

**INTERNATIONAL REGISTRATIONS / SUBSEQUENT DESIGNATIONS
DESIGNATING SINGAPORE**

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1. INTRODUCTION

This chapter deals with international registrations / subsequent designations designating Singapore for trade mark registration.

2. RELEVANT RESOURCES

Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement

Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto

The above materials are available at http://www.wipo.int/madrid/en/legal_texts.

Singapore Trade Marks Act

Singapore Trade Marks Rules

Singapore Trade Marks (International Registration) Rules

3. **ABBREVIATED EXPRESSIONS**

"**basic application**" means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

"**basic registration**" means the registration of a mark that has been effected by the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

"**Common Regulations**" means the regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement and it is usually referred as the Common Regulations;

"**Contracting Party**" means any country party to the Agreement or any State or intergovernmental organization party to the Protocol;

"**Contracting Party of the holder**" means

- the Contracting Party whose Office is the Office of origin, or
- where a change of ownership has been recorded or in the case of State succession, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfills the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration;

"**Gazette**" means the periodical gazette referred to in Rule 32 of the Common Regulations;

"**holder**" means the natural person or legal entity in whose name the international registration is recorded in the International Register;

"**international application**" means an application for international registration filed under the Agreement or the Protocol or both, as the case may be;

"**IB**" means the International Bureau of the World Intellectual Property Organization;

"**International Register**" means the official collection of data concerning international registrations maintained by the International Bureau, which data the Agreement, the Protocol or the Regulations require or permit to be recorded, irrespective of the medium in which such data are stored;

"international registration" means the registration of a mark effected under the Agreement or the Protocol or both, as the case may be;

"Madrid Protocol" and **"Protocol"** means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

"notification of Provisional Refusal" means a declaration by the Office of a designated Contracting Party, in accordance with Article 5(1) of the Agreement or Article 5(1) of the Protocol;

"Office" means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in Article 9quater of the Agreement or Article 9quater of the Protocol, or both, as the case may be;

"Office of Origin" means the Office of the country of origin defined in Article 1(3) of the Agreement or the Office of origin defined in Article 2(2) of the Protocol, or both, as the case may be; and

"subsequent designation" means the request for extension of protection ("territorial extension") under Article 3ter(1) or (2) of the Agreement or under Article 3ter(1) or (2) of the Protocol, as the case may be, or such extension as recorded in the International Register.

4. SINGAPORE AS DESIGNATED OFFICE

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

IPOS receives weekly electronic notifications from the IB containing the details of new international registrations/ subsequent designations designating Singapore. These marks will be indexed and assigned Singapore trade mark numbers. Once this is done, the mark details will be uploaded onto the Singapore Trade Mark Register and may be conveniently viewed online.

5. EXAMINATION OF INTERNATIONAL REGISTRATIONS / SUBSEQUENT DESIGNATIONS DESIGNATING SINGAPORE

5.1 Same examination procedure as national applications

International registrations/ subsequent designations designating Singapore are examined in the same way as national applications which are filed directly with IPOS. The international registrations/ subsequent designations are examined for registrability in accordance with the Trade Marks Act and Trade Marks Rules. These marks will also be examined for possible conflicts with prior marks on the Singapore Trade Mark Register.

5.2 Provisional refusal of protection

If the international registration / subsequent designation do not comply with the provisions of Singapore law, IPOS will notify the IB that protection of the mark has been refused in Singapore. This notification, known as a Provisional Refusal, must be sent to the IB within the applicable time limit of 18 months from the date of notification of the international registration / subsequent

designation. Once the Provisional Refusal has been sent to the IB, the IB will forward it to the holder of the international registration / subsequent designation or the holder's representative.

If IPOS does not notify a Provisional Refusal to the IB within the applicable time limit, IPOS would lose the right to refuse protection to the international registration/subsequent designation, and the mark will therefore be deemed to be registered in Singapore.

As with national applications, IPOS will routinely expedite international registrations with a priority claim in order to minimize the risk of registering earlier filed trade marks which are similar or identical but without a priority claim.

Partial or Total Refusal

Provisional refusals may relate to all the goods and / or services in the international registration / subsequent designation, in which case it is a Total Refusal, or to only some of the goods and / or services in the international registration / subsequent designation, in which case it is a Partial Refusal. Another kind of refusal known as a Provisional Refusal Based on Opposition may also be issued if a third party files a Notice of Opposition objecting to the mark being protected in Singapore.

