

Introduction

Purpose of this Guide

The purpose of this guide is to explain procedures for registering and processing marks under the International System, utilising [the Protocol to the Madrid Agreement](#). It also gives an overview of the Community Trade Mark (CTM) system and the role of the UK Intellectual Property Office in relation to CTM marks.

The guide indicates to examiners the procedures to follow when examining a mark filed under the international system. The registrability of a mark is determined in the same manner as for a mark filed under the national system applying the judgements and decisions from a variety of sources including, in particular the European Courts of Justice (ECJ), Court of First Instance (CFI), UK Courts and the Appointed Persons and is not covered in this guide. For further information on registrability issues please refer to [The Guide](#)

Role of the UK Office

The office is responsible for:

- Receiving, examining and processing through to the final outcome, international trade marks which designate the UK under the Protocol to the Madrid Agreement.
- Receiving, checking and certifying, forwarding and administering new international applications filed under the Madrid Protocol which are based on UK national trade marks.
- Updating our records to reflect changes to the details of international registrations, where those details are relevant to the UK.
- Receiving trade mark and/or design applications on behalf of the CTM office and forwarding the applications to Alicante, Spain. Certifying requests from trade mark and design practitioners for entry onto the CTM list of professional representatives.
- Searching the UK register of trade marks on behalf of the CTM office.
- Providing information and advice to colleagues and customers regarding aspects of the international system.

The International Trade Mark (Madrid) System

Background to the Madrid System

The [Madrid Agreement](#) for the International Registration of Marks has been in existence since 1891. [The Protocol to the Madrid Agreement](#) was introduced in 1989 with a view

to generating new interest in international trade mark registration. The Agreement and the Protocol together form the 'Madrid System'. The system is administered by the International Bureau at the World Intellectual Property Organisation (WIPO) which is based in Geneva, Switzerland.

The United Kingdom ratified the Protocol in December 1995 and it came into force on 1 April 1996. Holders of UK trade marks may use the system to gain protection for their marks in one or more member countries of the Protocol. Similarly, holders of marks in other Protocol member countries can use the system to apply for protection in the UK.

Reference in this section to 'Article' ('Art.') refers to the Article of the Protocol. Reference to 'Rule' refers to the Rules listed in the Common Regulations under the Madrid Agreement and the Protocol to that Agreement.

Basic Requirements for using the Madrid System

Filing criteria

The applicant must be able to meet one of the following three criteria to be eligible to file through the international system:

[Art. \(2\)\(1\)\(i\)](#)

- be a national of one of the Protocol member countries; or
- be domiciled in one of the Protocol member countries; or
- have a real and effective business or commercial establishment in one of the Protocol member countries. (The question whether a person has a real and effective commercial undertaking is determined under national law. In the UK we would not accept a PO Box or something that would suggest that a person's establishment is only temporary.)

Requires a UK application/registration

To use the Protocol, applicants must also have a national trade mark application or registration in one of the Protocol member countries. This national mark will be used as the basis of the international application. The international application will cover the same trade mark and a list of goods and services identical **or no wider than** that of the basic (national) mark. The international application will designate one or more other Protocol member countries, these being countries where the applicant would like to protect his mark.

Through the Office of Origin

The international application **must** be filed via the national trade mark office where the basic mark is held. This national office is referred to as the 'Office of Origin' of the international application (see [Art. 3](#)). The Office of Origin is required to certify that the

international application falls within the scope of the basic mark, following the criteria described above. The application can then be passed to WIPO.

WIPO formalities check

At WIPO a formalities check of the application will be carried out and the mark is translated into the three languages of the system, English, French and Spanish. The mark will then be registered and the details of the registration will be published in the '[International Gazette](#)'. A copy of the Gazette advertisement will be forwarded to the national trade mark office in each of the member countries where the applicant of the mark seeks protection (see [Art. 5\(2\)](#)). Each country will examine the mark according to their national systems and must inform WIPO within a set time limit whether or not the mark may be protected in that country. Notifications of provisional refusal in designated contracting parties will be published in the International Gazette and also forwarded to the applicant for the mark.

