

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

irregular and that if the irregularity is not corrected within two months then they will not regard our refusal to protect the mark as valid. Thus, the holder of the mark need do nothing about our refusal until they see whether the irregularity is to be corrected.

It is the responsibility of the examiner dealing with the case to correct the irregularity. The refusal letter is re-issued ensuring that the missing information is included. **The re-drafted letter should include a statement to say that it is issued in response to an irregularity letter and that it totally replaces the earlier refusal letter. The examiner should set a new reply by date.**

An irregularity should be corrected within two months. A deadline for receipt of the correction is normally given in the WIPO letter. However, irregularity letters must be dealt with as a matter of priority in order to ensure that all deadlines are met.

Provisional Refusal of Protection

[Art. 5\(1\)](#)

If examination of an international designation produces objections under absolute grounds, then that mark will be **provisionally** refused protection in the UK (see [Rule 17](#)). This refusal of protection must be communicated to WIPO. The refusal letter must contain certain information. In particular, paragraph (2) (vi) of [Rule 17](#) states that if the refusal does not cover all goods/services, then the letter should indicate which goods/services are or are not affected by the refusal.

Provisional Total Refusal

A total refusal of protection may be raised under absolute grounds. The mark itself may be open to objection under [Section 3 of the Act](#) for all goods/services listed in the application. A letter is sent to WIPO to explain that the mark is provisionally being refused protection. This is headed with the words 'Provisional Total Refusal' and states in the first paragraph that the refusal is for all goods and services. The letter is accompanied by a report detailing the grounds for refusal of protection of the mark and may include information regarding any earlier rights that are deemed to conflict with the designation.

International examiners prepare the refusal letter that is sent to WIPO and set a date for response. WIPO records the information contained in the letter and then forwards it to the holder of the international mark or to his representative. The holder of the mark can make representations, within the time limit set by the designated office, against the provisional refusal of protection.

Provisional Partial Refusal

This refusal may also be raised on absolute grounds. The difference is that the objections raised will not be for all goods and services. There will be some goods or services for which the mark may be accepted. This will occur, for example, if an objection is raised against one class of a multi-class designation. The case may be

protected for the classes of goods or services not affected by the objection. As above, it is made clear in the letter which International Section despatch to WIPO that the designation is only being refused protection in respect of certain classes. The letter will be headed 'Provisional Partial Refusal'. Again, the letter will be accompanied by a report detailing the grounds and the relevant Class where refusal of protection of the mark is raised. It may also include details of any earlier rights that are deemed to be in conflict with the designation. The Provisional Partial Refusal will list the classes of goods and services in respect of which the case may proceed, these will not include classes where only earlier rights are raised for information. A deadline for response is given, to allow the holder to make representations against the partial refusal of protection, if he so wishes. The letter will be sent to WIPO in order that the information it contains may be recorded in the International register. WIPO will then forward the letter on to the holder of the mark or his representative. An International registration may not be divided to overcome objections in the same way as national marks.

Time limits for raising objections by the UK Office

[Art. 5\(2\)](#)

Any member country of the Protocol has the right to refuse to protect an international mark within its territory. However, this refusal must be received by WIPO within a given time limit. For the United Kingdom, this time limit is 18 months from the date on which WIPO notified the UK of the new designation. A refusal letter may be reissued, for example, to correct an irregularity, provided that the case is still within the 18 month time limit.

Objections raised against a mark can of course be resolved through correspondence. However this takes time and may take an international designation beyond its 18 month time limit.

An opposition is a reason for total refusal of a case and a new provisional refusal letter must therefore be sent to WIPO. If this is sent after the 18-month deadline, it will not be accepted unless WIPO has been informed before the 18-month deadline that there is a possibility that late oppositions may be filed.

[Art. 5\(2\)\(c\)\(i\)](#)

Article 5(2) requires that in cases where an outcome will not be finally resolved within the 18 month period allowed, WIPO is informed **before** the end of the 18 months that it is possible that oppositions will be filed against the case **after** the 18 months. [Rule 16\(1\)\(b\)](#) requires that WIPO is informed of the start and finish dates of the opposition period, as soon as these are known. Thus, as soon as it becomes clear that a case is not going to be finally resolved before the end of the 18 month period, WIPO is informed of the possibility of late oppositions. This is done automatically with a computer-generated letter. Correspondence rounds may then be continued and the objections resolved, without fear of incurring problems with WIPO at a later date.

Post Examination

Possible action following a provisional refusal.

The holder of an international designation that is provisionally refused protection in the UK may choose to make representations against that refusal. Representations may take the form of:

- written submissions from representatives;
- request for more time;
- filing of evidence of use of the mark in the UK
- request for a hearing.

A hearing to discuss the case may be held before a senior officer at the Trade Marks Registry by telephone, video conference link or face to face; the former two options are preferred by the Registrar.

Where problems are small and a simple agreement to a proposal will allow the case to proceed, the holder may write directly to the examiner dealing with the case. However, for weighty objections or in circumstances where there will be a protracted exchange of correspondence, an address for service in the EC, Channel Islands or the European Economic Area (EEA) is required. Holders abroad are less likely to be familiar with UK trade mark law and practice, and it may be advisable that holders appoint a UK representative. However, this is of course at the discretion of the holder and it is the aim of International Section to explain problems simply and precisely so customers understand what is required of them.

Appointing an EU, Channel Islands or EEA based representative

One of the first actions a holder may wish to take on receiving via WIPO a letter of refusal of protection in the UK is to appoint an EU, Channel Islands or EEA based representative to argue their case. This is done by completing form [TM33](#) with the relevant details. A copy of the form may be downloaded from our website. Once form TM33 has been completed and forwarded to the office, the representative's details will be captured onto TMAD. Once recorded, **these details will be used in this office in preference to the holder's own contact details or those of his representative before WIPO.**

It should be remembered that **the UK representative can be different to the representative acting before WIPO** in respect of the case. The UK representative will be responsible for all action carried out on the case before the Intellectual Property Office. This includes responses to correspondence, attendance at hearings and requests for extensions to time deadlines. However, requests to change the substance of an international registration, such as changes to the holder's details or limitations to the goods and services, must be filed via WIPO. It may be necessary for the holder of the mark or his representative before WIPO to file the official forms requesting these changes. ([WIP forms](#))

Appeal Period for response to the provisional refusal

A letter provisionally refusing protection of an international mark in the UK usually carries a two month period for response in respect of an absolute grounds objection. If the holder of the mark wishes to appeal against the refusal he must ensure that he contacts the Intellectual Property Office by the date given for response. If nothing has been heard from the holder by the deadline, then the case must be allowed to continue to its outcome.