If IPOS has examined an international registration / subsequent designation and found no grounds for refusal, it may issue a Statement of Grant of Protection.

5.3 Examination of the list of goods and services

Misclassification of goods and/or services

The classification and description of the goods and services claimed in the international application is checked by the IB prior to registration in the International Register. The IB is the final authority for the classification of the goods and services listed in an international registration. Designated offices are not able to raise a formal objection to the *classification* of goods and/or services via a Provisional Refusal.

Nonetheless, if any goods and/or services appear to be misclassified, IPOS may informally seek clarification from the IB. The examination of the international registration will be held in abeyance by IPOS pending a reply or Correction Notice from the IB. However, the time limit of 18 months to issue a provisional refusal, if any, still continues to run during this period.

Indication of goods and/or services considered too vague, incomprehensible or linguistically incorrect

In some international registrations / subsequent designations notified to IPOS, there may be goods and/or services bearing an indication inscribed by the IB stating that a certain term is considered too vague, incomprehensible or linguistically incorrect. Such indications are inscribed by the IB where a holder failed to respond to an irregularity issued by the IB under Rule 13 of the Common Regulations for terms which the IB considers too vague, incomprehensible or linguistically incorrect.

Under Rule 19(2)(b)(ii)(A) of the Trade Marks Rules, IPOS may (independently or in view of the inscription by the IB), through a Provisional Refusal, object to descriptions of goods and / or services that are considered too vague, incomprehensible or linguistically incorrect. If IPOS does not receive a response to the Provisional Refusal by the given deadline of four months, the objected goods and/or services will be deleted. Where there are other goods and / or services which have not been objected to, those may proceed to acceptance and publication.

6. ACCEPTANCE OF INTERNATIONAL REGISTRATION / SUBSEQUENT DESIGNATION DESIGNATING SINGAPORE

If there are no objections to the international registration / subsequent designation designating Singapore, or where there are objections and these objections are overcome, the international registration / subsequent designation shall be published for opposition purposes in the IPOS Trade Marks Journal. A notice informing of the interim status of the international registration / subsequent designation containing the period of publication will be sent to the IB. This notice

will also be sent to the Singapore agent (if any) appointed to act for the holder of the international registration / subsequent designation.

International registrations / subsequent designations designating Singapore are published in a separate section of the Trade Marks Journal entitled, “International Registration filed under the Madrid Protocol Published for Opposition under the Trade Marks Act (Cap. 332, 2005 Ed)”.

Published marks are open to opposition for an initial period of two months, with a possibility of a further extension of two months. This process is similar to the process for national trade mark applications.

7. CORRECTIONS FROM WIPO

Under Rule 28 of the Common Regulations, where the IB, of its own volition or at the request of the holder or of an Office, considers that there is an error in the information recorded on the International Register, it will correct that information accordingly. The IB's practice with regard to the correction of the international registration is as follows:

- (a) where there has been an error on the part of the IB, the error will be corrected;
- (b) where there has been an obvious error and nothing else could have been intended other than what is offered as the correction, the error will be corrected as soon as the error comes to the IB's attention; and
- (c) where there is an objective error in a fact recorded in the International Register.

While the holder of the international registration or the Office may request for the correction of the international registration, the request for correction should be submitted by the Office of Origin of the Contracting Party in the event that the error results from a discrepancy between a document filed with the IB and what is recorded in the register of that particular Contracting

Party. Accordingly, an error which is attributable to an Office and the correction of which would affect the rights deriving from the international registration may be corrected only if a request for correction is received by the IB within nine months from the date of publication of the entry in the International Register.

There may be instances where the corrections would widen the scope of the list of goods and services originally filed. Additionally, there could even be instances where the corrections would result in a change to the representation and identity of the mark. In such cases, the international registration / subsequent designation designating Singapore may need to be re-examined. Also, in the event new goods or services appear in the international registration / subsequent designation after a correction, the international registration / subsequent designation will have to be re-examined in respect of those new goods and services. However, corrections which limit the scope of a mark are acceptable and will not need to be re-examined.

If the mark has been corrected substantially, it will be necessary to re-start the examination procedure with the corrected mark. If the international mark has already been published, it will be necessary to withdraw the publication.

