

IPO Transformation programme: second consultation
Response from Chartered Institute of Trade Mark Attorneys
31 October 2023

Introduction

Question 1. What is your name?

Question 2. In what capacity are you responding to this consultation?

Ian Bartlett, Beck Greener – ibartlett@beckgreener.com

On behalf of the Chartered Institute of Trade Mark Attorneys (CITMA)
(Chair, Law & Practice Committee)

Online Access and Confidentiality

Question 3. What would be the impact of having an online inspection service for trade marks and design documents?

CITMA welcomes the prospect of practitioners and UKIPO account holders having the ability to inspect and download trade mark and design documents online. We think the impact should be positive subject to the considerations set out below.

As the IPO will know, such functionality has been provided by the EUIPO to its account holders for many years. We believe the experience has been almost universally positive.

We understand the proposed default position to be that all documents relating to a given published application or registration, or to a process relating to such properties (eg renewals, assignments, licences, changes of name, oppositions, revocations, invalidations, etc) would be available for online inspection and for download (“Access”) unless excluded by properly supported reasons of confidentiality, or for other compelling public or private interests and immunities. That right to Access would include, we assume all filings, all outgoing actions, and decisions, and all incoming responses including evidence and submissions, concerning the property in question.

We would, however, make the following points:

- i. **Right to Access.** We submit that the right to Access should be limited to UKIPO account holders. Particularly given the considerable resources which the government is investing in this project, the right to hold an account should be limited, we contend, to individuals who are citizens of, or entities who have a real and effective commercial establishment, in the UK. It should be noted that such a requirement would be less onerous than that operated for many years by the EUIPO where the right to Access is generally limited to rights holders and authorised EUIPO lawyers and qualified representatives.

- ii. **Real Time** Unless there is a genuine claim to confidentiality etc. we think the IPO should aim at making documents available for Access within a short time scale, that is, within at most 24 hours from filing or issue, such that activity on a given case can be followed in real time.
- iii. **Copyright** We assume that appropriate provision will be made and carried over from the current “uncertified copy” procedures to prevent copyright or other IP rights being asserted in such a way as generally to negate or interfere with Access per se. But see comments concerning “abuse” below.
- iv. **Fees** We assume that the IPO, rightly in our view, is not intending to charge a fee for Access.
- v. **Alerts** We would suggest, if functionality allows, the ability of account holders to set alerts such as to be notified on a given case, of the availability of new documents.
- vi. **International Designations under Madrid and Hague and International filings** We assume that Access will apply not only to national UK cases but also to UK designations under Madrid and Hague as well as to Madrid and Hague filings originated through the UK IPO.
- vii. **Abuse** We assume that the IPO will maintain a log (including Account Names and their IP addresses) of those Accessing documents, and other procedures, in order to deter scraping, improper data mining and other potential forms of abuse. There is a legitimate concern amongst practitioners that for instance, statements of case, skeleton arguments and written submissions in contentious proceedings may, without the consent of the authors, be “mined” for incorporation into commercial precedent libraries and AI engines.

Question 4. Should the designs provision which prevents a document from being inspected until the period of fourteen days beginning after the day it was filed at or received by the IPO has passed, be removed?

CITMA supports the proposition that there should be no automatic delay to documents becoming available for Access for either published trade marks or published designs, unless there is some compelling reason for withholding Access (eg confidentiality).

Question 5. What are your views on allowing someone who is not the filer to request confidentiality of information filed at the IPO in respect of trade marks?

CITMA supports the proposition that parties, other than filers, should be able to request confidentiality in respect of documents filed at the IPO.

While this is likely to be a relatively rare occurrence, there are situations in which the other party or a non-party might otherwise be compromised. That might happen, for instance where a non-party becomes aware that a party intends to file in ex parte or inter partes proceedings a document, such as licence agreement, or a settlement agreement, containing the non-party’s confidential information.

Question 6. What are your views on allowing a request for confidentiality to be filed at a date later than the document was filed, in respect of trade marks?

CITMA supports the proposition that applications for confidentiality orders made either by parties or non-parties should be entertained even after a given document has been made Accessible. We agree that the document in question should be removed from Access whilst the request was considered. As stated in the consultation it may be, as a result of Access, that, particularly a non-party, will come to realise that the confidentiality of its information was being compromised.

Question 7. Do you have any other views on the proposals to amend design and trade mark legislation to harmonise public availability of documents and requests for confidentiality?

CITMA is supportive of the proposal set out in the consultation to harmonise Access to documents relating to published trade marks and published designs.

Series of Trade Marks

Question 8. Do you find series marks to be useful? Please explain why.

Question 9. What are the main drivers for you or your clients when deciding to apply for a series of marks?

Question 10. What are the legal and practical benefits of series marks?

Question 11. What is your view on the proposal to reduce the number of marks which may constitute a series?

Question 12. Do you have any views on which, a maximum of four or two marks, would be more appropriate?

