stage.

These are used as a reminder system. When some future action on a file will necessitate action on another case a Top Document is completed to show the number of the application and noted to indicate the necessary future action.

e.g. When this application is registered, refused, withdrawn or removed from record please pass the file to Ryan Giggs for determination of application.

(h) Amended Marks

Where this applies we must request four representations of the amended mark for attachment to the TM2/3 and TM4s. An original mark on a TM4 must be retained on the file. If the mark contains, or is, a device the PEO must be advised so that TRIMS can be updated accordingly.

(j) Camera ready copy (CRC)

Each application which proceeds has to be advertised in the Trade Marks Journal. When a mark contains a device or a stylized word it is sometimes necessary to obtain a camera ready copy (CRC). A CRC is a representation of the mark which will reproduce clearly. It is often necessary to get a camera ready copy made specially by a printer or artist. Camera ready copy is a technical term used in the publishing industry. If the original copy of the mark is not clear or is in colour it will probably be necessary to obtain a CRC.

The Examiner or Hearing Officer may not have requested a CRC so when the blue proceed sheet is being completed the mark shown on the TM4 should be checked to ensure it is clear enough to be used as a camera ready copy. If not Journal Section should be contacted for advice.

Particular attention should be paid to device marks, stylized words and marks in colour.

The representation of the mark is not acceptable if:

- (i) it is in colour (see below)
- (ii) it is coloured grey
- (iii) small detail cannot be clearly seen
- (iv) it is blurred or unclear in any way.

Where CRCs are required on a companion group of files it is necessary to request a separate CRC for each application.

(k) Marks in Colour

The Practice Guide to the Examination of Trade and Service Marks deals with the advertisement of marks in colour under the headings Heraldic Shading and Marks in Colour.

155. When a reply has been received to a proceed letter, the file should be passed to the appropriate AO. If the agent has not agreed to all of the amendments the file should be passed by the AO to the appropriate Examiner. If the agent has agreed to all amendments the file should be made ready for advertisement by the AO. (see paragraphs 156–159 of this Manual)

## **PART 5 – READY FOR ADVERTISEMENT ACTION**

156. The pre-advertisement TM2/3 check involves a complete review of all actions taken on a trade mark file before the details are electronically downloaded into a "Proof" Journal.

Typically, this will involve reviewing the file from back to front (together with any minute sheets) to ensure that all requests made during the examination process have been complied with. This action is the responsibility of the Examiner.

When the Examiner is satisfied that the file is ready to proceed to advertisement, a blue ready for advertisement sheet (see Annex 2) is attached to the file. This sheet must be completed by the Examiner detailing precisely how the mark is to proceed. The Examiner should keep a record of the number of blue sheets completed for statistical purposes.

The case will be passed, via the HEO for monitoring, to the AO who will complete the pre-advertisement action on OPTICS in accordance with the instructions on the blue ready for advertisement sheet. The AO will request a copy of the Draft First Advertisement from OPTICS.

The Draft First Advertisement is placed on file (on the right hand side blue tag). The file will then be passed to the Managing Examiner for sampling.

## **READY FOR ADVERTISEMENT – AO ACTION ON OPTICS**

157. Firstly, if the case has pending associations, check to see if they are still pending by means of "display case". If they are now registered amend the association sheet accordingly and note the Journal reference on OPTICS and on the yellow association sheet. If they have been abandoned, removed or refused delete them from the association sheet. Secondly check the TM2/3 and blue ready for advertisement sheet to see what amendments are necessary and call up the OPTICS record of the application. All amendments are entered using the 'change application' function.

Amendments can be made as required under the following options:

### Option 1 Case Details.

Mark Type – to be changed if the mark has been amended in a manner which changes the type of mark e.g. from word only (WO) to device plus word (DW).

Mark types available are:

- (a) DO – device only (type 1)
- (b) WO – word only (type 2)
- (c) DW – device plus word(s) (type 3)
- (d) SW – stylized word (type 4)

Schedule of goods – will be already set at 4 and will not need to be changed

Register Part – amend from A to B where applicable

Marks in a Series – the number in the series when the application was made will be shown. Amend if marks have been deleted from the series.

Section 29(1)(A/B) – this will normally have been entered at the time of application and if applicable will be shown as A or B. Delete if the Registered User application has been abandoned.

IC/IP Country Code – If IC/IP documents have been filed and approved, enter the code as appropriate – see Annex 9. An entry here necessitates an entry under Option 6

Association Indicators – If associations have been agreed amend indicator from N to Y

IC/IP Date – enter as appropriate

Registered User Indicator – If RU documents have been approved amend from N to Y.

#### Option 2 Goods' Specification

The finalised specification should be entered. Great care must be taken to ensure that the entry is made exactly as indicated on the blue ready for advertisement sheet, including punctuation. Only spelling errors may be amended. If the class needs to be amended it is also done under this section.

#### Option 3 Mark Text

Use when the mark has been amended.

If text is deleted from a word and device mark the mark type must be changed under Option 1 (case details) before amendment can be effected here. The PEO must be advised so that TRIMS can be updated accordingly.

#### Option 4 Names and Addresses

Use when necessary for amendment of agents name and address by entry of the agents ADP number.

Changes to the applicants name and address must be made by Names and Address Function Section (NAFS).

#### Option 5 Print Draft First advertisement

Used when the ready for advertisement check is completed to obtain a draft copy of the advertisement.

#### Option 6 Advertised Before Acceptance (ABA)

For use when an application is proceeding after the submission of evidence, trade evidence or on special circumstances. The text to be entered should be shown on the file cover and on the proceed letter. The officer who makes the decision on whether the mark is acceptable on evidence is responsible for marking the file cover in red ink.

#### Option 7 Conditions/Limitations/Clauses/Translations etc

Use to enter details of conditions or clauses imposed. They will be shown at Box 5 of form TM3 (box 12 of TM2) and must be entered exactly as shown on the form.

#### Option 8 Disclaimer

Use to enter details of disclaimers shown at Box 5 of form TM3 (Box 12 of TM2). The exact wording must be used.

#### Option 9 (spare)

Option 10 Associations and Consent

Under the heading "Association Text" enter the application number and Journal reference of the lead association. If there is more than one association the one to be entered will be contained in square brackets. If there are two associations add the words "and another". If there are more than two add the words "and others". For example , an entry may read:

To be associated with No. 1234567 (2387, 1181) and others

If the associated mark is in Part B of the Register this should also be shown e.g. B1243658 (2389, 2111).

If the application is proceeding by Consent of the owner of another mark the file cover should bear the stamp "By Consent". The blue ready for advertisement sheet will indicate which marks are involved. Under the screen heading "Consent Text" enter details as follows:

e.g. By Consent No. 1234569 (2131, 187).

