



# **Trade Marks Registry**

## **WORK MANUAL**

### **CHAPTER 27 - REGISTRATION OF USERS**

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 Registrars discretion, where appropriate.

## CHAPTER 27

### REGISTRATION OF USERS

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27-1 Since the prime purpose of a trade mark or service mark is to indicate the origin of goods or services, a registered proprietor who allows others to use his mark without satisfactory control runs the risk that it will lose its validity and be open to attack by a third party. To obviate this possibility, Section 28 provides for the registration of users if the Registrar is satisfied about the conditions of control. Although Section 28 does not lay down any specific conditions for the registration of a user, sub-section 5 makes it clear that the chief consideration is the public interest and that the Registrar has a discretion to refuse to register a user if he is not satisfied as to the means of control to be employed. This requirement follows from the probability that uncontrolled licensing of a mark would lead to goods or services of varying standards of quality reaching the public under the same mark, with consequent deception of or confusion to the public.

27-2 A further important consideration laid down in Section 28(6) is that an application to register a user is not acceptable if it appears likely to facilitate trafficking in the mark, ie if there is any indication that the registered proprietor is only concerned to make money out of the use of his mark by others without regard for such considerations as the continuing supervision of the quality of the goods sold under the mark. An example of one particular aspect of trafficking, character merchandising, is the Holly Hobbie case (1984 RPC 329) which resulted in the House of Lords upholding successive decisions of the Assistant Registrar, High Court and Court of Appeal. The House of Lords defined character merchandising as the exploitation of a well-known invented name, where the author or promoter of the name licenses or purports to license its use on goods of traders who have no other connection with the licensor. In practice the owner of a character or name legitimately registers it as a mark in respect of goods or services in which the owner has a genuine interest. The character as such becomes popular with the public and the owner seeks to profit from his good fortune or acumen, by licensing the character or name for use as a mark in areas with which he has no real connection. There is nothing reprehensible about this licensing, but it is not protectable by virtue of a trade mark or service mark registration because in offering to license their mark to others willing to pay a licensing fee they are trafficking, and thus offend against Section 28(6). Trafficking may also arise if for example a famous mark is licensed for goods which are quite unrelated to those for which it gained its reputation, eg Rolls Royce for wrist watches.

27-3 Section 28 is permissive. It seems fairly clear in practice that a registered proprietor who allows another person to use his mark under satisfactory conditions of control will not place his mark in jeopardy even though he does not register the user. It was observed in the BOSTITCH case (1963 RPC 183) that nothing in Section 28 indicated that an arrangement between the registered proprietor of a trade mark and a user of it needed to be registered and failure to register such an arrangement would not, of itself, impair the validity of the mark. However, one advantage of registration of a user lies in the fact that registration is prima facie evidence that the Registrar has examined the arrangements between the parties and has satisfied himself that the control is adequate. Also, use by a registered user can help the proprietor withstand, for example, any attack made under Section 26.

27-4 It is important to bear in mind that the sale of goods or provision of services under a trade mark or service mark by agents, wholesalers or retailers is not, in any sense, a "use" of the mark by such persons. In the ordinary course of distribution to the public or to commercial customers it is normal for goods to be handled by various intermediaries; and Section 4(3)(a) of the Act states clearly that such handling does not infringe trade or service mark rights. In spite of this, applications to register distributors as "users" are received from proprietors who are over-anxious about protecting their marks. There may be a tendency to accept such an application on the ground that no harm will be done and the proprietor will be saved from his anxiety; but the tendency should be resisted since the registration as a 'user' of a mere distributor would imply that any proprietor who sold goods or provided services bearing his mark through another party would be placing his mark in jeopardy.

27-5 In most registered user cases, the proprietor is a manufacturer of goods or supplier of services who has agreed to allow another to use his mark. However, Section 68 clearly goes much wider than manufacturing and selling but without indicating the limits; and cases sometimes arise in which it is not easy to be certain that the contemplated activity is, in fact, a registrable use. In such cases further investigation is necessary.

[27-6 to 27-29]

27-30 Although there are no specific conditions about the degree of control by the registered proprietor required for the registration of a user set out in the Act it is usually found in practice that the arrangements between the registered proprietor and the proposed user fall into one (or more) of the following categories:-

(a) contractual (see paragraphs 27-32 to 27-47) - in which both parties have subscribed to an agreement that lays down their relationship and the conditions under which the proposed use of the mark is to be effected;

(b) financial control (see paragraphs 27-59 to 27-60) - in which the financial connection between the two parties is such as to ensure that there can be no divergence of aims between them. The obvious example is straightforward ownership of the user by the proprietor (or vice versa) but there are many other possibilities

In addition to contractual and financial control the user and proprietor may be connected through a licence held under a patent covering the goods (see paragraphs 27-61 to 27-63). Such a link may, depending on the terms of the licence agreement, provide evidence of adequate quality control.

27-31 Although each type of arrangement is satisfactory by itself, the parties sometimes decide that they want to use more than one, as, for example, where a contract is drawn up in addition to a satisfactory financial control. There is no objection to such "belt and braces" arrangements from the Registrar's point of view as long as the conditions or restrictions which are placed on the register sheet reflect all the arrangements.

#### Contractual Arrangements

27-32 In cases where the parties rely on a contractual arrangement, ie have executed an agreement setting out the conditions under which the proposed user is to use the mark, a sworn copy of the document in question must be submitted for inspection with the registered user application as an exhibit to the statutory declaration.

27-33 The two main provisions to be looked for in a registered user agreement are :-

27-33 (Contd)

(a) a right given by the registered proprietor to the permitted user to use the mark in accordance with the terms of an entry under Section 28 and an undertaking given by the permitted user to use the mark in relation only to goods or services provided in accordance with specifications prescribed, standards of quality laid down, and directions and information given by the registered proprietor from time to time. It is not essential that such goods or services should be made or provided by the permitted user; they may be made or provided for him by others, so long as they conform to the proprietor's requirements:

(b) a right and permission given to the registered proprietor to inspect the goods and the arrangements for the provision of the services and the methods of manufacturing or providing them, on the premises of the permitted user or the premises from which the service is supplied or originates or to have samples of goods (or items supplied or equipment used in the provision of the service) submitted to him on request. This is to ensure that the registered proprietor is able to carry out continuing supervision of the use of his mark. If the goods are to be made or the services provided by a party other than the permitted user the registered proprietor should have the right of inspection before distribution and sale, on the premises of the permitted user.

27-34 Apart from these fundamental provisions, an agreement may also include a limitation as to the period during which the registered user is to be permitted to use the mark (any such limitation must state a specific date on which the period is to end, and should not be contingent upon some other event) and may limit or define the territory in which the use by the registered user is to be permitted. Limitations of this kind are matters for arrangement between the parties, and are of importance to the extent that they have to be noted as conditions or restrictions to be entered in the register. They are to be distinguished from the provisions of termination of an agreement referred to in paragraph 27-35 below. Where a period of permitted use is not specified, it may, subject to the wording used, be assumed that there is no limit of period.

