IPO Transformation programme: second consultation

**Introduction**

The Intellectual Property Office (IPO) is the government agency responsible for developing Intellectual Property (IP) policy and legislation. In addition, the IPO administers systems for issuing patents, trade marks, registered designs and supplementary protection certificates. It also has a tribunal role in relation to disputes on issues covering those IP rights.

The IPO launched a [One IPO Transformation programme](https://www.gov.uk/government/publications/one-ipo-transformation-prospectus/one-ipo-transformation-prospectus) in 2021 to transform its IP services. Since 2021, the IPO has progressed work to modernise, rationalise and improve its current processes, systems and services. This will deliver faster, more flexible and higher quality digital services. However, the One IPO programme aims for more than digitisation of the current IPO systems. We will provide IPO processes and practices that are more effective as well as more efficient.

The IPO will deliver an integrated digital service in tranches, with the new patents service rolling out in full in Spring 2024. This will be followed by the launch of the trade marks, designs, digital hearings and tribunal services by the end of 2025. In the meantime, work continues to identify ways that the IPO can redesign its services, processes and practices around customer needs.

As part of the programme, the IPO published a first consultation in 2022 to inform some of the potential legal and practice changes to enable transformation and the build of the One IPO service. The options for proposed changes covered many different aspects of the IP system and how the IPO operates. This included automation of IPO systems and processes, modernising the IP framework and IPO fee structures and national security checks. Changes to how we provide services and improvements to the IPO tribunal function were also proposed. The government published its planned next steps in the light of the responses to the first consultation on transformation on 1 August 2023.

We are now seeking views on further proposals to support the delivery of IPO transformation. This second consultation considers six further areas for potential changes to current IPO services and processes. There are more issues specific to trade marks and designs than in the last consultation but the complete list covers matters across IP rights registered at the IPO. The complete list of issues are:

* online public document inspection service for trade marks and designs
* public inspection of trade mark and design documents and requests for confidentiality
* series trade marks provision
* length of supplementary protection certificate fee payment periods
* collection and publication of addresses for patent inventors
* ways to encourage more mediation during IPO tribunal proceedings

We welcome responses from rights holders, IP specialists, small and large businesses, individuals, and those with a general interest in how the IPO conducts its business.

**How to respond to this consultation**

Respond to the consultation by filling in the response form on Citizen Space, or by email to [TransformationConsultation@ipo.gov.uk](mailto:to TransformationConsultation@ipo.gov.uk). When responding, please state whether you are responding as an individual or representing the views of an organisation. It is not necessary to respond to all the questions; you are welcome to provide answers only to those issues of most interest or relevance to you.

**Closing date**

This consultation will run for 10 weeks and the closing date for responses is 31 October 2023.

**Confidentiality and data protection**

Information you provide in response to this consultation, including personal information, may be disclosed in accordance with UK legislation (the Freedom of Information Act 2000, the Data Protection Act 2018 and the Environmental Information Regulations 2004).

If you want the information that you provide to be treated as confidential please tell us, but be aware that we cannot guarantee confidentiality in all circumstances. An automatic confidentiality disclaimer generated by your IT system will not be regarded by us as a confidentiality request. We will process your personal data in accordance with all applicable data protection laws. See our [Privacy notice](https://www.gov.uk/government/publications/intellectual-property-office-privacy-notices/privacy-notice-for-personal-data-processed-for-consultations-and-stakeholder-engagement).

We will summarise all responses and publish this summary on GOV.UK. The summary will include a list of names or organisations that responded, but not people’s personal names, addresses or other contact details.

**Introductory questions**

**Question 1.** What is your name?

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

**Online document inspection service for trade marks and designs**

An aspect of the IPO’s Transformation programme will be to make it easier for the public to access information relating to IP rights.

In most cases, documents held by the IPO concerning IP rights and applications are open to public inspection once the application is published. Yet, there are considerable differences between the rights in how they are accessed. For patents, most documents relating to applications can be viewed online for free via the document inspection service [IPSUM](https://www.ipo.gov.uk/p-ipsum.htm). For trade marks and designs only limited bibliographic information is available online. To view trade mark or design documents interested parties must instead visit the IPO in person or order copies of documents using our [uncertified copy service](https://www.gov.uk/get-copies-of-intellectual-property-documents). The latter requires a request to be made via email and the payment of a fee.

The lack of an online document inspection service for trade marks and designs may not meet customer expectations as we digitise our services. This is especially the case given the popularity of our IPSUM service for patents.