158. Once OPTICS action has been completed, check the Draft First Advertisement print against the TM2/3 and blue ready for advertisement sheet. Great care must be taken to ensure that the draft first advertisement agrees with the TM2/3 and the blue ready for advertisement sheet. When satisfied that the application is in order to proceed to advertisement, sign and date the blue sheet and pass the file to the Managing Examiner for sampling.
159. Every Wednesday evening the OPTICS system automatically sweeps the database to detect cases 'Awaiting Advertisement' to be printed in the next proof Journal. It is, therefore, essential that all files amended to 'Awaiting Advertisement' arrive in Journal Section by 4.00 pm on Monday.

In order to ensure that files reach Journal Section on time AOs must only change the status of applications to 'Awaiting Advertisement' on Thursdays, Fridays and Mondays.

On completion of the change of status to 'Awaiting Advertisement', the AO will send the file to Journal Section.

The shadow card must be marked accordingly. The shadow card should then be placed in the Journal Run. The shadow cards of all cases sent to Journal Section for advertisement are kept in this run in order to simplify the task of removing the cards after registration. This should be done immediately after the files are passed to Journal Section.

## **PART 6 - OPTICS DIARY**

### **ACTION ON DIARY PRINTOUTS (AO)**

160. When a letter is issued a specific date is set for reply. The length of time given for an examination report is six months and the time given for correspondence varies according to the circumstances of the case. Agents may apply to extend the time given by means of an Extension Of Time request (EOT) and if approved a new date for reply is set. (See Chapter 19 of the Work Manual.)

The date given is known as the diary date or may be referred to as the removal date.

Following the issue of a letter, form or extension of time, before the file is returned to the file store, the diary date is entered onto the OPTICS diary under "Record Diary". Details of this procedure are given at paragraph 170 of this Manual (AO/AA)

When replies are received they are linked to the file and the diary dates are deleted (see linking correspondence at paragraph 48 of this Manual)

161. If there is no reply on a case the diary date will remain on the diary until the date matures. Details of the case will then be automatically printed out on the OPTICS diary printout.

Once a week a printout is passed by Computer Customer Services to the Unit containing details of all the applications relating to that Unit with diary dates which have expired during the previous week.

The AO has to check each entry and take the appropriate course of action and delete the diary date.

If the date is not deleted it will continue to appear on the weekly printout for a period of three months before being automatically deleted.

AOs can therefore dispose of the diary printout when the following week's printout arrives. They must however ensure that all cases are found and actioned within three months.

162. When a removal date is entered onto the OPTICS diary an additional month is allowed.

This practice ensures that a reply has not in fact been received and not linked to the file, which may occur if there is a backlog of unlinked correspondence and avoids unnecessary removal of the case. For this reason the Managing Examiners must ensure that unlinked correspondence is not allowed to build up.

163. The extra month allowed does not apply to cases brought forward (BF) which also appear on the print out. Brought forward action means that staff can use OPTICS to advise them that a case needs to be reviewed.

164. On receipt of the diary printout, the following action should be taken:

- (a) check the current status of all entries on OPTICS under "display case". This will avoid unnecessarily looking for files on which some other action has taken place and on which the diary/BF date has inadvertently not been removed.

Where the status is shown as registered, advertised, awaiting advertisement, removed, refused, withdrawn or opposed – delete the diary/BF entry

- (b) on all other cases the file should be obtained from the appropriate file store

If the file is not available and the shadow card shows the file has been marked out to someone since the diary/BF date was entered – check with the person concerned and, if appropriate, delete diary/BF entry.

If the file is found – delete the diary/BF entry.

- (c) check the file for correspondence received or minutes written since the diary/BF date was entered

If there is a letter, minute or an EOT which indicates that a new diary/BF date has been given :

Check OPTICS using "display diary" to ensure that the new diary/BF date has been entered and if so delete the old date and return the file to the file store.

If the new diary/BF date is not shown it should be entered under "record diary" and the old date deleted. The diary stamp should be entered on the minute sheet showing the new date. If, however, a BF date has been entered, the minute sheet should be noted accordingly.

165. Diary stamps should be entered on the minute sheet in chronological order. Diary stamps should be used by all Units.
166. If documents, correspondence or a minute have been put on file since the diary/BF date was given and which appear to be unactioned, pass the file to the appropriate Examiner.
167. If there has been no action on the case since the diary/BF date was entered, refer the file to the appropriate Examiner or Hearing Officer.
168. If a file has not been found by the end of six weeks seek advice from your Managing Examiner.
169. If the application is to be removed continue as per paragraph 112 of this Manual.

#### **ENTRY ONTO OPTICS DIARY**

170. When a file is passed for an entry to be made on the OPTICS diary take action as follows:

- (a) check the minute sheet or letter to see if the date to be entered is a removal date, a refusal date or a bring forward (BF) date
- (b) enter the diary/BF date on OPTICS under the "record diary" option, adding an additional month for diary dates only.
- (c) under diary text state whether the entry is a removal, refusal or a BF date.

A number of applications with the same diary can be entered together under the "record multiple diary" option. However under this option there is only one text screen for all the application numbers entered and so removals, refusals and BF cases cannot be input in the same batch, the system only allows one date for diary purposes.

- (d) the file should be returned to the file store.

## **PART 7- HEARINGS CASES**

### **HEARING REQUESTS**

171. A hearing is requested by letter when an applicant or their agent wishes to discuss formally objections taken to their application before a senior officer of the Registry.

### **ORDINARY REQUESTS**

172. When it is apparent from the letter that an ex-parte hearing is requested the AA should send the file to the Hearings Clerk once the following action has been completed:

- (a) delete the diary date from the OPTICS diary system
- (b) record the hearing request on OPTICS under 'record hearing'. This will change the hearing indicator on 'display case' from N to Y to show that the file is awaiting a hearing
- (c) note the shadow card 'hearings ..... (date)'
- (d) stamp the minute sheet "See letter of ..... fix hearing".

A bundle of files may be passed to the Hearing Clerk with a note attached to the top file "HEARING REQUESTS". All shadow cards should be noted appropriately.

Correspondence relating to cases on which a hearing has been requested should be linked to the file by the Unit's AAs. This will involve obtaining the file from the Hearing Clerk, linking the letter and passing the file to the relevant Examiner for consideration. Based on the contents of the letter the Examiner will then decide if the need for a hearing is obviated. If this is the case the Hearing Clerk should be notified accordingly. However, if the hearing cannot be avoided, the letter should be attached to the file, a reply sent if necessary and the file returned to the Hearing Clerk.