Question 13. What are the potential impacts of the UK ceasing to offer series marks?

Question 14. Do you foresee any practical issues for trade mark holders with this proposed change which cannot be mitigated through the existing infringement provisions and/or existing ability to apply for multiple trade marks?

Question 15. Which of the options presented do you think the government should take forward to balance the needs of rightsholders whilst addressing the current issues faced by series marks? Please explain why.

There is a range of opinion amongst CITMA members as to the extent to which the provision for registering series of marks should be maintained. Having said that, there is no strong view amongst CITMA members that the provision should be abolished or modified in the manner contemplated by the consultation – to the contrary, many members have expressed concerns that the provision will be abolished or cut back. We would therefore prefer to answer questions 8 to 15 of the consultation as follows:

The factors mentioned by our members which bear upon maintaining the current series provisions, are set out below:

- i. A series registration guarantees that the variants in the registration are protected.

Where marks differ to any extent at all there must logically be a range of marks which would conflict with the registration in so far as that registration protects one of the marks in the series, yet would not infringe one or more of the other marks in that series. That range of marks might well be very narrow. However, a series registration must, as a matter of logic, increase, even narrowly, the scope of protection.

- ii. A series registration, effectively, guarantees that genuine use of the mark in one or more of the formats shown in the series would support the registration against non-use.
- iii. Item 2 above applies in particular in respect of monochrome, black and white and colour variants and therefore has particular application given the effect of the findings in the *SpecSavers* judgments).
- iv. The ability to file a series of marks in the UK is considered useful for preserving flexibility in “priority” filings. The applicant may have multiple graphical treatments for a new mark but it may yet be undecided as to which will be the main version(s). The ability to file a series covering different variations in the originating UK application therefore provides the applicant with a six-month period to decide which of the variants in the series to extend to overseas filings claiming the priority of the originating UK application. This makes the UK an attractive venue for such originating applications.
- v. The provision is attractive for applicants and overseas applicants particularly those from jurisdictions where series registrations are not allowed. It can be argued that maintaining the provision would continue to support the UK’s strong reputation for IP protection.
- vi. Preserving the provision for series of marks is consistent with the position in other common law jurisdictions, including for instance, Singapore, Hong Kong, Ireland, Australia and New Zealand, where, it is understood, a series of marks if they meet given criteria, are also registrable.
- vii. In addition, there is a number of jurisdictions, including Gibraltar and St. Helena, where registered trade mark protection is dependent on the existence of an underlying UK registration, including a series mark registration. A change to the system in the UK, could therefore have an effect on the protection available in territories outside the UK.

CITMA recognises that the current system, like any other, is open to mis-use. The consultation document refers to the filing of dissimilar marks. The series provision as it currently stands, provides the opportunity for an applicant to explore whether one of the marks in the series might be objectionable on absolute grounds without having to pay an additional application fee, and without the risk of it being shown clearly on the register that the “questionable” application did not succeed.

Whether this in fact is a mis-use is a matter of debate. However, the filing of a series of marks for this purpose, in the knowledge that they are not a proper series, is not in our experience the norm and should not be a significant factor when considering whether or not to preserve the provision. It might however, be addressed by

reintroducing the ability of an applicant to divide marks in a series, on payment of a fee, rather than forcing a deletion.

CITMA also recognises that for inexperienced applicants the provision for registering a series of marks may be confusing and its legal consequences, misunderstood. We think that can be dealt with by the providing additional information to prospective applicants before they file and during the application process itself.

Overall, therefore, CITMA seeks no change to the current provisions for the registration of a series of marks and the “flexibility” which the current system enables. We also appreciate that a change to the fee structure might address some of the IPO’s concerns.

Supplemental protection certificates and Inventor details

Question 17. What are your views on aligning the SPC payment periods with renewal payment periods for other IP rights?

Question 18. Do you prefer keeping both the standard period and the later grant period the same or would you prefer them to differ? Please explain why.

Question 19. Should the IPO stop including full addresses for inventors in the patents register?

Question 20. If the government were to implement this change, are you in favour of option 1 or 2 above? Please provide your reasons.

Question 21. If option 2 were implemented, should patents legislation require the applicant to provide contact details for the inventor, if the IPO needs to contact the inventor? Please provide your reasons.

Questions 17 to 21 concern patents and are therefore beyond CITMA’s remit.

Mediation

Question 22. What do you think of:

- the idea of a Mediation Information and Assessment Meeting (MIAM)?
- more robust use of hearing officer powers to direct that parties attempt to mediate, and to stay proceedings?
- more routine awarding of costs against a party if they unreasonably fail to engage in mediation?

Mediation can sometimes be an effective means of alternative dispute resolution. However, it is common amongst represented parties in IPO tribunal proceedings to engage in settlement negotiations. It is our experience that professional representatives in the UK are not only highly skilled but they actively encourage their clients to pursue settlement where reasonably possible. In a significant majority of cases such negotiations are successful and lead to a final resolution.

