Training Workshop for Trade Marks Application Prosecutors

Registry of Trade Marks
6 November 2017
Outline

Nice Classification, 11th Edition, Version 2018

ICGS Tools Available on IP²SG

IP²SG Filing Matters & System Updates

The Madrid System
Nice Classification, 11th Edition, Version 2018

Kok Chi Suan (Registry of Trade Marks)
6 November 2017
Nice Classification, 11th Edition

- Entry into force: 01 January 2018
- ~ 540 changes made to the Nice Classification
- Changes to Class Headings of 10 classes
- Changes to Explanatory Notes of 19 classes
Key Changes

Air fragrance reed diffusers (03)

Added to Class 3. Air fragrance and reed diffusers seen as a package that is always sold together. Similar to the classification of “lipstick cases” in Class 3.

Massage candles for cosmetic purposes (03)
Medicated massage candles (05)

Added to Class 3 & 5 respectively, even though candles are classified in Class 4.

Belts for sanitary napkins [towels] (05)

Deleted. Term deemed obsolete.
Key Changes

Metal ramps for use with vehicles (06)
Plastic ramps for use with vehicles (20)
Key Changes

Stoppers

Rubber stoppers (17)
Stoppers, not of metal (20)
Glass stoppers (21)

Stoppers of metal (06)
Rubber stoppers (17)
Stoppers, not of glass, metal or rubber (20)
Glass stoppers (21)

Fruit segmenters (08)
Fruit corers (08)
Kitchen mandolines (08)

Added to Class 8 as hand-operated tools for cutting.
Key Changes

Robots [machines] (07)  →  Industrial robots (07)
Laboratory robots (09)
Teaching robots (09)
Security surveillance robots (09)
Surgical robots (10)
Robotic cars (12)
Robotic drums (15)

To clarify that robots are not limited to Class 7.
Key Changes

Ring sizers (09)
Finger sizers (09)

Added to Class 9 as measuring instrument.

Rearview cameras for vehicles (09)
Electric wire harnesses for automobiles (09)

Added to Class 9 as cameras and electric wire clusters and connectors respectively even though they are specified to be for vehicles.

Snorkels (09)

Added to Class 9 by analogy with “Breathing apparatus, except for artificial respiration”.
Key Changes

Sports whistles (09)

Added to Class 9 as signaling apparatus.

Telecommunication apparatus in the form of jewelry (09)

Telecommunication apparatus in the form of jewellery (09)

Added to Class 9 as telecommunication apparatus even though they are in the form of jewellery.

Rescue laser signalling flares (09)

Rescue flares, explosives or pyrotechnicals (13)

Clarifies the difference between rescue flares in Class 9 and Class 13.
Key Changes

Baby feeding dummies (10)
Baby feeding pacifiers (10)

Added to Class 10 by analogy with “Feeding bottles”.

Cooling patches for medical purposes (10)
Cooling pads for first aid purposes (10)

Added to Class 10.

Heating and cooling apparatus for dispensing hot and cold beverages (11)

Added to Class 11 as heating and cooling apparatus.
Key Changes

Direction signals for vehicles (12)

Signal arms for vehicles (12)

Camera drones (12)
Photography drones (12)

Added to Class 12 by analogy with “Civilian drones” and “Military drones”.

Fishing trolleys (12)

Added to Class 12 instead of Class 28.
Key Changes

Rescue sleds (12)

Added to Class 12 by analogy with “Ambulances”.

Paper ribbons, other than haberdashery or hair decorations (16)
Paper bows, other than haberdashery or hair decorations (16)
Haberdashery ribbons (26)
Haberdashery bows (26)
Ribbons for the hair (26)
Ribbons and bows, not of paper, for gift wrapping (26)

Clarifies the classification of “ribbons” and “bows”.
Key Changes

Paper bags for use in the sterilization of medical instruments (16)
Paper bags for use in the sterilisation of medical instruments (16)
Paper for medical examination tables (16)
Dental tray covers of paper (16)

Added to Class 16 as the goods are essentially paper products even though they are for use in the medical industry.

Name badge holders [office requisites] (16)
Retractable reels for name badge holders [office requisites] (16)
Clips for name badge holders [office requisites] (16)

Added to Class 16.
Key Changes

Quay wall-mounted rubber cushioning materials for the prevention of damage to docks, ships and vessels (17)

Motorized suitcases (18)

Added to Class 18 as the goods are essentially “Suitcases” even though the goods are motorized and rideable.

Compression cubes adapted for luggage (18)
Key Changes

Conference folders (18)
Conference portfolios (18)

Added to Class 18 to avoid confusion with Class 16.

Hiking sticks (18)
Trekking sticks (18)

Added to Class 18 to avoid confusion with Class 28.

Head support cushions for babies (20)
Head positioning pillows for babies (20)
Anti-roll cushions for babies (20)
Key Changes

Hand-held flagpoles of metal (06)
Hand-held flagpoles, not of metal (20)

Cooking mesh bags, other than for microwaves (21)

Added to Class 21.