### **JOINT HEARING/COUNSEL HEARING**

173. Any such requests should be forwarded immediately to Law Section who will arrange the hearing.

### **HEARING ON AN EXTENSION OF TIME REFUSAL**

174. If a hearing has been requested when an extension of time has been refused the case should not be referred to the Hearings Clerk but should be referred to the Unit SEO to deal with by telephone at the earliest opportunity and in accordance with Chapter 19 of the Work Manual. If he/she cannot conduct the hearing within a reasonably short time-scale it will be his/her responsibility to arrange a hearing before another Hearing Officer.

If a hearing has been requested following a refusal of an extension of time on a case that has had a substantive hearing the file should be returned to the Hearing Officer concerned who should conduct a telephone hearing as soon as possible.

Delays in the appointment of hearings in respect of the refusal of an extension of time request can have embarrassing repercussions and, of course, may result in considerably longer extensions being necessary if the Hearing Officer decides to grant the extension.

## **RETURN OF FILES AFTER HEARING**

175. Once hearings have been held the files will usually be returned to the Unit in bundles.
176. All cases should be noted on OPTICS under 'hearings outcome'. Any entry under the screen text will return the hearings indicator under 'display case' to N and will post the notice 'hearing held on pending case' to the case history of the application. It is not necessary to enter details of the hearing outcome and the letter L should be entered.
177. Any further substantive correspondence relating to the hearing decision, including EOTs, should be referred back to the Hearing Officer concerned.

## **REMOVAL FROM RECORD**

178. Cases which have been to a hearing must not simply be "removed from record" because an agent has failed to respond by an agreed date. Hearings cases may only be removed from record when either:
  - (a) the applicant or their agent has formally withdrawn the application
  - (b) formal notice of refusal has been issued by means of form R.App12.

When an applicant or agent has failed to respond by a given date the file should be referred to the Hearing Officer who will decide whether formal refusal is appropriate.

## **EXTENSIONS OF TIME (EOTs)**

Where the Hearing Officer has allowed a set time for the agent or applicant to deal with a particular issue an extension of time should not be allowed without the Hearing Officer's specific authority. (See Chapter 19 of the Work Manual)

## **POST HEARING CORRESPONDENCE**

Letters sent by Examiners about cases which have been the subject of hearings should make it clear that they have been written at the request of the Hearing Officer.

For example:

Your letter of ..... has been considered by the Hearing Officer, Mr/Mrs....., who has asked me to tell you .....

It is very important that letters about cases which have not been to a hearing should not normally mention the name of any senior officer who has advised on the action being taken.

179. Instructions from Hearing Officers (or any senior) officer to Units should be carried out in full. For example if a minute from a Hearing Officer says "Please refuse EOT and say ....." Examiners should ensure that the resulting letter includes all the remarks. It is not enough to simply issue a stock refusal letter.
180. If staff have any queries about the wording, punctuation or any other details of a hearings case, these should be referred to the Hearing Officer. On no account should staff telephone agents and propose

amendments. Any suggested amendments should be referred to the Hearing Officer who will, if appropriate, seek the authority of the applicant or agent.

181. Action requested by the Hearing Officer is usually dealt with by the Examiner, or e.g. in the case of the application being suspended, an AA. However the Unit HEO may wish to see the files first to see the decisions made and to circulate them amongst the Examiners. If this is the case the AA should mark the shadow cards "A/H" (After Hearing) followed by the HEO's name and the date. The bundle should then be given to the HEO.

Following circulation the Managing Examiner will arrange for the files to be passed to the relevant Examiner, where appropriate, and the shadow card marked accordingly.

### **APPLICANTS' LETTERS FOLLOWING HEARING**

182. Those letters which consist of straightforward replies complying with the requirements for proceeding set out in after-hearing letters and/or minutes usually present no problem; they come to the Units to ensure that the form TM2/3 has been amended in the way set out in the minute or official letter. As form TM2/3 is a statutory form amendments should, in most cases, be carried out by the applicant, or his agent. However, it is now accepted that in the interest of expediency they may be altered within the Registry providing that permission has been given by the agent/applicant.

Letters requiring action are dealt with by examination staff in accordance with the procedures set out in the Chapters or paragraphs as indicated below:

- (a) letters of Notice (Chapter 10)
  - (b) letters of Consent (Chapter 10)
  - (c) complete or partial cancellations of cited marks, from the Register (Chapters 10 and 29)
  - (d) assignments of cited marks to the applicants and assignments of pending marks – see paragraphs 133–135 of this Manual.
  - (e) assignments (effective at registration stage of applications to the owners of cited marks – SIM TIM) (Chapter 9). (see also paragraph 136 of this Manual).
  - (f) amendment of mark (fresh representations) (Chapter 9) (see also paragraphs 74–79 of this Manual).
  - (g) agreement to association under Section 23 of the Act with other marks in the applicant's name (Chapter 9)
  - (h) agency authorisations (Chapter 8)
  - (j) extensions of time (Chapter 19).
  - (k) evidence (Chapter 12)
183. Sometimes a Hearing Officer will have indicated to an agent at the hearing on what terms he/she is prepared to allow the application to proceed and these conditions (including alternatives) will be noted in the after-hearing minute and the application suspended, for a specified time, for the agent to seek his/her clients' agreement.
184. Where a reply is not straightforward, or where the applicant does not agree to the conditions laid down or offers alternatives, the case should be referred directly to the Hearing Officer, without delay. The Examiner should write a minute suggesting possible courses of action.

## **ACTION ON AFTER HEARING CASES**

185. The Examiner, or, if appropriate, the Managing Examiner should read the after hearing minute and follow the directions of the Hearing Officer. This could involve a number of actions for which referral should be made to the appropriate Chapter of the Work Manual. However some of the more common instructions are detailed below.
186. If the hearing on the application has been suspended for a set period of time the minute may state e.g. 'please allow 3 months' and in such cases the application should be given a B/F date three months hence on the OPTICS diary.
187. If the Hearing Officer's minute asks for the case to be suspended the application should be brought forward (BF) on the OPTICS diary. If a period of time has not been specified check with the Hearing Officer.
188. The Hearing Officer may state that agreement has been reached on how the mark may proceed. If so check to see if the TM2/3 has been amended. If "yes" continue as per paragraph 156 of this Manual. If not continue as per paragraph 153 of this Manual.
189. If the hearing minute requests issue of form R App 12 the application is to be refused. Form R App 12 should be sent to the agents/applicants, a copy placed on file and the minute sheet noted accordingly showing the date of issue. The form R App 12 should refer to the hearing in these circumstances and the reference to a "considered reply" should be deleted.

## **REFUSAL ACTION**

190. The decision to refuse a case can only be made by a Hearing Officer and form R.App 12 must be sent in all cases. This gives the applicant one month to appeal against the refusal.

