

Filing and Prosecution: UK

This topic will look at how to file a UK trade mark application and the process an application goes through until registration and will cover the following:

- Who may apply?
- Languages
- Types of marks available
- Classification
- Priority
- Forms and fees
- Examination, procedure and appeal
- Registration, duration, use requirements and marking

A very useful resource is the Manual of trade marks practice:

<https://www.gov.uk/government/publications/manual-of-trade-marks-practice>

Geographic coverage

A UK trade mark registration provides protection to the entire United Kingdom of Great Britain and Northern Ireland. Great Britain is England, Scotland and Wales. The UK Trade Marks Act 1994 is also extended to the Isle of Man.

Who may apply?

Any natural or legal person, including authorities established under public law, may apply for a trade mark, irrespective of their nationality or domicile.

The name and address of the applicant (who becomes the 'proprietor' once the mark is registered) must be supplied on the form. The name of the applicant must be the correct legal name (particularly in the case of companies) and not a trading name or style.

A registered trade mark and an application for registration are both personal property and so this means that an applicant must be an individual (a natural person) or some sort of legal person, capable of owning property in their own name.

Where there appears to be some doubt as to an applicant's legal status, the UKIPO may ask for confirmation that the applicant has the necessary standing to hold property. They also recommend indicating the State of Incorporation for US companies, where applicable, in order to differentiate clearly between different owners in its database.

If the application is made on behalf of an unincorporated association, it is important to remember that the association as such may not be capable of owning the application or the trade mark.

Similarly, an application on behalf of an unincorporated charitable trust must be made by the trustees. An application in the name of a body calling itself a 'trust' or a 'club' is liable to give rise to such a request for clarification.

The UKIPO uses the following guidelines when considering whether to question the legal status of an applicant.

Companies/corporate bodies - Any form of company, that is, a business incorporated into a legal entity as distinct from its members or directors, is capable of holding property in its own name. It suggests including the company number to help distinguish between companies.

Partnerships - Partnerships (including limited liability partnerships, partnerships governed by an agreement and partnerships at will) are allowed to be recorded as applicants. In the case of a partnership at will, it is necessary to list the partners who make up the partnership because (in the absence of an agreement) the legal personality of the proprietor will change every time a partner changes.

Other unincorporated bodies - Other unincorporated bodies such as trading names do not have the capacity to hold property in their own name.

Trustees - Where an application is made by a trustee or trustees, for the benefit of another person (or body of persons), it should be noted that only the name of the trustees will be entered on Register as you cannot enter details of beneficial interests only. Accordingly, the Register will contain only the name of the legal owner of a mark, even where the beneficial owner is another person or body. Furthermore, that will still be the case, even where the beneficial owner is itself a person capable of owning property in its own right. Thus, wherever it is intended that the trade mark is to be held on trust for someone other than the legal owner, that legal owner (the trustee), rather than the beneficial owner (the person for whom the property is held), should be listed as the applicant.

Registered charities - The mere fact that an organisation is a registered charity may not entitle the organisation to hold property; some other form of legal personality may be needed before it possesses property holding powers. However, the Registrar will accept an assurance from the filer that a registered charity has the necessary status to hold property in its own name.

Address for service

If the applicant is not based in the UK (which for this purpose includes the Isle of Man), the Channel Islands or Gibraltar and is not represented by someone based in the UK, they must provide an address for service in the UK, the Channel Islands or Gibraltar with which the UKIPO can correspond with.

Language

Applications can be filed in English or Welsh, albeit the online form is only available in English currently. Welsh language (paper) forms can be requested from the UKIPO.

Types of marks available

Series marks, Certification and Collective marks are available in addition to standard trade marks.

Series marks

A series of marks means a number of trade marks which resemble each other as to their material particulars and differ only as a matter of non-distinctive character which would not affect the identity of the trade mark.