For designs, in the Intellectual Property Act 2014, there is provision for an online inspection service. Our current IT systems do not exploit this possibility. The One IPO Transformation programme offers the opportunity to introduce an online inspection service for both trade marks and designs. We intend to commence the 2014 IP Act provisions for designs alongside other legislation that may result from this consultation.

Some documents or parts of documents relating to trade mark and design applications are not open for inspection under law. As such, they would not be made available online. The Trade Marks Rules 2008 and Designs Rules 2006 specify which information should not be open to public inspection. This includes documents prepared for internal use only and information filed with the IPO which in the registrar’s opinion is likely to disparage any person in a way which might damage them.

Customers are also able to request that specific documents be treated as confidential under trade mark and design law. Where requests are approved, the documents will not be open for inspection and so would not be accessible via an online inspection service. The terms for requesting confidentiality of documents are considered separately below.

As for patents, there may be some information relating to trade marks and designs which, whilst open to public inspection, would not be made available online. This would be for practical or legal reasons. Forms are an example of documents which are not placed on the patents IPSUM service. This is because of the personal information they contain. Applicants and third parties are also able to request that documents be removed from IPSUM because of personal or sensitive information within.

We seek your views on the proposal to introduce an online inspection service for trade marks and designs and any potential unintended consequences.

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

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

The Patents, Trade Marks and Designs Rules set out provisions for when documents relating to applications should be available for public inspection. They also set out the conditions when customers can request confidentiality of information relating to applications. If requests for confidentiality are successful, the relevant information or documents will not be available for public inspection.

There are specific inconsistencies in these provisions across the rights which we would like to address as part of our One IPO Transformation programme. We are proposing changes which will align particular trade marks and designs provisions with the equivalent patents provisions.

There is a strong public interest in making documents relating to IP rights available in a timely manner, once an application has been published. However, this must be balanced with the need to enable customers to choose to protect confidential information in documents filed at the IPO. We believe the current arrangements for patents offer a fair balance. These provide a period of fourteen days after a document is filed for people to request confidentiality but there is no delay in making the document publicly available in the meantime. This could result in information being available to the public which is subsequently requested to be made confidential. However, we have confidence this is likely to be a rare occurrence, as very few retrospective confidentiality requests are made. Therefore, we believe this approach strikes a good balance between the public interest and the desire to give people a reasonable opportunity to request confidentiality. We would like to make changes to the Trade Marks and Designs Rules to reflect this approach.

***Proposed changes to the Trade Marks Rules***

Patents and designs legislation explicitly allows any person to request confidentiality in a fourteen day period after a document is filed. However, this is not the case for trade marks. The Trade Marks Rules previously provided a fourteen day window to request retrospective confidentiality for the person filing the document, but this was removed in 2008. At the same time, a provision requiring an automatic delay of fourteen days before a document could be inspected by the public was also removed. A similar provision is still currently in place for designs (see below).

Rule 59(1) of the Trade Marks Rules currently provides for confidentiality requests to be made at the time of filing. The government believes this rule should be revisited, particularly in view of plans to make trade mark related documents available online. We also believe that parties other than the person who files the documents should be entitled to request confidentiality, just as for patents and designs. An amendment would provide for the filer to request confidentiality after they filed the document, for example if they forgot to make the request at the time of filing. It will also provide for third parties to request confidentiality, for instance if information filed by someone else becoming publicly available is problematic for them.

The government therefore proposes introducing provisions into the Trade Marks Rules which stipulate a fourteen day period in which to request confidentiality and that third parties can request confidentiality.

Introducing these provisions may be particularly important if implementing a trade mark online inspection service. This would provide greater clarity for people needing to protect confidentiality of information provided to the IPO, particularly if continued online disclosure of the information would cause harm. Especially as third parties may have no way of knowing about this information at the time of filing.

Under this proposal trade mark related documents would still generally be open to public inspection upon filing. Upon receipt of a retrospective confidentiality request, the document would be removed from the public domain whilst the request is considered. This would include removal from any online inspection service.

***Proposed changes to the Designs Rules***

Previously the Patents and Trade Marks Rules provided that any document filed at the IPO was automatically kept confidential for fourteen days. However, these provisions were removed. As such, documents relating to a published patent or trade mark application will generally be open to inspection on filing, subject to any confidentiality considerations.

However, the Designs Rules still contain a similar provision to those which have been removed from the Patents and Trade Marks Rules. This states that a document cannot be inspected until the period of fourteen days beginning after the day the document was filed at or received by the IPO has passed. This means there is a delay of approximately fourteen days from filing before a member of the public can view any designs document received by the IPO.