When an R.App 12 is issued a copy must be kept on the file (signed and dated). The case should be given an OPTICS diary date of one month from the date on the R.App 12 (plus an additional month to allow for delays).

191. If the agent wishes to appeal against the decision he will submit form TM5 (statement of grounds of refusal). This is a fee paying form and it will normally be sent from the Cashiers to Law Section who will ask the Unit for the file.

If a TM5 is received in the Unit it should be linked to the file and forwarded to Law Section without delay.(AA)

192. If a TM5 has not been received during the period, continue as directed with steps

(a), (b), (c), (e), (f), (g), (j), (k)

in paragraph 112 (removal action). In addition:

record the refusal on OPTICS under "record death of application" giving the reason as "Refused"

note or stamp the minute sheet 'Refused', sign and date

stamp the file cover with the 'Refused' and 'Boxes' stamps.

## **PART 8 – POST ADVERTISEMENT ACTION**

193. Once applications have been made ready for advertisement, the OPTICS system automatically selects cases for inclusion in the next Proof Journal. This process takes place on Wednesday evenings.

### **PROOF JOURNAL**

194. Published copies of the Proof are distributed to HEOs and above. A detailed check of the marks to be advertised is carried out. The HEO should circulate their copy to the Examiners to look at those applications for which the Unit is responsible.
195. The SEO will arrange pre-proof meetings with the HEOs in his/her command to discuss errors and possible objections. Minor matters such as classification queries, wording of disclaimers, conditions, etc should be corrected immediately. The file should be obtained from Journal Section, corrected, with the approval of the agents where necessary, and returned to Journal Section by hand by 4.00 pm on the Monday following the Acceptance Committee meeting.
196. The SEO will ask Journal Section for any other files, dealt with by their Units, which they wish to inspect. They will then direct action accordingly or bring the file to the main Acceptance Committee for discussion.
197. The Acceptance Committee meetings are held on Thursday mornings. They are normally chaired by a Principal Hearing Officer (Grade 6) and are attended by the Grade 7s in charge of Examination and the Hearing Officers. Unit SEOs or their deputies will also attend. Hearing Officers will attend on a rota basis. The queries are discussed and the decision on whether to raise objections or request amendments rests with the senior officer who chaired the Acceptance Committee meeting.
198. Applications on which it is decided further action is necessary are handed to the SEO of the relevant Unit who should give exact instructions of the action to be taken in a minute to the Unit HEO.

The case is passed to the relevant Examiner for action as follows:

- (a) the Examiner should telephone the agent/applicant to advise them of the query. This should be done in the majority of cases even if it has been decided that the mark is not acceptable (i.e. an objection must be taken under Section 10). However, where a Section 10 objection is taken to which there is no apparent solution, the Examiner should inform the agent by letter. Where any objection cannot be resolved on the telephone the agent/applicant will have to be formally advised in writing. It is vital that, before a telephone call is made, the person making the call should understand clearly what the objection is and that they are confident in discussing it. If he/she is not clear, or has personal doubts about the proposed objection, he/she should feel free to consult with line management – up to the Chairman of the Acceptance Committee if necessary – before making the call. Although the Acceptance Committee can decide to raise an objection, it cannot in any circumstances decide to refuse an application or impose a disclaimer etc. without first giving the applicant an opportunity to respond in writing and/or attend a hearing. The Examiner should say that after reconsideration by the Acceptance Committee the Registry now takes the view that an objection arises. The Examiners may state that the late objection has been taken by the Acceptance Committee but should not distance themselves from it

- (b) there are many instances when the objection can be resolved by a slight amendment eg. to the specification. The most satisfactory solution is when the appropriate action to be taken can be agreed verbally. It is important though that a detailed minute of this conversation is made to avoid any misunderstandings or problems in the future
  - (c) if the agent/applicant does not agree with the proposed action, or requests written confirmation, then they should be advised formally in writing. It should be remembered that we should not apologize for the taking of the objection, but that we can apologise for the late stage at which the objection has been taken. We should state that after reconsideration the Registry now takes the view that objections arise. Suggestions to overcome the objections should always be made where possible
  - (d) if the objection cannot be resolved immediately, the file will have to be withdrawn from the Proof and Journal Section should be notified immediately. The shadow card must be obtained from the Journal Run. It should be noted to show the date and the name of the person dealing with the file and should be replaced in the main file store
  - (e) if the objection can be overcome a minute should be placed on the file under the heading "ACCEPTANCE STAGE QUERY" to explain what has happened. Any amendments necessary should be made in red ink on the Form TM2/3 with the note "proof query" and a reference to the date of the minute on the minute sheet. The file should be returned to Journal Section by hand by 4.00 pm on the Monday following the Acceptance Committee meeting. Details should be given on the minute sheet as to the action taken e.g. "Disclaimer entered", this should be signed and dated
  - (f) if there are any difficulties encountered in overcoming objections either at that time, or at a later stage, these should always be discussed with senior officers
  - (g) when acceptance stage has been cleared, Journal Section will stamp the file cover "ACCEPTED" (ie. for advertisement) and enter the number and date of the Journal
199. When the Journal is published the advertised files are taken by Journal Section by hand to the Post Advertisement File Store (PAFS) housed in Law Section.
200. After advertisement there is a four week period in which opposition may be filed against advertised applications. The advertised cases are therefore retained in the Post Advertisement File Store (PAFS) for approximately seven weeks to allow for delayed post.
201. Any letters received in the Unit relating to opposition or threatened opposition must be referred immediately to Law Section.

It is important therefore that files are not removed unnecessarily from PAFS during the opposition period and it is essential that all file movements are recorded. No files should be removed from PAFS without the file movement being recorded in the PAFS record book and the file signed for. As with Journal Section, files should not be requested by the Units by telephone but collected and returned by hand.

If no queries are received within the seven week period following advertisement the file is forwarded to Registration Section.

## **PART 9- MISCELLANEOUS**

### **USE OF PHOTOCOPYING MACHINES**

202. The following points should be noted about the use of photocopying machines.
- (a) the HEO in the relevant work area should appoint someone to be responsible for the photocopier. Their duties will include ensuring that the machine has enough paper and toner and making sure that the machine is in working order
  - (b) if the machine fails to work the person who is responsible for the machine should be contacted as they will be the only person authorised to call an engineer
  - (c) instructions on how to use the machine will be located close to it and staff should adhere to these instructions. Staff should ensure that the lid of the photocopier is left in the closed position to minimise the chance of damaging it
  - (d) staff should ensure that the photocopier is switched off at night, this is to avoid unauthorised use of the machine and to save electricity
  - (e) staff should be aware that for bulk photocopying of documents it is quicker and more economical to use the Reprographic Services located in Concept House.