Processing of correction notifications by IPOS

If a correction notice has been received by IPOS, the trade mark examiners will make the necessary amendment.

In cases where the correction involves the replacement of the original mark with a new mark, the mark will have to be re-examined. A re-calculation of the 18-month time limit may be necessary. If the correction results in a new objection, IPOS will issue a Provisional Refusal following a Correction Notice to the IB.

Where a correction notification is received after an international registration / subsequent designation has been published in the Trade Marks Journal for opposition, a further publication

may be made in the Corrigenda section of the journal stating the details of the correction after the correction notice has been processed.

Types of corrections which may be processed by IPOS could relate to:-

- (a) International Registration Date, Subsequent Designation Date, International Registration Notification Date, Subsequent Designation Notification Date
- (b) Name and/or Address of Holder
- (c) Mark
- (d) Mark Type
- (e) Goods/Services
- (f) Priority Details
- (g) Transliteration, Translation, Disclaimer, Color Claim, Mark Description, 3D Indicator

It is to be noted that not all correction notifications from the IB will require action on the part of IPOS. For example, there may be corrections for the inclusion or deletion of certain member countries from the designation list, or for the limitation of the list of goods and services which are not applicable to Singapore.

It is possible to receive more than one correction notification in an international registration. A second or subsequent correction notification may be issued by the IB to correct the details of the earlier corrections. The correction history is available for viewing online along with the other details of the mark.

8. PROVISIONAL REFUSAL OF PROTECTION OF INTERNATIONAL REGISTRATION / SUBSEQUENT DESIGNATION DESIGNATING SINGAPORE

The Provisional Refusal will indicate the grounds for refusal of protection together with a copy of the relevant laws in support of the objections. If any confusingly similar marks are cited, the details of these marks will also be attached to the Provisional Refusal.

The Provisional Refusal must state all the grounds on which the Provisional Refusal is based and if the refusal does not relate to all the goods and services of the international registration, it must state the goods and/or services which are affected by the refusal.

The Provisional Refusal will also provide guidance to the holder if he wishes to request for a review or file a notice of appeal against the Provisional Refusal. A time limit for such request will also be indicated therein. IPOS imposes a four-month deadline for the holder to respond to the Provisional Refusal. The four-month deadline is calculated from the date of the Provisional Refusal.

The IB will record the information contained in the Provisional Refusal and will forward it to the holder of the international mark or to his agent in the country of origin. The Provisional Refusal is also available for viewing online at WIPO's ROMARIN database (<http://www.wipo.int/romarin/>).

9. IRREGULARITY NOTICE FROM WIPO ON PROVISIONAL REFUSAL

The Provisional Refusal from the Office must meet the following conditions, among others:-

- (a) it must contain the international registration number;
- (b) it must indicate the grounds for the refusal; and
- (c) it is sent within the 18-month time limit;

If any of the above conditions are not met, the IB will send an Irregularity Notice to the Office highlighting the irregularities and will also inform the Office that the notification of Provisional Refusal is not valid. Where the irregularity relates to the contents of the notification, the Office may send a further notification in which the irregularity has been rectified, provided that this further notification is sent within the applicable time limit.

10. TIME LIMIT FOR NOTIFYING PROVISIONAL REFUSAL

Any member country of the Madrid Protocol has the right to refuse protection of the international registration. The Provisional Refusal of protection must however be received by the IB within a given time limit.

In the case of Singapore, the time limit is 18 months from the notification date of the international registration or a subsequent designation. This applies to all notifications of Provisional Refusal of protection whether based on grounds refused ex officio by the Office or based on opposition.

In general, an Office which has not notified a Provisional Refusal to the IB within the appropriate time limit loses the right to refuse protection.

Late provisional refusal based on opposition possible

A Provisional Refusal based on opposition may be notified to the IB after the end of the 18-month time limit. However, the member country must, before the expiry of the 18-month time limit, have informed the IB that there is a possibility that oppositions may be filed after the expiry of this time limit. Further, the notification of Provisional Refusal based on an opposition must have been sent to the IB before the expiry of:-

- (a) the period of one month from the expiry of the opposition period, or
- (b) the period of seven months from the beginning of the opposition period,

whichever is earlier.