Acceptable:

FENTON 1
FENTON 2
FENTON 3
FENTON 4
FENTON 5
FENTON 6

or

MERKINS LODGEMENT CENTRE
MERKINS LODGMENT CENTRE

Unacceptable:

PAINT WEB
PAYNT WEB

Growright
Gro Wright

It is not uncommon to file logos as series of marks – a colour version with a black and white version, but this will not always be acceptable.

An application can include a maximum of six marks in a series.

At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series and when the Registrar deletes a trade mark from a series, the application insofar as the deleted mark shall be treated as withdrawn.

Certification marks

The main feature of a Certification mark is that it is used not by the proprietor of the mark but instead by his authorised users for the purpose of guaranteeing to the relevant public that goods or services possess a particular characteristic.

The proprietor's mark certifies the presence of the characteristic and will authorise the use of the mark to anyone who can demonstrate that the goods and services for which it will be used have that characteristic/standard.

Examples:



Collective marks

A Collective mark is a specific type of trade mark that indicates that the goods or services bearing that mark originate from members of an association, rather than from just one trader.

Collective marks can be used to publicise products that are characteristic of a particular region and may be used together with the individual mark of the producer of a given good. This allows members of an association to differentiate their own products from those of competitors.

Examples:



Inherent registrability

You will recall that a trade mark must be inherently registrable (the grounds for refusal discussed before under Sections 1, 3 and 4 of the Trade Marks Act 1994). For example, a mark cannot be descriptive or deceptive.

As part of this course, you are not expected to make assessments as to the inherent registrability of trade marks.

Filing routes

There are three filing routes for trade marks to cover the UK:

- The 'regular' filing route;
- Right Start filing route; and
- Designating the United Kingdom in an International application

The latter route is rarely used by UK businesses as should become clear as you progress through this course. It won't be covered under this topic.

Right Start

Under this route, you only pay 50% of the filing fees at filing. Applications must be filed online.

The UKIPO will then issue its examination report and, at that stage, dependent upon the results of that examination, the applicant can either abandon the application or, if he/she proceeds, pay the remainder of the official fees. The balance of fees must be paid within 14 days of the examination report being issued or the application will be abandoned.

This route is a way for applicants to test the water with an application without incurring the full filing fees and so it is popular with applicants that are not professionally represented.

Priority

Any filing that is equivalent to a regular national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority from the Paris Convention.

This has the benefit of backdating the UK application to the filing date of the earlier application which we are claiming priority.

Priority will be granted if the following requirements are met:

1. the previous application(s) is a first regular filing ('first filing')
2. the mark in the earlier application(s) and the mark applied for are the same
3. the goods and services are identical - or are contained within those of the earlier application(s) (it is sufficient that one good or service is the same) (partial priority)
4. the proprietor is the same
5. the filing date of the mark is within six months of the filing date of the earlier application

The UKIPO policy is that a trade mark filed in black and white and/or greyscale is, for the purposes of assessing priority, not identical to the same mark filed in colour unless the differences in colour or in the shades of the grey are so insignificant that they could go unnoticed by the average consumer.

In relation to word marks, the mark applied for will in most cases be deemed to be the same as the earlier mark where there is a difference only in respect of typeface or where one mark is in upper case letters and the other in lower case.

If you've already made a filing before (i.e. the application you are claiming priority from is not a first filing) then claiming priority would be an invalid claim.

When: Priority must be claimed when filing the application.

Documents: The UKIPO does not usually request any proof of the priority application. However, Examiners have discretion and they may determine what documentation shall be filed in support of the application. Typically, this will be in the form of a Certified Copy of the first filing (with translation into English if the document is not in English). This is more likely where an overseas application is from a country without their Trade Marks Register being available online.

Filing the application

Your presenter will take you through an example application.

You can also refer to the specific part of the Manual related to new applications:
<https://www.gov.uk/guidance/trade-marks-manual/new-applications>.

You will see that you are entering in the information discussed above into the online **TM3** application form.

You will see there is a place to enter a disclaimer. A disclaimer is a statement by the applicant that they disclaim any exclusive right to an element of the trade mark representation that is not distinctive. Under UK law, it is not necessary to enter disclaimers and so this would be very rare.