### **TELEPHONE CALLS**

203. Much of the Registry's business, both internal and external, is conducted by telephone. It is imperative that a record is made of all telephone conversations on the minute sheet of the file. The following rules should also be followed on the use of the telephone to ensure that our customers receive a professional service.

#### **Answering the telephone**

- (a) answer the telephone promptly and speak clearly, saying "Trade Marks Registry" followed by your name
- (b) if you are unable to deal with the enquiry yourself you should offer to get someone else to return the call or transfer the caller to someone else who is able to give an answer
- (c) if you take a message for somebody you should write the details of the callers name, number, the details of the message and the time and date of the call. You should pass the message to the appropriate person
- (d) before offering to transfer a call you should make sure that you know how to do this. You should tell the caller to whom the call is being transferred to and ensure that they do get through to the right person. Make sure that you speak to the person to whom you are transferring the call, giving your name and Unit. Do not just put the telephone down when they answer
- (e) if the enquiry is concerning an application and you are unable to obtain the file immediately you should offer to return the call as soon as you have found the file. You should then make every effort

to locate the file and return the call, preferably within half an hour. If it becomes apparent that the file will take longer to find you should call back to give the person some idea of when you will be able to deal with their enquiry.

### **Making telephone calls**

- (a) when you are required to make a telephone call make sure you have all the information you will require during the call. Make sure you understand the purpose of the call. If you have been asked to make a telephone call by a senior officer and you do not understand what is required of you make sure you clarify this before you make the call, otherwise you will sound unprofessional
  - (b) when you get through to the person you want to speak to give your name and tell them you are from the Trade Marks Registry
  - (c) explain clearly and concisely the purpose of your call
  - (d) if the call is regarding an application full details of the call including any decision made by the applicant/agent should be recorded on the file
  - (e) staff should remember that it is cheaper to make calls after 1pm and also to utilise the GTN wherever possible
  - (f) staff should be as polite and helpful as possible on the telephone to both internal and external customers.
204. Details of the various facilities available on the telephone network, such as call forwarding and group pick-up are set out in the Patent Office internal telephone directory.

### **STATISTICS**

205. Statistics are completed on the first working day of the month and should relate to the previous calendar month. Guidance notes for the completion of the statistics form used in the Examination Units are shown at Annex 10.

### **STATIONERY**

206. Economy must always be kept in mind when ordering and using stationery. Previously used paper and obsolete forms should be used when possible for drafting and making notes.
207. There are sacks on each Unit for the collection of **WHITE** paper for recycling. These sacks are collected and replaced by the messengers. Staff should try to minimise the waste of paper wherever possible and paper should be recycled whenever possible.

Stationery should be ordered in the requisition book SS49 and must be signed by a Managing Examiner or HEO. Orders should not be placed more than fortnightly and should not cover more than 4 weeks supply. Any items no longer required should be returned to stationery section as soon as it becomes known that they are surplus.

## LIST OF ANNEXES

Annex 1	Transit Slip
Annex 2	Ready For Advertisement/Proceed Sheet
Annex 3	Voucher Form RF2
Annex 4	Official Complaints Procedure
Annex 5	Correspondence Re-routing Slip
Annex 6	Missing File Checklist
Annex 7	File Search Form
Annex 8	Most Frequently Used Journal Clauses
Annex 9	IC/IP Country Codes
Annex 10	Statistics - Guidance Notes

# TRANSIT SLIP

Name of Officer .....

Prefix	Number	Year
File Number .....	.....	.....

Initials	Surname
To whom sent .....	.....

Division .....

Date .....

Time .....

# REQUEST FOR FILE

PARTS 1, 2 AND 3 MUST BE COMPLETE

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## Part 1

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NO. \_\_\_\_\_

RE. \_\_\_\_\_

WANTED BY \_\_\_\_\_

ROOM NO \_\_\_\_\_

DATE \_\_\_\_\_

---

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FILE LOCATED ON \_\_\_\_\_

WITH \_\_\_\_\_

ROOM NO. \_\_\_\_\_

## **The Patent Office Complaints Procedure**

The Patent Office is committed to improving its standard of service

If things go wrong we need to know

If you wish to complain about the quality of service you have received from us and cannot resolve the problem with the person you have been dealing with in the Patent Office please write to

Paul Hartnack  
Chief Executive  
The Patent Office  
PO Box 49  
Cardiff Road  
Newport  
Gwent NP9 1YU

Your complaint will be acknowledged promptly and you will receive a reply within 10 working days

The Patent Office is committed to the principles of the Citizen's Charter

**CORRESPONDENCE RE-ROUTING SLIP**

This form is to be used whenever an item of correspondence is to be re-routed EITHER to the Post Handling Section, 12th Floor Chartist Tower, Newport (so that staff there can correctly re-route it) or direct to the person, Section or Unit to whom it should have been sent initially.

The correspondence attached was sent to me in error and reached me on ..... (date)

I am, therefore, sending it to you for \*action/re routing to its correct destination \*(delete whichever does not apply)

Signature..... Date.....

Name (Block Capitals).....

Official Address..... (Room) .....(Building)

Telephone..... (GTN) .....(Ext)

MISSING FILE CHECKLIST

APPLICATION NUMBER .....

CLASS .....

MARK .....

SHADOWCARD? YES/NO

If yes, last marking .....

OPTICS status DIS TMD .....

DIS HIS .....

DIS CAS .....

CHECK WITH AO

(Enter Name & Date) .....

CHECK WITH EO

(Enter Name & Date) .....

FILE STORES	RED 1, 2 & 3	BLACK 4 & 5	YELLOW 6, 7 & 8	WHITE 9 & 10
MAIN				
PRE EXAM				

VOUCHER TO BOXES

DATE SENT .....

DATE RETURNED .....

RESULT .....

(Destroyed, search failure etc.)

OTHER SECTIONS CHECKED (Date)

JOURNAL ROOM .....

ASSIGNMENTS .....

NEW REG .....

HEARINGS .....

NAFS .....

LAW SECTION .....

SEARCH COMPLETED BY ..... DATE .....

Further action requested by : MANAGING EXAMINER

Further action requested by : HEO

To:

All HEOs/SEOs and above

From.....

Unit.....

Room.....

Date.....

**URGENT FILE SEARCH**

The following application/s\* cannot be traced and is/are\* urgently required. Therefore, please will you arrange for your staff to carry out a desk or file run search, as appropriate, for the applications as listed below:

APPLICATION NO ..... CLASS NO.....

MARK OR DEVICE ..... OPTICS STATUS.....

LAST MARKING ON SHADOW CARD.....

