

## **INTERNATIONAL APPLICATIONS WHERE SINGAPORE IS THE OFFICE OF ORIGIN**

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## **1     INTRODUCTION**

This chapter deals with international applications where Singapore is the Office of Origin.

## **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](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

"**Agreement**" means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and amended on September 28, 1979;

"**applicant**" means the natural person or legal entity in whose name the international application is filed;

"**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 mark**" means the National trade mark upon which the international application is based.

"**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;

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

"**designated Contracting Party**" means a Contracting Party for which the extension of protection ("territorial extension") has been requested 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 in respect of which such extension has been recorded in the International Register;

"**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;

"**International Bureau**" or "**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;

**"Office"** means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in Article 9<sup>quater</sup> of the Agreement or Article 9<sup>quater</sup> 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;

**"subsequent designation"** means the request for extension of protection ("territorial extension") under Article 3<sup>ter</sup>(1) or (2) of the Agreement or under Article 3<sup>ter</sup>(1) or (2) of the Protocol, as the case may be; it also means such extension as recorded in the International Register;

#### **4. THE MADRID PROTOCOL**

The Madrid System of international registration of marks is governed by two treaties. The treaties are the Agreement, which has been in existence since 1891, and the Protocol relating to the Madrid Agreement (“Madrid Protocol”) which came into operation on 1 April 1996. The Madrid System is administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.

Singapore acceded to the Protocol on 31 July 2000 and the Madrid Protocol came into operation in Singapore on 31 October 2000.

#### **5. BRIEF DESCRIPTION OF THE MADRID PROTOCOL**

The Madrid Protocol is a treaty providing for the international registration of trade marks.

Under the Madrid Protocol, a trade mark owner can obtain an international registration, by filing a single application (called an international application) and paying one set of fees, to seek protection of the trade mark in several countries that are parties to the Madrid Protocol. The list of countries that one can seek protection is available at [WIPO’s website](#). The Madrid Protocol therefore offers an alternative to filing separate applications directly with individual countries where trade mark owners intend to seek registration.

#### **6. ADVANTAGES OF THE MADRID PROTOCOL**

The advantage of using the Madrid Protocol 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. Further, the applicant uses only one language and pays only in a single currency.

The trade mark owner enjoys similar benefits when the registration has to be renewed or changed i.e. a single request, in a single language accompanied by payment in a single currency.

## **7. FILING AN INTERNATIONAL APPLICATION**

An international application must be presented to the IB through the national trade mark office of a Madrid Protocol member state where local protection of the trade mark has been sought. This office is known as the Office of Origin for the international application and in the context of this manual would be IPOS.

International applications can be filed through IPOS if the applicant meets the following requirements:

- A. The applicant or applicants must:
  - i. be a citizen of Singapore; or
  - ii. have a business in Singapore; or
  - iii. be domiciled in Singapore; or
  - iv. have a real and effective industrial or commercial establishment in Singapore; and
  
- B. The applicant or applicants must have a trade mark application or registration with IPOS (known as the basic mark) for the mark that is sought to be protected in the international application.

The international application must be filed via the national trade mark office where the basic mark is held as it is required to certify that the information contained in the application form accords with the details of the basic mark(s). When certified, the application can then be passed to WIPO.

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 is then registered and details of the registration will be published in the WIPO Gazette of International Marks.

The IB then notifies the national trade mark office of each Contracting Party in which protection of the mark has been requested (also known as the designated Contracting Party). 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

refusals in designated contracting parties will be published in the WIPO Gazette and also forwarded to the applicant for the mark.

### *The International Trademark Registration Process*



#### International Application Form (MM2(E))

International applications must be made on the official WIPO form MM2(E) which may be obtained from [the WIPO website](#). The form MM2(E) may be submitted to IPOS on paper or electronically [through IP2SG](#). Paper MM2(E) forms must be completed in typescript as WIPO does not accept hand-written forms.

All paper MM2(E) forms submitted to IPOS must be accompanied by Continuation Sheet 8 (CS8) to enter an address for service in Singapore for the purposes of the international application. There is no similar requirement for electronically filed MM2(E) forms, as the electronic form contains a field for the insertion of an address for service.