Advantage of the Madrid System

The advantage of using the Madrid system is that applicants may protect their trade marks in several countries simultaneously by means of a single international application filed at their own national trade mark office. For trade mark owners based in the UK, there is the added benefit that the international application may be completed in English which is one of the working languages of the system (the others being French and Spanish).

UK as an Office of Origin

Filing an international application

[Art. 2\(2\)](#)

The UK Intellectual Property Office acts as 'Office of Origin' for international applications that are based on existing UK trade mark rights. The international application **must** be filed via the UK Intellectual Property Office in order so that we can perform the certification checks required by Article 3 of the Protocol.

The application form

[Art. 3\(1\)](#)

International applications must be made on the official form [MM2](#), which can be downloaded from the WIPO website. The form **must** be completed in typescript. An original representation of the mark must be placed in the box on the form. If the mark is to be applied for in colour, or colour is to be claimed as one of the essential features of the mark, then a colour representation should be attached. Representations of the mark must be no larger than 8 cm by 8 cm and must be placed in the box on the form. It is not acceptable to attach representations of the mark to the back of the application form.

If the European Community is designated and the applicant can claim seniority from a prior registration within the Community, then a form [MM17](#) must be completed.

If the United States of America is included amongst the designations, form [MM18](#) must be filed at the same time as the application form. This is the “declaration of intention to use” the mark in the USA and is a legal requirement. If the form is not filed with the application, an irregularity will be raised and this could lead to delay in the processing of the application.

The application form must be sent to the UK Intellectual Property Office, together with a handling fee sheet ([Form FS4](#)) and handling fee. New international applications are received by Finance Section. They are responsible for certifying applications and confirming the filing date of the case.

Filing date

[Art. 3\(4\)](#)

The Office of Origin is responsible for certifying, amongst other things, the filing date of the application. Applications must be passed to WIPO within two months if they are to retain the date of filing at the national office as the official filing date. If problems are encountered and the Office of Origin is unable to certify the case and forward it within the two month deadline, then the case will be given the date on which WIPO receives the application as its filing date.

The filing date will, on registration of the mark, become the international registration date. Rights acquired by protection of the mark will run from this date.

Certification by UK Office

[Art. 3](#)

One of the criteria for using the system is that the applicant must hold trade mark rights, either as an application or a registration, in one of the member countries of the system. The international application will be based on these national rights. The certification procedure is to ensure that each international application meets this criterion.

[Article 3 of the Protocol](#) states:

The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be.

[Rule 9\(4\)/9\(5\)](#)

The particulars that should, or may, appear in an international application are listed in Rule 9. The certification process may be summarised as a check that:

- **the same applicant**, should be applying for
- **the same mark**, (in all aspects!) in respect of
- **the same or no wider goods and services** than are covered by the basic mark.

There is no provision under the Madrid system to register a series of marks. If an international application is to be based on a UK series mark, then the applicant will be asked to choose one of the marks in the series to act as the basis for his international mark. The chosen mark will be the mark which is registered internationally. If an applicant wishes to register all the marks in his UK series internationally, he must file a separate application for each one.

Similarly, if an international application is to be based on a mark where colour has been claimed, then the international mark must be in colour. As indicated above, the rights in the international application must be the same as or no wider than those of the basic mark.

The certification check is not an examination of the application or of its acceptability. This check is simply to ensure that the applicant meets the entitlement criteria and has a mark in one of the member countries of the Madrid system. The certification check **does** ensure that the application form contains all the information necessary for the case to be given a filing date. If information is missing we cannot forward the case to WIPO.

If for any reason the application does not meet the criteria for filing, we will contact the applicant or his representative and explain the problem. In cases where the applicant is seeking to protect a list of goods or services which is wider than that of his basic mark, we will check the lists and confirm that the international application exceeds the scope of the basic mark. Finance Section will then contact the applicant or his representative (see [Art. 3\(4\)](#)). Any problem with the application prevents the certification of the case and, if the applicant is not to lose his filing date, must be resolved within the two month deadline for passing the case to WIPO.

When everything is in order and the case has been certified, we will forward it to WIPO by courier. Finance Section hold a list of the documents forwarded in each envelope to WIPO. Finance Section will send acknowledgment of the receipt of international applications to the applicant or his representative. One is a fee acknowledgement sheet and the other is a letter confirming that the international application has been forwarded to WIPO.