APPLICATION NO ..... CLASS NO.....

MARK OR DEVICE ..... OPTICS STATUS.....

LAST MARKING ON SHADOW CARD.....

APPLICATION NO ..... CLASS NO.....

MARK OR DEVICE ..... OPTICS STATUS.....

LAST MARKING ON SHADOW CARD.....

**NOTE: File searches are to be authorised by HEO or above.**

**Authorised by.....**

If file/s\* is/are\* found please immediately contact:

.....on ext.....

If the search proves negative, please return this minute signed and dated below:

Search carried out but file/s\* not located

Name.....Unit.....Date

\* Delete as appropriate

Further copies can be obtained from the Stationery Store at Nine Mile Point

# MOST COMMONLY USED JOURNAL TEXTS

Annex 8

## Special Clauses

### Previous acceptance text

- a) Previously accepted on 4 November 1993 and advertised in Journal 6004, page 5401.
- b) Previously advertised in Journal 6004, page 5401. (Used on ABA cases).

[entered by Journal Section]

## Series

Application under Section 21(2) for a series of three marks.

[only numeral entered]

## Section 29 Clauses

- a) Proceeding under Section 29(1) (a).
- b) Proceeding under Section 29(1) (b).

[checked by exam units but generated by OPTICS]

## Advertised Before Acceptance

- a) Advertised before acceptance. Section 18(1) (proviso).
- b) Advertised before acceptance by reason of special circumstances. Section 18(1) (proviso).
- c) Advertised before acceptance by reason of use and special circumstances. Section 18(1) (proviso).
- d) Advertised before acceptance by reason of trade evidence. Section 18(1) (proviso).
- e) Advertised before acceptance by reason of trade evidence and special circumstances. Section 18(1) (proviso).
- f) Advertised before acceptance by reason of use and trade evidence. Section 18(1) (proviso).
- g) Advertised before acceptance by reason of use, trade evidence and special circumstances. Section 18 (1) (proviso).

## Section 12(2)

- a) Use claimed from the year 1993. Section 12(2).
- b) Use claimed from the year 1993 in respect of toys and games; and from the year 1992 in respect of decorations for Christmas trees. Section 12(2).

- c) Proceeding by reason of special circumstances. Section 12(2).
- d) Proceeding by reason of use and special circumstances. Section 12(2).
- e) Proceeding by reason of trade evidence. Section 12(2).
- f) Proceeding by reason of trade evidence and special circumstances. Section 12(2).

### **International Convention**

International priority date claimed under Section 39(A) of the Trade Marks Act 1938 (as amended). 27 September 1993 (Canada).

[generated by OPTICS. Exam units check date and country code]

### **Translation and Transliteration Clauses**

- a) The mark consists of a Spanish word meaning "Grapefruit".
- b) The mark consists of the German words meaning "Golden Grapefruit".
- c) The French words "Le Moulin Rouge" appearing in the mark mean "The Red Mill".
- d) The Italian word appearing in the mark means "Tent".
- e) The transliteration of the Arabic characters of which the mark consists is "Al-Asri" meaning "The Modern".
- f) The transliteration of the Chinese characters appearing in the mark is "Gen Ki" meaning "Energy".
- g) The transliteration of the Arabic characters of which the mark consists is "Jim-Jamma" which has no meaning.
- h) The transliteration of the Greek characters appearing in the mark is "Splankna" which has no meaning.
- i) The transliteration of the foreign character(s) appearing in the mark is "Bibi Bola Cha" which is the name of the applicant company.

### **Colour Limitations**

- a) The mark is limited to the colours red, green and yellow as shown in the representation on the form of application.
- b) The mark, other than the word "Dog" appearing therein, is limited to the colours blue and red as shown in the representation on the form of application.
- c) The mark, here depicted in heraldic shading, is limited to the colour orange as shown in the representation on the form of application.
- d) The mark, here depicted in heraldic shading, is shown in the representation on the form of application in the colours blue and yellow but the mark is not limited to colour.

- e) The third mark in the series is limited to the colours blue and green as shown in the representation on the form of application.
- f) The second and fifth marks in the series are limited to the colours green, blue and red and green, red and yellow as shown in the representation on the form of application.
- g) The mark is shown in the representation on the form of application in the colours orange and silver but the mark is not limited to colour.

### Disclaimers

- a) Registration of this mark (these marks) shall give no right to the exclusive use of
  - i) a letter "Z"/a letter "z". [as appropriate]
  - ii) the letter "Q"/the letter "q". [as appropriate]
  - iii) letters "PF"/letters "pf". [as appropriate]
  - iv) the letters "SWX"/letters "swx". [as appropriate]
  - v) a device of an aardvark.
  - vi) the device of a spanner.
  - vii) the devices of fruit.
  - viii) devices of clocks.
  - ix) the words "Every One A Winner".
  - x) the words "Mince" and "Custard".
- b) Registration of this mark (these marks) shall give no right to the exclusive use, separately, of the words "Football" and "Chess".
- c) Registration of this mark (these marks) shall give no right to the exclusive use of the device of a lemur and separately of the words "Gold" and "Ring".
- d) Registration of this mark shall give no right to the exclusive use of the/a device of a bottle/container.
- e) Registration of this mark shall give no right to the exclusive use of a bottle/container coloured (for example) blue, green and red.

### Conditions

Blank space(s) (see also Castrol).

It is a condition of registration that the blank space(s) in the mark shall, when the mark is in use, be occupied only by matter of a wholly descriptive and non-trade or service mark character [underlined text to be entered as appropriate]

## **Box Condition**

Registration of this mark shall not prevent any person using a box coloured green or from describing such a box as a green box.

## **British Standards**

It is a condition of registration that the mark shall be used in relation only to goods which conform to British Standards Institution Safety Standards BS6969 and BS6970.

The following examples show the form of words to be used, where a condition can be agreed to:

- 1) "It is a condition of registration that the mark shall be used in relation only to goods that conform with British Standards Institution Safety Standards for face shields, spectacles, goggles, welding helmets, welding helmets, welding shields - BS679 or BS2092, filter masks and respirators - BS2091, airhoods, sandblasting hoods and ventilating suits - BS4667, firesuits - BS1547, ear muffs and ear plugs - BS5108, caps - BS5240, work clothing - BS2563 and 4679, shoes and boots - BS953 and 1870, gloves - BS697 and 1651, belts - BS1397, catchnets - BS3913, devices for the prevention of falling - BS5062, electrode holders BS638, or any standard or regulation which may replace those standards and that the applicable safety standard or safety regulation shall be indicated to the public in conjunction with the mark."