For more detailed information on how to complete the form, please refer to the following resources:

- [WIPO's explanatory notes for the form](#)
- "Guide to completing online Form MM2(e)" on [IPOS' website](#)

IPOS charges a handling fee for every MM2(E) form submitted and if the MM2(E) form is submitted on paper, an additional service bureau charge is payable for digitising the form. The amount of fees and service bureau charge can be found at [IPOS' website](#).

The applicant may designate one or more Contracting Parties, but not the member state where the international application originates from. For example, if the international application originates from Singapore, the applicant cannot designate Singapore in the list of Designated Contracting Parties.

#### *Special cases*

- (a) Where the United States of America is designated, it is compulsory for the applicant to lodge the form MM18 for the declaration of intention to use the mark.
- (b) Where the European Union (EU) is designated, the applicant must indicate a second working language before the Office of the European Union. The four official languages are French, German, Italian and Spanish. The second language serves as a language in which third parties may lodge opposition and cancellation proceedings before the Office of the European Union.

#### Seniority claim (where the European Union is designated)

The European Union Trade Mark system (EUTM system) is a unified trademark registration system in Europe, whereby one registration provides protection in all member states of the EU. The EUTM system allows the owner of a registered trade mark in an EU member state to claim seniority of that earlier mark when the owner applies for registration of an identical mark with the European Union Intellectual Property Office (EUIPO) as long as the goods and/or services claimed are covered by the earlier mark. Seniority claim has the sole effect under the EUTM Regulation that, where the proprietor of the EUTM surrenders the earlier trade mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.

To claim seniority, applicants are required to lodge the WIPO form MM17 together with the international application form. They will have to indicate:

- (a) each member state in or for which the earlier mark is registered;
- (b) the date from which the registration was effective;
- (c) the number of the registration; and
- (d) the goods and services for which the earlier mark is registered.

### Fees for International applications

The fees to be paid to obtain an international registration comprise:

- A basic fee (note that this fee is higher where the reproduction of the mark is in colour);
- A complementary fee for each designated country which does not require an individual fee, or an individual fee for those designated countries that require it; and
- A supplementary fee (for each class of goods and/or services over three classes in the international application. This fee does not apply if all the designated countries have individual fees.

The WIPO Fee Calculator at <http://www.wipo.int/madrid/en/fees/calculator.jsp> will help you to estimate your international application fees. In selecting the relevant date in the drop down menu of the online Fee Calculator, applicants should select a date closest to the date the international application is submitted to IPOS or the fees indicated may not be accurate.

Fees must be paid in Swiss francs (CHF) and via one of the following payment methods:

- Deduction from a [WIPO Current Account](#)
- Bank transfer to the WIPO bank account
- Postal transfer to WIPO postal account (within Europe only)

For payment of fees notified in WIPO irregularity letters or other WIPO communications concerning Madrid systems, payment can be via [E-Payment](#) by credit card or through a WIPO Current Account.

Further information about the fees under the Madrid system and the payment methods is available at <http://www.wipo.int/about-wipo/en/finance/madrid.html>.

### *Basic fee*

WIPO charges a basic fee for all international applications.

This fee is based on whether the mark sought for registration is in black and white or in colour. The basic fee for a black and white reproduction of the mark is 653 Swiss francs. If a coloured reproduction of the mark is lodged, the basic fee payable is 903 Swiss francs.

It does not matter that the applicant intends to limit the mark to colour(s) or claim colour(s) as a trade mark or claim colour as a distinctive feature of the mark. As long as the mark is in colour(s), the higher fee is payable.

### *Complementary fee*

Applicants must pay a Complementary fee for each designated Contracting Party which opts to charge complementary fee instead of Individual fee. The complementary fee set by WIPO is 100 Swiss francs for each designated Contracting Party. This means that if there are five designated Contracting Parties which collect Complementary fee, the complementary fee will be 500 Swiss francs.

### *Supplementary fee*

For Contracting Parties that charge a complementary fee and where the application contains more than 3 classes, a supplementary fee of 100 Swiss francs is payable for each additional class. The fee will be charged where at least a Contracting Party that collects complementary fee is designated and the amount charged will depend on the number of classes applied beyond the first 3 classes. For instance, if there are five designated Contracting Parties with two of them charging complementary fee and application is filed for 10 classes, the supplementary fee will be 700 Swiss francs. The supplementary fee is only applicable to Contracting Parties that charge a complementary fee. Hence if the applicant only designates Contracting Parties that charge individual fees, it would not be necessary to pay supplementary fees.