Failure to respond

If the holder does not respond within the set time period, there are two possible ways forward at this point.

Proceeds in respect of some of the Goods/Services

[Rule 17\(2\)\(vi\)](#)

If a Provisional Partial Refusal letter was issued at examination stage, this will have listed those goods and services for which the mark could be accepted. If nothing is heard by the deadline for response, cases subject to provisional partial provisional refusal will be advertised in respect of those goods and services not affected by the provisional refusal.

Refused in respect of all goods/services

[Rule 17\(5\) \(a\) \(i\)](#)

If a provisional total refusal letter was issued at examination stage and nothing further is heard, then the refusal will become final.

Final Refusal of the designation in the UK

[Rule 17\(5\) \(a\) \(i\)](#)

Total final refusal of a designation occurs in two circumstances: either there has been no response to original 'provisional' total refusal, or there has been an exchange of correspondence and possibly a hearing, but the objections raised have been maintained.

If a form [TM33](#) has been filed and a representative has been appointed, notice of refusal (R.App.12) will have been sent to the representative and one month allowed for the filing of Form [TM5](#). If no [TM5](#) is filed the provisional refusal of protection issued at examination stage will become final.

If the provisional refusal is appealed by filing form [TM5](#), a statement of grounds will be issued. A month is allowed for receipt of any further appeal. If an appeal against the

statement of grounds is lodged, either to the Appointed Person or to the courts, then when a final decision is reached the provisional refusal of protection issued at examination stage will become final.

WIPO are then informed of the final refusal of protection for the case. The letter refers back to the original refusal of protection and confirms that the decision is now final, for all goods and services. The letter is sent to WIPO, who record the decision and publish it in the [International Gazette](#). WIPO forward the letter to the holder of the mark. The case will become 'Dead-Refused' status on TMAD and the case file will be sent to the file store.

Publication of acceptable marks

Every international designation that is accepted in the UK is published in the Trade Marks Journal and is open to opposition, in exactly the same way as domestic applications. A draft advertisement is prepared using TMAD (see 'Acceptance of Designations' above) and this is checked and approved before the advertisement appears in the [Trade Marks Journal](#).

International marks are published in the Trade Marks Journal in a separate section, following national trade marks. Anyone may file observations or oppose an international mark within the set opposition period, in the same way as for national marks.

Observations

[The Trade Marks \(International registration\) Order 2008](#) allows for written observations to be sent to the registrar, about whether a mark should or should not be protected in the UK. Observations may also be sent about international designations. Observations can only be filed on absolute grounds. Any observations on international marks will be considered in the same manner as observations against domestic marks, that is, they should bring to the notice of the registrar new information regarding, for example, a descriptive or generic meaning of a mark. Observers will need to provide evidence in support of their comments. Observations on earlier rights will not be considered as an observation and will need to be addressed via the opposition or revocation route.

Observations will be duly considered and if we feel that the designation has been accepted in error, then the holder must be informed and given an opportunity to respond. If the designation is to be allowed to proceed despite the observations, the holder must nevertheless be informed of the observations. Correspondence regarding observations will always be directly between the UK Intellectual Property Office and the holder of the mark or his representative. It is not necessary to involve WIPO in such matters.

Oppositions

International designations are opposed in exactly the same way as national marks, that is, by filing [form TM7](#), together with a statement of grounds of opposition and a fee.

WIPO must be informed of oppositions since an opposition is a reason for provisional refusal of protection of a designation.

It is important that WIPO is provided with all information about the opposition. A copy of the [form TM7](#) and statement of grounds of opposition is therefore attached to the letter informing WIPO of the provisional refusal of protection of the mark.

Details of the forms necessary for filing a counterstatement are also attached along with form [TM33](#) for an agent/address for service in the United Kingdom to be appointed. In cases where it has taken longer than the prescribed 18 months to process the case, we are also required to tell WIPO the start and finish dates of the opposition period ([Rule 16\(1\)](#)). In such cases, the refusal letter to WIPO will be accompanied by a separate letter providing this information.

In the UK notices of opposition are 'served' upon the applicant for a mark and the two month period allowed for filing of a counterstatement begins on the date of serving the papers. Oppositions are time-critical and provisional refusals of protection based on opposition are therefore faxed to WIPO in order that they can be forwarded to the holder as quickly as possible. Because international opposition papers are 'served' to WIPO, it is **imperative** that a confirmation of receipt of the fax is received. The [Administrative Instructions Section 8, 2.07](#) confirm that WIPO will promptly confirm receipt of faxes.

In accordance with [Tribunal Practice Notice \(TPN\) 2/2001](#), the United Kingdom sends a copy of the international opposition papers to the applicant's address for service in the United Kingdom (if applicable), or to the holder's representative before WIPO if an address for service in the United Kingdom is not available. This copy is sent for information purposes only and does not replace the formal notification issued to WIPO.

Opposition to an international designation is equivalent to opposition to a national application. Because oppositions are filed under the Trade Marks Act 1994, these are dealt with by Tribunal Section and not by International Section.

Protection

When the opposition period has expired and no opposition has been received, or when any filed opposition are not successful or are resolved in the favour of the holder, an international designation will gain 'protected' status in the United Kingdom. [Section 3 \(2\) of the International Order 2008](#) states that:

..... a protected international trade mark (UK) shall be treated as if it were a trade mark registered under the Act and the holder shall have the same rights and remedies but shall be subject to the same conditions as the proprietor of a registered trade mark

If no opposition has been received, we regard protection to have been achieved the day after the end of the opposition period for the case. This date is important for non use revocation purposes as the 5 year period for non use begins from the date of protection

in the UK. However, the rights of the trade mark will date from the international registration date in the same way that the rights of a UK registration date from the filing of the UK application. The protected status will be recorded on TMAD approximately 9 days after the end of the opposition period, to allow for any opposition filed at the last moment.