27-35 Some agreements include provision for terminating the permitted use if the proprietor is not satisfied that his mark is being used in relation to goods or services of the right quality, etc, but the Registrar does not insist on such a provision being present. Other agreements may recite the terms of the financial arrangements between the parties, but as those arrangements are seldom relevant to the question of control of the use of the mark, they are seldom of concern to the Registrar. What the Registrar is concerned with is to ensure that the two fundamental points mentioned in paragraph 27-33 are covered and to note any additional conditions or restrictions which may be contained in the agreement. Where the agreement filed with the Registrar makes reference to any other written agreement a copy of the latter should be requested so that it can be checked to ensure that it does not contain any additional provisions which negate the Registrar's requirements.

27-36 The conditions or restrictions governing the use of the mark concerned by the registered user, as embodied in his agreement with the registered proprietor, are required to be entered in the register. Examples of the statements of such conditions, etc, which have been adopted in the past in relation to trade marks, showing what is entered in the register and also indicating the various forms of conditions or restrictions which may be embodied in registered user agreements are as follows:

(a) "The trade mark is to be used by the registered user (who is to be the sole registered user while he remains so registered) in relation to the goods only so long as they are manufactured in accordance with standards of quality laid down by the registered proprietor and only so long as the registered proprietor or his authorised representative has the right and is permitted to inspect the goods and the methods of manufacturing them on the premises of the registered user and is supplied with samples of the goods on request." (If it is appropriate, the reference to "sole" registered user should be inserted at the same point in any other variant of conditions or restrictions).

(b) "The trade mark is to be used by the registered user in relation to the goods only so long as they are manufactured by him in accordance with specifications laid down, directions given and information supplied by the registered proprietor from time to time and only so long as the

27-36 (Contd)

registered proprietor or his authorised representative has the right and is permitted to inspect the goods and the methods of manufacturing them on the premises of the registered user and is supplied with samples of the goods on request."

(c) "The trade mark is to be used by the registered user in relation to the goods (a) only so long as they have been prepared in special vehicles supplied by the registered proprietor with equipment and using ice cream mix and ancillary supplies supplied or approved by the registered proprietor and in accordance with recipes, formulae and instructions given by the registered proprietor from time to time and only so long as the registered proprietor or his authorised representative is permitted to enter for inspection of vehicles from which the goods are sold and has the right to take samples of the goods and (b) only so long as the goods are sold in the territory comprised within a line drawn from and including Northallerton, Kirby, Sigston ....."

(d) "The trade mark is to be used by the registered user in relation to the goods only so long as they have been prepared by him from ingredients and in accordance with recipes, formulae and instructions supplied by the registered proprietor from time to time and only so long as the registered proprietor has the right and is permitted to inspect the method of preparation, storage and sale of the goods on the premises of the registered user, which premises shall have been approved by the registered proprietor, and is supplied with samples of the goods on request."

27-37 These are, of course, only examples and there are many other possible conditions that would be acceptable. It is not possible to produce "standard" wording which will suit every circumstance, the main criteria should be that conditions should ensure that the proprietor is capable of exercising control over the use of his mark. No attempt should be made to "force" the provisions of an agreement into the constraints of a "usual" form of wording when to do so would alter the meaning or sense of those provisions. There is in fact no such thing as a "usual" provision, each agreement probably will differ albeit slightly, because it will reflect the circumstances of the case.

27-38 A special type of contractual case is that in which the registered proprietor wishes to appoint a registered user for goods supplied by the registered proprietor but which are not ready for resale by the registered user until some further action affecting the goods is taken by the user. In most such cases, the goods are supplied by the proprietor in bulk (eg sugar, chemicals, wines) and are put up for sale by the user in bottles or packs in accordance with the directions of the proprietor. In these cases, it is accepted that the user could have an adverse effect on the goods (and, therefore, the mark) if his handling of the goods was not satisfactory in all respects and that the proprietor is entitled to the protection afforded by the registration of the user. The mere breaking down of goods supplied in bulk would not, by itself justify a registered user registration.

27-39 The following is an example of the conditions or restrictions that could be used in a case of the kind referred to in paragraph 27-38:-

"The trade mark is to be used by the registered user in relation to the goods only so long as they are sold by him and packed by him in materials approved, in accordance with directions from time to time given and from bulk supplies furnished, by the registered proprietor, and only so long as the registered proprietor has the right and is permitted to inspect the goods and the methods of packing them on the premises of the registered user."

27-40 If a territorial limitation is laid down in the agreement this must be reflected in the conditions or restrictions. Most of these cases are either

(a) defining a small area within the United Kingdom, or

(b) limiting the use to the United Kingdom (or part of it), with or without specified overseas territories.

27-41 The usual method of dealing with territorial limitations is to spell them out at the end of the conditions or restrictions on the lines of the following examples:-

(a) ".....and only so long as the goods are for sale in ..... [simple or detailed description of

27-41 (Contd)

area inside the United Kingdom] or [the United Kingdom]"

(b) ".....and only so long as the goods are for sale in the United Kingdom and for export to and sale in [named overseas territories]."

27-42 It is not permissible to accept general descriptions such as "British Commonwealth", "Latin America", "Eastern Europe" or even "EEC" since third parties are entitled to know exactly the area covered and these descriptions are either vague or subject to change.

27-43 Another type of limitation of area is that in which the proprietor wishes to register the user for use only in specified countries and not for export from the United Kingdom. The Act does not cover such use but, if the registration is required only as a preliminary to registration of the user in the overseas countries specified, the Registrar is prepared to turn a blind eye to it. This is a practice of many years standing. (See paragraph 27-209).

27-44 These deliberate limitations of the area in which the use of the mark is to be permitted must be carefully distinguished from cases in which the trade or service mark specification itself is limited, eg "Toilet preparations, all for sale in England and Wales" or "Dry cleaning services in the county of Essex". Whatever the reason for such a restriction in the mark's specification, it must be carried into the description of the goods or services of permitted use and not incorporated into the conditions or restrictions.

27-45 Registered user agreements frequently cover many points that are irrelevant from the point of view of registration but this does not matter so long as the Registrar's requirements are adequately covered. However, all agreements must be scrutinised in detail in case they contain matter at variance with the Act. For example, Section 28(12) lays down that a registered user of a mark does not have any assignable or transmissible right, and if an agreement purports to grant a transferable right it is not acceptable for the Registrar's purposes since acceptance would imply approval. Paragraphs 27-184 to 27-189 of this Chapter deals with the effect on registered users of assignment of marks.

27-46 The following is an example of a simple agreement (relating to goods but which suitably adapted could be used for services) that covers the Registrar's requirements without any extraneous material:-

"An Agreement made the \_\_\_\_\_ day of 19 \_\_\_\_\_ between [name of the registered proprietor] (hereinafter called "the proprietor") of the one part and [name of the proposed user] (hereinafter called "the user") of the other part.

Whereas the proprietor is the registered proprietor of the trade mark no ....., registered in class ..... in respect of [specification] and whereas the user is desirous of manufacturing [either (a) all the goods of the trade mark specification, or (b) named goods within that specification] and of using the said trade mark in relation thereto and of being registered as a registered user of the trade mark under the provisions of Section 28 of the Trade Marks Act, 1938.