Formalities Checks taken at WIPO

The International Bureau of WIPO is a paperless office. All documents received by the office are scanned into their electronic system and assigned an internal working number. Figurative marks are scanned separately using a colour scanner.

[Rule 9\(5\)/9\(6\)](#)

New applications receive a formalities examination. WIPO checks that all filing requirements have been complied with, that the classification of the goods and services listed on the application form is correct and that all appropriate fees have been paid.

This is not a check as to the validity or acceptability of the mark but simply a formalities check.

Irregularities

[Rules 11-13](#)

If WIPO finds irregularities in an application, both the applicant, or their representative, and the Office of Origin of the mark will be contacted. WIPO will highlight the problem and set a three month deadline for response. **This deadline cannot be extended.**

[Rules 11, 12 and 13](#) of the Common Regulations cover fees and filing deficiencies, classification and vague terminology respectively. Fee irregularities may be dealt with directly by the applicant.

Additional Class Fees

If the irregularity related to a reclassification of certain goods and services, WIPO may insist upon adopting their own proposal for reclassification of those goods and services and may require additional fees. If an irregularity is not responded to within the time allowed or if the additional fees are not paid, the international application will simply be abandoned. For irregularities relating to vague wording, WIPO will publish the wording but with a proviso that they consider the wording to be too vague for classification purposes. It is then left to individual designated contracting parties to object to the wording.

Non-extendable Time Limits

The time limit given for responding to letters of irregularity is non-extendable. It is therefore imperative that applicants or their representatives respond to us in good time so that we can send these responses to WIPO before the deadline

Reply through the Office of Origin

If the irregularity may only be put right by changing the content of the application, then the irregularity letter **must** be responded to by the Office of Origin. Responses sent directly from the applicant or their representative to WIPO will be disregarded even if they contain a clear response to the irregularity raised. This is because such responses do not comply with [Rule 11](#). It should be remembered that international applications are based on national trade marks. It is the job of the Office of Origin to ensure that any amendments to international applications are within the scope of the basic mark.

Registration

Once the formalities check is complete, the application will be registered and assigned an international registration number. It will be published in the [International Gazette](#). A certificate of registration will be sent to the holder. At this point the mark has achieved

registration but is not yet 'protected' in any of the designated contracting parties. A copy of the Gazette publication of the mark will be sent to each of the countries where the holder requested protection. Each country will then examine the mark **according to the national system in that country** and will notify WIPO whether or not the mark may be protected in that country. Details of this procedure are given in - 'UK as a Designated Contracting Party.'

Post-Registration Matters

Ceasing of effect and cancellation

[Ceasing of Effect during dependency period](#)

If a basic mark is cancelled, refused, successfully opposed, withdrawn, or the rights cease for other reasons, then WIPO must be informed. We will send a letter to WIPO giving details of the extent (total or partial) to which the basic mark has ceased to be valid. This letter may also request WIPO to cancel the international mark either in part or in totality. As previously noted, an international registration is based on a national trade mark for a period of five years. It may not be wider in scope than the mark upon which it is based. Hence, if the basic mark narrows in scope or ceases to be valid, then this must be reflected by the international registration.

We will write to WIPO who will then inform all interested parties of any change in the scope of the international mark or of the cancellation of the mark. This information is also published in the [International Gazette](#).

In the UK, national marks which are the basis of an international application are flagged on OPTICS. OPTICS produces a report of any changes made to the national mark. This alerts us of the need to review the matter and inform WIPO of any changes necessary to the international registration.

Central attack

If anyone wishes to attack an international registration, this may be done in two ways:

- they may oppose individual designations in individual member countries, by following the national opposition or invalidation procedures of that country; or
- if the mark is still within its five year dependency period, it may be possible to attack the basic mark.

If the attack is successful, the basic mark will die and the entire international application, in all designated contracting parties, will have to be cancelled. Thus by attacking the base on which the international registration relies; it is possible to completely topple the international trade mark rights.