It should be noted that **no registration certificate is issued** with regard to international designations. The reason for this is that the mark received its 'registration certificate' from WIPO when it was registered internationally, prior to being forwarded to the UK for examination. The holder will learn that his mark is protected in the UK via one of the three 'final' letters which are sent to WIPO regarding cases. All 'final' letters are sent via WIPO in order that the final status of the UK designation may be recorded on the international register, and published in the International Gazette for the information of third parties. WIPO will forward a copy of the final decision to the holder or their representative.

Confirmation of Protection in the UK

The UK office will notify WIPO when a designation is protected in the UK. This is done at the time the mark achieves protection in the UK and follows the procedure laid out in the Common Regulations

Statement of Grant of Protection

[Rule 17\(6\)\(i\)](#) (*This will become Rule 18ter(1) on 1.9.2009*)

This letter is sent in cases where no provisional refusal has been issued. The grant of protection letter allows WIPO to 'close the case' as regards the UK designation and the holder's rights in respect of the UK are confirmed without the need to wait until the end of the 18 month period. The protection of the mark is recorded and published in International Gazette and the grant of protection letter is forwarded to the holder.

Statement of Withdrawal of Provisional Refusal

[Rule 17\(5\)\(ii\)](#) (*This will become Rule 18ter(2)(i) on 1.9.2009*)

This letter is issued in cases where the provisional refusal issued at examination stage was waived or overcome **in its entirety**. The mark was advertised in the UK Trade Marks Journal **for exactly the same goods and services as are recorded at WIPO**. The letter informs WIPO that the provisional refusal raised has been **completely withdrawn**, and that the mark is now protected in the UK. The protection of the mark is recorded and published in International Gazette and the statement of withdrawal letter is forwarded to the holder

Confirmation of Final Decision

[Rule 17\(5\)\(iii\)](#). (*This will become Rule 18(2) (ii) on 1.9.2009*)

This letter is issued in circumstances where a provisional refusal has been partially overcome and the case has been allowed to proceed to advertisement in respect of **part of the list of goods and services originally notified**. We then inform WIPO that the mark has been **partially protected** in the UK. The letter lists the goods and/or services

that have been protected and also confirms that all other goods and services have finally been refused protection.

This information is recorded in the international register and the letter is then forwarded to the holder or his representative.

A final decision may not refuse protection to more goods and services than the provisional decision. This means that if no refusal is issued at provisional stage, then the mark **will** be published and protected in the UK in respect of the goods and services covered by the international designation. Similarly, if a partial refusal is issued at examination stage, we are bound to publish and protect the goods listed as acceptable. Therefore, if the holder wishes to limit the scope of his mark more than the registry proposes, or to withdraw the UK designation completely, he must do this directly with WIPO.

Transformation to national application

[Art. 9quinques](#)

Where an international application is cancelled at the request of the Office of Origin of the case, the holder may opt to try to obtain protection for his mark in some or all of his designated countries by filing national applications in those countries. If the national application is filed within three months of the recordal in the international register of the cancellation of the international mark, then the holder may claim the filing date of the international application. This procedure is known as 'transformation'.

Transformation is defined in [Article 9quinques](#) of the Madrid Protocol. Applications must meet the following criteria in order to transform:

- the national application must be filed within three months of the death of the international mark;
- the national application must be for the same mark and for the same or no wider goods and services than the international mark;
- all national filing requirements, including payment of fees, must be met.
- The request will be filed on [form TM4](#)

Applicants wishing to transform international rights to national (UK) rights will do so by completing and filing the relevant national application form. Details of the international mark on which the transformation is based must be provided. If the application meets all requirements and transformation is allowed, the case will be given the same status as the international mark prior to cancellation. If the international mark had 'protected' status prior to being cancelled, then the transformed 'national' mark will automatically be given 'registered' status. This is possible because the case has already been through the UK examination procedure as an international designation. If the international mark was 'examined' status, then the new national application will be 'examined' status. It will continue through the registration procedure as a domestic application.

The International Register

The international register is kept and updated by WIPO. Any changes to details held on the international register, such as limitations to the goods or services covered by a mark or updates to the holder's details, must be notified to WIPO. WIPO are responsible for recording these details onto the international register.

Who may update the international register?

Clearly not everyone may request changes to the details of an international registration. WIPO must be assured that the party filing the official form has authority to act with respect to the international mark in question. Persons with authority to act fall into three groups:

- the holder or their representative in the country of origin of the mark;
- the Office of Origin of the international application; and
- the Office of the contracting party of the holder.

The holder or their representative

Every international application form carries the name and address details of the holder of the mark. The holder may also choose to allow a representative to file his application and to act for him in matters relating to the international trade mark. These are the only names that WIPO records for the mark. These are therefore the only people from whom WIPO will accept forms requesting changes to details of a mark.

The Office of Origin of the application

The Office of Origin has to inform WIPO (under [Rules 22 & 25](#)) of changes to the national mark on which the international application is based. If the basic mark is refused, opposed or falls away for some reason, within the first 5 years following filing, WIPO must be informed. Similarly, if the basic mark is registered for a narrower list of goods and services than that originally applied for, WIPO will need to limit the international mark in line with the case upon which it is based. So, the Office of Origin may forward letters from the holder requesting partial or total cancellation of an international trade mark, or may notify WIPO of ceasing of effect of the basic mark.

The Office of Origin is also authorised to accept and pass on certain of the official [forms MM5 to MM15](#), where the holder's address is in the UK. These forms may be endorsed by the Office of Origin.

Office of the contracting party of the holder

In cases where an international mark has been assigned to a holder in another member country of the system, the national office of the new holder may forward official forms to WIPO, if requested to do so.

The notable exception to the list of persons who may act before WIPO in respect of an international mark is **the representative appointed in a single designated contracting party**.

Representatives in designated contracting parties

Representatives appointed to deal with individual designations of an international registration may **not** normally file official forms requesting updates to the international register. These individual representatives are not recorded on the international register. Clearly, it would not be acceptable that the international register be updated by any third party that has no connection with the mark in question. Therefore, since WIPO is unable to recognise representatives from designated contracting parties, any limitations or changes to individual designations are required, such requests must be sent to WIPO by the holder or by the instructing attorney in the country of origin of the mark.

This may cause problems for attorneys dealing with UK designations of international marks.

Changes to international registrations - ([Rule 25](#))

Transfer of ownership - form [MM5](#)

[See Rule 25\(3\)](#)

Under the Madrid system assignment of a trade mark is referred to as 'transfer of ownership'.