11. OPPOSITION FILED NEAR THE END OF THE 18-MONTH TIME-LIMIT

Where an Office has informed the IB that the opposition period will expire within 30 days before the end of the 18-month period, a Provisional Refusal that is based on an opposition filed within those 30 days, may be notified to the IB within one month of the opposition being filed.

Where an Office fails, before the expiry of the 18-month time limit, to notify the IB of the possibility of late Provisional Refusals based on opposition, the IB will disregard the Provisional Refusal and inform the Office accordingly. Similarly, where a Provisional Refusal based on an opposition is notified after the end of the 18-month period, and the prior notification of this possibility had not been given, or had been given too late, the IB will disregard the Provisional Refusal and inform the Office accordingly.

12. AFTER THE EXAMINATION - REQUEST FOR A REVIEW

The holder of an international registration designating Singapore which has been provisionally refused may request for a review of the refusal.

12.1 Address for service in Singapore

Upon receiving the Provisional Refusal of protection issued by Singapore from the IB, the holder may request for a review of the Provisional Refusal. The request for review must include an address for service in Singapore. It is important that the holder provides a valid address for service in Singapore as it is this address to which all correspondence from IPOS will be sent.

The holder may appoint an agent in Singapore to act for him but this is not mandatory.

12.2 Four-month deadline by IPOS

A Provisional Refusal of protection comes with a four-month deadline for the holder to respond. If the holder of the international registration does not respond with his submissions before the deadline the international registration faces two possible outcomes:-

- (a) If the international registration has been partially refused, the mark will be accepted and published only for those goods / and or services not affected by the provisional refusal.

- (b) If the international registration has been refused totally, the refusal will become final for all goods / and or services.

13. REINSTATEMENT OF RIGHTS

It is possible to reinstate an international registration which is treated as withdrawn due to failure to respond within the four-month deadline. Reinstatement is done by filing Form CM13 with the requisite fee within six months from the deadline. However, holders should note that any request for reinstatement received after the six months will not be accepted.

Upon receiving Form CM13, IPOS will conduct a search for conflicting marks to ensure that there are no conflicting marks received or citations waived during the time when the holder's application was treated as withdrawn. If there are no conflicting marks received or citations waived during this period, the application will be restored and its status will be updated on the Trade Mark Register. If there are conflicting marks received or citations waived during this period, the reinstatement request will be refused.

14. PUBLICATION OF INTERNATIONAL REGISTRATION

Every international registration / subsequent designation designating Singapore which has been accepted for protection will be published in our online Trade Marks Journal and are open to opposition for a period of two months. The two-month opposition period may be extended to four months, in exactly the same way as national applications.

International marks are published in the Trade Marks Journal in the section titled "International Registration filed under the Madrid Protocol Published for Opposition under the Trade Marks Act (Cap. 332, 2005 Ed.)".

15. OPPOSITION TO INTERNATIONAL REGISTRATION

International marks are subject to the same opposition procedures as national marks. The opponent must file Form TM 11, together with a Statement of Grounds of Opposition and the relevant fees. When an opposition action is initiated against an international mark which has been published, IPOS will issue a Provisional Refusal based on opposition.

A copy of the Form TM 11 and the Statement of Grounds of Opposition will be attached to the Provisional Refusal of protection based on opposition. Copies of the forms necessary for filing a counter-statement are also attached along with Form CM 1 for an address for service in Singapore to be appointed.

As with national marks, opposition hearings of international marks are dealt with by the Hearing & Mediation Group (HMG) within IPOS.

16. PROTECTION OF INTERNATIONAL REGISTRATION

If there are no oppositions or where there are oppositions and the proceedings are resolved in favour of the holder, the international registration designating Singapore will be protected in Singapore.

It should be noted that no registration certificates are issued by IPOS with regards to protected international marks in Singapore. Instead, one of the following statements on the final status of the mark will be issued to the IB to inform on the conclusion of the proceedings in Singapore.

16.1 Statement of grant of protection where no notification of Provisional Refusal has been communicated

With effect from 1 September 2009, an Office which has examined an international registration in which it is designated and found no ground for refusal must issue a Statement of Grant of Protection (“Statement of Grant”).

A Statement of Grant will be issued under this limb only if the mark is registered within the 18-month time limit from the date of notification of the international registration / subsequent designation. However, the Statement of Grant will not be issued where the mark is registered after the 18-month time limit as the international registration will be regarded as protected in Singapore.