Dependency

[Art. 6\(3\)/\(4\)](#)

Each international application is, as noted above, based on one or more trade mark applications or registrations in the country of origin of the application. It is the duty of the Office of Origin to monitor these marks for a period of five years from the date of the international registration. Any 'ceasing of effect' of the basic mark, whether it is total or partial, will have an effect on the international registration. The Office of Origin is responsible for notifying WIPO of changes to the basic mark during this five year period. If the international application is based on an UK application which never reaches registration, then the international case will be cancelled. It is possible that an international application may become registered before the national application upon which it is based. Even so, if the basic application is refused or cancelled for any reason, the international application will also be cancelled.

Other changes to the status of the basic application or registration which will affect the international application include successful opposition of the basic application or rectification or invalidation of the basic registration.

[Article 6\(2\)](#) states that the international registration is dependent on the basic mark for a period of 5 years from the international registration date. Actions taken on the basic mark after this date will not affect the international mark unless action resulting in changes to the basic mark was begun before the five years expired.

Renewal

[Art. 7](#)

An international mark is valid for a period of ten years from the date of registration ([see Art. 7\(3\)](#)). WIPO will send an unofficial reminder to the holder of the international mark approximately six months before the mark is due for renewal. This reminder will also be copied to the holder's representative in the country of origin of the mark, together with a copy of the renewal form. Renewals should be sent directly to WIPO,

A request to renew an international registration may be sent to WIPO up to six months before the renewal date. However, holders should be aware that if they file a request for renewal more than three months in advance of the renewal date and the fees are changed before the renewal date, they will be expected to pay the new fee.

Requests for renewal may be filed in the form of a letter or by using the official renewal form [MM11](#), which can be printed from the WIPO website. It is important to ensure that WIPO receives the renewal fee before the due date. A request for renewal cannot be actioned without the necessary fee.

It is possible to renew international trade marks for six months after the expiry of the registration. However, if renewal requests are filed in this six month 'grace period' a surcharge will be added to the renewal fee.

Replacement

[Art. 4bis](#)

An international registration may replace an existing national registration in any designated contracting party. To be eligible to replace a national mark, the international designation must:

- be in respect of the same mark;
- be held by the same holder;
- cover all the goods and services covered by the existing national mark.

The international designation must also have been granted protection in the relevant country (see [Art. 4\(bis\)\(2\)](#)). Replacement is deemed to happen automatically if the above criteria are met. However, it is only recorded by a particular country if a request to record is made. Holders of international marks which have designated the UK who wish these designations to be recorded as replacing their existing national rights in this country, must ask us to record this fact by filing form [TM28](#). We will examine the request to check that it meets all the relevant criteria as defined above and we will put an indicator on OPTICS against the national mark to indicate its link with the international case. When the national mark is due for renewal the holder may then choose to let his national registration lapse. His trade mark rights will continue embodied in the international registration.

Subsequent Designation

[Art. 3ter](#)

At any time **after registration** the holder of an international mark may apply to add to the list of countries where his mark is protected. Such 'territorial extension' of an international trade mark is referred to as 'subsequent designation.'

[Rule 24\(1\)\(a\)/Rule 24\(2\)\(b\)](#)

The holder of the international mark can file a subsequent designation - complying with the criteria laid down in [Article 2 of the Protocol](#) - using the official form [MM4](#), which can be printed from the WIPO website. The form may be filed directly to WIPO, via the Office of Origin of the case, or via 'the office of the contracting party of the holder.' However, if the original international application was based on an application rather than a registered national mark, then endorsement of the Office of Origin is needed in order to confirm the continued existence of the basic mark.

Filing a subsequent designation

Subsequent designation forms filed via the Intellectual Property Office are received in our Finance Section. The form is stamped with the date on which it was received. This date will become the filing date of the subsequent designation provided no irregularities are found, and provided that WIPO receive the form within two months. The Intellectual

Property Office does not charge a handling fee for the processing of the subsequent designation form.