Dust sheets (22)
Drop cloths (22)

Added to Class 22 by analogy with “Tarpaulins”.
Key Changes

Bumper guards for cots, other than bed linen (20)
Bumper guards for cribs, other than bed linen (20)
**Cot bumpers [bed linen] (24)**
**Crib bumpers [bed linen] (24)**

Complementary entries in Class 24 added.

Artificial Christmas garlands (26)
Artificial Christmas wreaths (26)

Added to Class 26 by analogy with “Artificial garlands” and “Wreaths of artificial flowers”.

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Key Changes

Novelties for parties, dances [party favors, favours] (28)
Practical jokes [novelties] (28)

Novelty toys for parties (28)
Novelty toys for playing jokes (28)

Amended for clarity that “Novelties” refers to “Novelty toys”.

Toy imitation cosmetics (28)

Added to Class 28 as the goods cannot apply color pigment to the skin.
Key Changes

Cranberry sauce [compote] (29)

Cranberry compote (29)
Cranberry sauce [condiment] (30)

Amended for clarity.

Mints for breath freshening (30)
Chewing gum for breath freshening (30)

Added to Class 30 as the goods are essentially “mints” and “chewing gums” even though the goods have a breath freshening effect.
Key Changes

Barley wine [beer] (32)

Barley wine is a style of strong ale, implied to be as potent as wine, usually containing more than 6% alcohol.

Gift registry services (35)

Added to Class 35.

Arranging of travel tours (39)
Conducting guided tours (41)

Arranging of transportation for travel tours (39)
Conducting guided tours (41)
Cosmetic Changes
Cosmetic Changes

British and American English

- Entries containing both British and American English are replaced with two entries of each spelling
- E.g. inner tubes for pneumatic tires [tyres]
  - inner tubes for pneumatic tyres
  - inner tubes for pneumatic tires

- E.g. detergent additives to petrol [gasoline]
  - detergent additives to petrol
  - detergent additives to gasoline
Cosmetic Changes

Wording

- E.g. synthetic resins [semi-finished products]
  synthetic resins, semi-processed

- E.g. linseed oil for culinary purposes
  linseed oil for food
## Cosmetic Changes

### Spelling

<table>
<thead>
<tr>
<th>Improper</th>
<th>Corrected</th>
</tr>
</thead>
<tbody>
<tr>
<td>Vulcanisation accelerators</td>
<td>Vulcanization accelerators</td>
</tr>
<tr>
<td>Vulcanisation apparatus</td>
<td>Vulcanization apparatus</td>
</tr>
<tr>
<td>Rental of dish washing machines</td>
<td>Rental of dishwashing machines</td>
</tr>
<tr>
<td>Baby sitting</td>
<td>Babysitting</td>
</tr>
</tbody>
</table>
ICGS Tools Available on IP²SG

Pang Hui Jiun (Registry of Trade Marks)
6 November 2017
Feature 1: Search as you type

Add Goods & Services

Search as you type

Type your list of goods/services in the textbox above. Please ensure that individual descriptions of goods/services are separated by a semi-colon (;).

Items entered in the textbox above are highlighted in either green or red. Items highlighted in green: These items are found in our classification database in their respective indicated class(es). Items highlighted in red: These items are not found in our classification database in the respective class(es) you have chosen to indicate.

You may enter a class filter by typing “@” followed by a number between 1 to 45 to see results from a specific class. e.g. “@9@28 computer games” will show results containing “computer” and “games” in either Class 9 or 28.
Features of Form TM4 Part 6: Specification of Goods/Services

Feature 1: Search as you type

Class filtering

- Add "@<class number>" (e.g., @43) to filter results to specified class

- May add more than one filter (e.g., @29@30)

- Filter can be placed in front or behind keyword. E.g.,
  - @29<space>food
  - food@29
Features of Form TM4 Part 6: Specification of Goods/Services

Feature 2: Advanced Search

- Use “OR” to search for descriptions containing any of the words entered
- If multiple words are entered, results will be based on all the words in any combination

Refine search results based on specific class number(s), “All Goods” or “All Services”
Features of Form TM4 Part 6: Specification of Goods/Services

Feature 2: Advanced Search

- Number of rows per page can be customized
Features of Form TM4 Part 6: Specification of Goods/Services

Feature 3: Colour coding

- Items in **green**: Item(s) found in our classification database in the respective class(es)
- Items in **red**: Item(s) not found in our classification database in the respective class(es)
ICGS Database Download

Search and Enquiry/ eAlert
- Trade Marks
  - Patents/Patents Open Dossier
  - Designs
  - Journal

Search Type
- Forms
- IP
- Journals
- Trade Marks Classification of Goods or Services
- Trade Marks Similar Mark
- Patents Abstract and Specification
- Design International Registrations

Download Classification Database

Click [here](#) to download the latest classification database.

IPOS International Classification of Goods and Services Database (Updated as of 20/10/2017 09:55)

Disclaimer: Please note that the database is constantly being updated. You are advised to check your specification of goods and services against the latest version of the database before making any submissions by using the “Search as you type” facility in the electronic trade mark application form.