If the assignment of an international registration is to be recorded on the international register, then the new owner of the mark must be entitled to hold marks under the Madrid system ([entitlement to be new holder](#)). He must **also** be entitled to hold the mark in question. For example, if the mark is registered under the Madrid Agreement and the new holder is a national of, resident in, or holds a real and effective commercial establishment in a 'Protocol only' country, then the assignment of rights will not be recorded in the international register. Holders in 'Agreement only' countries may only hold 'Agreement designations' of international marks; likewise holders in 'Protocol only' countries. It follows that if the new owner of the mark is in a country which is party to both the Agreement and the Protocol, he will be entitled to hold all designations of the mark.

[Form MM5](#) is used to record the transfer of ownership of a mark to a different legal entity. (Compare [form MM9](#), which is used to change the holder's name and address details in circumstances where the legal ownership of the mark has not changed.)

The form may be sent to WIPO by the holder or by the national office of the holder. It may also be filed by the national office of the transferee, it being understood that this office is in a member country of the Madrid system. A fee is payable for recording the transfer in ownership. The new holder of the mark will be required to indicate on the form his entitlement to hold the mark.

Transfer of ownership is recorded as the date when WIPO receive a form [MM5](#) which complies with all filing requirements. Transfers are published in the [International Gazette](#).

Limitation, renunciation and cancellation

These three actions all have the same result - a limit in the original scope of the international registration. The difference between them is:

- Limitation - limits **some** of the list of goods and services, in respect of **some or all** of the designated contracting parties.
- Renunciation - renunciation of protection for **all** goods and services, in respect of **some but not all** designated contracting parties.
- Cancellation - cancels **some or all** goods and services, in respect of **all** designated contracting parties.

From the above definitions it will be clear that a limitation and a cancellation have much in common. There is however one important difference. A **limitation** means that the goods that have been struck out are no longer covered by the international registration. But if protection for the goods that have been struck out **is** required in the future, this can be obtained by filing a subsequent designation form. **The goods and services have not been taken out of the international registration itself**. They are simply 'not protected' in the designated contracting parties affected by the limitation.

A **cancellation**, however, has the effect of **removing the cancelled goods or services from the international registration**. It would not be possible to protect the cancelled goods and services by making a subsequent designation. This could only be achieved by filing a new international application in respect of the cancelled goods or services.

So the effects of a limitation and a cancellation are different and hence, the choice of which of these actions to take in given circumstances must be made with care.

Limitation of the list of goods and services - [form MM6](#)

An international mark may be limited in respect of some or all designations. Even if the limitation of the list of goods and services is only valid in one designated contracting party, it is still necessary to request the limitation centrally at WIPO.

It is the ultimate responsibility of the holder of the mark to ensure that his rights are reflected accurately, both on the international register and in designated contracting parties. It is therefore imperative that the desired limitation is clearly set out when filing the official form. WIPO will not interpret instructions given on the form but will simply pass on the request to limit to the designated contracting parties concerned. If a limitation is not clearly worded, then designated contracting parties may find it impossible to record the limitation. For example if it appears to widen the list of goods

and services originally filed or if it requests that goods and services are struck out of the original list when in fact these do not feature in the original list.

[Form MM6](#) is used to limit an international mark in some or all designated contracting parties, by the removal of some goods or services from the list originally filed. The form may be sent to WIPO by the holder of the mark or by the national office of the holder. The form does not specify how the limitation should be set out and holders have the choice of listing the goods or services to be excluded, or stating that 'the limited list should now read as follows '...'. Whichever of these options are taken, the desired end result should be clearly and unambiguously stated.

Limitations are recorded and published in the International Gazette. The instruction to limit is then forwarded to all the designated contracting parties concerned.

Renunciation - [form MM7](#)

Under UK law a trade mark application will be withdrawn or refused if the applicant decides that he no longer wishes to pursue it. The Madrid system requires a positive final outcome in respect of every designation to the UK. Thus, if a holder decides that he does not wish to continue with his international designation, he may choose either to renounce his rights in the UK by filing form MM7 to WIPO, or if a provisional total refusal has been raised request that we formally and finally refuse protection for the case in the UK.

[Form MM7](#) is used to request the complete withdrawal of a request for protection of a mark in one or more of the designated contracting parties to a case. This is equivalent to the 'withdrawal' of an application to the UK Intellectual Property Office. The holder no longer wishes to protect his mark in a designated contracting party where he renounces protection.

The form can be sent to WIPO directly by the holder, through the office of the contracting party of the holder, or by the office of the designating contracting party of the holder. The holder is simply required to list the designations where he wishes the renunciation to be effective. If he wishes to renounce the mark in its entirety, that is, in all designated contracting parties, he should use a request for cancellation ([MM8](#)) rather than a renunciation form.

The renunciation will be recorded and published in the [International Gazette](#). Copies of the publication will then be forwarded to all designated contracting parties affected by the action.

Cancellation of the International Registration - [form MM8](#)

Cancellation of an international mark will be effective in all the countries designated in the international application. As with limitations, it is the responsibility of the holder of the mark to ensure that his rights are accurately reflected on the international register and in

the designated contracting parties where his trade mark has protection. The difference between cancellation, limitation and renunciation should be noted and care taken to ensure that the desired result is achieved.

[Form MM8](#) is used to request cancellation of some or all of the goods and services in all countries listed on the international registration. The cancellation has the effect that goods or services are removed from the international registration as though they had never been listed.

The form may be filed by the holder or by the office of the contracting party of the holder. The holder will be required to state whether the cancellation is to be recorded in respect of some or all goods and services covered by the international registration. If specific goods are to be cancelled the holder will need to list these.

WIPO will record the cancellation and publish it in the [International Gazette](#). A copy of the publication will be forwarded to all designated contracting parties, since all will be affected by a cancellation.

Change in name and/or address of the holder - [form MM9](#)

[Form MM9](#) is used to record changes in the holder's name and address details when there has been no change in the legal entity of the company (compare [form MM5](#) - 'transfer of ownership'). One form may be used to record the change for several international registrations held by the same holder.

The form may be filed to WIPO directly by the holder or his representative, or via the office of the contracting party of the holder.

WIPO will record the change and publish it in the [International Gazette](#). It will then be forwarded to all designated contracting parties concerned.