### *Individual fee*

A number of countries, including Singapore, have opted to receive an individual fee instead of a complementary/supplementary fee.

The quantum of the individual fee varies for each Contracting Parties and depends on the number of classes and type of mark applied for (in particular, certification and collective marks have a higher fee).

Some Contracting Parties that require an individual fee may also request for fees to be paid in two parts, the first part at the time of filing the international application and the second part at a later date, which is determined in accordance with the law of that Contracting Party. The list of individual fees, including information on Contracting Parties that have a two part fee is at:

[http://www.wipo.int/madrid/en/fees/ind\\_taxes.html](http://www.wipo.int/madrid/en/fees/ind_taxes.html)

### *Indication of payment in the international application form MM2(E)*

The applicant is required to enter the name of the party making the payment under “Identity of the party effecting the payment” at part c of the “Fee Calculation sheet” of the international application form MM2(E). The IB will notify the party indicated at part c if the payment is insufficient or where there is a partial or total reimbursement.

To confirm that the payment has been made and to allow the IB to attribute the payment correctly, the payment details of the bank's transfer transaction must be indicated in the appropriate space on form MM2(E) at the time of filing. Hence, applicant should make payment to the IB first before submitting form MM2(E) with IPOS. IPOS requires a photocopy of the bank's transaction advice to be furnished together with the international application. Applicants should also note that they are responsible for all relevant bank charges when making an international bank transfer.

WIPO has introduced an E-Payment Service, which allows payment of fees notified in their irregularity notices or other WIPO communications, with regard to international applications or registrations. Irregularity notices are notices issued by WIPO in respect of certain errors or

deficiency found in forms or letters which may require rectification by the applicant or the Contracting Parties.

### **Certifying process**

All international applications must be sent to the IB by the Office of Origin. The IB will not accept any international applications directly from applicants or their agents. This is because the Office of Origin must certify:

- 1) The filing date of the international application; and
- 2) That the details on the international application accord with those on the basic mark.

### **Filing date of the international application**

As the Office of Origin, IPOS is responsible for certifying, among other things, the filing date of the international application.

Where the international application is certified and forwarded to the IB within **two months** from receipt by IPOS, the date of receipt by IPOS will be the date recorded for the resulting International Registration. Otherwise, the filing date of the international application will be the date on which the IB receives the international application. This filing date will, upon registration of the mark by the IB, become the international registration date. Rights acquired by protection of the mark will run from this date.

A later filing date may also be accorded to an international application by the IB if there are deficiencies in the form MM2(E) and the deficiency is not rectified within the stipulated time. When this happens, the priority claim, if any, may be lost if the later filing date is more than 6 months after the priority date.

### **Certification of particulars**

This process requires the office to ensure that the basic trade mark(s) and the international application details are in accord. This means checking the following:

- 1) The applicant of the international application and the owner of the basic mark are the same
- 2) The addresses are the same or the differences explained
- 3) The marks are identical

This means if the basic mark is in black and white, so must the mark in the international application.

The Madrid Protocol does not provide for a series of marks to be registered. Where the basic mark is a series of trade marks, the applicant should select one of the marks in the series for the international application. If the applicant wishes to apply for an international registration for all the marks in the series, the applicant must file a separate international application for each mark in the series.

- 4) The goods and services claimed on the international application are the same or narrower than those covered by the basic trade mark

If the basic trade mark has not yet been accepted, the specification of the basic trade mark(s) should be checked to ensure it is in the correct class. Although IPOS only has to certify that the goods and / or services cover those specified in the international application, IPOS should also ensure that classification is correct before certifying the international application before forwarding it to the IB.

- 5) Certain indications appearing on the international application also appear on the basic trade mark(s)

Any endorsements or written descriptions of the trade mark must be the same on the international application and the basic trade mark(s). This includes translations, transliterations, colour limitations, colour claims and descriptions of non-conventional trade marks.

- 6) The applicant's entitlement to file must be stated

If there is more than one applicant, all joint applicants must state their nature of entitlement to file. This need not be the same criterion for each person.

### Irregularities

If the international application cannot be certified, the applicant or the applicant's agent will be notified of the irregularities in writing. The Irregularity Letter will include:

- Suggestions to resolve the irregularities, where possible; and

- A reminder that the filing date of the international application will be lost if both the international application and the office's certification are not received by the IB within two months of the date IPOS received the application.