<table>
<thead>
<tr>
<th>S No.</th>
<th>Goods and Services Description</th>
<th>Class No.</th>
<th>Source</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>Absorbent granules of synthetic materials for liquids</td>
<td>1</td>
<td>IPOS List</td>
</tr>
<tr>
<td>2</td>
<td>Absorbent graphite</td>
<td>1</td>
<td>IPOS List</td>
</tr>
<tr>
<td>3</td>
<td>Absorbents [synthetic materials]</td>
<td>1</td>
<td>IPOS List</td>
</tr>
<tr>
<td>4</td>
<td>Absorbents [synthetic materials] for soaking up liquids</td>
<td>1</td>
<td>IPOS List</td>
</tr>
<tr>
<td>5</td>
<td>Absorbents derived from silica</td>
<td>1</td>
<td>IPOS List</td>
</tr>
<tr>
<td>6</td>
<td>Absorbents for cleaning solvents</td>
<td>1</td>
<td>IPOS List</td>
</tr>
<tr>
<td>7</td>
<td>Absorption agents</td>
<td>1</td>
<td>IPOS List</td>
</tr>
</tbody>
</table>
IP²SG Filing Matters & System Updates

Pang Hui Jiun (Registry of Trade Marks)
6 November 2017
Commonly Encountered Filing Issues
Amending Form TM4 (Application to Register a New Trade Mark)

Correction of Error in Ownership

<table>
<thead>
<tr>
<th>Requestor</th>
<th>Form</th>
<th>Information Required</th>
</tr>
</thead>
<tbody>
<tr>
<td>Agent or “applicant” on record</td>
<td>TM27</td>
<td>Written statement in Part 4I (free-text box) explaining the error made</td>
</tr>
<tr>
<td>Not agent or “applicant” on record</td>
<td></td>
<td>Consent letter or declaration letter from “applicant” on TM4 declaring non-ownership of the mark</td>
</tr>
</tbody>
</table>

What happens next:

- If all requirements are fulfilled, IPOS will proceed to correct the erroneous entity appearing on record.

- IPOS will also issue a fresh tax invoice bearing the name of the rightful owner. A credit note will also be issued to declare the original tax invoice as null and void.
## Amending Form TM4 (Application to Register a New Trade Mark)

### Types of Changes/Amendments to Form TM4

<table>
<thead>
<tr>
<th>Nature</th>
<th>Form</th>
</tr>
</thead>
<tbody>
<tr>
<td>Add/change/discharge agent</td>
<td>CM1</td>
</tr>
<tr>
<td>Change or correct applicant details (e.g. typo in name or address)</td>
<td>CM2</td>
</tr>
<tr>
<td>Note: Applicant entity remains unchanged</td>
<td></td>
</tr>
<tr>
<td>Correct ownership details (e.g. wrong owner inserted at point of TM4</td>
<td>TM27</td>
</tr>
<tr>
<td>filing)</td>
<td></td>
</tr>
<tr>
<td>Note: Applicant entity to be changed</td>
<td></td>
</tr>
<tr>
<td>Amend or correct errors in TM4 application (other than applicant</td>
<td></td>
</tr>
<tr>
<td>details)</td>
<td></td>
</tr>
<tr>
<td>Rectify errors in TM4 registration</td>
<td>CM3</td>
</tr>
<tr>
<td>Cancel goods/services in TM4 registration</td>
<td>CM9</td>
</tr>
<tr>
<td>Withdraw class(es) in a TM4 application</td>
<td></td>
</tr>
<tr>
<td>Add priority claim</td>
<td>Not allowed</td>
</tr>
</tbody>
</table>
Request for Certifying Office Copies

- Template for request to certify document issued by IPOS is available at https://www.ipos.gov.sg/resources/trade-mark under **Forms and Fees > Registry Counter Services** (“For certifying office copies, manuscripts or printed matter”).

- Requested information is used for processing of tax invoices and to record identity of person collecting the certified copy.

<table>
<thead>
<tr>
<th>Registry Counter Services</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Descriptions</strong></td>
</tr>
<tr>
<td>For certifying office copies, manuscripts or printed matter</td>
</tr>
</tbody>
</table>

- [Template (14KB)](https://www.ipos.gov.sg/resources/trade-mark)
- [Template (162KB)](https://www.ipos.gov.sg/resources/trade-mark)
## Request for Certifying Office Copies

### Request to Certify Document(s)

**General Instructions**
- Each request is chargeable at SGD12 per copy of document requested to be certified.
- This request form must be accompanied by the fees chargeable.
- All relevant fields in this form should be duly filled.

I would like to request the following document(s) to be certified:

- **Trade Mark Number**: 
- **Document Type**: 
- **Number of Copies**: 
- **Mode of Payment**: 
- **Payment Amount**: 

### Particulars of Person/Representative Collecting Certified Document(s)

Applicable if the person collecting the certified documents is not the requestor, or if the person is a representative of the requestor which is a business entity.