The Statement of Grant allows WIPO to close the case without the need to wait till the end of the 18-month period. WIPO will record and publish the Statement of Grant before forwarding the Statement of Grant to the holder.

IPOS will include in the Statement of Grant details such as particular features of mark and clauses reflected in the Trade Marks Register.

16.2 Statement of grant of protection following a Provisional Refusal

If a Provisional Refusal of protection has been issued in respect of the international registration and protection of the mark is eventually granted whether wholly or partially, a statement would be issued indicating either:

- (a) That the provisional refusal is withdrawn and protection of the mark is granted for all the goods and services for which protection is requested; or
- (b) The goods and services for which protection is granted.

16.3 Confirmation of total Provisional Refusal

If a total Provisional Refusal of protection has been issued in respect of the international registration and the total Provisional Refusal is maintained, a statement will be issued confirming the refusal of protection for all the goods and services i.e. that there is no protection accorded in Singapore.

17. DATE OF COMPLETION OF REGISTRATION PROCEDURE

For the purposes of Rule 18 of the Trade Marks (International Registration) Rules, the date of completion of the registration procedure is the date on which the Statement of Grant is issued or one day after 18 months from the date of the notification of the international registration / subsequent designation, in a case where no Statement of Grant and no notification of Provisional Refusal has been communicated. This means that use of the mark must commence within five years from this date or the registration stands to be revoked.

18. COLLECTIVE/CERTIFICATION/GUARANTEE MARKS

International applications may be filed for collective, certification or guarantee marks. As the international application form does not distinguish between these three types of marks, in all cases it will be necessary to raise a provisional total refusal of protection. The reason for this is that Singapore only accepts collective and certification marks and do not accept guarantee marks. The holder therefore needs to specify the type of protection applied for. It is also a requirement under the Trade Marks Act that regulations governing the use of collective or certification mark are filed.

19. PRIORITY CLAIMS

Where priority is claimed, a statement to that effect appears in the notification of International Registration / Subsequent Designation.

IPOS will verify that the priority date falls within six months of the international registration / subsequent designation date.

20. CANCELLATIONS

20.1 Cancellations effected for all the goods and/or services

When the IB notifies IPOS that the international registration has been cancelled for all goods and/or services at the request of the Office of Origin, IPOS will keep in view the notification of cancellation from the IB for four months to allow time for transformation, if requested by the holder.

Under Article *9quinquies* of the Protocol, holders of international registrations may file an application to transform an international registration / subsequent designation (cancelled at the request of the Office of Origin) into a national or regional application, within three months from the date on which the international registration was cancelled, provided certain conditions are met.

More about transformation is dealt with in Paragraph 21. When IPOS receives an application to transform all or some of the cancelled goods and / or services within the three month period, IPOS will ensure that the application is submitted by the same holder of the international registration, the application relates to all or some of the cancelled goods and / or services and the application for the identical mark.

The cancelled goods and/or services as applied for in the transformation application will then form the subject of a new national trade mark.

The transformed national application or registration retains any priority date(s) applicable to the goods and/or services from the international registration.

The process of examination, opposition or registration, whichever applicable, will continue with regards to the newly transformed national trade mark.

20.2 Cancellations effected for some of the goods and/or services

Partial cancellations, that is, cancellations which relate to only some of the goods and services of an international registration at the request of an Office of Origin, are processed in the manner indicated in Paragraph 20.1. The difference is that only those goods and services in the international registration which are affected by the cancellation will be deleted from the international registration and eligible for transformation. Those goods and/or services not affected by the cancellation will remain in the International Registration.

20.3 Updating cancellations

IPOS will process the cancellation notice from the IB in the following manner:

- In the case of a partial cancellation at the request of the Office of Origin, the goods and services partially cancelled will be deleted from the international registration designating Singapore.
- In the case of a full cancellation at the request of the Office of Origin, the status of the international mark will be set to “Withdrawn” for pending mark and "Cancelled" for registered mark

21. TRANSFORMATION OF A CANCELLED INTERNATIONAL REGISTRATION INTO NATIONAL APPLICATION

Where, during the five year dependency period following the date of international registration, the national application or registration on which IR is based is refused or cancelled, the Office of Origin is required to request that the international registration be cancelled, to the same extent. The IB will then notify all designated Contracting Parties of the cancellation.