Applications may be sent to the Office electronically (by far the most common method of filing), by post/private courier, or handed in personally.

Fees

The application fee covers one class and is £200 but a £30 discount is provided for online applications making this £170.

Each additional class in an application is £50 per class (electronic or paper filing).

If filing for a series of marks, the first and second marks in the series are included in the application fees. Each additional mark in a series carries a fee of £50 per mark.

For Right Start applications, the £30 discount is not provided for. 50% of the application and additional class fees must be paid on filing, and if the application is for a series of marks then any additional series fees are to be paid in full. The balance of the fees is then due to be paid 14 days after receiving the examination report or the application will be deemed abandoned.

Fees can be paid by credit or debit card or by debiting a deposit account, if your firm has one of these with the UKIPO. You can also pay the UKIPO by cheque or bank transfer, but these payment options are not available for online applications.

If you have a deposit account with the UKIPO then you do not have to debit this on filing. If the fees are not paid on filing, then they will give you one month to make payment. While this can be useful for private practice firms (because in that month period they have hopefully received payment from their client), you lose out on the £30 discount.

Filing receipt

For electronically filed applications, the system will let you know the application number on screen and an electronic filing receipt with the application number and filing date will issue by e-mail shortly afterwards. This information should be docketed in your database.

Essential filing requirements

An application will be given a filing date as soon as all the essential filing requirements are met. The application is given a formalities check, to confirm that the essential requirements are present, they are:

- a) A request for registration of a trade mark - A request for registration is generally taken to be the provision of Form TM3 as this in itself requests registration. However, if the UKIPO receives a letter which clearly states that a request for registration of a trade mark is sought, this would be sufficient to meet this requirement
- b) The name and address of the applicant - The name and address of the applicant must be supplied

- c) A statement of the goods or services for which it is sought to register the trade mark - An application must include a list, or statement, of all goods and services for which an applicant uses or intends to use the trade mark. It is not essential to provide a class number in order to obtain a filing date, but this is a requirement which must be met before the application can proceed further. The specification will not be examined in any detail at this stage; a detailed examination will be made by a trade mark Examiner, but if the specification is not clear the Office will contact the applicant to clarify the specification
- d) A representation of the trade mark - A representation of the mark (or marks in the case of a series) in the format that registration is sought must be provided

Non-essential requirements for filing date

- a) Use or a *bona fide* intention to use - Every applicant must be either currently using the trade mark (or allowing someone else to use it with their consent) or have a *bona fide* (good faith) intention to use it in relation to the goods or services requested. The declaration on the application form, stating this, must be signed by the applicant or their representative.
- b) Fees – all the correct fees need to be paid
- c) Form TM3 – if the application is not requested on a Form TM3 then this form needs to be filed subsequently
- d) Application to specify the class - The application must specify the class of the Nice classification system
- e) Address for Service - Applicants shall provide an address for service in the United Kingdom, Gibraltar or the Channel Islands, if they are not from one of these

If an application is filed online, then the system will ensure it meets the essential and non-essential requirements for a filing date (with the exception of the fees).

The UKIPO will send an official letter giving a one-month deadline for any deficient applications. Failure to rectify the deficiencies in this time period will result in the application:

- deemed never to have been made, in respect of essential requirements; or
- treated as withdrawn, in respect of requirements which are not essential for obtaining a filing date

It is possible to extend the period for resolving filing or fee deficiencies by filing a Form TM9 with a fee of £100.

Examination

More substantive examination will be undertaken by an Examiner.