- **Name of Person/Representative Collecting Certified Document(s)**: 
- **IC, Passport or Identification Number**: 

### Goods and Services Tax (GST) Information

- **Name** (tax invoice to be issued to): 
- **Date**: 

Tax invoice will be issued to the entity/individual as indicated. Goods and Services Tax (GST)-registered businesses may claim input tax with Inland Revenue Authority of Singapore (IRAS), subject to meeting the requirements under the GST Act.

### Particulars of Requestor

- **Name of requestor**: 
- **Company Name (if applicable)**: 
- **Designation (if applicable)**: 
- **Singapore Telephone No**: 
- **Email**: 
- **Date**: 

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“Request for Certifying Office Copies” ≠ “Request for certified copy of entry in Register or certified extract from Register” (Form CM12)
Filing Form CM5 to Request for Extension of Time (EOT)

- Filer should be agent or applicant on record.

- From 4th EOT request onwards, we will **refuse** the request if the reason provided is not valid. An example of an invalid reason would be “We are still waiting for further instructions from our client”.

```
PART 7

Reason for Request
For Third or Subsequent Request only.

☐ Obtaining the consent of the proprietor of a relevant earlier trade mark (for Trade Marks only)
☐ Obtaining/ recording an assignment for a relevant earlier trade mark (for Trade Marks only)
☐ Disposing of invalidation or revocation proceedings which have been issued against an earlier trade mark (for Trade Marks only)
☐ Executing a Statutory Declaration or compiling evidence of use to overcome Registrar’s objections (for Trade Marks only)
☐ Executing a worldwide agreement or in a negotiation with a third party (for Trade Marks only)
☐ Others. Please state the reason below:

```
Filing Form CM5 to Request for Extension of Time (EOT)

- If the same valid reason has been used consecutively for at least four times, we will request the applicant to submit evidence(s) of progress made to be attached to the subsequent EOT request(s) for our review.

**Example**

The reason “executing a worldwide agreement or in a negotiation with a third party” was selected for four consecutive EOTs. We will accept the 4th EOT and notify the filer to attach evidence (such as a letter from the cited proprietor or a progress summary of ongoing negotiations) from the 5th EOT request onwards.

- An approval of an EOT request grants the applicant a three-month extension.

- A refusal of an EOT request grants the applicant only a one-month extension. To further request an EOT, the filer will need to lodge another Form CM5 (with requisite fees) and attach the necessary evidence.
Points to Note Before Dividing a TM Application (Form TM8)

- Following the division of a TM application in respect of its goods/services, the resultant applications are considered to be separate applications. Changes which the applicant wishes to make to the resultant applications (e.g., amendment of mark representation to overcome series mark objection) are to be made on a per-application basis.
Points to Note Before Dividing a TM Application (Form TM8)

- Transfer of goods/services across separate applications are NOT ALLOWABLE. The specification within each application can only be restricted, or at best be reworded without leading to any expansion in the scope of protection in that application. Hence, it is advisable to perform any necessary class transfers before filing any divisional application.
Points to Note Before Dividing a TM Application (Form TM8)

Example A
A trade mark application was filed in Classes 25 and 35. An item was deemed to be wrongly classified in Class 35 and should be transferred to Class 25. At the same time, relative grounds objection (Section 8 of the Trade Marks Act) was raised for Class 35 because a conflicting mark with an earlier filing date was found on the Register.

** The applicant wishes to divide Class 35 out of the application.

Suggested Procedure:

1. File the amendment form (Form TM27) to transfer the wrongly classified item from Class 35 to Class 25.
2. Proceed to file Form TM8 to divide the application, i.e., divide out Class 35 from the application.
Points to Note Before Dividing a TM Application (Form TM8)

Example B
A trade mark application (series of two marks) was filed in Classes 25 and 35. A series mark objection was raised as the two marks did not constitute a series. One of the marks should be removed from the application. Absolute grounds objection (Section 7 of the Trade Marks Act) was also raised in respect of Class 35.

** The applicant wishes to divide Class 35 out of the application.

Suggested Procedure:

1. File the amendment form (Form TM27) to (i) delete one of the two marks, and (ii) delete series mark indication to overcome the series mark objection.
2. Proceed to file Form TM8 to divide the application, i.e., divide out Class 35 from the application.
Points to Note Before Dividing a TM Application (Form TM8)

- Division approval letter will provide new IPOS Reference Number(s) for the application(s) that has/have outstanding objections
  - Note: Form TM8 is NOT considered as an official response to our examination report!

- Quote the new IPOS Reference number(s) pertaining to the respective resultant application when replying to the Registry

Dear Sir/Madam

TRADE MARK APPLICATION NO: ________ IN CLASS NO(S): 14, 18, 25, 35

DIVISION OF AN APPLICATION FOR REGISTRATION

We refer to the above.

2. Further to your application for division (Form TM8) lodged on 13 September 2017:

   Specification to remain
   Application No.: ________ 01
   Our Reference: ________
   Class: 14
   Class: 18
   Class: 25

   Specification divided out
   Application No.: ________ 02
   Class: 35

3. If you have received any objections and/or timelines from us pertaining to Application No. ________ please ensure that you respond to us within the stipulated timeline by quoting the new Application No(s). in Paragraph 2.