Now it is hereby agreed as follows:-

(1) The proprietor hereby authorises the user, during such time as the user shall be registered as a registered user of the trade mark, to use the trade mark upon or in relation to goods manufactured by the user in accordance with specifications laid down, directions given, and information supplied by the proprietor from time to time and will join with the user in making application to the Registrar of trade marks for the purpose of securing the registration of the user as a registered user of the trade mark under the provisions of the Trade Marks Act, 1938, and this agreement shall not come into effect until the user shall have been so registered.

(2) The user undertakes to manufacture the goods in strict accordance with specifications laid down, directions given, and information supplied by the proprietor from time to time and to use the trade mark in relation only to such goods and will permit the proprietor or his authorised representative at all reasonable times to enter the user's premises for the purpose of inspecting the goods and the

27-46 (Contd)

methods of manufacturing them and will, if called upon by the proprietor to do so submit samples of the goods for the inspection of the proprietor.

(3) This agreement shall continue in force from year to year unless determined by either of the parties giving six months' notice in writing to the other party, but in the event of either party committing a breach of any of the provisions of this agreement it shall be lawful for the other party by giving one months' notice in writing to terminate the agreement and upon such notice being given the user will not thereafter make any use of the trade mark.

In Witness whereof ....."

27-47 Oral agreements are not regarded as a satisfactory basis for registered user applications because, in the absence of proof of the existence of terms, parties, consideration and date of any agreement, the Registrar is unable to conclude that the degree of control to be exercised by the proprietor will be sufficient to safeguard the public interest.

[27-48 to 27-58]

Financial Control

27-59 This is a general description covering all the various forms of financial connection between the parties that are considered by the Registrar to meet the requirement to provide a satisfactory degree of control. Section 28(4)(a) of the Act speaks of "... the degree of control by the proprietor over the permitted use ..." but, in practice it is accepted that other forms of control can be as satisfactory as direct control by the proprietor. The forms of control range from complete ownership of the proposed user by the registered proprietor to cases in which the proprietor owns enough of the capital of the user to enable him to appoint or elect a majority of the directors to the board of the user. Each possible case is just as satisfactory for our purposes if the positions are reversed, ie with the user in control of the registered proprietor. In cases made under Section 29(1)(b) it may be that registration of a user is not necessarily required where control is financial as it would be possible for the trade mark or service mark application to proceed under Section 17 of the Act, however it is not now normal practice to object to such registered user applications (Radiation TM(1930)47 RPC 37).

27-60 In other cases where the control is less direct but still effective, eg when both parties are owned or controlled by a third party or when the proprietor (or user) owns or controls another company which in turn owns or controls the user (or proprietor). There are many possibilities and new ones may arise in future but the criterion will always remain the same, ie the Registrar must be satisfied that the proprietor or the user or some third party is able to ensure that the use of the mark by both the proprietor and the user will be in conformity and that there will be no divergence between them. The following are examples of conditions or restrictions that are suitable in financial control cases:-

- (i) "The mark is to be used by the registered user (who is to be the sole registered user while he remains so registered) in relation to the goods/services only so long as the registered user remains controlled by the registered proprietor." (If it is appropriate, the reference to "sole" registered user should be inserted at the same point in any other variant of conditions and restrictions).

27-60 (Contd)

(ii) "The mark is to be used by the registered user in relation to the goods/services only so long as the registered proprietor owns sufficient share capital of the registered user to enable the registered proprietor to elect or appoint a majority of the directors of the registered user."

(iii) "The mark is to be used by the registered user in relation to the goods/services only so long as both the registered proprietor and the registered user are controlled by ....."

(iv) "The mark is to be used by the registered user in relation to the goods/services only so long as the registered user is controlled either directly or indirectly by the registered proprietor."

(v) "The mark is to be used by the registered user in relation to the goods/services only so long as the registered user is controlled by [named company] and only so long as [same named company] is controlled by the registered proprietor."

(vi) "The mark is to be used by the registered user in relation to the goods/services only so long as the registered user is/or remains a wholly owned subsidiary company of the registered proprietor."

(vii) "The mark is to be used by the registered user in relation to the goods/services only so long as the registered user remains a subsidiary company, as defined in Section 736 of the Companies Act 1985, of the registered proprietor."

The expression "subsidiary company" should not be used alone since it is both vague in itself and used loosely by many people.

Patentee/Licensee Relationships.

27-61 If the registered proprietor of a mark is also the registered proprietor of a British patent covering goods of the mark specification, and the proposed registered user is a licensee under the patent, this relationship is held to justify a registered user entry in respect of goods made under and protected by the patent.

REGISTRATION OF USERS -  
CONDITIONS OF CONTROL BY PROPRIETOR

27-62-27-63

27-62 The same conditions of control by the proprietor over the registered user exist as described in previous paragraphs 27-32 to 27-60 and may be financial, contractual or both.

27-63 In those cases where the parties rely on a contractual arrangement, the agreement may state that a registered user can make goods or supply services in accordance with a patent - and apply the registered proprietor's mark to those goods or services under the proprietor's control until the expiry date of the patent (see, for example R U 51576) or the agreement may state that the registered user can make the goods or supply services until some date long after the relevant patent has expired. The choice is entirely a matter of agreement between the registered proprietor and the registered user.

REGISTRATION OF USERS -  
TRAFFICKING IN TRADE MARKS

27-64 to 27-67

27-64 Trafficking in a mark may not be self evident from an individual application for registration but the following are indications which may lead to an objection:

- (a) The application is made within the provisions of Section 29(1)(b) and
- (b) The application is made by a film company or TV company outside Classes 9 and 16
- (c) The application is made by an author/publisher outside Class 16 for literary fictional characters
- (d) The application is made for a famous mark for goods well outside the field in which the mark gained its reputation
- (e) Applications are made for identical marks for a range of unrelated goods or services
- (f) Applications are made by known character merchandising operators and
- (g) Applications are for known fictional characters eg Holly Hobbie.

Control by the proprietor over the goods or services is, although necessary, not sufficient to allow registration where trafficking appears to be taking place. A clear connection in the course of trade or provision of service between the parties must also exist.

27-65 While, normally, objection on the grounds of trafficking will be taken by classification section on examination of the application, such an objection may not always be obvious at this early stage and the possibility of such an objection must be borne in mind.

27-66 Where there is a trafficking objection to applications for registration under section 29(1)(b) a stock letter is sent to the applicant, stating the grounds for the objection. Applicants may submit written details or may have a hearing on the objection if the matter cannot be settled in correspondence.

27-67 Objections arising from applications to register users under Section 28, to which any of paragraphs 27-64(b) to (f) apply, are dealt with by Register Maintenance Section.

REGISTRATION OF USERS -  
TRAFFICKING IN TRADE MARKS

27-68

27-68 As for Section 29(1)(b) cases a stock letter is sent stating the grounds for objection. Applicants may submit a written reply or have a hearing on the objection if the matter cannot be settled in correspondence.