Change in name and/or address of the representative - [form MM10](#)

[Form MM10](#) is used to update the details of the recorded representative, for example if the representative moves to new premises. One form may be used to update the representative details on many international applications.

The form may be sent directly to WIPO or via a national office.

Renewal - [form MM11](#)

[Form MM11](#) may be used to request renewal of an international registration. Use of this form is not compulsory. Requests to renew international registrations can also be made by letter. It is important to ensure that renewal fees are paid on time as renewal requests cannot be actioned without the fees.

The form may be sent directly to WIPO.

Appointment of a representative - [form MM12](#)

[Form MM12](#) is used to appoint a representative or to change to a different representative. It is not compulsory to use this form when appointing a representative.

The form may be sent directly to WIPO or via a national office.

Recording a licence - [form MM13](#)

[Rule 20bis](#)

[Form MM13](#) allows holders to record licences against international marks. The licence may be recorded against all designations covered by the international mark, or just against certain designations. The form is fee-bearing and the appropriate fees must be paid before a licence can be recorded.

The form may be sent directly to WIPO, via the office of the contracting party of the holder, or via the national office of a contracting party in which the licence is to be recorded.

Amendment of a licence - [form MM14](#)

[Form MM14](#) should be filed directly to WIPO, via the national office of the holder, or the national office of a contracting party in which the licence is valid. It is used to amend the details of an existing licence, ie, one that **has been recorded** on the international register. This form is fee-bearing and it is important to ensure that the correct fees are paid since amendments will not be actioned without the fee.

Cancellation of a licence - [form MM15](#)

[Form MM15](#) is used to cancel a licence that has been recorded on the international register. Like other forms for licences, it may be filed directly to WIPO, via the office of the contracting party of the holder or via the national office of a contracting country where the licence is valid. One form may be used to request the cancellation of a licence from several international registrations. If more than one licence is recorded against an international mark, it must be made clear beyond all doubt which licence is to be cancelled.

There is no fee for cancellation of a licence.

Claim to Seniority –[Form MM17](#) (for applications designating the EU)

Where applicants designate the Community, they must also complete from [MM17](#) when they are claiming seniority from prior registrations within the Community

Declaration of intention to use the mark [Form MM18](#) (for applications designating USA)

Where applicants designate the USA, they must attach a completed form [MM18](#) to their international application form or subsequent designation form. This form contains the exact wording of the declaration of intention to use the mark required under United States law. If the form is not filed with the international application, this will result in an irregularity being raised and the progress of the application being delayed.

Records held by the Intellectual Property Office

The Intellectual Property Office is required keep a record of all international registrations valid in the United Kingdom. This is called the supplemental register. This is achieved using the TMAD computer system. TMAD holds details of all international registrations for which the UK is Office of Origin, as well as international marks designating the UK.

WIPO is responsible for the flow of electronic information to the TMAD system. The details relating to new international registrations which have designated the UK are received on a weekly basis. Some updating of existing information on the system is also carried out electronically by WIPO. In other cases, a notification giving details of changes to existing information is sent and the TMAD system is then updated by International Section.

The TMAD database shows details of international registrations **insofar as these are valid in the UK.**

Details recorded on TMAD by International Section

All international marks designating the UK will be examined according to the Trade Marks Act 1994. TMAD shows the status of a designation and the history held on the system can be used to trace the progress of a case through the UK examination process. Certain additional information is added to that sent electronically from WIPO in order to make designations compatible with UK examination procedures. This includes a categorisation of 'mark type' (word only, device and word, form and word, and so on) in order to make the mark compatible with UK-IPO systems. As the case proceeds, we will record changes in status and add clauses which are agreed with representatives or holders prior to publication of the mark in the UK Trade Marks Journal. To facilitate this, certain of the UK national forms (['TM' forms](#)) may also be used when dealing with international designations.

Some UK Intellectual Property Office forms have already been mentioned in this chapter. [Form TM3](#) is used when holders file an application transforming their international rights into national (UK) trade mark rights. [Forms TM7 and TM8](#) are used in the opposition of an international designation since the mark is being opposed under the Trade Marks Act 1994. Other 'TM' forms used with international designations are listed below:

- [TM4](#) Request to transform an International mark designating the UK into a domestic application
- [TM5](#) Request for a statement of grounds. This form is used when the provisional refusal is maintained after the holder has made written representations to the office, or after a hearing before one of the registrar's hearing officers. The holder has the right, in the same way as national applicants are entitled, to request a written statement of the grounds for refusal of protection.
- [TM7](#) Notice of opposition and statement of grounds. This form is used to file formal opposition against a published UK or International trade mark.
- [TM8](#) Notice of defence and counterstatement. This form is used to submit applicants defence and counterstatement following the filing of form TM7
- [TM7A](#) Notice of Threatened Opposition. This form is for any party which is considering filing an opposition against a published UK or International trade mark, and who wishes to extend that mark's opposition period from two to three months
- [TM8\(N\)](#) Notice of defence and counterstatement for use in revocation on the grounds of non-use
- [TM9](#) Where extra time is necessary to resolve matters at the ex officio examination stage, after a hearing or during opposition or invalidation proceedings form TM9, (with appropriate fee post hearings), must be used to request this.
- [TM9c](#) Request for a cooling off period or for an extension of such a period. This form is used in opposition proceedings.
- [TM9e](#) Request for an extension to the cooling off period
- [TM9t](#) Request to terminate a cooling off period
- [TM21](#) Used during opposition proceedings to request limitation to the list of goods or services of an international designation in order to overcome the opposition. Limitations to the list of goods and services are normally recorded by filing form MM6 to WIPO. However, opposition is a reason for provisional refusal of protection to **all** goods and services covered by an international designation. Having provisionally **totally** refused protection for a designation, the UK Intellectual Property Office may then agree limited protection to overcome any problems originally raised.
- [TM24](#) This form is used for recording of registrable transactions against international designations in the UK.
- [TM28](#) Concurrent registrations are recorded using this form (see 'Replacement'). If a holder has existing UK national trade mark rights he may request that his international mark replace his national mark. This is done by recording a concurrent registration at any time after the international mark achieves protected status in the UK.
- [TM31M](#) Information about international designations is requested using this form (compare TM31C - used for requesting information about UK trade marks). Third parties will file this form to request that they be notified for example, when the designation is published or refused.