4. If you have any queries, please contact the writer.
Points to Note Before Withdrawing a Class or Application

- Form CM9 can be filed to withdraw class(es) of goods and/or services within a pending TM4 application, or the entire pending TM application.

- Class(es) selected in the form will be withdrawn.

Warning

Once the goods and/or services of an application have been withdrawn, they would no longer be allowed to be restored to the Register.

I understand the above, and confirm that the indicated goods and/or services of the application are to be withdrawn.

[Cancel] [Proceed]
Points to Note Before Withdrawing a Class or Application

- If the applicant wishes to transfer all the items from one class to another within a pending TM4 application, it is NOT advisable to file Form CM9. This is because the class may become withdrawn from the TM4 application before the “transfer” can take place. The subsequent addition of withdrawn items to another class within the same application is not allowed under the Trade Marks Act as it may result in an expansion of a pending application’s protection scope.

Example

The trade mark application is filed under Class 25 (with only item A) and Class 35. Item A was found to be misclassified and examiner proposes to transfer item A to Class 35.

Suggested Procedure:

File the amendment form (Form TM27) to add item A inside Class 35 and attach cover letter requesting to withdraw Class 25.
Points to Note Before Withdrawing a Class or Application

- For withdrawal requests pertaining to published TM4 applications, we recommend filing Form CM9 rather than submitting a written request as the form will help to generate the relevant journal entry for public viewing.
Replies to Examination Reports

- It is recommended that the reply is sent through the IP^2^SG system.

- Refrain from sending the same reply via multiple channels of communication (e.g., fax, post and IP^2^SG system).

- If urgent attention to your reply is required, you may send an email to the handling examiner (contact details are available in exam report). Alternatively, you may contact our hotline at 6339-8616 to request for the processing of your reply to be expedited.
New Features in IP²SG System and Future Initiatives
Subscribing to eAlerts

“Simple Search” > search for desired IPs based on set criteria > tick the checkboxes of IPs you desire to track and subscribe alerts for > click “Track selected IPs”
IP²SG eAlert Facility – Launched on 3 Dec 16

Subscribing to eAlerts

- Select types of desired alerts here
- Enter up to three email addresses for the alerts to be sent to
Dear Sir/Madam,

We received your request on 20/10/2017 to subscribe for email alerts on the following type(s) of updates to the following intellectual property.

<table>
<thead>
<tr>
<th>Application Number(s):</th>
<th>Type(s) of Alert:</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Change(s) to IP Details</td>
</tr>
<tr>
<td></td>
<td>Amendment / Correction</td>
</tr>
<tr>
<td></td>
<td>Assignment / Licence / Security Interest</td>
</tr>
<tr>
<td></td>
<td>Name / Address / Address for Service / Agent</td>
</tr>
<tr>
<td></td>
<td>All Other Register Entries</td>
</tr>
</tbody>
</table>

Please click [here](#) to confirm your subscription.

If the link above is not working, please copy and paste the link below to your browser to continue:

**Subscribing to eAlerts**

A system-generated email will be sent to the email address(es) indicated.

Note: You need to click on the hyperlink in the email to confirm your subscription!
### Before

**For Individual and Corporate**

| PART 3 | Types of Changes* | ☐ Name (where the change pertains strictly to the names) |
| ☐ Address |

| PART 4 | Change of Address for Service in Singapore* | ☐ Singapore Address for Service |

### After

**For Individual**

| PART 3 | Types of Changes* | ☐ Name (where the change pertains strictly to the names) |
| ☐ Address |
| ☐ Nationality |
| ☐ Country of Residency |
| ☐ Singapore Address for Service |

**For Corporate**

| PART 3 | Types of Changes* | ☐ Name (where the change pertains strictly to the names) |
| ☐ Sole Proprietor or Partners Name (where the change pertains strictly to the names) |
| ☐ Address |
| ☐ Country of Incorporation |
| ☐ State of Incorporation (for US entities only) |
| ☐ Singapore Address for Service |
New fields added to Part 2 of Form CM2 which allow a user to change or correct the relevant information:

**For Individual Applicants**
- Nationality
- Country of Residency
- Singapore Address for Service*

**For Corporate Applicants**
- Sole Proprietor or Partner(s)’ Names
- Country of Incorporation
- State of Incorporation
- Singapore Address for Service*

* "Singapore Address for Service” was previously under Part 4 of Form CM2. To avoid the situation where filers may accidentally omit editing this field and only amend “Address”, this field is hence shifted to Part 2 of Form CM2."
Form TM19 Detailed Receipt – Implemented in April 2017

<table>
<thead>
<tr>
<th>DESCRIPTION</th>
<th>QTY</th>
<th>UNIT (S$)</th>
<th>AMT (S$)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Application for Renewal of Registration (Before the Due Date of Renewal)</td>
<td>3</td>
<td>380.00</td>
<td>1,140.00</td>
</tr>
</tbody>
</table>

This Receipt will serve as the Notification Of Renewal for the trade mark registration above. In the event of an unsuccessful payment, the user shall be notified immediately of the matter, and this Notification of Renewal shall then be taken to be void.