[27-69 to 27-76]

27-77 Section 29(1)(b) of the Act allows registration of a mark by a proprietor who does not propose to use it himself but who applies at the same time to register a user. According to the wording of the Act, the application to register the mark should be "accompanied by" the application to register a user of the mark; and this is normally taken to mean that both applications should be received on the same day. It sometimes happens that an applicant will make an application to register a mark in the ordinary way under Section 17 and then at a later stage will seek to change the application to one made under Section 29(1)(b). In such cases the Registrar will usually allow the change to be made on receipt of a statutory declaration explaining why the original application was not correctly made and stating that, at the date of the original application, the applicant would have been entitled to apply under Section 29(1)(b) (ie he had made the necessary arrangements with the proposed user) if he had realised the necessity to do so. Alternatively, a change to a 29(1)(b) application may be allowed if it is established that the applicant genuinely intended to trade when making the application for registration but that subsequently there has been a change in his trading plans and he now intends to appoint a registered user.

27-78 An application to register a mark under Section 29(1)(b) is received in the Public Enquiry Office. The PEO checks that the correct fee has been paid, marks the TM50 with the serial number given to the application for the mark and places the TM50 and any accompanying documents in a special orange-coloured jacket marked "Registered User" and the warning "Not to be shown to the public". This warning is necessary because some of the information which it contains (such as the agreement) may well be confidential (see Section 28(7)). The TM50 is open to public inspection and if inspection is requested it should be made available in a separate folder and then returned to its own file. The TM50 in the orange jacket is then placed in the (green) application file of the mark. The application file must be stamped in red ink on the front of the cover "Application made under Section 29(1)(b)". If the TM50 relates to more than one Trade Mark or Service Mark application, it should be placed on the lowest numbered TM/SM file. A special note should be attached to the minute sheet of all the other files to which the TM50 relates, with the words "Application under Section 29(1)(b)" - Form TM50 on file (lowest numbered file in the group). The application file is then sent to Classification Section, from where it goes on to the examining unit where the normal examination process is

REGISTRATION OF USERS-  
APPLICATIONS UNDER SECTION 29(1)(b)

27-78 to 27-82

27-78 (Contd)

carried out. For guidance on the handling of RU applications covering more than one TM/SM application, see paragraphs 27-96 and 27-97 below.

27-79 When the TM/SM application in a Section 29(1)(b) case reaches the stage where the "proceed" letter is ready to be issued, a check is made to ensure that all the relevant Registered User supporting documents have been filed. If they have not been received, they should be requested in the "proceed" letter.

27-80 It is not necessary for applicants/proprietors to provide the originals of any agreement in support of their request for registration of a user. They should be asked to supply a sworn copy of an agreement submitted as an exhibit to the statutory declaration, and, after examination, this is retained on the file. If, however, an original deed or other legal document is inadvertently supplied it is photocopied at once and the copy annotated "copy of original submitted \_\_\_\_\_ (name of agent or applicant) on \_\_\_\_\_ (date of receipt)". This note is signed and dated by the officer making the copy. The copy is retained on the file and the original returned immediately under cover of letter RU4 by registered post. A note is made on the copy of the agreement that the original has been returned to the agent or applicant and signed and dated.

If there is any reason to believe that duty should have been paid on an agreement, the applicant should be requested to submit it to the Inland Revenue for adjudication.

27-81 A special registered user "report" sheet - RU7/EXAM copy at Annex G, which is the basis for the official letter in response to the application - is attached to the file as top document. The RU7/EXAM sheet sets out all the points which need to be checked on the TM50 and its supporting documents (where necessary) in comparison with the Form TM2. Each point should be ticked as dealt with in the box provided and the appropriate paragraphs marked on the RU7/EXAM where there is a query or objection to be raised, free text being added to the RU7/EXAM as appropriate.

27-82 The particulars given on the TM50 with regard to the name and address of the proprietor, the number and class (with schedule) of the mark, should be checked against the TM2.

27-83 The designation of the goods or services of permitted use should be examined in order to see that they are not wider than the specification of the mark. They may, of course, be narrower. If there is an agreement between the parties the goods or services of permitted use must also be consistent with the terms of the agreement. It is essential to be certain that the goods or services of permitted use are in fact, included in the trade mark or service mark specification. If there is any doubt at all the question must be put to Classification Section.

27-84 The application form must be signed on behalf of both the registered proprietor and the proposed registered user, since they are parties to a joint application. If an agent is acting he may sign the form as "Agent for the Applicants"; provided that he is authorised by both parties.

27-85 Form TM 33, requesting the entry of an address for service on behalf of the proposed registered user, may be signed by an agent expressly authorised for the purpose. (Both parties should authorise such an agent, but in practice we have allowed an agent to sign if only the proposed registered user has authorised him). A TML is not required unless there is any doubt about who is currently authorised as agent for the registered user application.

27-86 It is laid down in Section 28(4) that the applicant must furnish a statutory declaration showing, in brief, the relationship between the parties, the goods or services of permitted use, the conditions or restrictions including whether or not the user is to be the sole user and whether the use is to be with or without limit of period. The following is an example of a simple statement of case that covers the Registrar's requirements:-

27-86 (Contd)

TRADE MARKS ACT, 1938 (as amended)

Statutory Declaration

In the matter of an application  
for registration of a registered  
user of Mark No .....

I..... of [insert home address] do hereby  
solemnly and sincerely declare as follows:-

1. I am a Director (or the Secretary of .....  
a British company of ....., the  
registered proprietor of mark No .....  
registered in class ..... in respect of .....  
..... and I am duly authorised to make this  
declaration on behalf of .....  
(hereinafter called the registered proprietor).

2. The registered proprietor desires to register  
..... (hereinafter called the user) as  
a registered user of the mark in respect of  
.....  
(Insert the actual goods or services of permitted use if  
part specification, or the statement 'all the goods/services  
for which mark is registered')

3. (Here insert any financial arrangement which may exist  
between the parties or, if use is based on an agreement, a  
reference to that agreement.)

4. The user is (or is not) to be the sole registered user.

5. The proposed permitted use is to end on .....  
(or is without limit of period).  
And I make this solemn Declaration conscientiously believing  
the same to be true and by virtue of the provisions of the  
Statutory Declaration Act, 1835.

[Signature]

Declared at .....  
This ..... day of ..... 19....

Before me:  
.....  
A Commissioner for Oaths/Solicitor/Notary Public

27-87 In many cases, a statement of case is first submitted by the agent and when any queries have been cleared up the final version is made an exhibit to a statutory declaration by a principal officer of the applicant company sworn before a Commissioner of Oaths/Solicitor/ Notary Public, declaring that the statements made therein are true. This procedure is to be encouraged since even small amendments to a statutory declaration require that the document must be re-sworn.

27-88 The statutory declaration should be carefully examined to see that it corresponds with the TM50 and with the terms of any agreement or other document lodged in support of the application, and that it deals with all the matters specified in Section 28(4).

27-89 If the relationship is not entirely clear from the description given it must be queried. If the relationship is based on an agreement or other legal document a copy must be exhibited to the statutory declaration. Although it rarely arises in practice, it is acceptable for the relevant provisions of an agreement to be recited in the statutory declaration, thus avoiding the filing of a copy.