The government proposes to remove this provision from the Designs Rules. This will ensure that access to documents relating to published design applications is not unnecessarily restricted. Removing this provision will mean that there will be no automatic delay to documents becoming available on the new online inspection service.

The proposed changes to the Designs and Trade Marks Rules will result in greater alignment across the IP rights, providing a more consistent customer experience. We believe it will ensure timely availability of documents and a clear and harmonised basis for requesting confidentiality for all of our customers.

We seek your views on these proposals.

**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?

**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?

**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?

**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?

**Series trade marks**

A series trade mark is defined in Section 41(2) of the Trade Marks Act 1994 (“TMA”) as:

*a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark*

The filing of series marks is not explicitly provided for under the TMA. Instead, it delegates the provision of series marks to the Trade Marks Rules 2008. Rule 28 states that an applicant can file a maximum of six marks, provided they meet the above criteria, within a single application. An additional fee of £50 is charged for each of the third, fourth, fifth and sixth marks in a series.

Series marks are a reasonably unique feature of the UK trade marks system. Only a limited number of other jurisdictions provide for them. A series of marks is not intended to provide materially different protection to that afforded by the base mark. However, there is a risk customers may believe they are gaining a greater scope of protection than is actually provided.

The last policy review of series marks was over a decade ago and was subject to public consultation in 2009. Back then, the majority view (albeit a small one) was that the ability to apply for a series of marks should be maintained. As a result of the 2009 consultation, series marks were retained but the maximum number of marks was capped at six. Additional fees were introduced after the first two and the rules permitting applicants to divide unsuccessful applications for series into separate applications were removed.

Over the last five years, annual demand for series marks has followed broader trade mark filing trends. Series applications peaked at 25,000 in 2021, before returning to 16,000 in 2022. This represents around 10% of all domestic trade mark applications.

On average, 65% of series mark applications are filed by unrepresented applicants. In 2022, 39% of these were objected to and the objection rate increases steeply with the number of marks in a series being applied for. This high objection rate suggests that unrepresented applicants have difficulties with filing series marks. This is also evident where many of these applications include marks which clearly do not resemble the other marks in the application. As no refunds are issued for invalid series applications, unrepresented applicants can be financially disadvantaged by these filings. In these instances, the series mark service currently being offered may not be meeting customer expectations.

In terms of represented applicants, these also attract a relatively high objection rate. Some representatives choose to file marks which clearly and unquestionably do not form a series, one of which is then removed during the examination phase. In 2022, 17% of series marks filed by represented applicants were objected to. This filing strategy could be to achieve some form of dual examination at a reduced cost, for what should be two separate trade mark applications. The IPO has already conducted some initial work on potential practice routes to address this. The additional time spent processing these applications has resource implications for the IPO. It can also lead to processing delays.

The above summaries demonstrate some of the challenges facing the IPO’s provision of series marks. This raises questions about whether the series mark provisions are still functioning effectively and delivering value to customers.

The government is now exploring proposals for the future of series marks. As part of this consultation, we invite views and experiences from stakeholders on the current series provisions.

1. **Maintain the current legal framework providing for series marks**

Series marks are consistently well utilised. There were clear calls to retain the provision of series marks in the preparation of the 1994 TMA. There was also a slight preference to maintain them back in 2009. The government is keen to understand whether this demand remains and, if so, the rationale behind this. Retaining them will ensure applicants continue to have a cost-effective way of registering multiple non-distinctive variations of a mark. However, as referenced above, the high objection rates for series mark suggests clear shortcomings in the current system. Recent changes made to IPO guidance as part of the online trade mark application system have had a limited effect on some of these issues.

We are keen to understand more from customers of the practical benefits of series marks. Especially as a series of marks is not intended to provide materially different protection to that afforded by other marks in the series.

**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?

1. **Reduce number of allowed marks in a series**

Currently, applicants can apply for up to six marks in a series. The majority of applicants do not file this many, with only 26% of applications being for more than two marks in a series. The objection rate rises significantly for applications containing more than two marks. Around 50% of these applications are objected to. Many of these applications include marks which clearly do not resemble the other marks in the application. This causes particular difficulties for unrepresented applicants. This is because they can then struggle to overcome objections raised by the examiner. Reducing the number of marks permitted in a series may decrease the objection rate, especially for unrepresented applicants. It may also increase the likelihood that a series is accepted. However, this change will not address those using series marks provisions for some form of dual examination.