Where the international registration designating Singapore is cancelled whether for all or some of the goods and services at the request of the Office of Origin, the holder is given the possibility to obtain protection of his mark in Singapore by transforming it into a national application within three months from the date of cancellation of the international registration. If the holder chooses to do so, the filing date of the international registration is preserved. This is known as transformation.

The transformed national application will be treated as though it had been filed on the date of the international registration or the date of the subsequent designation, provided that:-

- (a) the national application is filed within three months from the date on which the international registration was cancelled;
- (b) the transformed national application is for the same mark and for the same or no wider goods and services than the international mark; and
- (c) all national filing requirements, including payment of fees, have been met.

The transformed national application shall also enjoy the priority which was enjoyed by the international registration.

Holders who wish to transform their cancelled international registrations to Singapore national applications may do so by completing Form MP 1 with the requisite fee.

If the transformation application is successful, the international registration / subsequent designation in national register will reflect the new national trade mark number, under the field "Transformation Application under Madrid Protocol". Likewise, it will also be indicated in the register that the new national trade mark has been transformed from an international registration.

Transformation may take place only where the international registration has been cancelled, either partially or totally in respect of the goods and services, at the request of the Office of Origin. It is not available where the international registration was cancelled at the request of the holder.

22. REPLACEMENT OF NATIONAL REGISTRATION WITH INTERNATIONAL REGISTRATION

A national registration in Singapore is, under certain conditions, deemed to be replaced by an international registration of the same mark. These conditions are:-

- (a) both the national registration and the international registration are in respect of the same mark;
- (b) both the national registration and the international registration are in the name of the same holder;
- (c) all the goods and services listed in the national registration are also listed in the international registration; and
- (d) the international registration is extended protection in Singapore on a date later than the date of the national registration.

Therefore, if the holder of the international registration designating Singapore already owns an existing Singapore national registration(s), it is possible for the holder to replace the national registration(s) with the international registration if the conditions above are met.

While the list of goods and services in the national registration must also be listed in the international registration, the international registration need not have an identical list of goods and services. The list of goods and services in the international registration may be broader in scope than that of the national registration. However, it cannot be narrower.

As replacement is deemed to take place automatically as long as the above conditions are met, there is, technically, no action required by the holder. However, such replacement will only be recorded by a particular designated country if a request to record is made. Such a recordal is necessary for the information of the third parties. As such, the holder is advised to request IPOS to record on the national register the fact that the national registration has been replaced by the international registration.

Notwithstanding the replacement, it will be in the interest of the holder of the international registration to renew the Singapore national registration(s) during the five-year period which the international registration is dependent on the fate of the basic application /registration. For more information, please see the chapter on “International Applications where Singapore is the Office of Origin”.

The holder of the international registration wishing to record the fact of replacement on the register can do so by completing Form MP 2.

If the replacement application is successful, the international registration in national register will reflect the national trade mark number that it replaces, the class number(s), the date of protection, the good and/or services that it replaces and the priority claim details (if any) under the field "Replacement Application under Madrid Protocol".

Where IPOS has taken note of the replacement in register, following a request made by the holder, it will also notify the IB accordingly. Such a notification will include the international registration number, the filing date, trade mark number, the priority date (if any) and the goods and/or services of the national registration which has been replaced. The IB will record the indications so notified in the International Register and will also inform the holder. This information is also published in the WIPO Gazette.

Citation of replaced national application / registration

A reference to a replaced national registration in a citation against a later trade mark application will continue to be maintained by the international registration which replaced the national registration. This is because the holder of the international registration enjoys the filing date and the priority date from the replaced national registration.

23. CHANGE OF NAME AND / OR ADDRESS

A request to record a change in the name and/or address of the holder must be presented on the official form MM9(E) established by the IB.

The request may be presented to the IB directly by the holder or through the Office of the Contracting Party of the holder.

The IB records the change in the International Register and notifies the designated offices. It will also inform the holder and where the request was presented by an Office, that Office.

When IPOS receives such notifications, it will also update the change in the national register.

24. CHANGE OF OWNERSHIP

A request to record a change in ownership must be presented on the official form MM5(E) established by the IB.

The request may be presented to the IB by the holder, through the Office of the Contracting Party of the (recorded) holder or through the Office of the Contracting Party of the new owner (transferee).