27-90 If the permitted user is to be the sole registered user this fact must be reflected in the conditions or restrictions.

27-91 The information about the goods or services covered should be consistent with the designation of goods or services of permitted use set out on the TM50.

27-92 It has been fairly common for the conditions or restrictions to be omitted when the application is first made, the applicant leaving it to the registry to suggest suitable wording after examination of the supporting documents. It is preferable for applicants to insert conditions or restrictions when filing their applications, and they should be encouraged to do this, although if an applicant insists that he would rather the Registrar propose a form of words we can agree to do this. (The old practice of insisting that the conditions/restrictions follow the Registry's preferred version should not be followed - see paragraphs 27-32 onwards).

27-93 The information about the period of use should be consistent with the statement made on the TM50 and with the reference in any agreement.

27-94 The goods or services of permitted use must be exactly the same as the mark specification (or within it) and care must be taken to ensure that any amendments which might have been made after the filing of the application in order to make it acceptable for registration are carried through to the registered user application. This arises because there would otherwise be some goods or services in the specification in respect of which there would apparently be no intention to use the mark. The only exceptions to this rule are fairly rare cases in which the mark specification is shared between two or more registered users.

27-95 Following satisfactory examination of the registered user application the mark file is noted to the effect that the registered user documents are in order and the registered user register sheet, letters of notification of registration for the proprietor and user of the mark, and the printer's copy for advertisement of the user's registration in the journal are prepared. Printer's copy and the registered user register sheet are prepared by photocopying the TM50 and indicating on that copy, or by an attachment to the copy, the information to be typed for each document. This is done at the end of the examination process by the officer carrying out the examination. The advertisement consists of the serial number of the marks followed by the number of the journal and page number (in brackets) in which the application for the mark was advertised (stamped on the mark file cover) and the class number. Unless the registered user is in respect of all the goods or services for which the mark is, or is to be, registered, there then follows a statement of the goods or services covered by the permitted use, the name and address of the registered user and the date of registration of the user/ie the date on which the TM50 was, or was deemed to have been filed. The register sheet for a registered user will show the date of registration (see above), the name and address of the user, the actual goods or service of permitted use when only a part of the specification is to be covered. Where all the goods or the services of a registration are to be covered the wording "In respect of all the goods (or services) for which the trade (or service) mark is registered" should be inserted, the period of permitted use (if it is limited), the conditions or restrictions, and the address for service (if any). These documents are placed in an envelope marked "RU registration documents", and put on the mark file as the top document. The mark file should be noted "RU in order" and sent forward to Journal section for advertisement of the mark. Registration Section is responsible for sending the registered user register sheet to Register Maintenance

27-95 (Contd)

Section, sending the letters of notification of registration of the user to the proprietor and the user, and for sending the printers copy to the Journal Section when they deal with the mark registration.

#### RU APPLICATIONS COVERING MORE THAN ONE TM/SM APPLICATION

27-96 A single registered user application may cover a number of TM/SM applications. This does not prevent its being filed as a single TM50 - ie the TM50 relates to the registered user applications and not to the number of marks covered. (Conversely one mark may be the subject of several registered user applications, eg fast food chains such as Wimpy who sell their products by a franchise system, and in this case each registered user application must be filed on a separate TM50).

27-97 If the various TM/SM files form a companion group, the checking of the RU agreement should be done by the lead file unit. When a number of TM/SM applications covered by a single TM50 do not form a companion group (ie when the TM/SM applications are for different marks) the unit responsible for the lowest numbered application in the group must check the TM50 in relation to all the applications in the group. When they have been checked "ready for advertisement", they should be referred to the lowest numbered application unit for TM50 action.

#### SECTION 28 CASES

27-98 In order to be registrable directly under the provisions of Section 28 rather than under the provisions of Section 29(1)(b) the mark(s) in question must be already registered.

27-99 When a TM50 concerning an application under Section 28 is received the actions carried out in connection with its recording and examination are exactly the same as for 29 (1)(b) cases (set out in paragraphs 27-78 to 27-97) with the following exceptions:

27-100 A letter of acknowledgement of the registered user application, which gives the registered user reference number, is sent out by the Public Enquiry Office as for Section 29(1)(b) cases. Once the receipt and jacketting and other preliminary formalities have been carried out the files are placed in the appropriate part of the filing system to await their turn for examination, at which time a check will be made as to whether the marks covered by the

27-100 (Contd)

application are registered. Where not all the mark applications are registered, discretion should be exercised, in consultation with the agent as necessary, as to whether action should be taken to carry out prompt registration of the user in respect of those marks already registered, leaving for subsequent action those applications which may mature into registrations. This latter course should only be adopted however, when the necessary supporting documents are already available. If the supporting documentation is not available, it should be requested on a letter RU13 (Annex M). If all action is deferred until all marks are registered then the case should be given a B/F date to ensure it is not overlooked and the application files for registration should be marked for referral to RU Section after registration.

27-101 When the examination is being carried out and the particulars given on the TM 50 are being checked particular care should be taken to ensure that there are no differences between the name and address of the registered proprietor as shown on the TM 50 and that on the register. Any differences should be queried and if necessary the registered proprietor should be asked to amend his entry in the register before the RU is finally accepted.

27-102 If a TM 33, requesting the entry of an address for service on behalf of the registered proprietor, is also lodged, it should be transferred to the mark file and minuted to Register Maintenance Section to be dealt with in the usual way.

27-103 The mark which is to be the subject of the permitted use should be examined to see if it bears any wording, such as "Manufactured only by (the registered proprietor)" or "Manufactured in USA", which would be inconsistent with use by a permitted user. Any such inconsistency will effectively prevent the acceptance of the application unless the registered proprietor is prepared to take the necessary action to remove it by filing a TM 25. The mere presence of the name and address of the registered proprietor or of a predecessor in business would not call for any alteration of the mark.

[27-104 to 27-110]

27-111 Printer's copy for the advertisement in the Journal is prepared as set out in paragraph 27-113.

27-112 In the case of an application under Section 29(1)(b) the printers copy is then placed with the other registration documents in accordance with instructions in paragraph 27-95.

27-113 When a registered user application under Section 28 is in order to proceed to registration, the front of the file cover is stamped "Registered User Entered", if not already so stamped, and the printer's copy for advertisement, the registered user register sheet, (see paragraph 27-95) and the letters of notification of registration are prepared.

27-114 Both registered users under Section 29(1)(b) and Section 28 are advertised under the main heading "Registered Users of Registered Trade Marks" and the subheading "Entered on the register". Where only part of the specification is to be covered, the actual goods or services of permitted use are given. Where a date of expiry of the period of permitted use is applicable this is also given in the advertisement - see paragraph 27-95.

27-115 Each Thursday all the printer's copy for Section 28 cases which has been prepared for advertisement is taken to Journal Section to arrive no later than 10.30 am, for collection by the printer. See paragraph 27-95 for advertisement procedures for Section 29(1)(b) cases.