**Reduce to four:**

Only 5% of applications feature five or more marks in a series. Around half of these are objected to as being invalid as a series. Reducing the number of marks in a series to four would reduce the objection rate for series applications. It would continue to allow for a number of variations in a mark to be protected at a reduced cost. However, those who file invalid series marks would continue to be financially disadvantaged under the existing ‘no refund’ policy.

**Reduce to two:**

Currently, applicants who file invalid series marks are financially disadvantaged. This is because no refunds are provided when marks in the series are refused. By limiting the number of marks in a series to two, even if the additional mark is refused, applicants will not be financially disadvantaged. This is because the second mark in the series will continue to be covered by the standard application fee. On average, 74% of series applications are for only two marks in a series. As such, a significant number of applicants would be unaffected by this change. Applicants who wish to protect more than two variants of their mark would still have the option to protect these as separate trade marks. However, choosing to do so will have the added financial burden of filing additional applications.

The government’s initial assessment is that any reduction is unlikely to address many of the issues currently faced. It is also unlikely to reduce the filing of invalid series marks. Customers may continue to believe they are gaining a greater scope of protection than actually provided.

**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?

1. **Abolish series marks**

A series of marks is not intended to provide materially different protection to that offered by the other marks in the series. The majority of series marks are applied for by unrepresented applicants. As such, some may believe they are gaining a greater scope of protection than actually provided. Some applicants also file dissimilar marks to achieve some form of dual examination at a reduced cost, for what should be separate trade mark applications. These applications fall outside of the intention of this provision. Removing the option to apply for series marks would simplify the application process. It would be particularly beneficial for unrepresented applicants who apply for a series of marks in error. Applicants would still be able to apply for variations of marks. However, this would be as separate trade mark applications, incurring full application fees. Under this proposal, existing series mark registrations would remain valid. Transitional provisions would ensure they can continue to be maintained. This change would also create greater harmonisation with the broader international trade mark landscape.

We are keen to better understand the potential impact of abolishing series marks. We invite views and evidence on the usefulness of series marks.

**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?

Based on the evidence we presently have, the government’s current preference is to cease offering series marks. This will address the current difficulties caused by improper use of the system. Many valid series applications are received and registered each year. However, the negligible benefit these appear to confer on rightsholders are outweighed by the potential gains to be achieved through simplifying the application processes.

The government’s initial position for series marks is based on the internal evidence currently available to us. Therefore, we are interested in any evidence that shows concrete benefits to customers in holding series marks. We are also interested in any further comments or other mitigating actions which you deem could help overcome the above issues with series marks. Finally, we seek your views on any anticipated advantages or disadvantages of all the proposals, or potential unintended consequences.

**Further questions**

**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.

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

**Supplementary protection certificate fee payment periods**

Fees for a supplementary protection certificate (SPC) must be paid for in a single payment before the SPC may take effect. The period within which the fee must be paid is three months ending with the start date of the SPC. This period runs up to the day on which the certificate is due to take effect (the standard period). However, if the SPC is granted less than three months before its start date, this three-month period runs from grant of the SPC (the later grant period).

We are proposing that both the standard period and the later granted period is extended to six months, in line with renewal fees for other IP rights. This would further simplify the payment periods in this area. A previous 2022 consultation concluded that the patents renewal period should be changed to six months, aligning with the equivalent trade marks and designs periods. We are not proposing any change to the date of the end of this period. This proposal would have the effect of simplifying the payment periods for SPCs. Both the standard period and the later grant period will be the same length. However, it may cause a longer period of uncertainty for third parties.

We appreciate that the payment of an SPC fee is different from a renewal fee. However, as these fees have a similar purpose (that is to maintain an IP right) we have decided to explore the option of extending the period.

An alternative solution could be to align the standard period to six months but leave the later grant period at three months. As noted above, this period would apply when the SPC is granted less than three months before its start date. This would keep the period of uncertainty at its current length but would make the calculation of the suitable period more complex.

**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.

**Inventors’ addresses**

The government is considering no longer including full addresses for inventors in the patents register. Instead, the published address details for each inventor would be limited to their country and place of residence or employment. For example, “Oxford, UK” rather than a complete street address. Guidance would be made available to make clear what is meant by “place of residence or employment”.

This would align law and practice in the UK with the outcome of the European Patent Office’s [Convergence of Practice](https://www.epo.org/law-practice/convergence-of-practice.html) programme. Reducing the address data that is included in the register will also reduce the personal data that the IPO makes available online.