It should also be noted that contentious proceedings at the UKIPO will often be part of a wider, multi-jurisdictional dispute and will often concern not only the registration of trade marks but also the use of the marks concerned and injunctive or threatened injunctive proceedings. It is therefore common that agreements settling IPO proceedings will also make provision relating to the use of the marks and will do so on an international basis. IPO mediation in complex multijurisdictional and potentially injunctive disputes, might therefore require an extended skillset and field of experience.

Subject to the above, CITMA is broadly supportive of there being one or more points in contentious proceedings at which those proceedings would be paused and the parties encouraged to consider settlement. That might act as a catalyst for corresponding negotiations the parties had not already been considered or attempted.

However, CITMA is against the proposition that the tribunal should have the power to “require” that parties “consider” mediation.

In CITMA’s view, such a power would in effect be redundant – a party may have a variety of legitimate reasons to consider but reject mediation or any other form of ADR. It might for instance not be willing to make the concessions that a settlement pursuant to a mediation would inevitably involve; or it might prefer to obtain a decision of the tribunal to support proceedings in another territory, or before another tribunal (for instance an infringement court following IPO invalidation proceedings).

By the same token, CITMA is also against the proposition that the IPO tribunals should routinely award costs against a party if they unreasonably fail to engage in mediation.

First, penalising a party in the manner proposed would have the effect of breaching that party’s right to pursue its claims as it sees fit. As a principle of fundamental justice, a party should generally be entitled to pursue its claim to judgment unless that claim is summarily dismissed as being bound to fail, is vexatious or should otherwise be excluded. Each of these latter eventualities is capable of being handled via the tribunal’s current case management powers.

Second, as the parties are frequently reminded, the IPO tribunal is “low cost” as is reflected in the limitations on the amount of evidence that may be filed, and the tribunal’s general reluctance to allow cross examination of witnesses or disclosure. Hearings, if they are appointed, generally last half a day at most. To try to require parties to mediate and therefore enter into settlement agreements in such circumstances, under threat of above-scale costs orders, would appear heavy handed and out of step with the current low-cost ethos of the IPO tribunal, at least in relation to trade mark and design matters.

Third, even in injunctive proceedings before the court, (where the cost of taking a case through to judgment is often significantly greater than proceedings before the IPO, and which would therefore significantly outweigh the cost of mediation), it is understood that the court rarely considers the parties’ enthusiasm for ADR to be a significant factor when costs come to be considered.

Question 23. What do you think is the optimum point (before or during proceedings) to offer mediation?

As stated in our answer to Question 22, CITMA is broadly supportive of their being a point in tribunal proceedings at which the parties are encouraged to consider mediation and other forms of ADR. CITMA considers that the first optimal point for that would be the closure of the pleadings phase, that is, concurrent with issuing of a preliminary indication (if any). In this respect, it might be appropriate to set first evidence round at 3 months rather than the current 2 months in order to facilitate the consideration of ADR.

There are some cases of course, where it is only following the evidence phase that the parties' prospects of success can properly be assessed and which therefore, might in turn inform the parties' prospects for settlement and what might be the terms of any such settlement. Where evidence is filed there might therefore be a second pause in the proceedings at the end of the evidence phase where the tribunal reminds the parties again of the possibilities for mediation and ADR generally and allow a period for that to be explored.

Question 24. Are there particular types of proceedings where mediation should be more actively encouraged? For example where the parties are unrepresented, or concerning particular IP rights or on particular grounds?

CITMA recognises that unrepresented parties may sometimes have an unrealistic view of the merits of their case. In that respect it is our members' experience, that engaging in meaningful settlement discussions with such parties can sometimes be challenging. It is our experience that professional representatives will generally advise their clients to explore a negotiated resolution where reasonably possible.

For the reasons stated, CITMA is against the tribunal sanctioning parties that refuse to engage in mediation, whether those parties are represented or not. As also stated, CITMA does however, support the view that the tribunal should pause the proceedings at an appropriate point or points to remind the parties of the possibility of mediation and ADR. However, we do not consider that unrepresented parties should be treated any differently in this respect to parties that are represented and further, we do not think that the proposal should be focussed on any particular IP right or any particular ground.

Question 25. Do you have other views in relation to mediation and resolving disputes at the IPO tribunal?

We believe that this is covered by our answers given above. As mentioned, in our experience represented parties will actively and seriously consider settlement where appropriate. It may therefore be constructive to encourage unrepresented parties to seek professional advice and representation.

Lastly, there is a perception amongst CITMA members that persuading the tribunal to agree a jointly requested stay in contentious proceedings is more onerous than it should be, and that even after the extended cooling off period has expired, stays to promote settlement should be looked on more favourably than at present. We refer in this regard to the EUIPO procedure where stays of up to 2 years are granted upon the parties' request, even after the end of the 2-year cooling off period. Many EU

cases are settled during this period of extended suspension avoiding the tribunal having to expend resources in issuing a decision.

END.