[27-116 to 27-126]

REGISTRATION OF USERS - ENTRY IN REGISTER 27-127 to 27-131

27-127 The register sheet for a registered user will show the date of registration (ie application date as shown on TM50), the name and address of the user, the goods or services of permitted use (the actual goods or services when only a part specification or the statement "in respect of all goods (or services) for which the mark is registered", whatever is applicable) the period of use (if it is limited), the conditions or restrictions, and address for service (if any). It is produced by sending the TM 50 to the typing pool together with a note of instructions as to the details to appear on it.

27-128 On return from the typing pool the register sheet is checked for accuracy and it is then sent to Register Maintenance Section for filing in the registered user register. (See paragraph 27-95 for action to be taken with register sheets for Section 29(1)(b) cases).

27-129 The registered user number is marked on the inside of the front cover of the trade or service mark file.

27-130 The main register is stamped as follows by Register Maintenance Section:-

REGISTERED USER - SEE REGISTERED USER VOLUME

27-131 In cases where the permitted use is for a limited period, a card is prepared which will be held in the index maintained in register maintenance section showing: The date of expiry of the period of permitted use, the name of the registered proprietor, the name of the registered user, the serial number(s) of the trade or service mark(s) concerned and the R.U. serial number and whether the application originated under Section 28 or Section 29(1)(b).

27-132 This card index is reviewed monthly so that when the period of permitted use has finally ended, both parties are notified as follows -

Registered Mark No .....  
and.....registration as Permitted  
User.....

I have to inform you that the permitted use protected by the above-mentioned registration came to an end on .....

The entry of Registered User was accordingly cancelled by the Registrar as of date ..... under the terms of Rule 113 of the Trade and Service Marks Rules 1986.

Yours faithfully

27-133 The register is noted that the registered user registration has ended.

27-134 If as a result of the ending of the period of permitted use there are no remaining users registered against that mark the computer database is amended by completion of form TR 1 (E) and inclusion of a batch number (taken from the batch number book). The completed form is then sent to data processing at St Mary Cray and when a revised computer print-out is received from Eastcote it is checked and placed on the file and the old one removed. Any errors must be corrected at this stage, preparing a fresh TR1 (E).

27-135 Register Maintenance Section notify Indexing Section that action should be taken by Indexing Section to amend the search indexes.

[27-136 to 27-147]

REGISTRATION OF USERS -  
VARIATION OF ENTRIES IN THE REGISTER

27-148 to 27-152

27-148 Application to vary the registration of a registered user with regard to the goods or services or the conditions or restrictions are made on form TM 51 accompanied by a statement of case stating the grounds for the desired variation. If the original entry of the registered user was based upon an agreement, it is usual for a fresh agreement, setting out or providing for the variation, to be submitted for inspection, but a letter setting out and agreeing to the variation, and signed by both parties, may be accepted in lieu thereof. The method is not important provided that the Registrar is satisfied that the registered user is in agreement with the proposed changes.

27-149 The amount of the fee paid on the TM 51 is noted in the fee book, a separate section being used for these forms only.

27-150 Under Rule 112 the office is obliged to advertise proposals for variation and notice of proposed variation is advertised in the Journal under the heading "Notice of Proposed Variation (Rule 112)", with an explanatory footnote: "A further advertisement will appear only if the proposal is amended or abandoned following opposition or appeal". Then below follows the mark number, the number of the journal and page number in brackets in which the original registered user entry was advertised, class number, the name of the registered user and a brief statement of the variation thus:- "Application made on the .....(date) to vary the registration by the substitution of ..... (whatever it may be)".

27-151 Where a proposal is amended or abandoned a further advertisement will appear in the registered user part of the Journal under a sub heading with an explanatory footnote as set down below. In practice this is very unlikely ever to happen.

Amendment/Abandonment of Proposed Variation. The proposal(s) for variation advertised in Journal No ..... page ....., has/have been amended to the form shown below or has/have been abandoned.

27-152 The variation is then duly entered on the relevant registered user's register sheet and an appropriate notification of the recordal of the variation is sent to both the registered proprietor and the registered user.

REGISTRATION OF USERS -  
VARIATION OF ENTRIES IN THE REGISTER

27-153 to 27-156

27-153 The registered user file is suitably minuted with a record of the entry of the variation in the register, including a note of the number of the journal in which the variation was advertised as follows:-

Entry of Registered User varied in pursuance of an application made on the \_\_\_\_\_ by the Registered Proprietor \_\_\_\_\_  
ADVERTISED. See JOURNAL ..... PAGE .....  
Notification to Registered Proprietor and Registered User sent .....

27-154 It should be noted that the term "any conditions or restrictions" in Section 28(8)(a) is held to relate to the "conditions or restrictions" mentioned in Section 28(4)(c). The "limit of period" is mentioned separately under Section 28(4)(d) and is not one of the "conditions or restrictions" covered by Section 28(4)(c) or 29(8)(a). It cannot, therefore, be varied under the provisions of Section 28(8)(a). There must be a separate register entry in a case where an existing user is to be registered in respect of the same (or other) goods for a different period of permitted use, and such a case should be the subject of a separate application.

Changes of name or address

27-155 Application to change the name and or address of a registered user are made on form TM18 (for alteration of trade or business address) or TM21 (for change of name). All such changes are dealt with by Register Maintenance Section who update the registered user register and file, following the same general procedures as for changes of name or address of registered proprietors of marks, set out in Chapter 29 of this Manual.

27-156 When the TM18 or TM21 is in order and the registered user register has been amended the change must be advertised in the Trade Marks Journal. Printers copy is prepared by hand showing the old name, new name and details of the registration (ie its number, the number of the Journal and page number in which it was originally advertised and the class number), and is sent to Journal Section for advertisement in the Journal under the heading "Names and Addresses of Registered Users Altered in the Register". The proof copy of the advertisement is returned to RU Section for checking.

[27-157 to 27-165]

27-166 Applications for cancellation under Section 28(8)(b) and Rule 110 must be made either by the registered proprietor or a registered user of the marks concerned on a TM 52 which should be accompanied by a statement of the grounds for the application. It is usual for the application for cancellation to be made by the registered proprietor, and accompanied by a written consent to the cancellation from the registered user. There is now no fee for this service.

27-167 Under Rule 112 the office is obliged to advertise proposals for cancellation of a registered user. Notice of proposed cancellation is advertised in the Journal under a sub heading, with an explanatory footnote, as follows:

Notice of Proposed Cancellation. A further advertisement will appear only if the proposal is amended or abandoned following 'opposition' or appeal,

followed by the trade or service mark number(s), journal number/and page number, class number/and name of the registered user only). The journal number in which notice is made is noted on the registered user file.

27-168 Where a proposal is amended or abandoned a further advertisement will appear in the registered user part of the Journal under a sub heading with an explanatory footnote as set down below. In practice this is very unlikely ever to happen.

Amendment/Abandonment of Proposed Cancellation. The proposal(s) for cancellation advertised in Journal No ..... page ..... has been amended to the form shown below or has been abandoned.