- [TM33](#) Used to appoint an EC, Channel Islands or EEA representative to act on the holder's behalf in respect of an international designation in the UK (see 'Appointing a UK representative').
- [TM35](#) Used for filing copies of the regulations governing use of a certification or collective mark. Appropriate fees must be paid.
- [TM36](#) This form covers amendments to the regulations governing use of a certification or collective mark. Appropriate fees must be paid.

Recording licensees

[Rule 20bis](#)

The Common Regulations allow for licences to be recorded on the International Register. A licence may be recorded in respect of one or several of the contracting countries covered by an international mark

Licences are now recorded in the international register of trade marks maintained by WIPO. However, those licences which were recorded in the UK Registry's supplementary register prior to the current revision of the Common Regulations (that is, before April 2002) will continue to have effect.

Requests for certified copies

The international register is held by WIPO. The UK Intellectual Property Office is therefore unable to give certified copies of international trade marks. These may be obtained by writing to WIPO directly. There is no official form for use when requesting certified copies. A fee is payable when requesting a certified copy from WIPO. We will, however, provide an extract of the IBIS database showing the current details of the designation in the UK

International Fees

Fees for international trade mark applications are paid in Swiss francs.

The fee structure is made up of many parts. Applicants pay according to the mark they are seeking to protect and the countries where protection is sought. Fees fall into two categories:

- fees relating to the mark; and
- fees relating to the designated contracting parties

Basic Fees

Every applicant will be required to pay an application fee – described by WIPO as a 'basic fee'. This covers an application with up to three classes of goods and services. Further fees relating to the application are payable according to the nature of the mark.

Is the mark in colour?

If a colour representation of the mark is provided then it will be necessary to pay the higher 'basic fee' applicable to coloured marks. If colour is claimed as an element of the mark then a colour representation **must** be provided. Applicants may also **choose** to file a colour representation of the mark even if they do not claim colour. But in any circumstances where a colour publication of the mark is either necessary or desired it will be necessary to pay the higher basic fee.

Supplementary fees

The basic application fee covers up to three classes of goods and services. For each additional class a supplementary fee is payable.

Supplementary fees cover the additional classes in designated contracting parties that do not charge individual fees. Therefore, if all the countries designated in an application charge individual fees, then it will not be necessary to pay supplementary fees.

Fees relating to the Designated Contracting Parties

Applicants must pay a fee for each designated contracting party that is listed on the application. These fees are paid in addition to the basic fees, which are detailed above.

Individual fees

Certain member countries of the Protocol have exercised their right to collect individual fees ([see Article 8\(7\) of the Protocol](#)). To designate these countries it is necessary to pay the 'individual fee' specified. An up-to-date list of the fees for individual countries is available on [WIPO's fee calculator](#). It should be noted that different member countries specify that their fees cover different numbers of classes of goods and services. Further, some of the countries charge different individual fees depending upon whether the international application is for a trade mark or a collective mark. Thus, it is important to be clear about the nature of the mark for which international protection is being sought.

Some countries split the fee they will collect and require part of the fee when the application is filed and the rest at protection of the mark in their particular country. This will result in the applicant being requested to pay fees again, after the mark has been registered internationally and passed to individual designations. Applicants need to be aware of this, since if the fees are not paid, this may result in the designation being abandoned.

The Community Trade Marks Office requires 'direct' applicants to pay the fees in two parts – an 'application' and a 'registration' fee. The individual fee for designating the EU under the Madrid Protocol is equivalent to **both parts** of this fee and is payable at the time of designation. If for any reason the designation to the EU does not become

protected, the part of the individual fee equivalent to the 'registration' fee paid by direct Community applicants will be refunded.

Complementary fees

Where there are no individual fees listed for a country, applicants wishing to designate that country will instead pay a 'complementary fee'.

The total application fee for an international application is the sum of the fees relating to the mark and those relating to the designated contracting parties. A [fee calculator](#) is available on the WIPO website.

UK handling fee

Where the international application is based on an UK mark, the Intellectual Property Office will be the Office of Origin for that case and the international application will be filed via the Intellectual Property Office. A handling fee (currently £40) is charged. This covers the cost of certification of the case, as well as, courier fees for transportation of the case to WIPO.

The application form is the only international form on which we are permitted to charge a handling fee at the UK Intellectual Property Office. Other forms filed via the UK Intellectual Property Office are forwarded to WIPO after a basic check.

Payment of international fees

International fees may be paid by:

- deduction from a WIPO current account;
- bank transfer to WIPO's bank account Bank name: Credit Suisse - 1211 Geneva 70 - Switzerland
Account name: WIPO/OMPI
Account number (IBAN): CH51 0483 5048 7080 8100 0
SWIFT code: CRESCHZZ80A
- payment or transfer to the Swiss postal cheque account of WIPO, Account number (IBAN): CH03 0900 0000 1200 5000 8
at SWISS POST/Postfinance – Engehaldenstrasse 37 – 3030 Bern
SWIFT/BIC: POFICHBE

Alternatively, if customers hold a deposit account with the Intellectual Property Office, they may instruct the Intellectual Property Office to pay the fee and debit their account with the requisite amount of Swiss francs. The Intellectual Property Office will also pay fees for customers who send a cheque in sterling.

Community Trade Marks

Background to the system

The [Office for Harmonization in the Internal Market \(OHIM\)](#) is based in Alicante, Spain. It was set up to process applications to register Community trade marks and designs. Applications for trade marks were accepted from 1 January 1996 and the office opened officially on 1 April 1996. All applications received prior to 1 April were given a filing date of 1 April 1996.

Applicants for Community trade marks file a single application, but if successful gain trade mark rights which cover all member states of the EU and are valid for ten years and renewable for further periods of ten years. The UK holds a register of all trade mark applications and registrations which are valid in the UK, including information relating to Community trade marks.

Community trade marks are examined by the OHIM under [European Council Regulation 40/94](#) on the Community Trade Mark (referred to in this chapter as 'CR 40/94' or 'the Community Trade Mark Regulation'). The Community Trade Mark Regulation is intended to harmonise the laws of member states of the European Union. The UK Intellectual Property Office is not involved in the examination of Community trade marks and our contact with the Community office is limited. However, there are certain procedures that we are required to carry out and these are outlined below.