## **Buildings (pictorial representations or names of)**

### **For Example:**

The building represented in the mark is the property of the applicant. [or as the case may be]

## **Castrol-type condition. (See also Blank space(s).)**

### **a) For Trade Mark applications:**

It is a condition of registration that the blank space(s) in the mark shall, when the mark is in use in relation to the goods of the present application, either be left vacant or be occupied only by matter of a wholly descriptive and non trade mark character or be occupied only by one or more associated marks registered in respect of goods included in the specification of the present application with or without the addition of matter of a wholly descriptive and non trade mark character.

### **b) For Service Mark applications:**

It is a condition of registration that the blank space(s) in the mark shall, when the mark is in use in relation to the services of the present application, either be left vacant or be occupied only by matter of a wholly descriptive and non service mark character or be occupied only by one or more associated marks registered in respect of services included in the specification of the present application with or without the addition of matter of a wholly descriptive and non service mark character.

Note. When imposing a Castrol blank space condition all marks to be used in the blank space should be associated under Section 17(2).

## **Cigarettes (see Low Tar Cigarettes)**

### **Crescent/Moon**

It is a condition of registration that the mark shall not be used with the Crescent Moon device in red or in any similar colour.

### **Crosses**

- a) It is a condition of registration that the mark shall not be used with the cross device appearing thereon in red, or in white, or in silver on a red ground, or with the cross device or ground in, or of, any similar respective colour or colours.
- b) It is a condition of registration that the cross device appearing in the mark shall not be used in red or any similar colour.

### **Geographical Origins**

- a) It is a condition of registration that the mark shall be used in relation only to goods the produce of Ireland. [normally relates to foodstuffs, wines etc].
- b) It is a condition of registration that the mark shall be used in relation only to goods manufactured in Spain. [normally relates to manufactured goods].

### **Label**

Registration of this mark shall not prevent any person using a label coloured black or from describing such a label as a black label.

### **Low Tar Cigarettes**

It is a condition of registration that the mark shall be used in relation only to cigarettes yielding not more than 10 milligrammes of tar per cigarette.

### **Natural Springs**

It is a condition of registration that, in the event of the proprietors of this mark ceasing to have the exclusive rights to sell natural mineral water the produce of Evian, they will voluntarily cancel this registration.

### **Partnerships**

- a) It is a condition of registration that neither (no one) of the applicants shall use the mark except on behalf of both (all) of them.
- b) It is a condition of registration that the mark shall be used in relation only to goods (services) with which both (all) of the applicants are connected in the course of trade (business).

- c) It is a condition of registration that neither (no one) of the applicants shall use the mark except a) on behalf of both (all) of them, or b) in relation to goods (services) with which both (all) of them are connected in the course of trade (business).

### **Portrait**

- a) The portrait appearing in the mark is that of Sir Gerald Nabarro.
- b) The mark consists of a portrait of Bishop Abel Muzorewa.
- c) The portrait appearing in the mark is part of an original painting of which the applicants own the copyright.

### **Red Crescents (See Crescent Moon)**

### **Red Cross (See Cross)**

### **Royal Warrant**

It is a condition of registration that if, at any time, the applicants or their successors in title cease to hold the Royal Warrant they or their successors in title will make application forthwith to cancel the registration of this trade mark.

### **Safe (See British Standards)**

### **Scotch Whisky**

It is a condition of registration that the mark shall, when in use in relation to whisky or whisky-base liqueurs, be used in relation only to Scotch Whisky or Scotch Whisky based liqueurs.

### **Shamrock**

It is a condition of registration that the mark shall be used in relation only to goods which are the produce of Ireland. [normally relates to foodstuffs, wines etc].

It is a condition of registration that the mark shall be used in relation only to goods which are manufactured in Ireland. [normally relates to manufactured goods].

### **Thistle**

It is a condition of registration that the mark shall be used in relation only to goods which are the produce of Scotland. [normally relates to foodstuffs, wines etc].

It is a condition of registration that the mark shall be used in relation only to goods which are manufactured in Scotland. [normally relates to manufactured goods].

### **Variation Clause**

In the term "brown ale", "ale" is the name of the goods and "brown" is the description.

- a) In use in relation to goods covered by the specification other than brown ale the mark will be varied by the substitution of the name and description of such goods for the words "brown ale".

When the variation clause applies only to the name of the goods or only to the description then the clause should be adapted accordingly, ie varied by the substitution of the name of such goods eg lager or varied by the substitution of the description of such goods eg light.

- b) In use in relation to ale other than brown ale the mark will be varied by the substitution of the description of such ale for the word "brown".

### **Varietal**

- a) It is a condition of registration that the mark shall not be used as a varietal name or as part of a varietal name.
- b) It is a condition of registration that the word(s) appearing in the mark shall not be used as a varietal name or as part of a varietal name.

### **Whisky (See Scotch Whisky)**

#### **Association**

- a) To be associated with no. 1234567 (5682,1).
- b) To be associated with no. 1234568 (5821,27) and another.
- c) To be associated with no. B1234569 (5991,123) and others.

#### **Consent**

By Consent No. 1234567 (5682,1).

By Consent Nos. 1234567 (5682,1) and B1234569 (5991,123).

### **Hunter Douglas/Lucky Goldstar Condition**

For example:

It is a condition of registration that should this mark be transferred outside the Hunter Douglas Group of Companies this registration will be cancelled.