[Art. 3ter\(2\)](#)

WIPO examine the application for subsequent designation. Irregularities will be brought to the attention of the holder of the mark and the Office of Origin in the same manner as with new international applications. A non-extendable three month deadline for response is set. Once the formalities check is complete, the subsequent designation will be registered and the details published in the [International Gazette](#). Details of the designation will be passed to each of the newly designated contracting parties. The mark will be examined in each new country and WIPO will be notified whether the subsequent designation can or cannot be protected in that country. The rights in each new country will run from the date of the subsequent designation.

A subsequent designation is not a separate international mark. It is simply a means to add countries to an existing international registration. The international mark must be registered if a subsequent designation is to be made. The protection gained in the new countries will only run until the international registration is due for renewal. If the subsequent designation is filed nine-and-a-half years into the ten year life cycle of the international mark, the mark will only be protected for six months in the new countries. For this reason, most subsequent designations are made shortly after the registration or shortly after the renewal of the international mark.

UK as a Designated Contracting Party

In the same way that holders of UK Trade Marks may use their national mark as a basis for an international registration seeking protection in other member countries of the Protocol, so holders of marks in other Protocol member countries may use their national rights as a basis of an international registration designating the UK.

[Article 3\(4\)](#) and [Rule 14](#) of the Common regulations states that once an international mark is registered:

The International Bureau shall notify the international registration without delay to the Offices concerned.

Receipt of Designations

We receive notification from WIPO on a weekly basis of new international marks seeking protection in the UK. The information is received in electronic format. The electronic information is downloaded onto the TMAD computer system. International Section add extra information (for example, a mark type and a status) to make the case details compatible with the in-house computer systems of this office. TMAD will then update the UK-Intellectual Property Office databases - OPTICS and IBIS - with the new information.

We are required to inform WIPO within 18 months of the notification date whether each mark can be protected in the UK. We issue a provisional decision to WIPO at examination stage if objections are raised against the mark and follow this up with a final decision once all proceedings before this office, including any appeals to the courts, have been completed. WIPO forward all letters from us relating to the international designation to the holder, or their representative, of the mark.

Examination of designations at the UK Office

International designations under the Madrid Protocol are examined under the [Trade Marks Act 1994](#) in exactly the same way as national applications. Examination procedures are described in [The Examination Guide](#). New international designations are examined to ensure they comply with the Act, and searches of the UK Trade Mark Register are carried out to check for earlier rights.

The nature of the Madrid system is different from that of our own national registration system. Two main differences become evident when administering the system:

- the status of international trade marks in the UK; and
- the communication chain between the UK Intellectual Property Office and the holder of the mark.

Status of international trade marks

International designations are already 'registered' status when we receive them, having been placed onto the International Register prior to publication. This means that in practice:

- there are limitations on what action may be taken on the case; and
- the vocabulary, when working with international marks, differs from that associated with domestic applications.

Limitations on action

The limitations when dealing with an international designation fall into two categories:

- issues relating to formalities of trade mark examination;
- issues relating to the communication of information.

Issues relating to formality checking of designations

[The Trade Marks \(International registration\) Order 2008](#) specifically excludes international designations from the parts of the Act which relate to examination of formalities. Examination of international designations does not include a check that filing requirements are met or that the representation of the mark and the classification of goods and services are acceptable. These aspects have already been checked and the

mark has been found to be acceptable for international registration before it is sent to the UK.

Issues relating to the communication of information

International examiners may not always communicate directly with the holder of the international designation, but must pass certain information through WIPO. Under the Madrid system, national offices must inform WIPO of any action that may affect the scope of protection of a mark within that country. WIPO pass this information to the holder or his representative as well as to all other countries involved with the mark. The information is also published in the International Gazette.

Vocabulary used in respect of international marks

When international designations reach the UK they are already 'registered' status. It is therefore necessary to adopt a new vocabulary when dealing with international designations. A [glossary of terms](#) used in relation to international trade marks is at the back of this guide.

The Examination Procedure

International designations to the UK are subjected to the same examination procedure as new national applications. They are tested under [Section 3 of the Trade Marks Act 1994](#) and searches are carried out to identify any earlier rights that are thought to be similar to the designation ([Section 5 of the Trade Marks Act 1994](#)). Examiners carry out examination of international marks using the IBIS, and OPTICS systems. The results of the examination are then recorded onto TMAD. TMAD holds a record of whether substantive objections have been raised against a mark, as well as indicating whether a provisional refusal letter was sent to WIPO about the case.