The following class(es) has/have been renewed for a period of 10 years:

Class Number(s): 01, 02, 03
Next Renewal Date: 10/03/2027

The following class(es) has/have yet to be renewed, and will be removed from the Register by 11/03/2018 (1 year after expiry date) if no further renewal request is submitted:

Class Number(s): 01, 02

New “Notification of Renewal” paragraph(s)

These paragraphs serve to inform filers of the classes which they have renewed (or yet to be renewed) for the current renewal cycle.

They are added to Form TM19’s detailed receipt generated following successful form submission.
Preventive Measures Against Unsolicited IP Services

Unsolicited IP Services – Requests for Payment of Fees
(Circular No. 7/2017, dated 5 July 2017)

We have noticed an increasing number of unsolicited mails on Intellectual Property (IP) protection and renewal services being received by IP holders. They may take the form of an official notification, inviting recipients to make payment for the registration or renewal of their IP on record.

To our information and belief, these mails appear to originate from private business establishments which are neither related to nor connected with the Intellectual Property Office of Singapore (IPOS) or the World Intellectual Property Organization (WIPO).

Should you receive any of such mails from entities other than IPOS, WIPO or your appointed IP agent, you are advised to treat them with caution.

Please feel free to contact us or your IP agents should you wish to verify the authenticity of a communication that you have received.

For samples of unsolicited mails, please refer to a similar notice issued by the WIPO.

You can also access the official list of IPOS’ forms and fees via the links below:

<table>
<thead>
<tr>
<th>Trade Marks</th>
<th><a href="https://www.ipos.gov.sg/resources/trade-mark">https://www.ipos.gov.sg/resources/trade-mark</a></th>
</tr>
</thead>
<tbody>
<tr>
<td>Patents</td>
<td><a href="https://www.ipos.gov.sg/resources/patent">https://www.ipos.gov.sg/resources/patent</a></td>
</tr>
<tr>
<td>Registered Designs</td>
<td><a href="https://www.ipos.gov.sg/resources/design">https://www.ipos.gov.sg/resources/design</a></td>
</tr>
<tr>
<td>Plants Varieties</td>
<td><a href="https://www.ipos.gov.sg/resources/plant-varieties-protection">https://www.ipos.gov.sg/resources/plant-varieties-protection</a></td>
</tr>
</tbody>
</table>
Preventive Measures Against Unsolicited IP Services

Cautionary paragraph regarding unsolicited IP services included in registration cover letters

REGISTRY OF TRADE MARKS
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

Dear Sir/Madam

Enclosed is the certificate of registration

Trade Mark No. [redacted]

Date of Registration 24 July 2017

Renewal Due 24 July 2027

Update to Particulars of Trade Mark Proprietor(s)

Upon any change of ownership of the trade mark, address or other particulars of the trade mark proprietor(s), please visit http://www.ip2.sg to update the particulars by lodging the relevant form.

Unsolicited IP Services – Requests for Payment of Fees

Should you receive mails to make payments for renewal and/or other transactions from private establishments not related to IPOS or your appointed IP agent, please treat them with caution. For more information on unsolicited invitation(s) for payment of fees, please visit http://www.ipos.gov.sg.
Preventive Measures – To be Implemented

Updates to TM’s renewal reminder notices

- Renewal reminders will include a representation of the mark image
- Shorter paragraphs (with clear headers) will be used for better clarity
- Cautionary paragraph on unsolicited mail will be added
Preventive Measures – To be Implemented

Pre-renewal reminder notice to be sent during 8th registration year

- New pre-renewal reminder notice will be sent to the proprietor of a registered mark during its 8th registration year
- The notice reflects IPOS’ official renewal fees and serves as a cautionary note on unsolicited mails by private establishments requesting renewal payments

TRADE MARK NO. <<TM no>> IN CLASS NO(S). <<1, 2, 3 AND 4>> <<Applicant name>>

1. The above-captioned trade mark registration will expire on <<expiry date>>. The registration can however be renewed for another 10 years.

2. We will send a Notice of Renewal (pursuant to rule 50 of the Trade Marks Rules) when the trade mark registration is open for renewal. No action is required from you at this point in time.

3. For your information, the official renewal fees payable to IPOS are as follows:

<table>
<thead>
<tr>
<th>Renewal fee</th>
<th>SGD380 per class</th>
</tr>
</thead>
<tbody>
<tr>
<td>if a request is made on or before the expiry date</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Late renewal fee</th>
<th>SGD560 per class</th>
</tr>
</thead>
<tbody>
<tr>
<td>if a request is made within 6 months after the expiry date</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Restoration and renewal fee</th>
<th>SGD610 per class</th>
</tr>
</thead>
<tbody>
<tr>
<td>if a request is made within 6 months after the mark is removed from the Register</td>
<td></td>
</tr>
</tbody>
</table>

Unsolicited IP Services – Requests for Payment of Fees

4. Should you receive mails to make payments for renewal and/or other transactions from private establishments not related to IPOS or your appointed IP agent, please treat them with caution. For more information on unsolicited invitation(s) for payment of fees, please visit our website at http://www.ipos.gov.sg.

