

2009 No. 2089

INTELLECTUAL PROPERTY

**The Trade Marks and Trade Marks and Patents (Fees)
(Amendment) Rules 2009**

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| <i>Made</i> | - - - - | <i>23rd July 2009</i> |
| <i>Laid before Parliament</i> | | <i>30th July 2009</i> |
| <i>Coming into force</i> | | |
| <i>Rules 20 to 22</i> | | <i>4th October 2009</i> |
| <i>Remainder</i> | | <i>1st October 2009</i> |

The Secretary of State makes the following Rules in exercise of the powers conferred by sections 41, 78 and 79 of the Trade Marks Act 1994(a) and section 123 of the Patents Act 1977(b).

In accordance with articles 5 and 7 of the Department of Trade and Industry (Fees) Order 1988(c), the Secretary of State has taken into account the functions and matters specified in Parts 2 and 4 of Schedule 1 and Parts 1 and 2 of Schedule 2 to that Order.

In accordance with paragraph 24 of Schedule 7 to the Tribunals, Courts and Enforcement Act 2007(d), the Secretary of State has consulted the Administrative Justice and Tribunals Council before making these Rules.

Citation and commencement

1. These Rules may be cited as the Trade Marks and Trade Marks and Patents (Fees) (Amendment) Rules 2009.

2. Rules 20 to 22 of these Rules come into force on 4th October 2009 and all other rules come into force on 1st October 2009.

Amendments to the Trade Marks Rules 2008

3. The Trade Marks Rules 2008(e) are amended as follows.

4. In rule 2(1), for the definition of “the Office” substitute—

(a) 1994 c. 26.

(b) 1977 c.37. Section 123 was amended by the Copyright, Designs and Patents Act 1988 (c.48), Schedule 5, paragraph 29, and the Patents Act 2004 (c.16), Schedule 2, paragraph 26.

(c) S.I. 1988/93, amended by S.I. 1990/1473, both of which were made under section 102 of the Finance (No.2) Act 1987 (c. 51).

(d) 2007 c.15.

(e) S.I. 2008/1797, to which there are amendments not relevant to these Rules.

““the Office” means the Patent Office which operates under the name “Intellectual Property Office”;

5. In rule 5, omit paragraph (1) and insert—

“(1) An application for the registration of a trade mark (other than a transformation application, which shall be filed on Form TM4) shall be filed on Form TM3 or, where the application is filed in electronic form using the filing system provided on the Office website, on Form e-TM3.

(1A) Where an application is filed on Form TM3 (a “standard application”) the application shall be subject to the payment of the standard application fee and such class and series fees as may be appropriate.

(1B) Where an application is filed on Form e-TM3 (an “electronic application”) the application shall be subject to the payment of the e-filed application fee and such class and series fees as may be appropriate, which shall be payable at the time the electronic application is made and if they are not so paid the application shall be subject to the payment of the standard application fee referred to in paragraph (1A) and such class and series fees as may be appropriate.”.

6. In rule 5, at the beginning of paragraph (2) insert “Subject to paragraph (6)”.

7. In rule 5(3), for the words “Form TM3 which shall be filed electronically using the filing system provided on the Office website, or by such other means as the registrar may permit in any particular case,” substitute “Form e-TM3”.

8. In rule 5, after paragraph (5) add—

“(6) Where it appears to the registrar that the period (the “routine period”) within which applicants are routinely notified of the outcome of an examination under section 37 is equal to or less than the period specified in paragraph (5), the registrar may suspend the right of applicants to file a request for expedited examination until such time as the routine period exceeds the period specified in paragraph (5) and the registrar shall, in each case, publish a notice on the Office website to this effect.”.

9. In rule 13(2), for the words “one month” substitute “14 days”.

10. In rule 26(1), for the words “for a division” substitute “to divide the specification”.

11. In rule 28, omit paragraph (1) and insert—

“(1) An application may be made in accordance with rule 5 for the registration of a series of trade marks in a single registration provided that the series comprises of no more than six trade marks.

(1A) Where an application for registration of a series of trade marks comprises three or more trade marks, the application shall be subject to the payment of the prescribed fee for each trade mark in excess of two trade marks.”.

12. In rule 28, omit paragraphs (3), (4) and (7).

13. In rule 77(2)(a), after “extension” insert “relates to a time or period other than one specified under rule 13 and”.

Amendments to the Trade Marks (Fees) Rules 2008

14. The Schedule to the Trade Marks (Fees) Rules 2008(a) is amended as follows.

15. In the entry “TM3 – Application for registration of a trade mark (rule 5) or a series of trade marks (rule 28) – 200”, before “Application” insert “Standard”.