The applicant’s address and the address for service are both required to be published in the register and that will continue to be the case. The address for service is the contact point for all queries in relation to the patent application or granted patent.

Inventors will also continue to have the right to waive their right to be mentioned or to have their partial address mentioned, as they do currently.

Making this change will require legislative change. For example, rule 44(1)(b) of the Patents Rules 2007 currently requires the IPO to enter “the name and address of the person identified as the inventor” in the register.

However, the government believes there are multiple options available as to how this change could be introduced. For example, as well as no longer publishing full addresses for inventors, the European Patent Office (EPO) also no longer collects the full address at the time the patent application is filed.

Possible options as to how this change could be introduced are summarised below:

Option 1: Continue to collect full address for inventors; publish reduced details.

Option 2: Stop collecting full addresses for inventors; instead, collect and publish reduced details. Ask the applicant to provide inventor contact details if and when they are required as part of an inventorship or entitlement dispute.

Option 1 would mean that the IPO would have address details for the inventor. This would be useful should contact details be required in the event of an inventorship or entitlement dispute. However, this would not be the case for granted EP(UK) patents. In addition, in some cases the address supplied at the time of filing can become out-of-date by the time a dispute occurs.

Option 2 would align with EPO practice. It would result in the IPO only holding inventors’ contact details in those cases where it is necessary to contact the inventor. This is desirable from a data protection perspective. This option could also allow the applicant to provide alternative contact details for the inventor. This could include an email address or telephone number, rather than being restricted to a postal address.

Currently, there is no provision within the patents rules that compels the applicant to provide contact details for the inventor if they are required at a later stage. For example as part of an inventorship or entitlement dispute. As a result, there may be benefits in the patents legislation being amended to include such an obligation. For example, it would then seem likely that the applicant could rely on Article 6(1)(c) of the [UK General Data Protection Regulation](https://www.legislation.gov.uk/eur/2016/679/article/6) (“processing is necessary for compliance with a legal obligation”) when storing the inventor’s personal data. Alternatively, option 2 could operate without a legal provision and the request for inventor contact details could be a purely administrative one.

**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.

**Mediation within IPO tribunal services**

As part of its remit, the IPO operates tribunal services. These offer a forum to resolve a wide range of disputes over IP. For certain types of disputes, the IPO tribunal is the forum which parties must use at first instance.

In 2022, as part of the first consultation on IPO transformation, the government consulted on a number of possible improvements to IPO tribunal procedures, rules and practices.

The government would now like to explore ways to encourage more mediation within the IPO tribunal service.

The IPO actively encourages parties to mediate, as a quicker and less costly alternative to litigation. As part of designing our new digital service for hearings and tribunals, launching in 2025, we are keen to explore whether and how mediation can be used more during all IPO tribunal proceedings.

As part of this thinking, the IPO is considering the introduction of a mediation information and assessment meeting (“MIAM”) during proceedings. The MIAM would be a short meeting with a trained IPO mediator and offered free to the parties. The parties could choose to attend together, or alone. They could choose whether to bring their representative (if any).

The MIAM would be a chance to ensure the parties understand what mediation is, what their options are, and the likely costs involved in mediating (compared to litigating). It would explore whether the parties are able to attempt to settle, and the options for doing so. It would not provide legal advice nor indicate the strength of a party’s case. It would be entirely confidential, and without prejudice.

If parties agree to try mediation, proceedings could be stayed and the IPO could refer the parties to a suitable mediation provider. This would be through the IPO Mediation Service or any other accredited mediation provider.

Furthermore, we are interested in maximising use of hearing officers’ powers to direct the management of proceedings in this area. The Trade Mark Rules 2008, Patents Rules 2007 and Registered Designs Rules 2006 all give powers to the comptroller or registrar to manage proceedings as they think fit. There are specific powers to stay proceedings either generally or until a specified event. Hearing officers have tended to encourage rather than direct the parties to consider mediation. However, they could do so more frequently and could stay proceedings until that direction has been complied with.

Hearing officers could also more readily adopt a practice whereby anyone who unreasonably refuses to engage in mediation becomes subject to an unfavourable costs order. In those circumstances, the costs being awarded could be higher than those on the IPO’s published scale of costs (which is aimed at providing a winning party with a contribution to their costs, rather than compensating them fully). This would mean hearing officers spending more time routinely assessing cases for suitability for mediation. They would also need to analyse the reasonableness of any objections to mediation raised by the parties.

**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?

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

**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?

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