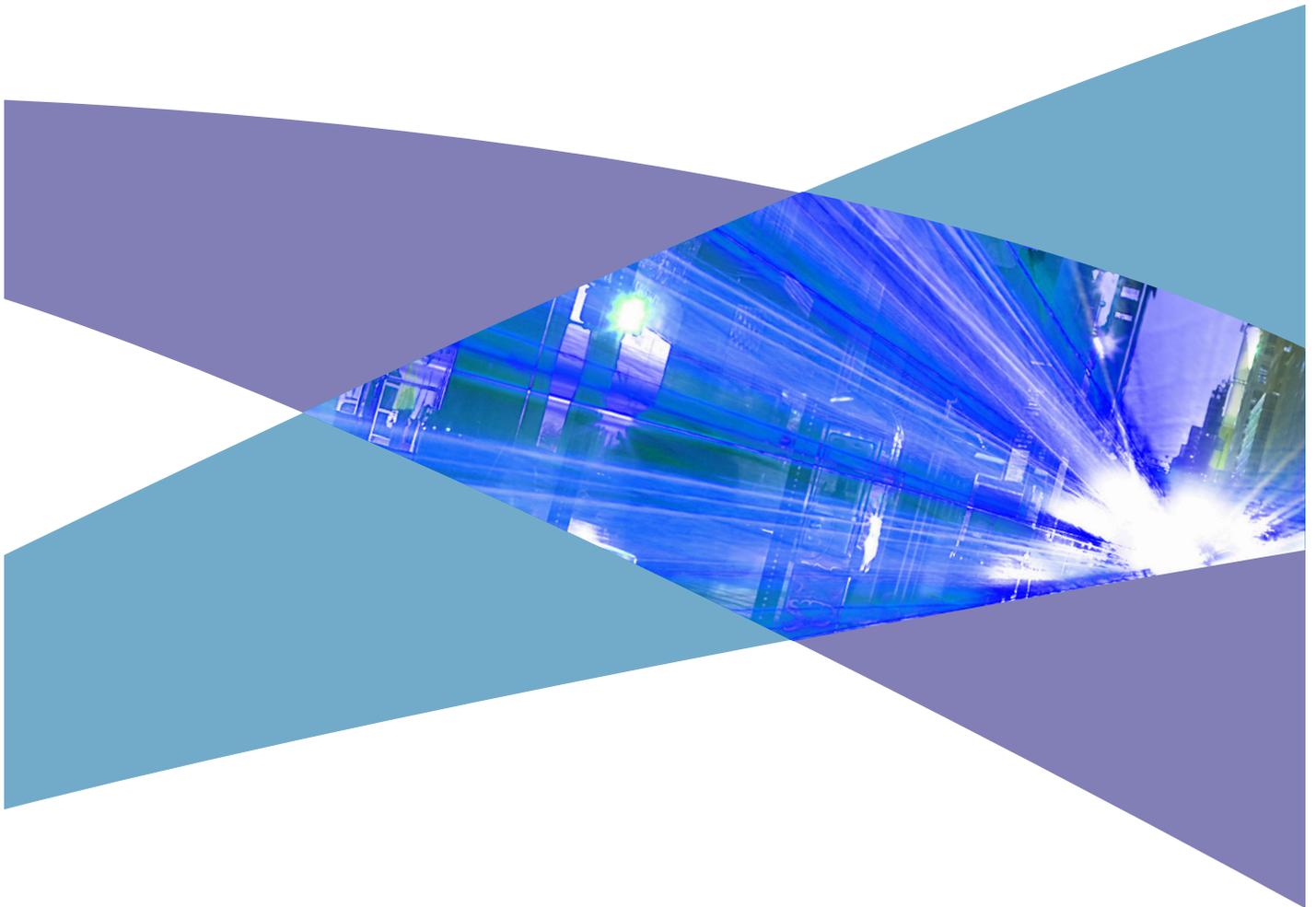




Intellectual  
Property  
Office

# Response Document:

Fast Track Examination of Trade Marks

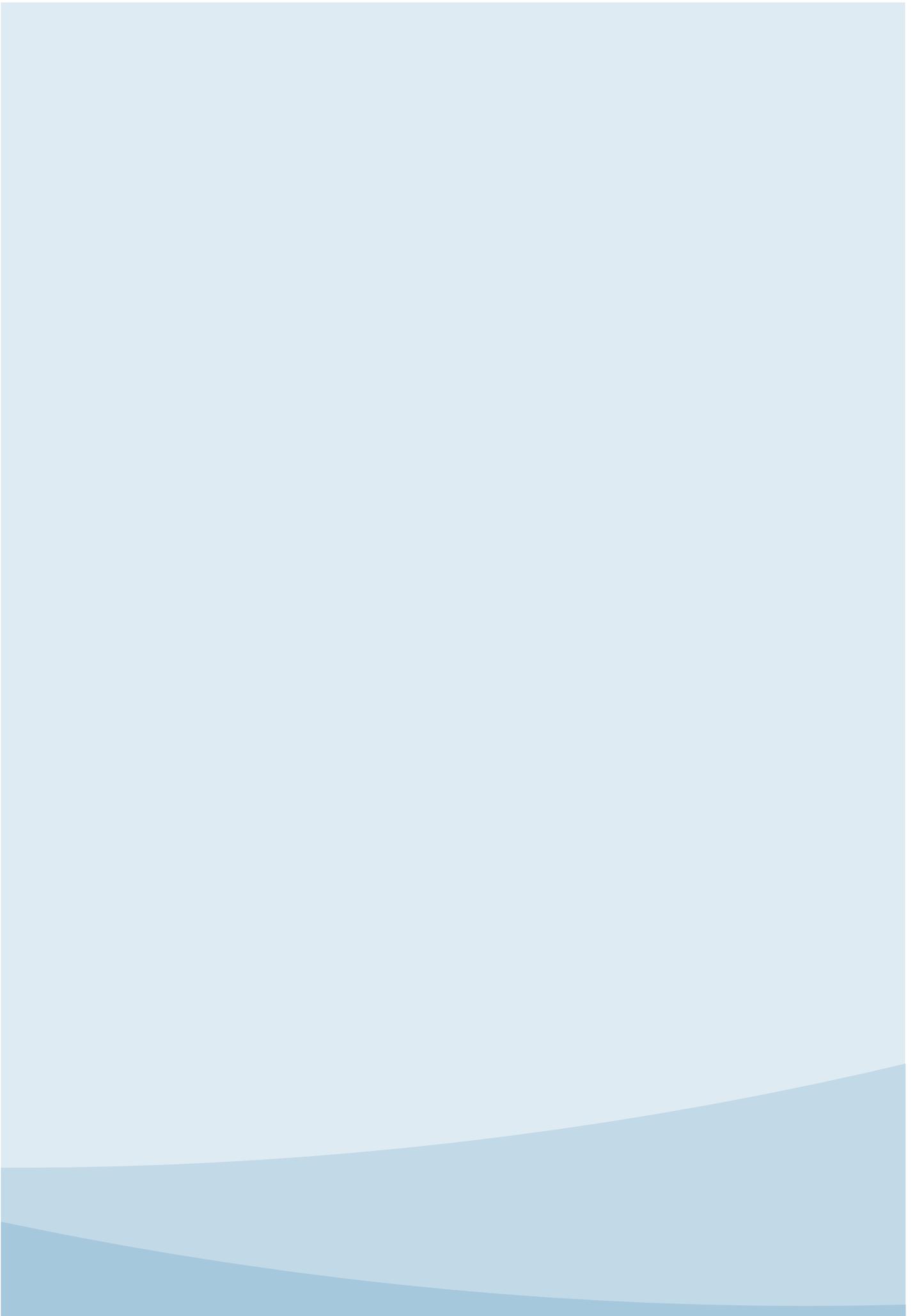






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## Executive Summary

This document sets out Government policy in light of the recent consultation on the potential reintroduction of a fast track examination procedure for trade marks. It indicates the Government's intention not to reintroduce this service, based on the lack of demand identified in the responses that were received.



## Background

In April 2008, the Intellectual Property Office introduced a fast track application procedure, for trade marks. This was in response to recommendations in the Gowers Review<sup>1</sup> suggesting faster processing of trade marks (and patents) subject to the payment of a higher fee as a way to speed up the trade mark registration process.

Prior to the introduction of the fast track procedure no form of accelerated examination of marks was available. Applications were examined in the order in which they were received. Whilst in many cases the length of time to registration met customers' needs, there were instances when more speedy examination was preferable. For example, if businesses needed shorter timescales for product launch, or legal proceedings, etc.

Throughout the lifetime of the fast track procedure the Office received an average of 20 fast track applications per month (as compared to 2600 standard applications at the time).