Important Differences

An important difference between the international and domestic examination procedures is that international examiners do not send a 'report' of the examination directly to the holder of the designation (see [Art. 5](#)) where a substantive objection under [Section 3](#) is raised. If objections are found, a letter of provisional refusal is sent to WIPO. This will then be forwarded to the holder by the International Bureau once the Bureau has recorded the information on the international register.

Where examination of the designation finds only earlier rights issues, information regarding any conflicting earlier rights is sent directly to the representative before WIPO, or if there is not one recorded, to the holder.

Possible outcomes of examination

Examination of international designations has four possible outcomes:

- **acceptance** of the mark for all goods and services; or
- **provisional total refusal** of the mark, ie refusal of the mark for all goods and services; or
- **provisional partial refusal** of the mark, ie objections are raised in respect of some but not all of the goods and services listed on the application, or
- **information regarding earlier rights**, i.e. earlier rights have been identified which conflict with the mark for some or all of the goods/services of the designation

Whilst the examination process mirrors closely that for domestic applications, there are certain differences in administration which are necessary simply because International Section are dealing with trade marks which have already been registered. These differences are detailed below.

Acceptance of designations

If an international designation is found to be acceptable at examination stage, then the case will be forwarded directly for advertisement in the UK Trade Marks Journal. There is no requirement to notify WIPO regarding the case at this point. Neither will the holder be notified directly regarding the findings of the examination.

The Examiner will record the examination on TMAD and produce a draft advertisement. The examiner will check that all information is correct and approve the case for publication. The case status will then be updated to 'awaiting advertisement' and the case will join those awaiting publication in the Trade Marks Journal (see [Rule 17\(6\)](#)). We will write directly to the holder or their representative to inform them of the date of publication on the [Intellectual Property Office](#) website.

International designations are published in a separate section after national marks in the [Trade Marks Journal](#). The marks are open to opposition in the same way as national marks.

Administrative Differences in examination procedure

Collective/certification/guarantee marks

International applications may be filed as a collective, certification or guarantee mark. The international application form does not distinguish between the types of mark and we will receive notification of the designation with the statement reading: 'collective/certification/ guarantee mark.'

Designations for collective/certification/guarantee marks are examined in the same manner as international trade mark designations. However, in **all** cases it will be necessary to raise a '**provisional total refusal of protection**' for the case to be sent to WIPO. The reason for this is that for UK examination purposes, we can only accept marks as either a collective or certification mark. We do not accept guarantee marks.

Therefore the holder needs to specify the type of protection applied for and they should therefore be requested to confirm this. It is also a requirement of [Schedules 1 and 2 of the Trade Marks Act](#) that a copy of the regulations governing use of the collective or certification marks are filed. The letter will request filing of form [TM35](#) and fee together with the filing of the regulations.

Any other objections raised against the mark, such as Section 3(1)(b) or (c) objections or earlier rights, must be dealt with before the international file is released to the experts in dealing with collective and certification marks. The experts will examine the regulations supplied and ensure that these comply with the law before the case proceeds to advertisement.

Examining graphic representations

In examining international designations, the details captured onto the TMAD system should be noted. The electronic details of the case are sent directly from WIPO. These may show that a word is included in the mark. The word may not be legible, or even visible, on the representation. However, if the word is captured on TMAD then it should be understood to form part of the mark and the case should be examined as a 'word and device' or 'form and word' mark. Similarly, it may appear from the representation that a mark contains a word element but that word element is not captured on TMAD. In these circumstances, the mark should be examined as a 'device only' or a 'form only' mark.

These comments do not detract from the examiner's consideration of the mark **in the format in which it has been registered**. Hence, if a distinctive element of a mark is minimal when considered in the context of the mark as a whole, then examiners will continue to raise objections against protection of the mark.