[27-169]

27-170 The registered user file is stamped as follows:-

Entry of Registered User cancelled, in pursuance of  
an application made on the .....  
(date by the registered proprietor)  
ADVERTISED See JOURNAL ..... PAGE .....  
Notification to Registered Proprietor and  
Registered User sent .....

The relevant registered users register sheet is marked  
"Expired \_\_\_\_\_ (date) Journal No \_\_\_\_\_" and left  
in place.

27-171 Applications for cancellation under Section  
28(8)(c) and Rule 111 are also made on a TM 52, accompanied  
by a statement of the grounds for the application. There is  
no fee for this service.

27-172 Procedure on applications under Rule 111 follow  
those applying to Rule 110, and in all cases the proposal  
for cancellation must be advertised.

27-173 If there are no registered users remaining  
following cancellation action the computer record is amended  
by filling in form TR 1 (F) and following the same actions  
as in the case of cancellations when the period of permitted  
use has ended-which is set out in paragraph 27-136.

27-174 Register maintenance section notify indexing  
section that action can be taken by that section to amend  
the search indexes in respect of proposals for cancellation  
in the Journal concerned.

[27-175 to 27-183]

27-184 Generally speaking a licence of a property right binds only the parties to it. The disposal of the mark by the licensor may be a breach of contract, actionable against him by the licensee, but it will not give the licensee any rights against the new owner, even if the new owner has taken the mark with knowledge of the licensee. However, the position on assignment of a registered mark which is subject to the registration of a registered user is rather different. The registered user's right to use the mark derives from his registration as such, not from the underlying agreement between him and the proprietor. Section 28 of the Trade Marks Act 1938 (as amended) provides that any variation or cancellation of a registered user registration can be made only by the Registrar, and has the effect that, even if the proprietor and registered user in question agree to this step, the Registrar may refuse, having regard to the interest of other registered users and the public. The registration of the user creates rights which are good against the whole world, not just the proprietor, and it continues to bind the mark to the user until it is cancelled, irrespective of the identity of the proprietor.

27-185 It is not therefore necessary for an assignment to be made expressly subject to the registered user, and when an application is made to record the assignment of a trade or service mark in respect of which one or more registered users have been entered in the register, no initiative is taken by the Registrar to inform the registered user(s) of the change or to question the user's relationship with the new proprietor. These matters are regarded as being the concern only of the parties and the registration of the user will continue in force under the new proprietor if no action is taken by the proprietor or the user. However, it often happens that the parties wish to make some recognition of the changed circumstances without going to the expense and trouble of cancelling the entry and making a fresh application. In these cases, the Registrar is prepared to accept and place on file a "Letter of Novation" ie a letter from the proprietor to the effect that the arrangements previously in force between the late proprietor and the user will continue as before between the new proprietor and the user.

27-186 Where through an assignment a registered user becomes the proprietor the Register Maintenance Section stamp the registered user file "Registered User now Proprietor" and the register sheet, which remains in its place, in the same way.

REGISTRATION OF USERS - ASSIGNMENT

27-187 to 27-189

27-187 A registered user cannot assign or transmit his right to the use of the mark - see Section 28(12).

27-188 Any entries of other registered users of the same mark are not affected by this procedure.

27-189 In other assignment cases, the registered user file is noted and the files sent to the file store.

[27-190 to 27-199]

27-200 The rights of registered users cease automatically on the expiry of a registration. After Register Maintenance Section have stamped the register sheet and the registered user register sheet as "expired" they mark the registered user file as "expired" and the mark file and registered user file are then sent to the main file store where they will be the subject of the weeding process for dead files in due course. As expiry of a mark is advertised, there is no need and no provision has been made for, advertisement of expiry of registered users.

[27-201 to 27-208]

27-209 It may happen that a mark is registered in the United Kingdom merely as a preliminary to obtaining registration in countries overseas where it is a pre-requisite of registration that the mark shall have been registered first in the United Kingdom. Individual cases are rarely apparent however since exports qualify as use (Section 31). The Registrar is prepared to accept applications to register users of United Kingdom marks in overseas countries provided he is satisfied that registration of the user in the United Kingdom is an essential pre-requisite to obtaining a similar user registration in the overseas country. It is therefore necessary to check the position in every case in which both the proposed registered user and his proposed area of permitted use are outside the United Kingdom.

[27-210 to end]

ANNEXES



**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

You are advised that the Form TM NO ..... was received without the required fee of £ ..... If you wish to proceed with the matter the fee should be paid to this Office within three weeks of the date of this letter. It should be noted that the form will be deemed to have been filed on the date of receipt of the fee and that it is that date that will be considered as the date of application.

Please quote our reference, as given above, in any correspondence with this Office on this matter.

Yours faithfully

RU1/Unpaid Fee

SARAAE





**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

You are advised that the fee payable in respect of Form  
TM No ..... is £ ..... The fee received from you was  
£ ..... and you are now requested to pay the balance of  
£..... If this balance is not received within three  
weeks of the date of this letter it will be assumed that you do  
not wish to proceed with the matter and the application will be  
treated as cancelled.

Please quote our reference as given above, in any  
correspondence with this Office on this matter.

Yours faithfully

RU2/Part Paid Fee

SARAAF





The Patent Office

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829

Our ref

Your ref

Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

The application filed on ..... for registration  
as above has been recorded under the reference: RU .....  
This reference should be quoted in any correspondence with this  
Office on this matter.

If the documents necessary to support the application have not  
already been filed you are reminded that:-

- 1 they should be filed promptly on registration of the mark, if more than one mark is featured in the application, promptly on registration of all of the marks. If the mark is already registered or, where more than one mark is featured in the application, all of the marks are registered, the documents should be filed within one month of the date of this letter.
- 2 they should be filed within the time that will be specified in the notification that will be sent to you by this Office when the initial examination of each mark featured in the application has been completed.
- 3 It should be noted that the Registrar is prepared to dispense with a sight of the original of an agreement between the parties provided copy is exhibited to the attested statutory declaration or affidavit.

Yours faithfully

RU3 /APPLN. ACK

SARAAG





**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

The original of the agreement(s) filed to support the above application is/are returned with thanks.

It should be noted for future applications that the Registrar is prepared to dispense with a sight of the original of an agreement provided a copy is exhibited to the attested Statutory Declaration or Affidavit.

Please quote our reference number, as given above, in any correspondence with this Office on this matter.

Yours faithfully

RU4/Agreement

SARAAH





**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

You are requested to confirm that you wish the above application to remain on record for a further period of time and, if so, to give some assurance that matters are proceeding. Failing receipt of any communication from you within two months of the date of this letter the application will be sent to store.

Please quote our reference, as given above, in any correspondence with this Office on this matter.

Yours faithfully

RU5 Sect. 28 Reminders

SARAAI





**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

*Telex* 266546 PATLDN G

Direct line 01-829

Our ref

Your ref

Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

The above Trade Mark is proceeding to acceptance and you are now requested to file a Statement of Case, duly exhibited to a Statutory Declaration or Affidavit, together with any other documents necessary to support the Registered User application. These documents should be filed within two months of the date of this letter.

It should be noted that the Registrar is prepared to dispense with a sight of the original of an agreement provided a copy is exhibited to the attested Statutory Declaration or Affidavit.