In 2009, the fast track examination service was suspended. This was partly due to the low take up, and partly because of the fact that, at the time, the Office was examining within 5-10 working days using the standard procedure. Consequently, it was difficult for businesses to justify the £300 premium for the accelerated service.

In December 2012, the then Minister for Intellectual Property, Lord Marland, announced that the Office would consider a reintroduction of the fast track procedure as a further way to support business and encourage economic growth. However, the introduction of a new electronic case management system in April 2013, led to a change in circumstances, with applications again being examined in relatively short time periods.

Consequently the Government considered that it was now an appropriate time to gauge customers' views on whether there is a genuine demand for the reintroduction of a fast track service.

The IPO launched a consultation<sup>2</sup> on 18 February 2014, which closed on 15 April 2014. 9 responses were received. Official responses came from trade mark attorneys (4), IP professionals (2), professional representative bodies (2), and other government departments (1). Some respondents commented on the specific questions whereas others responded more generally about the proposal in its entirety.

This document summarises the responses received to the proposal and details our conclusions and next steps. We have taken all individual points into account when reaching our conclusions.

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1 The Gowers' Review, available online: <http://www.official-documents.gov.uk/document/other/0118404830/0118404830.pdf>

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2 Available online: <https://www.gov.uk/government/consultations/fast-track-examination-of-trade-marks>



# Responses

## Question 1

**Did you make use of the previous fast track application procedure for trade marks? If not, why not?**

The majority of respondents to this question had little, or no, experience of using the previous fast track application service.

One respondent, who had used the service, stated that they had been deterred from doing so regularly due to the poor quality of examination they had received as compared to the routine application procedure: unfounded objections were raised which were overturned only after significant delay.

A legal respondent outlined that they had not used this service as there was no demand amongst their clients for expedited examination. They stated that the priority for customers is to submit the application and receive an early priority date. Another reiterated this view stating that fast track examination of trade marks is rarely a critical matter for clients.

Other responses stated that the fast track service offered little benefit to customers, especially when considering the high costs associated, and the fact that the IPO examiners conduct routine examinations in a “fast and efficient” manner.

## Question 2

**If you used the fast track application procedure how many times did you do so/how often in relation to use of the standard application procedure?**

The respondents who had used the fast track procedure stated that they had done so only a small number of times as compared to all also citing regular use of the routine procedure. One respondent highlighted the disparity between their use of the two procedures, explaining that they had used the fast track on just one occasion whereas they use the standard procedure up to several times a week.





### Question 3

**If you used the fast track procedure in what circumstances (business or otherwise) were you prepared to pay a premium for a fast track application?**

Only one respondent addressed this particular question. They stated they had used the fast track procedure in a situation where the client wished the application to proceed to registration as soon as possible so that the mark would be registered when the product bearing the mark was launched.

### Question 4

**Would you make use of a fast track procedure at 5 days for £300? If not, why not?**

All respondents indicated that they would not make use of a fast track procedure where examination was completed in 5 days. There were a number of reasons for this.

Some respondents stated that there is little need for a fast track service as the IPO currently examines in a relatively short period of time. They outlined that there is little business need for such a fast turnaround as routine examination is more than sufficient to meet user needs. One respondent further stated that granting a registration in less than 6 months, where priority periods run for 6 months, and where registration is no defence to infringement, would not give peace of mind to a company looking to launch any new product.

Other respondents cited cost as the reason why the fast track procedure does not appeal to them or their clients. The £300 fee for using the procedure was thought to be excessive for the benefits of a 5 day service. Some suggested that such a fee would be easier to justify if examination happened much more quickly than at present, suggesting that a 48 hour examination may lead to the fast track procedure being warranted.