(a) S.I.2008/1958.

16. In the entry “TM3 – Request to the Registrar for expedited examination of application for registration of a trade mark (rule 5(2)) – 300”, for “TM3” substitute “e-TM3” and before “application” insert “electronic”.

17. In the entry “TM3 – Class fee (rule 5), for each class over one – 50”, after “over one” insert “contained in a standard application”.

18. After the entry “TM3 - Class fee (rule 5), for each class over one – 50” insert the following—

| | | |
|-------|---|-----|
| “TM3 | Series fee (rule 28(1A)), for each trade mark over two contained in a standard application | 50 |
| e-TM3 | Electronic application for registration of a trade mark (rule 5(1B)) or a series of trade marks (rule 28) | 170 |
| e-TM3 | Class fee (rule 5), for each class over one contained in an electronic application | 50 |
| e-TM3 | Series fee (rule 28(1A)), for each trade mark over two contained in an electronic application | 50” |

19. In the entry “TM9 – Request for extension of time (rule 77(2)) - 50” for “50” substitute “100”.

Amendments to the Patents (Fees) Rules 2007

20. The Patents (Fees) Rules 2007(a) are amended as follows.

21. In rule 3, at the end of paragraph (1)(b) insert “ (except where an application is filed in electronic form or using electronic communications in accordance with directions given under section 124A and the application is accompanied by the fee, in which case the application fee is £20)”.

22. After rule 3 insert the following rule—

“Electronic filing fee reduction

3A. Where Form 9A or 10 is filed in electronic form or using electronic communications in accordance with directions given under section 124A, the fee specified in Schedule 1 in respect of a request for a search in accordance with rule 27 of the 2007 Rules or a request for a substantive examination in accordance with rule 28 of the 2007 Rules shall in each case be reduced by £10.”.

Transitional Provisions

23. Rule 12 shall not apply to an application for registration of a series of trade marks which was filed before 1st October 2009.

23rd July 2009

David Lammy
Minister for Higher Education and Intellectual Property
Department for Business, Innovation and Skills

(a) S.I. 2007/3292.

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Trade Marks Rules 2008 (SI 2008/1797) (“the 2008 Rules”), the Trade Marks (Fees) Rules 2008 (SI 2008/1958) (“the Trade Marks (Fees) Rules”) and the Patents (Fees) Rules 2007 (SI2007/3292) (“the Patents (Fees) Rules”).

The amendments to the 2008 Rules and the Trade Marks (Fees) Rules contained in rules 4 to 19 make the following changes of substance—

(1) An application for the registration of a trade mark which is filed electronically on Form e-TM3 shall be subject to a fee of £170 where the fee (and any relevant class or series fees) are paid in full at the time the application is filed. Where the full fees do not accompany the application, the standard application fee of £200 shall apply, together with any class or series fees (rule 5).

(2) Rule 5(2) of the 2008 Rules contains a provision under which for a fee of £300 an applicant may request an expedited examination of the application, in which case the report is issued within 10 working days or the fee is refunded. Rule 5 is amended to provide that where the time period within which standard examinations are routinely dealt with is equal to or less than 10 days, the registrar may suspend provision of the expedited examination service as there will be no benefit to applicants over the standard service. In this event, the registrar will advertise the suspension of the service on the website operated by the Intellectual Property Office. If the time period within which standard examinations are routinely dealt with subsequently exceeds the 10 day period, the registrar may resume the expedited examination service and advertise the same (rule 8).

(3) The right to file a single application in respect of a series of trade marks under rule 28 of the 2008 Rules is now limited to six trade marks and a fee of £50 will be payable in respect of each trade mark over two in number. The right to request a division of an application for a series of trade marks into separate applications is removed in relation to applications filed on or after 1st October 2009 (rules 11, 12 and 23).

(4) The fee to request an extension of time under rule 77(2) of the 2008 Rules is increased from £50 to £100 (rule 19).

The Patents (Fees) Rules are amended by rules 20 to 22. Under rule 21, the application fee for a patent is reduced from £30 to £20 where the application is filed electronically and it is accompanied by the fee. Under rule 22, the search fee and the examination fee are each reduced by £10 where the relevant form (Patents Form 9A or Patents Form 10) is filed electronically.

A full impact assessment of the effect that this instrument will have on the costs of business and the voluntary sector is available from the Intellectual Property Office, Room 2B36, Concept House, Cardiff Road, Newport, NP10 8QQ and is annexed to the Explanatory Memorandum which is available alongside the instrument on the OPSI website.

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