If the international application is in order and has been certified, IPOS will transmit the international application to the IB electronically.

## **8. ACTION TAKEN BY THE IB**

Upon receiving the international application, the IB will conduct formalities examination.

In formalities examination, the IB checks that all filing requirements have been complied with, that the classification of the goods and services listed on the international application is correct and that all appropriate fees have been paid.

### **Irregularities in the international application**

If the IB identifies irregularities in an international application, the IB will notify both the Office of Origin and the applicant by way of an irregularity notice. The irregularities must be remedied either by the IPOS or the applicant, depending on their nature.

The IB will highlight the nature of the irregularities in the notice, giving a three-month deadline to remedy them. If the irregularities are not rectified during the prescribed period, the international application is considered abandoned. This deadline is not extendable.

#### **Types of irregularities**

The applicant may deal with the IB directly on any irregularities relating to fees.

However, if the irregularity may only be remedied by changing the contents of the application, then that irregularity must be responded to by the Office of Origin. For example, if IB holds the

view that the description of goods does not comply with the ICGS, the IB will issue the irregularity notice with proposed alternative description to the Office of Origin. The Office of Origin will liaise with the applicant on the issues raised by IB and the office will then inform IB of the applicant's response accordingly.

If the irregularity relates to a classification of goods and services, the IB may propose a reclassification which could require additional class fees.

For irregularities concerning terms which are (i) deemed to be too vague for the purposes of classification, (ii) incomprehensible, or (iii) linguistically incorrect, the IB may suggest a rewording or deletion of the objected terms. If the Office of Origin and the applicant are able to remedy the irregularity within the given deadline, the IB will make the changes. However, if no acceptable proposal is received by the IB within the deadline, the IB will include the term in the international registration but with a proviso that they consider the term to be too vague for classification purposes, incomprehensible or linguistically incorrect. It is then left to the individually designated Contracting Parties to object to the objectionable terms.

## **9. REGISTRATION**

If the international application is in order, the IB will assign it an international registration number and published it in the [WIPO Gazette](#) as an international registration. A Certificate of Registration will be sent to the applicant who is now known as the "holder" of the international registration. The IB also advises the Office of Origin of the IR number.

Although the international application is registered upon the completion of the formalities examination, this does not amount to protection of the mark in the designated Contracting Parties, as the international registration is still subject to substantive examination in those countries.

For an overview of the whole filing process of form MM2(E), please refer to Annex at the end of this manual.

## **10. SUBSEQUENT DESIGNATIONS**

If the owner of an international registration wishes to extend protection of his trade mark to other Contracting Parties, in addition to those already designated, he can subsequently designate more Contracting Parties in the same international registration. Subsequent designations may only be made after the international application has resulted in an international registration.

Subsequent designation is made using the official WIPO form MM4. Unlike international applications, subsequent designations need not be filed through the Office of Origin but may be filed directly with WIPO. In fact, direct filing with WIPO is recommended.

Similar to an application for international registration, the IB will conduct formalities check on the subsequent designation filed. Applicants will be given three months to rectify any irregularities. Once the formalities check is complete, the subsequent designation will be registered and published in the [WIPO Gazette](#). Details of the subsequent designation will be sent to the newly designated Contracting Parties. The acquired rights in each newly designated Contracting Party will run from the date of subsequent designation.

Applicants may wish to note that the period of protection under the subsequent designation will expire on the same date as the international registration. For example, if an international registration mark has already been registered for 9 years and the subsequent designation is filed at the end of the 9<sup>th</sup> year, the mark will only be protected for 1 year in the newly designated Contracting Parties. Assume an international registration mark is registered on 15 June 2000 and the designated country is Japan. A subsequent designation is filed on 1 January 2009 and the country designated is China. The protection of the mark in Japan and China expire on the same date, ten years after the date of international registration.

## **11. DEPENDENCY AND CENTRAL ATTACK**

For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the mark applied for or registered in the

Office of Origin (i.e. the basic mark). The period of five years is known as the “dependency period” and the consequence of it is the ceasing of effect of the international registration which may be partial or full.

As the Office of Origin, IPOS needs to notify the IB when:

- 1) A basic trade mark ceases to exist within this period; or
- 2) The scope of the basic trade mark is restricted during this period; or
- 3) The basic trade mark ceases to exist or is restricted as a result of an action which commenced within this period.