## Question 5

**If yes, in what circumstances (business or otherwise) would you be prepared to pay such a premium?**

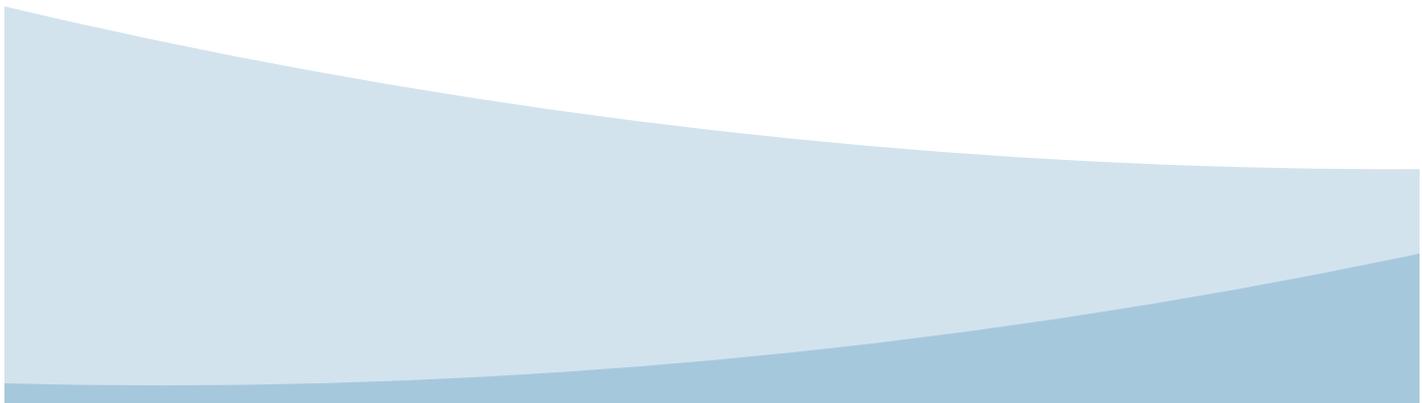
As aforementioned, all of the respondents indicated that they would not use the fast track examination procedure if it were reintroduced. It was stated that the only circumstances in which a 5 day examination may add value is where a separate transaction is affected. For example, where diligence identifies a corporate name or key product brand as unregistered and where there are borderline issues on absolute grounds which can be resolved by an early examination. However, the abandonment of relative grounds examination means that fast track examination adds very little to advice which solicitors or agents can give directly on absolute grounds points.

As aforementioned, two respondents did state that despite not intending to use the fast track if it were reintroduced on the terms outlined in the consultation document, they would be willing to pay a premium for this service, if the time was reduced further, so that fast track examination was completed within 48 hours.

## Question 6

**The current examination procedure fluctuates based on demand between 10-20 days. What would you consider to be an optimum period for receiving the first examination report?**

All respondents to this question agreed that an examination time of one month, or less, is reasonable. One respondent highlighted that examination within 1 month would beat, or match, offices in other states across the world. The majority of respondents agreed that examination between 10-20 days would be optimum.





## General Comments

Alongside answers to specific questions some respondents also provided more general comments. One respondent stated that they believe the low use of the previous procedure demonstrated how unnecessary it was in the first instance, adding that over the past years, the speed of examination has increased further still thus making a fast track service redundant. This particular respondent believed that it would be better to dedicate the money and resource into making improvements to the routine examination system, for instance improving the system for filing forms and letters electronically.

Other respondents outlined their hesitation surrounding the reintroduction of the fast track procedure, stating that fast examination does not guarantee acceptance and does not ensure that no opposition is raised. Fast track examination is limited in the effect it will have on the time to registration due to the two month opposition period, which cannot be moved without significant legislative change.

## Summary

The responses that were received outlined that users are content with the routine examination procedure, and associated timescale, which is currently offered by the Office. Respondents indicated that an ideal time to examination of trade mark is a period of between 10-20 days. The Office currently examines within that bracket, in less than 20 days.

Furthermore, whilst the majority of respondents indicated that they would not be opposed to the reintroduction of a fast track service, all indicated that they would not personally use it, and did not anticipate any real demand amongst colleagues, or clients.

Several respondents believed that the take up of a fast track procedure may be increased if the period of exam was faster than suggested, with examination being completed within 48 hours. An expedited service with such a short turnaround would not be feasible at this time. However, the Office is committed to improving our service offerings, and will keep this suggestion in mind should circumstances change in the future.





## Conclusion

The Trade Mark Rules 2008<sup>3</sup> require a fast track service to be provided if examination periods exceed 10 business days (Rule 5(6)). However, the Government has listened to feedback and consequently decided that, due to the lack of demand amongst users of the system, the fast track service will not be reinstated at this time. The Rules will be amended in due course to provide greater flexibility as to when the service can and should be offered.

As promised in the consultation document, the Government will keep the issue under review and reconsider the matter if the time for examination were to reach levels where a fast track procedure would be more attractive.



## List of Respondents

Abigail Woolhouse (Stratagem IPM Ltd)

Daniel Smart (Colman & Smart)

Edmund Harrison (Mewburn Ellis LLP)

Institute of Trade Mark Attorneys (ITMA)

Law Society of Scotland

Squire Sanders

Tony Brown (UK Trade and Investment)

Tata Steel

Vanessa A.B. Lawrence (A. A. Thornton & Co)





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