AF	- Afghanistan	GM	- Gambia
AL	- Albania	GH	- Ghana
DZ	- Algeria	GI	- Gibraltar
AO	- Angola	GB	- Great Britain
AI	- Anguilla	GR	- Greece
AG	- Antigua and Barbuda	GD	- Grenada
AR	- Argentina	GT	- Guatemala
AU	- Australia	GN	- Guinea
AT	- Austria	GW	- Guinea-Bissau
AD	- Andorra	GY	- Guyana
BS	- Bahamas	XG	- Guernsey
BH	- Bahrain	HA	- Haiti
BD	- Bangladesh	VA	- Holy See
BB	- Barbados	HN	- Honduras
BY	- Belarus	HK	- Hong Kong
BE	- Belgium	HU	- Hungary
BZ	- Belize	IS	- Iceland
BX	- Benelux	IN	- India
BJ	- Benin	ID	- Indonesia
BM	- Bermuda	IR	- Islamic Republic of Iran
BT	- Bhutan	IQ	- Iraq
BO	- Bolivia	IE	- Republic of Ireland
BW	- Botswana	XD	- Isle of Man
BR	- Brazil	IL	- Israel
VG	- British Virgin Islands	IT	- Italy
BN	- Brunei	XJ	- Jersey
BG	- Bulgaria	JM	- Jamaica
BF	- Burkina Faso	JP	- Japan
BU	- Burma	JO	- Jordan
BI	- Burundi	KH	- Cambodia
CM	- Cameroon	KE	- Kenya
CA	- Canada	KI	- Kiribati
CV	- Cape Verde	KP	- Democratic Peoples Rep. of Korea
KY	- Cayman Islands	KR	- Rep. of Korea
CF	- Central African Republic	KW	- Kuwait
TD	- Chad	LA	- Laos
CL	- Chile	LB	- Lebanon
CN	- Peoples Republic of China	LS	- Lesotho
CO	- Columbia	LV	- Latvia
KM	- Comoros	LT	- Lithuania
CG	- Congo	LR	- Liberia
XC	- Cook Islands	LY	- Libya
CR	- Costa Rica	LI	- Liechtenstein
CI	- Cote d'Ivoire	LU	- Luxembourg
CU	- Cuba	MG	- Madagascar
CY	- Cyprus	MW	- Malawi
CZ	- Czech Republic	MY	- Malaysia
DK	- Denmark	MV	- Maldives
DJ	- Djibouti	ML	- Mali
DM	- Dominica	MT	- Malta
DO	- Dominican Republic	MR	- Mauritania
EC	- Ecuador	MU	- Mauritius
EG	- Egypt	MX	- Mexico
SV	- El Salvador	MC	- Monaco
EE	- Estonia	MN	- Mongolia
GQ	- Equatorial Guinea	MS	- Monserrat
ET	- Ethiopia	MA	- Morocco
FK	- Falkland Islands	MZ	- Mozambique
DE	- Federal Republic of Germany	NR	- Nauru
FJ	- Fiji		
FI	- Finland		
FR	- France		
GA	- Gabon		

NF - Nepal  
AN - Netherlands Antilles  
NZ - New Zealand  
NI - Nicaragua  
NE - Niger  
NG - Nigeria  
NO - Norway  
NL - Netherlands  
OM - Oman  
PK - Pakistan  
PA - Panama  
PG - Papua New Guinea  
PY - Paraguay  
PE - Peru  
PH - Philippines  
PL - Poland  
PT - Portugal  
PR - Puerto Rico  
QA - Qatar  
RO - Romania  
RW - Rwanda  
RU - Russian Federation  
SH - Saint Helena  
LC - Saint Lucia  
VC - Saint Vincent and the Grenadines  
WS - Samoa  
SM - San Marino  
ST - Sao Tome and Principe  
SA - Saudi Arabia  
SN - Senegal  
SC - Seychelles  
SL - Sierra Leone  
SG - Singapore  
SK - Slovakia  
SI - Slovenia  
SB - Solomon Islands  
SO - Somalia  
ZA - South Africa  
ES - Spain  
LK - Sri Lanka  
SD - Sudan  
SR - Suriname  
KN - St Kitts and Nevis  
SZ - Swaziland  
SE - Sweden  
CH - Switzerland  
SY - Syria  
XS - Society Islands  
TW - Taiwan, Republic of China  
TH - Thailand  
TG - Togo  
TO - Tonga  
TT - Trinidad and Tobago  
TN - Tunisia  
TR - Turkey  
XT - Turks and Caicos Islands  
TV - Tuvalu  
UG - Uganda  
UA - Ukraine  
AE - United Arab Emirates  
TZ - United Republic of Tanzania  
US - United States of America  
UY - Uruguay

VU - Vanuatu  
VE - Venezuela  
VN - Vietnam  
WI - West Indies  
YE - Yemen  
YU - Yugoslavia  
ZR - Zaire  
ZM - Zambia  
ZW - Zimbabwe

# GUIDANCE NOTES FOR COMPLETING MONTHLY STATISTICS RETURN

Annex 10

The statistics should be completed on the first working day of the month and should relate to the previous calendar month.

1. Pre-exam

Number of new application received.

Also include any applications that have been received after a transfer (eg change of Class) prior to examination.

Post-exam

Enter the number of applications that have been received after examination ie transferred from another unit.

Also include the number of applications that have been restored to record.

2. Number of applications transferred to another unit (pre-exam and post-exam).

3. Pre-exam

Physical count of applications in the pre-exam store.

Part-exam

Total number of part-examined cases

Pre-exam (notional)

The figure for pre-exam (notional) is calculated as follows:-

Last month's pre-exam figure

Applications added to pre-exam store (box 1) **MINUS**

Total number of applications examined (box 6) **MINUS**

Applications refused/removed/withdrawn from pre-exam store (box 7) **MINUS**

Applications transferred from pre-exam store (box 2) **PLUS**

Applications restored to record before examination

4. Post-exam (notional)

The figure for post-exam (notional) is calculated as follows:-

Last month's post exam figure **PLUS**

Number of cases examined (box 6) **MINUS**

Applications refused/withdrawn/removed from post-exam store (box 7) **PLUS**

Applications added to post-exam filestore (box 1) **MINUS**

Applications transferred from post-exam filestore (box 2) **MINUS**

Applications registered (box 8) **PLUS**

5. Enter application dated for IC/non IC cases that are to be examined next.
6. An application should be counted as 'examined' when the OPTICS status has been changed from pending to examined.

This should be done when the exam report has been sent for typing or to the Unit HEO/SEO.

Do not count a transferred application eg change of Class, as another 'examined' case if the OPTICS status has already been changed to examined.

7. Sent for advert - these should be recorded when the application has left the Unit and has been sent to Journal Section.
8. An application should be counted as **registered** when the shadow card is removed from the Journal store.

This figure should relate to applications registered (Chapter 18-37 paragraphs 2 and 3 refer).

The number of the last Journal checked should be entered.

9. Actual days worked:

Do not include annual/sick/special leave, bank holidays or days spent on training courses.

Do include flexi leave as days worked.

10. Unit Examinations - total from box 6.
11. Unit Completions - total from box 7.
12. Final Completed Cases - this figure is the total of:

Cases Registered (box 8) **PLUS**

Cases refused/withdrawn/removed from pre-exam and post-exam filestores (box 7).

**NB Do not use TOTAL figure from box 7 as this includes cases sent for advert.**

13. Enter the total number of gross hours worked eg if an EO works 7 actual hours overtime it is equivalent to 14 hours gross.

Saturday working

AA/AO/EO - Double time

HEO/SEO - Time and a half

Sunday working

All grades - Double time

BACK PAGE

List the batch numbers for the applications received from Data Capture.

NOTES

When OPTICS has an incorrect status (eg pending) and a file is requested from boxes and the status is updated, do not count as a completion unless the case has not been counted previously.

Transfer of applications

When an application transfers from a unit (eg a change of Class) the shadow card should be used ie a white shadow card should not be used as a duplicate. This is to avoid double-counting during audits.

**CENTRAL UNIT  
MAY 1992**

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