IPOS must therefore monitor Singapore basic trade marks for any of the following changes:

- 1) The basic trade mark application is refused, withdrawn or treated as withdrawn
- 2) The scope of the basic trade mark application or registration is restricted (i.e. some of the goods and/or services are deleted)
- 3) The basic trade mark registration is cancelled, revoked or invalidated
- 4) The basic trade mark registration is not renewed

The following reports are used internally by IPOS to monitor the status of basic applications and registrations: five-year dependency status report and five-year dependency amendment report. These reports are generated weekly.

Once notified, the IB cancels the international registration to the same extent, and notifies all designated countries as well as the holder of the International Registration.

After the expiry of the dependency period, the international registration becomes independent of the basic application(s) or the basic registration(s). This means that any challenge or withdrawal of the basic application or basic registration will not have an impact on the international registration.

There is no separate dependency period for subsequent designations. The only dependency period is the one which runs from the date of the international registration. For instance, the date of

international registration is 1 February 2010 and the date of subsequent designation is 1 February 2012. The dependency period for both the international registration and subsequent designation is within five years from the date of the international registration.

The international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees directly to the WIPO.

## **12. TRANSFORMATION INTO NATIONAL APPLICATION**

If an international registration is cancelled as a result of the ceasing of effect of the basic application or the basic registration, the holder of the international registration can apply to transform international registration into one or more national applications (in the designated Contracting Parties). This is known as “transformation”.

The process of transformation helps to mitigate the vulnerability of the five-year dependency feature in the Madrid Protocol, as the national applications resulting from this transformation will be treated as if they had been filed on the date of the original international registration. In other words, the filing date of the international registration is not lost upon cancellation of the international registration, if it is transformed into national applications.

To qualify for transformation, the holder must apply for transformation within three months of the date of the cancellation of the international registration.

Transformation may take place only where the international registration has been cancelled, in respect of all or some of the goods and services at the request of the Office of Origin. When this happens the Office of Origin will inform the IB. After the international registration has been cancelled, the holder will have three months from the date of cancellation to file the transformation request directly with the designated Contracting Parties. Transformation is not available where the international registration has been cancelled at the request of the holder. If an international registration originating from Singapore has been cancelled and the applicant wishes to transform it to a national application in the designated Contracting Parties, the applicant will have to file the

request for transformation with the respective designated Contracting Parties. It is to be noted that the transformation process and requirements may differ between the Contracting Parties.

### **13. CHANGES AFFECTING THE INTERNATIONAL REGISTRATION**

The International Register is kept at WIPO. Therefore WIPO must be informed of changes relating to international registrations. Most of these changes can be filed directly with WIPO by the holder of the international registration.

#### **13.1 Change of Ownership (MM5)**

The holder of an international registration may transfer ownership of the international registration to another party (i.e. the transferee).

To do so, the holder must use the official WIPO form MM5 and a fee in Swiss francs is payable. The request may be presented to the IB by the holder directly, or through the national trade mark office of the holder or the national trade mark office of the transferee.

In order for the transfer to be recorded on the international register, the transferee must also be entitled to own the mark under the Madrid Protocol. This means that the transferee must:

- (a) have a real and effective industrial or commercial establishment; or
- (b) be domiciled in the contracting party, or
- (c) be a national of the contracting party.

The condition known as the entitlement to hold the mark must be indicated on the form MM5.

#### **13.2 Limitation, Renunciation and Cancellation (MM6, MM7 & MM8)**

To restrict the scope of protection of an international registration, the applicant may choose to record a limitation, renunciation or cancellation with the IB.

The differences are:

**(a) Limitation**

Limits some of the goods and services in some or all of the designated Contracting Parties.

**(b) Renunciation**

Affects all the goods and services in some but not all of the designated Contracting Parties.

**(c) Cancellation**

Cancels some or all of the goods and services in respect of all designated Contracting Parties.

	<b>Goods and services</b>	<b>Contracting parties affected</b>
<b>Limitation</b>	Some	Some or all
<b>Renunciation</b>	All	Some but not all
<b>Cancellation</b>	Some or all	All

Although a limitation and a cancellation have much in common, there is one important difference. If some goods and services have been removed following a limitation, the applicant can lodge a subsequent designation if protection for these goods and services is required in the future. The goods and services are not permanently removed from the international registration. Similarly, goods and services that have been renounced can be designated again.

