



LATEST IP UPDATE FROM POTTER CLARKSON

NEW UK TRADEMARK APPLICATION FEES AND SERVICES

On 1 October 2009, the UK Intellectual Property Office (UK IPO) is introducing a number of changes regarding trademark applications.

Reduction in official filing fee for e-filing

At present, the official filing fee for filing a trademark application is the same, regardless of whether the application is filed by fax, by post or via the on-line application system.

From 1 October 2009 a £30 reduction in the official filing fee will apply to applications filed via the on-line system.

The reduction will only apply where full payment of the official filing fee is made at the time of filing, and not in situations where a decision has been taken to pay the official fee after filing and during the "grace" period.

It is our firm's policy to file all UK trademark applications via the on-line system. Accordingly, unless a decision has been taken to defer payment of the official filing fee, all UK applications filed through us should qualify for the reduced fee.

The official filing fee for filing an application via post or by fax, remains at the current level.

"Right Start" application service

"Right Start" is a new trademark application service which may be used as an alternative to the standard application service. With a "Right Start" application only half of the standard official filing fee is paid on filing the application (which is filed on-line).

The application will then be examined to determine whether it meets the requirements for registration, and an Examination Report will be issued by the UK IPO. If it is decided to proceed with the application, the balance of fees must be paid within 14 days of the date of the Examination Report. If it is decided not to proceed with the application, no further fees will be payable and the application will be deemed abandoned. A refund of the "half fee" already paid will not be made.

It should be noted that the on-line reduced fee outlined above does not apply to "Right Start" applications.

This service will be of particular interest for applicants who have trademarks which might possibly encounter inherent registrability objections, and will enable the applicant to obtain a quick official opinion as to whether the mark is likely to be acceptable for registration. If there are insurmountable objections raised against the application it will be possible to abandon the application without having paid the full official filing fee.

Applications for a "series" of marks

A "series" application consists of a number of marks that are essentially the same and which do not have significant differences. An example of a series application (consisting of two trademarks) would be the trademark presented in capital letters and in lower case. At present, it is possible to apply for an unlimited number of marks in a "series" and there is no additional cost involved.

For applications filed on, or after, 1 October 2009, the following changes will apply:

- It will only be possible to file up to a maximum of six marks in a "series";
- The application fee will cover the first and second marks in the "series". However, for each additional mark in the series (up to the maximum of six) there will be an additional £50 official filing fee, per mark;
- At present, if the Examiner finds that certain marks do not constitute a valid "series", it is possible to divide those marks from the application, and pursue registration of those marks under cover of a separate application(s). Once the new practice is adopted, it will no longer be possible to divide an application on the basis of objectionable marks in a "series"; it will only be possible to delete marks from the application until a valid application remains. No refund of any "series" fee will be made in these circumstances.

Accordingly, careful consideration needs to be given when filing for a "series" of marks, and it may be preferable in certain circumstances to file separate applications for the various marks.

It should be noted that the new "series" official fee will still need to be paid in full for each mark in the "series" (beyond the first two marks in the series) in the case of "Right Start" applications as outlined above.

Extension of time fee

The official fee for requesting an extension of time in any Registry *inter partes* proceedings, or to extend certain deadlines in examination matters, will be increased from £50 to £100.

For further information on these matters, please contact Sanjay Kapur, John Peacock, Jackie Tolson or Lucy Mills.

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The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem. Please note that all our Newsletters can be found on our website: www.potterclarkson.com.

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