Certification of professional representatives

Art. 89CR 40/94

Whilst anyone may file a Community trade mark or Community design application, applicants from outside the Community must appoint a representative from within the Community to act for them before the OHIM in all proceedings after filing. Legal practitioners (solicitors or barristers) who are qualified in one of the member states of the EU are automatically entitled to act before the OHIM. Other representatives need to be entered onto the OHIM's list of professional representatives before they may represent applicants for Community marks and/or Community designs.

Article 89(2) of the Community Trade Mark Regulation requires the Intellectual Property Office to certify representatives living or with their place of business in this country, who wish to be entered onto the OHIM's list of professional representatives. Representatives must apply **on an individual basis** to be entered onto the list. There are certain criteria they must meet, namely (see Art.89(2) CR 40/94):

- be a national of one of the member states;
- have a place of business within the EU; or

- be entitled to represent applicants before the UK Intellectual Property Office, this being the national office of the member state of the EU where the representative's place of business is located.

Entitlement to act before the Intellectual Property Office is assessed either by special professional qualification (such as a member of the Solicitor's Roll) or by habitual practice before the UK office over a 5 year period (as detailed in Article 89(2)(c) of the Regulation).

International Section examines applications to be entered on the OHIM list of representatives, to ensure that applicants meet all of the above criteria. We then sign the certification form and send the complete application on to the OHIM. We inform the representative that we have forwarded the application. The OHIM confirms directly with the representative when they have been entered onto the official list of professional representatives.

Conversion to national trade mark application

Art. 108, 110 CR 40/94

Holders of Community trade mark applications or registrations may apply to convert their Community marks into national trade marks and may request conversion of the Community trade mark to a national trade mark if the Community application is refused, withdrawn, deemed to be withdrawn, or ceases to have effect. (Conversion is not permitted where the Community mark has been revoked on grounds of non-use.)

For conversion to be permitted, there must have been a valid Community application or registration to begin with, that is, the mark must have satisfied all filing requirements and have been granted a filing date.

A request for conversion should be made in writing, to the OHIM within three months of the date of OHIM's final decision. The form for making this request can be downloaded from the OHIM website. If the request for conversion is admissible, the papers relating to the case will be forwarded to the national offices of the countries where conversion is requested.

Partial or total conversion is possible. For example, where one class of a multi-class application is successfully opposed, that class could be converted to national trade mark applications in any or all of the countries of the EU, except in the country where the opposition originated. The rest of the application, that is, the 'unopposed' classes, will continue life as a Community mark.

Converted cases retain the filing date of the application to the OHIM. The papers are passed to us exactly as they were filed to the OHIM - this could mean that they will be in any of the officially accepted languages of the Community Office. If the papers are in a language other than English we will ask the applicant or his representative to provide a translation.

If the conversion request is acceptable, the papers will be passed to New Applications section to make up a file. The holder of the Community mark will be asked to provide an address for service and also to pay an application fee for this country. The case will then be examined as a new national trade mark application.

Filing a Community application via the Intellectual Property Office

Art. 25(1)(b) CR 40/94

The UK Intellectual Property Office is authorised under Article 25(1)(b) of the Community Trade Mark Regulation to receive Community trade mark applications on behalf of the OHIM. Finance Section is responsible for the receipt of Community applications. We do not examine applications in any way at the UK Intellectual Property Office, but simply check to ensure that they are complete and can be given a filing date.

If an application complies with all the filing requirements, then the filing date assigned to the case at the OHIM will be the date on which we at the UK Intellectual Property Office received the application. We forward applications by courier to the OHIM in Alicante. We send the applicant a confirmation slip confirming the filing date assigned to the case and the number of pages, including attachments, which have been forwarded. The handling fee we charge for receiving and forwarding Community applications covers the cost of the courier service.

The advantage of filing a Community application via the UK Intellectual Property Office is that the filing date is quickly established and confirmed. However, Community applications do not have to be filed through this office. They can be filed directly to OHIM using any of the prescribed ways which now include electronic filing.

National searches

Art. 39(2)/(3) CR 40/94

We search the UK Trade Mark register in respect of each new Community application. A report is produced for each case listing any marks with earlier rights in the UK, which are considered to conflict with the new Community mark. This report will include earlier UK marks and international marks with rights in the UK, but not earlier filed Community marks. The OHIM conducts an independent search of the Community register in order to find conflicting marks.

Details of new Community trade mark applications are received at the rate of four batches (approximately 1500 marks) per week. Word elements of marks are searched electronically using the MARKSMAN computer system. Figurative elements of marks are searched using the IBIS computer system. MARKSMAN amalgamates all results and produces a report with one document for each Community application. These reports are e-mailed back to the OHIM. We are required to compile and return the reports to the OHIM within three months of receiving the batch. From March 2008, applicants for a

Community trade mark will not be obliged to have a national search conducted; they can opt for one on payment of a separate fee. At that point the deadline for return to OHIM of the searches we conduct will be reduced from three to two months

The OHIM does not itself raise objections under relative grounds (i.e. citations) against new Community applications. Community colleagues compile search reports for each case consisting of reports from all countries in which national searches are carried out, together with a report of conflicting earlier filed Community marks. They send the complete reports to the applicant for the new Community mark **for information purposes**. On the basis of this report, the applicant will decide whether he wishes his Community application to continue to publication and possible opposition or whether he prefers to withdraw it.

All relative grounds objections raised against Community trade marks are dealt with via the opposition process. Holders of UK marks must therefore oppose Community trade marks which appear to conflict with their own marks, in order to prevent the Community mark gaining a foothold in the UK marketplace. It should be noted that the OHIM does not have a caveat system and it is the responsibility of individual holders to monitor the Community Register.

Sources of information

The OHIM database

Community trade marks and designs are examined and registered by the OHIM. The register of Community trade marks is maintained by the OHIM. They send the UK Intellectual Property Office a limited amount of information about each new mark to enable us to conduct searches of the national register. We hold the information in the IBIS database. The database will provide basic details of marks and a status of 'pending', 'registered' or 'dead'.

The OHIM website

The OHIM website www.oami.europa.eu includes an on-line search facility as well as general information about the Community trade mark registration system.

The Bulletin and the OHIM Journal

The OHIM publishes all new Community trade marks for opposition purposes. The 'OHIM Bulletin', which is published weekly, is a source of information about individual trade marks. Community trademarks are published in all officially accepted languages of the Community Office.