A cancellation, on the other hand, removes the goods and services permanently from the international registration. The applicant will not be able to apply for a subsequent designation to seek protection of the cancelled goods and services. The only way to do so is by filing a fresh international application.

**13.2.1 Limitation of the list of goods and services (MM6)**

The official form to record a limitation is the official WIPO form MM6 and a fee is payable for each Contracting Party to which the limitation applies.

This form may be presented directly to the IB by the applicant or through the national office of the applicant. Once the limitation is recorded and published in the WIPO Gazette, the notification of limitation will be sent to the Contracting Parties concerned.

### **13.2.2 Renunciation (MM7)**

If the applicant no longer wishes to protect his mark in one or more (not all) designated Contracting Parties, the applicant may lodge the official WIPO form MM7 to request for a complete withdrawal for protection of a mark in those countries. It should be noted that if the applicant wishes to renounce the mark in all the designated Contracting Parties, the applicant should request for a cancellation rather than a renunciation.

The form may be sent directly to the IB or through the national office of the applicant. A request to record a renunciation is free of charge.

Like a request to record a limitation, the renunciation will be recorded and published in the WIPO Gazette before the notifications are sent to the relevant Contracting Parties.

### **13.2.3 Cancellation of the International Registration (MM8)**

Cancellation affects some or all of the goods and services in all the designated countries.

The applicant may lodge the official WIPO form MM8 to request for a cancellation. Upon cancellation, the goods and services are removed from the international registration permanently.

The applicant will have to indicate on the form if the cancellation is in respect of some or all of the goods. If the cancellation relates to specific goods and/or services, the applicant will have to list these goods and/or services in part 4(b) of the form.

The completed form may be submitted directly by the applicant or through the national office of the applicant. A request to record a cancellation is free of charge. The request will be published in the WIPO Gazette and all the designated Contracting Parties will be notified accordingly.

### **13.3 Renewal (MM11)**

Renewal of an International Registration is due 10 years from the date of the International Registration. The IB will send the holder an unofficial reminder six months before the IR is due for renewal.

This may be done by way of letter or by using the official renewal form MM11. Alternatively, renewals may also be filed electronically via WIPO's website.

It is possible to renew the IR six months after the expiry of the registration. However, if renewal requests are filed during this six month grace period, a surcharge would be added to the renewal fees.

Applicants are encouraged to file the renewal directly with WIPO. If the renewal is filed through IPOS, a handling fee of S\$85 is payable.

### **13.4 Change in name and/or address of the holder (MM9)**

Where there has been a change in the name and/or address of the holder, WIPO form MM9 is to be used to record the change and a fee in Swiss francs is payable. Applicants can lodge one form to effect the change for several international registrations that belong to them. The request may be lodged directly with the IB by the holder or through the national office of the holder.

### **13.5 Appointment of a representative (MM12)**

Appointment or change of a representative may be done at any time via a simple letter or WIPO form MM12. Such communication may be presented to the IB by the new representative, the applicant or the representative on record. If it is presented by the representative on record, it must be signed by the holder or the new representative. One form or letter may be used for multiple international registrations. However, all the international registrations affected must be clearly stated.

### **13.6 Change in name and/or address of representative (MM10)**

To update the details of the applicant's representative on record, the request may be made by way of a simple letter or WIPO form MM10. This form is free of charge and one form may be lodged for multiple international registrations. However, all the international registration numbers of the affected international registrations must be specified. The form may be sent directly to the IB or through a national office.

Do note that form MM10 may only be used to amend the details of the agent or representative on record. It cannot be used to appoint a new representative.

## **14. REPLACEMENT OF NATIONAL REGISTRATION**

An international registration may replace an existing national registration in any of the designated Contracting Parties under certain circumstances. When this happens, the international registration will substitute the national registration.

For replacement to take place, the international registration must:

- (a) Have been granted protection in the relevant country;
- (b) Be in respect of the same mark;
- (c) Be held by the same holder; and
- (d) Cover all the goods and services listed in the national registration.

Although replacement is deemed to happen automatically if the above conditions are met, it is only recorded by the designated country if a request to record is made.

For Singapore's approach on recording a replacement, please refer to the Trade Marks Work Manual Chapter on "International registrations / Subsequent designations designating Singapore" [here](#).

**ANNEX**

**Flowchart for Office of Origin**