5. To receive our circulars and updates via email, you may subscribe to our mailing list by sending an email to news@ipos.gov.sg. You may also follow us on Facebook at http://www.facebook.com/IPOSG/ to get the latest news and information about IPOS.
Issuance of Madrid Flyers – Implemented on 23 Sep 17

Flyers On Patent Cooperation Treaty, Madrid and Hague Systems
To encourage international filings, from 23 September 2017 IPOS will be including flyers¹ from the World Intellectual Property Organization (WIPO) which provides information on the Patent Cooperation Treaty (PCT), Madrid and Hague systems.

- PCT Flyers – Patents Form 1 Notification of Filing Date Letter
- Madrid Flyers – National Trade Mark Registration Certificate
- Hague Flyers – Upon lodgement of Designs Form D3

¹The correspondence administrator of your I²PSG account may log in to I²PSG from 23 September 2017 to uncheck the flyer option under Correspondence Setting if you do not wish to receive the flyers.
Issuance of Madrid Flyers – Implemented on 23 Sep 17

Madrid flyers are issued together with Trade Mark registration certificates to your IP²SG account.
Issuance of Madrid Flyers – Implemented on 23 Sep 17

A new option is added to your Correspondence Settings to allow you to decide whether you wish to receive WIPO-related flyers.

- Madrid Flyers (Trade Marks) unchecked: Do not wish to receive flyers until: 14/09/2018
- PCT Flyers (Patents) checked: Do not wish to receive flyers until: [input field]
- Hague Flyers (Designs) checked: Do not wish to receive flyers until: [input field]

Save
Accessing of Draft Forms by Multiple Users – To be Implemented by December 2017

- Creator of draft form can assign his own draft to another user
- New role for assigning of draft forms so that users other than the creator can reassign any draft forms to another user
Contingency Plan for SingPass or CorpPass Login Service

- “Request Contingency Login Password” button will appear below SingPass/CorpPass buttons in Public Portal

- Clicking the button will prompt user to key in SingPass ID and UEN (for CorpPass account)

```
IP2SG Login mode*  | SingPass  | CorpPass

SingPass ID*  

Submit  Cancel
```

```
IP2SG Login mode*  | SingPass  | CorpPass

UEN*  

SingPass ID*  

Submit  Cancel
```
Contingency Plan for SingPass or CorpPass Login Service

- System will send email containing contingency login User ID and Password.

- User to use contingency login User ID and Password to login via email address method to IP\(^2\)SG account.

- Upon resumption of SingPass/CorpPass login services, contingency login will be deactivated. Contingency login User ID and Password will no longer be usable.

- Should SingPass/CorpPass login becomes disrupted again, user will need to request new set of contingency login User ID and Password.
Contingency Plan for General Service Disruption

- A new module to allow submission of TM4 form in Excel format and making payment online at a later date
- Instructions on alternative filing methods will be published on www.ipos.gov.sg

IP²SG Service Disruption – Filing Alternatives

Dear Customers,

IP²SG is experiencing a service disruption. We are currently investigating the matter. We apologize for the inconvenience caused and seek your understanding on this matter.
Discontinuation of Corporate Accounts (est. December 2017)

- You are encouraged to create a CorpPass Account in replacement of your Corporate Account
- Transaction details of your old Corporate Account will be migrated over to your new CorpPass Account

PART 1: Types Of Account

You may wish to register for a CorpPass Account or Other IP2SG Accounts.

CorpPass

Singapore Corporate Access (CorpPass) is a user-centric, self-service login platform for business users to access Government e-Services. It is designed to better protect personal information of your staff and allow better internal control in your company. Click here to know more about CorpPass and proceed with registration.

Other IP2SG Accounts

- Corporate Account (For entities registered in Singapore)
  - You are encouraged to create a CorpPass Account as IP2SG Corporate Account will not be available from December 2017.
  - From this date, all IP2SG Corporate Account users must use CorpPass Account to access IPOS e-service, IP2SG.
  - Pre-Requisites:
    - UEN ID - UEN stands for Unique Entity Number. It is a standard identification number for Singapore corporate entities to interact with government agencies.
    - SingPass ID - SingPass stands for Singapore Personal Access. It is used by residents to access e-services offered by government agencies.
The Madrid System

Gladys Sim (Registry of Trade Marks)
6 November 2017
Content Page

General Information

Singapore as the Office of Origin

Singapore as the Designated Office
General Information on the Madrid System
The Madrid System

The Madrid system allows filing to other countries:

- In 1 application
- Through 1 Office of Origin (OO)
- In 1 language
- In 1 currency
- 1 renewal per international registration (IR)
ASEAN and the Madrid System

Madrid Protocol Members
- Brunei
- Vietnam
- Cambodia
- Thailand
- Singapore
- Indonesia
- Laos
- Philippines