They will look at:

- Inconsistencies with the mark (including series objections)
- Applicant's legal personality clarification if they have question marks over the applicant's entitlement to hold property
- Absolute grounds - inherent problems with the trade mark applied for (Sections 1, 3 and 4 of the Trade Marks Act 1994) e.g. the mark is descriptive or non-distinctive
- Specification queries where goods and services are considered too vague, require clarification or have been put into an incorrect class
- Searches for earlier marks – the Examiner will search for similar/identical marks and if any are found they will be sent to you for your information. The Examiner does not

have the power to refuse applications on the basis of earlier marks but will inform you of the marks they feel are similar. If the application then proceeds to publication then the owners of these earlier marks will be notified of the application by the Examiner

They may have no objections and you will receive an acceptance letter. If there are objections or earlier marks raised, they will issue an examination report. There will be a two-month deadline to respond.

This deadline is extendable for a period of two-months. Unless the only issues raised are earlier marks because they are for information purposes only and not a ground for refusal.

An example Examination report:



Your Reference:
Trade Mark No:
Examiner: Richard Hayes
Direct Telephone: +44(0)1633814877
Date: 15 July 2021

Please reply by **15 September 2021** quoting the Trade Mark Number.

[Please click here to reply](#)

Dear Sir or Madam,

Trade Mark No:
Mark:
Owner:
Classes: 9,16,25,28,41

Examination of Trade Mark Application

I have examined your application under the Trade Marks Act 1994 and carried out a search of the relevant trade mark registers.

Search for earlier trade marks – for your information only

I have searched the relevant trade mark registers and found earlier trade marks that I think you should be aware of. My initial view is that your trade mark and your goods and services are similar to the earlier trade marks and their goods and services. Therefore the public are likely to confuse your trade mark with the earlier trade marks.

The earlier trade marks I found are listed at the end of this report.

I am not refusing to accept your application because of the earlier trade marks. Should you decide to proceed with your application I am obliged to inform the owners of the marks listed below, that your application will be published in our online journal.

If you proceed, your application will be published in the online Trade Marks Journal and anyone can oppose your application should they have grounds to do so. If such action were to be successful, this would likely result in a costs award against you. Further information can be found on our website:

ipo.gov.uk/tmoppose

Next steps

You can delete or limit the goods/services to reduce the risk of opposition by the owners of any earlier marks. Or, you can proceed with the application without making any changes.

If you disagree with my assessment of the application, you can write, e-mail or telephone me. My contact details are shown at the top of this letter. As this is not a formal objection to your application proceeding, I can only allow **one** opportunity for you to write to me on this issue.

If you do not reply by the date shown above, your application will be published in the online Trade Marks Journal, and notifications will be sent to the earlier trade marks.

Yours faithfully,

Richard Hayes

Trade Marks Registry

Options to respond to an examination report

Telephone the Examiner – for relatively minor changes, a chat with the Examiner may allow them to move an application forward. Generally, they would want something in writing, however.

Written response (see also Legal submissions below) – short written response can be used e.g. to change a term in a specification.

Add a class – If terms in the specification fall in another class(es) then it is possible to add class(es) to an application. It is necessary to pay a fee of £50 per class. You cannot add a class where items may be in another class but, at the same time, may also be covered by the specification as filed.

Division – This is a useful for isolating certain goods and/or services in an application (likely to be in dispute) while maintaining the original application for the remainder.

This does not, strictly speaking, overcome any objections. However, the application for the other goods/services can progress accordingly.

The goods and services of the divisional application must not overlap with the list of goods and services of the original application.

There are certain periods during which, for procedural economy or to safeguard third party rights, division is not admissible, but during examination it is fine.

A request to divide an application should be carried out on Form TM12 which carries a fee of £100.

You cannot use this form to divide a series of marks. Instead, you have to delete the marks from the application.

Legal submissions – more substantive legal submissions can be filed in response. These may address absolute grounds objections or challenge an Examiner's objections. You may want to explain why you do not think the earlier mark(s) should be raised, and you could delete goods/services to support this as another example.

Request a Hearing – alternatively, it is possible to request a Hearing before a senior UKIPO official to discuss the objections. This is a useful aspect of UK practice and it can be more cost-effective than filing legal submissions in writing.

Should a reply to an examination report not overcome all of the objections raised, the right to a Hearing remains.

