

Paperless Administrative Procedure

Thank you for inviting me to Madrid to talk about the electronic filing of trade marks and electronic trade mark application forms. It is a privilege for me to be here.

I am pleased to report that the electronic filing of trade marks has begun in the UK. At the moment, as of the time of writing, only three firms in the UK have filed any electronic trade mark applications. The firm which worked with the Registry in the initial setting up of the system filed the very first electronic application at the end of last year. That was the firm where I was until last year, Gill Jennings and Every. My present firm, Page White and Farrer, became the next firm to file live trade mark applications electronically; and now a third firm has used the system too.

The first question is, why have only three firms so far taken up this new technology to file trade marks electronically? Why have fewer than a dozen applications been filed electronically? There really is no good reason for that. The only answer is habit. For example, my firm Page White & Farrer was founded in 1876 and we have been filing trade mark applications on paper for well over a hundred years. We are very good at it. We have excellent systems for filing trade mark applications on paper and they work very well. Why change?

The answer is that the new system is, simply, quicker and more efficient, and most importantly, just as safe. At the moment, most firms file trade mark applications on paper by sending a messenger to the Registry every afternoon with a bundle of documents and an itemised list. Our firm is just round the corner from the Registry. The Registry document reception counter acknowledges the bundle and issues a paper receipt for the documents. There is no doubt that the document was filed correctly on that date.

If the application comes in after the messenger has left, the attorney can take the document round himself, in person, and get his paper receipt. The Registry is open all night to receive documents. Or he can fax it at his own risk. Or he can post it and get the next day's date.

However, when an electronic application is filed, an electronic receipt and a confirmation of valid filing are issued within five minutes of sending the email. That confirmation can be sent to the attorney's accounts and records departments, who can tally the account and complete the records without any possibility of error because there is no typing, just copying: no possibility of change because the application is set and fixed. This may represent a small saving of time and administration fees for a firm, but if that is multiplied up by all the firms, as the Registry sees it, it is clear how enormous a saving of time and resources the Registry could make from electronic filing.

How is a trade mark filed electronically? Is it very simple, or so complicated that only a computer specialist can do it? Most importantly of all, is it safe?

The process begins with having a computer with an Internet connection. The Registry then provides specially written software, called PaTrAs, which stands for "Patent and Trade Mark Application System". The software allows the authorisation and the sending of filings. The Registry also provides a word template to assist with the creation of the electronic form in a PaTrAs-compatible format. It comes on a CD-Rom with some manuals. It is all free. The IT person in the firm then installs the software on the system.

Then, the attorney contacts the Registry to tell them who he is and who in the firm is authorised to file applications. A list of the firm's personnel is sent to the Registry on a special form. This is very important because one cannot simply file an application in the UK; the Applicant or his representative has to declare that there is a bona fide intent to use the mark. That is a particular requirement of English law. A filing can be invalidated if the application is made without such intent, so this is a serious matter and only a registered trade mark attorney makes such declarations. With a paper form this is done by a partner or a qualified person signing the form. For electronic forms, there is a special authorisation button controlled by a password. Only an authorised person, a qualified person, can give that authorisation and the name is checked against the Registry's list. This is as secure as a personal signature.

Once the software has been installed and the personnel list has been sent to the Registry, and test filings have been sent to the Registry and confirmed at the Registry and within the firm to ensure the connection, the Registry will notify the firm of the designated email address for filing applications. Then, the system

is ready and the attorney or his secretary or the formalities clerk can work through the generated form in the usual way. It is no different from using the macro automatic forms which most firms use, except there is an additional step: because the software comes from the Registry, the software will check the form for errors and verification. If no residence letter code has been given for the Applicant or if the fee is wrong, the machine will say. Those sorts of mistake cannot be made any more. The attorney's secretary can run that check and bring the attorney a printed form if he prefers, so he can look at it carefully on paper. He might even sign it with a pen to confirm it to himself and that copy can be kept in the file.

Then, the attorney uses his secure password to authorise the form and emails it as an attachment to a special designated Registry email address. The fee is deducted from the firm's deposit account at the Registry. Within five minutes there is a filing receipt. We at Page White Farrer have a special designated email account purely to receive these receipts, and this is designed automatically to forward the emails to the attorney, to Accounts and to Records. Everything that paper filing did through the old systems is thus done electronically in just a few minutes. That is really all there is to it.

What are the disadvantages? First, we are all used to paper filing and to the time delay between signing the form and the messenger leaving. Delay has the advantage that if the Client calls in the meantime the form can be retrieved and changed. That cannot be done electronically; there is no time delay. But that does not happen often, and really it never should. It is always possible to refile and withdraw the previous application. After all, the email can be sent at any time up until midnight, it doesn't stop at close of business.

Secondly, electronic filing works by email and so all the problems of email are relevant. However, the fact that a receipt comes in just five minutes means that one will know immediately if there is a problem and there is always the Registry helpdesk. We know the direct telephone numbers of the staff.

No-one has yet filed a mark which has pictures. There is a mechanism involving attaching jpeg files to the electronic form and this has worked very well in tests, but no live filing has yet been made. There is really no advantage to device filing yet because it is so very rare for device marks to be received in the office by jpeg; normally the Applicant sends his attorney a camera-ready copy. That will change, though, with time, as more and more device marks are sent by email; and electronic device filing will then become more popular. Colour marks have not yet proved viable for electronic filing because the colour varies so greatly, so at the moment paper is needed for marks which claim colour or which are colours. That is a new decision of the Registry of 24 April 2002, so you see the field is developing all the time and I am sure this early issue will be resolved soon.

So that is my experience with filing electronic trade mark applications. As soon as the form has been processed by the Registry an official paper filing receipt is issued and the electronic phase stops. Interestingly the paper receipts have been issued far more quickly with electronic filing than with paper filing, which proves how much more efficient the system is for the Registry, especially with these early applications which are obviously attracting some attention. At the moment it is still a novel system; it is still in its early stages. But the efficiency for the users is enough to make it worthwhile; and if that efficiency is multiplied up as it is for the Registry, it seems likely to me that one day the Registry will encourage electronic filings over paper filings. That day will come, I expect quite soon, in months rather than years. It is important therefore to be in at the start; and we are very proud of our involvement in this early stage of electronic trade mark filing.