The OHIM also publishes information such as decisions and updates in law and practice in a monthly journal, the '[OHIM Bulletin](#)'.

ANNEX

Glossary of international (Madrid) terms

- Applicant** Holder of national trade mark rights in a member country of the system, who applies to register his mark internationally and gain protection in other designated member countries.
- Application** A new request to register an international trade mark. Applications are filed to WIPO via the Office of Origin of the trade mark
- Article** Refers to Articles of the Protocol relating to the Madrid Agreement concerning the International Registration of Marks.
- Base mark/** National trade mark rights upon which the international application is based.
- Basic mark** Under the Protocol, the basic mark may be an application or a registration, whereas under the Agreement only registered rights may be used as the basis for an international application.
- Certification** Required by Article 3 of the Protocol. To use the system an international application must be based on existing national rights. The national administration where those rights are based (Office of Origin) is required to certify that the international application is in line with the existing national rights.
- Common Regulations** The 'Rules' which govern the practical administration of the 'Madrid System'.
- Dependency** International applications are based on existing national trade mark rights - see [Article 6\(2\) of the Protocol](#). For the first five years of the life of the international mark, it is 'dependent upon' the national mark. Thus, if the national trade mark rights die for any reason during this five year period, the international mark will also die. After the five year period the international mark will become independent of the basic mark.
- Designated Contracting Party (DCP)** Any member country of the system which is listed in an international application as being a country where the holder wishes to seek protection for his mark.
- Designation** When an international application is filed, the applicant will 'designate' other member countries of the system where he would like his mark to be protected. When the mark is registered, copies of the details will be sent to each of the designated contracting parties. In each individual country the application for protection will be known as a 'designation'. For examiners

of international trade marks the term 'designation' is approximate to the term 'application' used on domestic examination units.

ENN The code used by WIPO to classify the details of a new mark which is seeking protection in the UK. An ENN carries all the details of the mark which we need in order to examine the case.

EXN The code used to classify the details of an existing international mark which has just applied for protection in the UK (see 'subsequent designation').

Filing date Date on which the international application was filed. In most cases this will be the date on which the application was received by the Office of Origin. When the mark is registered, the filing date will become the international registration date.

Holder The 'registered proprietor' of an international trade mark. The holder of an international mark is recorded on the international register.

International Gazette Published by WIPO, this contains details of new International trade marks as well as any updates to details of existing marks on the International Register.

Irregularity Letter Letter from WIPO to the applicant for international registration to notify him of any instance where the application does not comply with the Common Regulations. Irregularity letters are sent both to the holder and the Office of Origin for the mark.
Irregularity letters may also be sent to Designated Contracting Parties where refusal letters do not comply with the Regulations.

Madrid Agreement Treaty of April 1891 (and still in force) allowing for the international registration of trade marks. Member countries of the Madrid Agreement are referred to in this chapter as 'Agreement countries'.

Madrid Protocol Protocol to the Madrid Agreement, adopted in 1989 with a view to making the Protocol more accessible to a greater number of parties. Member countries of the Protocol are referred to in this chapter as 'Protocol countries'.

Madrid System System for the international registration of trade marks based on two system international treaties - the Madrid Agreement and the Protocol to the Madrid Agreement.

National Representative Trade mark attorney, lawyer or other individual representing the holder in respect of one designation of the international registration before the national administration of the designated contracting party.

Office of Origin National trade mark office where the basic mark is held - thus the office of 'origin' of the international application. The Office of Origin never changes, even if a mark is transferred into the ownership of another party who is based in another of the member countries of the system.

OHIM Bulletin This publication contains details of new Community trade marks which are published for opposition purposes, as well as marks which have achieved registration.

OHIM Journal Details of updates to law and practise as well as legal decisions are published in the OHIM Journal.

Protected Similar to domestic 'registered' and indicates that an international designation has successfully passed through the UK examination and advertisement procedure. International designations are already 'registered' when they come to us and the term 'protected' is therefore used to describe the final status of cases which have achieved protection in the UK.

Refusal We examine all designations to the UK under the Trade Marks Act 1994. Just as with UK trade marks, international marks will be accepted or refused protection. Where there are grounds to object to a mark a 'provisional refusal letter' will be drafted (may be compared to the domestic 'examination report'). Partial or total refusal is possible.

Registration/Registered A registered international mark is one which has been recorded in the Registered international register. Marks are registered internationally before being sent out to the member countries of the system which are designated in the international application. Thus a 'registered' mark may not yet have achieved any protection in countries other than its country of origin. (See also 'Protected')

Representative Trade mark attorney, lawyer or other person designated by the applicant to act on his behalf before WIPO. (Compare 'national representative')

ROMARIN A record of the current marks on the International Register. This is produced by WIPO and available on the WIPO website.

Rule Refers to the 'Common Regulations under the Madrid Agreement and the Protocol relating to that Agreement'.

Safeguard This phrase refers to [Article 9sexies of the Protocol](#) as amended in September 1, 2008, repeals the safeguard clause. New paragraph (1)(a) of Article 9sexies provides that the Protocol, and the Protocol alone, will, in all aspects, apply between Contracting Parties bound by both the Agreement and the Protocol. As a result, as from September 1, 2008,

designations of a Contracting Party bound by both the Agreement and the Protocol made in an international application or subsequent to an international registration, by an applicant or holder of a Contracting Party also bound by both the Agreement and the Protocol will be governed by the Protocol. For convenience, such designations are hereinafter referred to as “designations governed by the Protocol by virtue of new Article 9sexies” ..

Subsequent Designation Once an international trade mark is registered, the holder may apply to add further countries to the list of those where he seeks or has protection. This is done, as the name suggests, by filing an application to **designate** further member countries **subsequent** to the registration of the international mark.

TMAD Intellectual Property Office database recording the status of international designations to the UK and the history of their progress through the UK examination procedure.

Transformation [Article 9quinques](#) of the Protocol deals with this. Where an international registration is cancelled at the request of the Office of Origin (ie because of the death of the basic mark) then the holder of that registration may request transformation of his international rights in one or all of the countries designated to national rights in those countries. This request must be made within three months of the cancellation of the international application. Partial or total transformation of a case is possible.

WIPO World Intellectual Property Organisation.