

IPO transformation programme: second consultation – IP Federation response

Introduction

The IP Federation represents intellectual property (IP) intensive companies in the UK - a list of members is attached. Our members are extensively involved with IP in the UK, Europe and internationally, including IP aspects of innovation policy and trade issues. Not only do our members own considerable amounts of IP in the UK, Europe and elsewhere, but they are affected by the activities and IP rights of competitors. Our cross-sectoral membership of over forty influential IP-intensive companies has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit.

Second transformation consultation

The Government has launched a [second consultation](#) on proposed law changes for the IPO's digital transformation programme. It contains a series of proposals for legislative changes that will remove barriers and allow the IPO to be more innovative. The consultation ends on **31 October 2023**.

IP Federation response

Introductory questions

Question 1. What is your name?

David England

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

Secretary of IP Federation

Online document inspection service for trade marks and designs

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

Our members find the online Ipsum service for patents very useful, and we would welcome the introduction of a similar online inspection service for trade marks and designs. It would also be useful if documentation relating to renewals (e.g. reminders) was included on the online system.

We support transparency and ease of access to such information, with the caveats specified in the preamble to this question of the consultation.

Public inspection of trade mark and design documents and requests for confidentiality

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?

See our answer to Question 6.

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?

Without practical examples as to what type of information this might apply to and when or why a third party might make such a request, we do not see how this would be useful.

Our members believe it would be sensible for the IP rights to be aligned. However, as with patents and designs, reasons should be required when making a request for information to be made confidential and the outcome of such a request should be at the discretion of the IPO.

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?

Our members support aligning the IP rights and introducing a fourteen day period during which the confidentiality of any document can be requested.

However, if this is to be allowed, then it is essential that there is a reintroduction of the provision requiring an automatic delay of fourteen days before a document could be inspected by the public. Otherwise, any such information is already public, and many people will have already (potentially) had access to it. We do not see how such information can then be retroactively confidential.

It may be important to make the distinction between commercially confidential information and information that a person would like removed from the public record such as libellous comments and/or personal information.

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?

Our members are always in favour of harmonisation, although they prefer this to be on an international level whenever possible.

Series trade marks

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

When our members file marks at the UK IPO direct, series marks are a useful way of filing multiple variations on the same mark, whilst keeping costs down. However, many would choose to file an international mark designating the UK and other countries. Since series marks are not allowed in the majority of territories, and cannot be request them via WIPO, they would not typically apply for series marks.

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

As indicated above, series marks are a useful way of filing multiple variations on the same mark, whilst keeping costs down.

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

(i) Simplicity (a single record to manage internally), and (ii) cost.

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

We agree with the government's initial assessment that any reduction is unlikely to address many of the issues currently faced.

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

Neither of these seems particularly appropriate.

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

Our members would be concerned as to the fate of current series marks. We would want these to remain on the register as series marks and would not want them to be split out into individual trade marks. If the latter happened, this would have a large cost implication.

We note that the change would create greater harmonisation with the broader international trade mark landscape. Our members are generally in favour of this, with the above proviso.

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?

No, we do not foresee any practical issues.

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.

Our members do not have a unanimous view on this question.

Question 16. Are there any options not identified which you think should be considered regarding the future of series marks?

Please see are answer to Question 13. Series marks that are already on the register should remain unaffected.

Supplementary protection certificate fee payment periods

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

Our members are generally in favour of 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.

Our members prefer keeping both the standard period and the later grant period the same. Although the alternative would result in keeping the period of uncertainty at its current length, this is outweighed by the issue of making the calculation of the suitable period more complex.

Inventors' addresses

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

Yes, our members agree that the IPO should stop including the full address for inventors in the patents register. It is enough that the applicant's address and address for service are required. Whilst this is not generally an issue for our members, no longer including the inventors address would likely cut down on the receipt of unwelcome mail by inventors.

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

Our members are in favour of option 2 (stop collecting full addresses for inventors; instead, collect and publish reduced details). This approach is more desirable for the following reasons:

- *It aligns with EPO practice.*
- *Addresses can become out of date.*
- *It is better from a data protection point of view.*

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.

The applicant should be asked to provide any contact details that they may have.

Mediation within IPO tribunal services

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?

The introduction of a mediation information and assessment meeting (MIAM) during proceedings is certainly an option worth exploring.

Our members would be hesitant in agreeing to more robust use of hearing officer powers to direct that parties attempt to mediate, and to stay proceedings. Likewise, they would be hesitant in agreeing to more routine awarding of costs against a party if they fail to engage in mediation. Both of these options need exploring more fully before we could agree to them.

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

The sooner the better would be a good principle, but it is difficult to give a general ruling without reference to any specific proceedings.

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?

Our members have no views on this.

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

No.

IP Federation
30 October 2023



IP Federation members 2023

The IP Federation membership comprises the companies listed below. The UK Confederation of British Industry (CBI), although not a member, is represented on the IP Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. The IP Federation is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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