Indistinguishable elements within marks

It is the responsibility of the examiner to ensure that the representation of the mark is acceptable for Journal publication. If the representation of the mark is unclear at draft first advertisement stage, the examiner will need to check ROMARIN, IBIS and the International Gazette to ensure that the clearest possible representation of the mark is used for publication. In the circumstances described above, where TMAD indicates that a word forms part of the mark but that word is unclear and not minimal within the mark, then a clause should be added to state:

“The mark contains the word(s) ‘.....’ ”

Priority claims

A claim to International Convention priority appears as a simple statement on the notification of a new international designation. The date should be checked and if this is within six months of the filing date, the claim to priority may be accepted.

The rapid processing of domestic applications may lead to a circumstance where a domestic mark, with a later filing date, has already proceeded to advertisement and even to registration before the receipt of an international designation, which has an earlier priority date.

When a conflicting domestic mark with later filing date is discovered in the course of searching for citations, then the status of this mark should be considered. If it has not yet proceeded to advertisement, then the domestic examiner should be informed in order that the international mark may be raised as a late notification of an earlier right. If the domestic case has already been advertised or registered, then no action can be taken against it. The international designation, having earlier rights through priority or filing date, may also proceed.

Publication of descriptions

Descriptions filed by applicants will appear in the Trade Marks Journal advertisement for the case.

Section 3(1)(a)

WIPO examine and register representations of marks and hence there should be no reason to object to a representation of a mark. However, there are times when an objection under Section 3(1)(a) of the Act is unavoidable. It may be that it is not possible to examine the mark from the representation provided. This may be, for example, because the holder claims that the mark is three-dimensional but it is not possible to ascertain this from the representation, or the mark may consist of a graphic representation and a description but the description does not match the representation provided. **Any case where a Section 3(1)(a) objection appears necessary should be passed to the Team Leader for consideration.**

Specifications listing 'retail services'

[The Trade Marks \(International registration\) Order 2008](#) excludes international designations from the provisions of [Section 34 of the Trade Marks Act 1994](#). Hence, it is not possible to raise the same objections to the wording of specifications listing '[retail services](#)' as are raised by domestic examination units.

International designations which include a reference to '[retail services](#)' or any other wording which indicates retail services will be subject to objection under Section 1(1) and Section 3(1)(a) of the Act '...because such claims do not clearly identify 'services' within the meaning of Section 1 (1).' Holders will be given the option to overcome the objection by 'defining their area of interest more precisely'.

The objection may be overcome by adopting the wording for definition of retail services which is given in the Class 35 heading of the Nice Classification Index, together with a statement of the manner of providing the service and the goods of interest, for example:

Retail services connected with [indicate goods or type of services]

Retail services connected with the sale of [indicate goods or type of services]

Mail order retail services connected with [indicate goods or type of services]

The bringing together, for the benefit of others, of a variety [indicate goods or type of services] enabling customers to conveniently view and purchase those goods.

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a clothing and accessories catalogue by mail order or by means of telecommunications.

Further guidance on this issue can be obtained by consulting Classification Section at the Trade Marks Registry

Three-dimensional marks

If a mark claims three dimensions, then it must be clear from the representation what those dimensions are. If the three dimensions are not clear, the mark will be open to objection under Section 3(1)(a), as described above.

There are no hard and fast rules as to how many representations of a mark are necessary to establish three dimensions. This will depend on the mark. WIPO's requirement that the international mark must be fitted into a box 8cm x 8cm on the application form should also be remembered. This requirement may restrict the number of representations of a mark that a holder can provide.

UK Clauses

International designations may include any amount of information relating to the mark. Clauses include descriptions of the mark or three dimensional claims. If the written information does not match the representation given, then the mark will be open to objection under [Section 1 \(1\) and 3\(1\)\(a\) of the Act](#). For example, a clause may indicate that colour A is claimed, but the representation of the mark shows it in colour B. Similarly, in cases where three dimensions are claimed but the representation only shows two dimensions, it may be necessary to raise an objection. **Team Leaders should be consulted.**

Vague terms in specifications

Generally, these should be left. The term has already been accepted by WIPO. However, it may be that a term gives us absolutely no idea what the goods or services being described actually are, to the extent that it is not possible to examine the case in

respect of those goods/services. **Team Leaders should be consulted in such circumstances.**

[Rule 13](#) of the Common Regulations allows WIPO to object to vague terms in specifications. This objection will be raised prior to the registration of the international mark and a time limit for clarification will be set. However, if the holder does not clarify the term within the time allowed [Rule 13\(2\)\(b\)](#) will apply. This states that if the Office of Origin has classified the term then WIPO will include it in the international registration, albeit with an indication that the term is considered too vague. Thus, we may receive designations with the phrase 'terms considered too vague by the International Bureau ([Rule 13 \(2\)\(b\)](#))' appearing in one or more specifications of goods or services.