The change in ownership may relate to all the goods and services covered by the international registration, or to only some of those goods and services. Similarly, the change in ownership may be in respect of all the Contracting Parties designated or only some of them.

25. RENEWAL OF INTERNATIONAL REGISTRATION

Under the Madrid Protocol, an international registration is valid for a period of 10 years from the date of the international registration. The international registration can be renewed every 10 years upon payment of the required fee.

The renewal of an international registration is a matter between the holder and the IB. The IB will send an unofficial notice, six months before the expiry of each 10-year term of protection, to remind the holder and representative (if any) of the impending expiry of the international registration.

WIPO has implemented the electronic renewal of international registrations which can be accessed under Forms at <http://www.wipo.int/madrid/en/forms> and also under the Online Services at <http://www.wipo.int/madrid/en/services/>.

The IB records the renewal of the international registration in the International Register, by inscribing the date on which it was due. The IB will also notify the Offices of the designated Contracting Parties concerned and send a certificate to the holder. The relevant data concerning the renewal will also be published in the Gazette.

Apart from reflecting in its records of the extended term of protection of the international registration, an Office which is notified of the renewal needs to take no other action.

26. LICENCES

Licences may be recorded against an international registration. However, as Singapore has declared that the recording of licences in the International Register has no effect in Singapore, a holder of an international registration wishing to record a licence of an international registration designating Singapore has to lodge CM6 with the requisite fee.

27. CHANGES NOT ACCEPTABLE IN THE INTERNATIONAL REGISTER

The following changes are not allowed:-

- (a) Changes to marks that have been recorded in the International Register are not allowed even if such changes are minor in nature. If the holder of the international registration wishes to obtain protection of a mark which differs from the mark recorded, the holder may only do so by filing a new international application.
- (b) Requests to extend the list of goods and/or services in the international registration are not allowed. If the holder of the international registration wishes to extend protection

beyond the scope of the goods or services indicated in the recorded international registration, the holder has to file a new international application.

28. DOS AND DON'TS FOR INTERNATIONAL REGISTRATIONS DESIGNATING SINGAPORE

S/No	Description	Practice / Recommendations
1	Amendment to the list of goods and services to overcome an objection raised in a Provisional Refusal issued by IPOS	No amendment form or fee is required. A letter to inform IPOS of the final list of goods and/or services will be sufficient. If the amendment overcomes the objection, IPOS will effect the amendment.
2	Amendment to the list of goods and/or services NOT due to a Provisional Refusal raised by IPOS	Do NOT lodge an amendment form to amend the list of goods and services. The amendment must be effected through the IB using their official form. The IB will record such changes in the International Register and inform the relevant designated Contracting Parties.
3	Request for the recordal of a Change in Name and / or Address of the Holder	Do NOT lodge Form CM2 to update the change in name and / or address of the holder. The change must be effected through the IB using their official form, MM9(E). The IB will record such changes in the International Register and inform the relevant designated Contracting Parties.
4	Request for the recordal of a Change in Ownership	Do NOT lodge Form CM8 to update a change of ownership of a trade mark. The change must be effected through the IB using their official form, MM5(E). The IB will record such changes in the International Register and inform the relevant designated Contracting Parties.
5	Renewal of the international	Do NOT lodge Form TM 19 to apply

	registration	for renewal of the international registration. The renewal must be effected through the IB using their official form, MM11(E). The IB will record the renewal in the International Register and inform the relevant designated Contracting Parties.
6	Changing the particulars of the international registration (eg. 3-dimensional claim, colour claim etc.)	IPOS will examine the international registration / subsequent designation as notified by the IB. Any request to change the particulars of the international registration / subsequent designation (such as inserting or deleting the 3-dimensional claim, colour claim) will have to be made through the IB. If the IB is satisfied that there is an error concerning such claims, it will correct the error and notify the holder and the relevant designated Contracting Parties.
7	Issuance of Registration Certificates for Protected International Trade Marks (Singapore)	<p>IPOS does not issue registration certificates for protected international trade marks designating Singapore.</p> <p>An international registration / subsequent designation is automatically protected within 18-months from the date of notification of the international registration / subsequent designation.</p> <p>In most cases, however, the holder would receive a Statement of Grant of Protection as confirmation of the fact that the international registration / subsequent designation is protected in Singapore.</p>