If nothing further is heard from you within the period allowed, the Trade Mark application will be removed from record and the Registered User application will then naturally fall away.

Any request for an extension of time should be supported by an explanation of the circumstances justifying the request.

Please quote our reference, as given above, in any correspondence with this Office on this matter.

Yours faithfully

RU6 Sect 29(1)(b) Docs





The Patent Office

Trade Marks Registry  
State House  
66-71 High Holborn  
London  
WC1R 4TP  
Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....><

TRADE MARK NO(S) .....><

APPLICATION FOR REGISTRATION OF .....><  
AS A PERMITTED USER

I am writing with reference to the application as above.

- 1 You are requested to amend or complete the enclosed Form TM No 50 by
- 1A insertion of the correct/full >< name of the proprietor
- 1B insertion of the correct/full >< address of the proprietor
- 1C insertion of the Class(es) >< of goods
- 1D insertion of the correct trade mark number(s)
- 1E insertion of the specification(s) >< of goods
- 1F correction of the specification(s) >< of goods to agree with the Form(s) >< TM No 2
- 1G insertion of the correct/full >< name of the proposed registered user
- 1H insertion of the correct/full >< address of the proposed registered user
- 1I insertion of the goods of permitted use. If all the goods of the trade mark registration(s) >< are to be covered the wording "All goods of the registration(s)" >< should be inserted



2

Ref:

- 1J insertion of the conditions or restrictions. A suitable wording would appear to be:
- 1K amendment of the conditions or restrictions to reflect the terms of the agreement. The following wording would appear to be suitable:
- 1L amendment of the conditions or restrictions to accurately reflect the relationship of the proprietor and user. The following wording would appear to be suitable:
- 1M amendment of the conditions or restrictions to a more usual form. The following wording would appear to be suitable:
- 1N insertion, where indicated, in the conditions or restrictions of the clause "(who is to be the sole registered user)"
- 1O insertion of the date of expiry of the period of permitted use
- 1P deletion of the inappropriate wording with regard to the period of permitted use
- 1Q insertion of the signature of the proprietor or his authorised agent
- 1R insertion of the signature of the proposed registered user or his authorised agent.
- 2 The enclosed Statutory Declaration/Affidavit and Statement of Case should be amended as set out below. The amended document should be re-attested before being refiled.▶◀
- 3 The draft Statement of Case is acceptable and should be filed as an exhibit to a duly attested Statutory Declaration or Affidavit.
- 4 You are requested to file the original(s) ▶◀ of the agreement(s) ▶◀ of ▶◀

If you have not yet filed an attested Statutory Declaration or Affidavit, a copy/copies ▶◀ of the agreement(s) ▶◀ may be exhibited to that document. A sight of the original(s) ▶◀ of the agreement(s) ▶◀ will not then be required by the Registrar.

3

Ref:

5 The agreement(s) ▶ filed by you are returned herewith you are requested to submit it/them ▶ to the Inland Revenue for adjudication before returning it/them ▶ to this Office for further inspection.

6 The agreement(s) ▶ of ▶ is/are ▶ returned herewith. You are requested to acknowledge it/their ▶ safe receipt.

7 The agreement does not appear to give the proprietor adequate control over the goods of permitted use in that ▶

8 The area of territorial restriction on the use of the mark(s) ▶ requires to be classified by ▶

9 Other objections are:- ▶

10 If nothing is heard from you within one month of the date of this letter it will be assumed that you do not wish to proceed with the matter and the application will then be sent to store.

Any request for an extension of time should be supported by an explanation of the circumstances justifying the request.

11 If nothing is heard from you within one month of the date of this letter it will be assumed that you do not wish to proceed with the matter. The trade mark application will then be removed from record and the registered user application will then naturally fall away.

Any request for an extension of time should be supported by an explanation of the circumstances justifying the request.

12 Please quote our reference, as given above, in any correspondence with this Office on this matter.

Yours faithfully





**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829

Our ref

Your ref

Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

In reply to your letter of ..... in connection  
with the above application, the Registrar is prepared to grant  
you an extension of time until ..... in which to deal  
with the matter.

Please quote our reference, as given above, in any  
correspondence with this Office on this matter.

Yours faithfully

RUS/EOT

SARAAL





**The Patent Office**

Trade Marks Registry  
State House  
66-71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

You are informed that the above named person has been entered  
in the Trade Marks Register as a registered user of the Trade  
Mark(s) numbered as above with effect from .....

Particulars of the registration will be advertised in Trade  
Marks Journal No .....

Please quote our reference, as given above, in any  
correspondence with this Office on this matter.

Yours faithfully

RU9/Regn

SARAAM





**The Patent Office**

Trade Marks Registry  
State House  
66-71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

TRADE MARK NO(S) .....

VARIATION OF REGISTER ENTRY OF .....  
AS A PERMITTED USER

With reference to the application made on .....  
you are informed that the proposal for variation of the  
Register entry as above is being advertised in Trade Marks  
Journal No .....

A further advertisement will appear only if the proposal does  
not proceed, or proceeds in an amended form, as a result of an  
objection to the present proposal or for any other reason. You  
will, of course, be notified if the proposal cannot proceed as  
advertised.

Please quote our reference, as given above, in any  
correspondence with this Office on this matter.

Yours faithfully

RU10/Variation

SARAAN





**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP  
Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

TRADE MARK NO(S) .....

CANCELLATION OF .....  
AS A PERMITTED USER

With reference to the application made on .....  
you are informed that the proposal for cancellation of the  
Register entry as above is being advertised in Trade Marks  
Journal No .....

A further advertisement will appear only if the proposal does  
not proceed, or proceeds in an amended form, as a result of an  
objection to the proposal or for any other reason. You will,  
of course, be notified if the proposal cannot proceed as  
advertised.

Please quote our reference, as given above, in any  
correspondence with this Office on this matter.

Yours faithfully

RU11/Cancellation

SARAAO





**The Patent Office**

Trade Marks Registry  
State House  
66-71 High Holborn  
London  
WC1R 4TP

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01-831 2525

Telex 266546 PATLDN G

Direct line 01-829  
Our ref  
Your ref  
Date

Dear .....

**TRADE MARK(S) NO(S) ..... AND REGISTRATION OF  
..... AS A PERMITTED  
USER**

As the permitted use protected by the above mentioned registration expires on the entry of a Registered User will accordingly be cancelled by the Registrar as of that date under the terms of Rule 113 of the Trade Marks and Service Marks Rules 1986.

It would be helpful if the reference number given above is quoted in any correspondence with the office on this matter.

Yours faithfully

RU12/END OF PPU

SARAAP





**The Patent Office**

Trade Marks Registry  
State House  
66—71 High Holborn  
London  
WC1R 4TP

Switchboard  
01-831 2525

Telex 266546 PATLDN G

Direct line 01-829

Our ref

Your ref

Date

Dear .....

TRADE MARK NO(S) .....

APPLICATION FOR REGISTRATION OF .....  
AS A PERMITTED USER

With reference to the above application I am to request that  
you file the necessary documents in support thereof.

Yours faithfully