Appeals

There are two routes of appeal: to the Court or to the Appointed Person, where an applicant disagrees with a maintained objection. The appeal would usually be lodged following a Hearing, although it is possible to make a direct appeal following the examination report. The Appointed Person is a senior lawyer who is an expert in IP law.

Appeals to the Appointed Person

In order to make the appeal the applicant must first apply to for a Statement of Grounds using Form TM5, which carries a fee of £100. The Hearing Officer will then issue a written decision outlining the legal basis for the rejection of the mark.

Only when there is a Statement of Grounds issued by the office can an appeal be made to the Appointed Person on Form TM55, which has no fee. The appeal must be filed within 28 days of the decision being issued. The TM55 must include a Statement of Grounds of appeal. It must specify whether, and in which respects, they wish the Appointed Person to reverse, set aside or vary the decision.

The appeal deadline can be extended by filing a Form TM9 with a fee of £100. Strong and compelling reasons are required to support such a request and it will be considered on its own merits.

The decision of the Appointed Person is final and no further appeals can be lodged. However, it is a relatively quick and informal process.

Appeals to the courts

The alternative to appealing to the Appointed Person is to make an application to the courts. This is a more formal and costly approach. The first court to hear a case would be the High Court. Any further appeals, on points of law, may be made to the Court of Appeal or the Supreme Court.

Acceptance and publication

If a mark is accepted it will then be advertised or published in the Trade Marks Journal. This gives third parties the opportunity to oppose registration of the trade mark if they feel they have grounds to do so. There is a two-month opposition period calculated from the date of publication.

A one-month extension of time is available, but only the party who filed the extension request can file opposition in the additional month.

As an alternative, a third party can file observations and this may result in re-examination of the application and grounds for refusal being raised.

Important deadlines

Filing deficiencies	One month - extension requires TM9/£100
Responding to examination report (inherent objections/specification objections)	Two months – extensions of time possible
Responding to examination report (earlier marks only)	Two months – no extensions possible
Deadline to oppose	Two months – one-month extension possible
Deadline to appeal	28 days - extension requires TM9/£100 and strong and compelling reasons

Registration, duration, use requirements and marking

If the opposition period expires without incident or any oppositions or threatened oppositions are resolved, then a mark will be registered and a Certificate of Registration issued.

A mark is registered for 10 years from the filing date and can be kept in force indefinitely, as long as the requisite renewal fees are paid.

A trade mark will become vulnerable to cancellation (revocation) if it is not used for a continuous period of five years. This period is calculated from the date of entry in the Register (the date the Certificate is issued).

You can use a registered trade mark symbol ® to deter others from using your mark, but it is a criminal offence in the UK to use the ® symbol if your trade mark is not registered, including if you only have a pending application.

The TM symbol ™ can be used at any point.

Scam notices

Once a mark is filed, it is on public register. This has resulted in applicants receiving an increasing amount of unsolicited mail from companies requesting payment for trade mark and design services such as publication, registration or entry in business directories that provide no additional legal benefits.

It is important to be vigilant regarding these to ensure payments are not made – e.g. alert clients, alert those in accounts. More information from the UKIPO:
<https://www.gov.uk/government/collections/warning-misleading-invoices>.

Activities

1. Particularly, if you have not filed many UK trade mark applications, go to <https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees> and prepare a trade mark application. Be imaginative, choose your brand and choose the products.

When you reach the 'Check application details' screen you can download your application as a PDF document.

Do NOT click further and do NOT make payment of the fees!

2. You are working on UK Application No. UK0003468912 YOU JAMMY... in Class 30 covering "doughnuts" and Class 32 covering "beers" in the name of Jammy Gillespie Holloway Limited and you want to divide Class 30 from the application to allow Class 32 to proceed. Go on to the Trade mark forms and fees section of the UKIPO's website a complete a Form TM12.

You can put your own name and address as the 'Person making this request' and you can also be the 'Recorded representative for the owner'.