Where WIPO have objected to the term and we also consider it to be too vague we will query it. The query should be raised under the heading 'Specification' and should state that '...the following term is considered too vague for the purposes of examination.... Please clarify this term'. If no other objections have been raised then a partial refusal may be offered, deleting the objectionable term and allowing publication of the acceptable terms within the specification. **Again, if there is any doubt, Team Leaders should be consulted.**

Wrongly classified terms in specifications

On occasions, it may appear that a term listed in the specification of goods or services for an international designation has been wrongly classified. Classification of international trade marks is checked at WIPO prior to the international registration of the mark. The classification has been accepted and should not be queried post-registration except on the rare occasion when there has been a mis-translation from the original French or Spanish list. Occasionally, where goods and services appear to have been wrongly classified, investigation may reveal that the queried term has in fact been mis-translated. The language of the original international application can be found on the paper that notifies us of the new designation. French or Spanish versions of specifications can be found on [Madrid express](#). If a mis-translation is spotted, a brief telephone call to the International Bureau is sufficient to arrange a correction of the translation in order that the queried terms are accurately represented in English and in the correct class.

Conflicting Earlier Rights

Where the designation is found to be acceptable under Section 3 and no issues are identified in relation to the specification, but a search of the database has identified earlier conflicting marks, then the holder will be informed of the conflicting marks. As earlier marks are not an official objection and are provided for information, but do not prevent the designation from proceeding to advertisement, under the rule of the Protocol it is not necessary to inform WIPO. (see also [Notifications in Examination guide](#))

Information regarding earlier marks is sent directly to the holder, or their representative. Any amendments to the specification submitted to avoid the need to notify earlier mark, **must** be filed on form MM6 and sent to WIPO. The holder is requested to send a copy of this form to the examiner of the designation and this will be sufficient to allow the designation to proceed for the restricted specification.

Corrections received from WIPO

Under [Rule 28](#) of the Common Regulations, where the International Bureau of WIPO considers that there is an error in the information recorded on the register, it will correct that information. Corrections may be initiated by the holder of the mark, by a national office or by the International Bureau itself. They may be corrections to any part of the information originally provided and may widen the scope of the specifications originally filed or even change the mark ([see Rule 28\(3\)](#)). However, requests by national offices to correct the international register must be made within nine months of the date of publication of the relevant information. The 18-month time limit, within which we are required to issue any refusal of protection for a case, starts from the date on which we are notified of the correction.

Corrections which limit the scope of a mark can be actioned. However, if a correction makes the case wider or changes the mark from that originally received, then the case will need to be re-examined in respect of the corrected information. If new goods or services appear in a correction then the case will be re-examined for those goods/services.

If the correction relates to a change in the substance of the mark itself, then it will be necessary to halt the progress of the original case and restart the examination procedure with the new mark. In such cases the date on which we are notified of the correction will become the new protection date for the case. If the case has already been advertised and the mark is changed, then it will be necessary to withdraw the advertisement, so that the case can be re-examined and re-advertised in respect of the amended mark. It is important to note that in these circumstances the 18-month period commences from the date of sending the notification of correction to the Registry.

It may be that a notice to correct a mark is received after that mark has been protected in the UK. Corrections that widen the coverage of the protected mark will be considered and treated as a subsequent designation. Any rights in the additional goods will derive from the date of notification of the correction.

Irregularity letters in respect of Examination issues from WIPO

[Rule 18](#)

In order for WIPO to accept letters refusing protection of a mark, these letters must contain certain information as listed in [Rule 17](#). If our refusal letters do not comply with Rule 17, WIPO will send us a letter of irregularity pointing out the error. WIPO will send the holder our refusal letter and a letter explaining that they consider our refusal to be