Non-Madrid Protocol Members
- Myanmar
- Malaysia

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General Information on Contracting Parties

Thailand

- Madrid protocol will enter into force on 7 November 2017
- National law amendments to cater for the Madrid system:
  - Sound marks registrable
  - Multi-class application
  - Association of marks abolished
General Information on Contracting Parties

Indonesia

- Madrid Protocol will enter into force on 2 January 2018
- 100\textsuperscript{th} member of Madrid Union
General Information on Contracting Parties

Philippines

- Scent and sound marks non-registrable
- Notarised declaration of actual use required:
  - Within 3 years from international registration (IR) date or subsequent designation (SD) recordal date;
  - 5th year of the statement of grant of protection of the mark;
  - Within 1 year from renewal date; and
  - 5th year of renewal date
General Information on Contracting Parties

China

- Within 15 days:
  - Indication to reply
  - Through a local attorney or qualified Chinese agency

- 3 months period thereafter:
  - Full response to objection(s)
The Madrid System – To Use or Not To Use?

Possible considerations:

- Business focus and direction
- Interested market(s)
- Budget
- Portfolio management
- Possibility of objection(s)
WIPO Online Tools (Live Demo)

  - Monitor trademark status
  - Access detailed information on Madrid applications/registrations
  - Search options:
    1) Simple Search – find records of interest using search terms
    2) Advanced Search – for more complex search using ≥1 search criteria
    3) Realtime search – provides most up-to-date data (including unpublished data)
    4) Image search – search for identical or similar images
  - WIPO Gazette – contains weekly publication of the Madrid system
WIPO Online Tools (Live Demo)

  - Worldwide collection of brand related data

- Madrid Goods and Services Manager ([https://webaccess.wipo.int/mgs/](https://webaccess.wipo.int/mgs/))
  - Assists holder to compile goods and/or services
  - Classification of goods and/or services

- Madrid Member Profiles ([http://www.wipo.int/madrid/memberprofiles/#/](http://www.wipo.int/madrid/memberprofiles/#/))
  - Information on Madrid system members practices and procedures
Singapore as the Office of Origin
New IP²SG features – Apr 2017

- Part 2: Enter basic application/registration number to auto-populate basic mark details:
  - Part 3: Applicant’s name and address
  - Part 6: Priority details
  - Part 7: Mark image
  - Part 9: Transliteration and translation
  - Part 10: Specification of goods and/or services

*(Details can be further amended/deleted)*
New IP²SG features – Apr 2017

- Part 4A: Tax invoice
  - IPOS requirement; not part of the Form MM2

<table>
<thead>
<tr>
<th>Part 4A</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Tax Invoice Details</strong></td>
<td>Tax Invoice will be issued to:</td>
</tr>
<tr>
<td>In general, the name of the Applicant/Proprietor (as in Part 3 above) is to be indicated in this field.</td>
<td></td>
</tr>
<tr>
<td>Name:</td>
<td></td>
</tr>
<tr>
<td>Click <a href="#">here</a> for help.</td>
<td></td>
</tr>
</tbody>
</table>
New IP²SG features – Apr and Oct 2017

- Part 11: Interface for adding Designated Contracting Parties
  - Differs from hardcopy Form MM2
  - Allows multiple selections of countries
  - Allows selection/de-selection of all Designated Contracting Parties at once
  - Text field for searching Designated Contracting Parties
Form MM2 Online Filing Pointers

Part 3: Applicant’s nationality or legal nature and organized state

Click on hyperlink

For individual, sole proprietorship or partnership

For company
## Part 3: Multiple applicants (if based on >1 basic applications/registrations)

<table>
<thead>
<tr>
<th>Applicant*</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Name</strong></td>
<td>Test</td>
</tr>
<tr>
<td><strong>Address</strong></td>
<td>Test Road 123</td>
</tr>
<tr>
<td><strong>Address for correspondence</strong></td>
<td></td>
</tr>
<tr>
<td><strong>Telephone</strong></td>
<td></td>
</tr>
<tr>
<td><strong>Fax</strong></td>
<td></td>
</tr>
<tr>
<td><strong>Email address</strong></td>
<td></td>
</tr>
<tr>
<td><strong>Preferred Language for correspondence</strong></td>
<td>English</td>
</tr>
<tr>
<td><strong>Nationality of applicant</strong></td>
<td></td>
</tr>
<tr>
<td><strong>Legal nature of the legal entity</strong></td>
<td></td>
</tr>
<tr>
<td><strong>Organized State</strong></td>
<td></td>
</tr>
</tbody>
</table>

Click to add applicants
Part 4: Entitlement to file

- Select entitlement for each applicant

Click to add
Part 4: Entitlement to file

- **Box 3(a)(i)**
  If the applicant is:
  - A Singapore national; or
  - A company incorporated in Singapore

- **Box 3(a)(ii)**
  Not applicable for international applications (IAs) filed in Singapore
Part 4: Entitlement to file

- **Box 3(a)(iii)**
  If the applicant is domiciled or staying in Singapore
  (Examples: foreigner staying in Singapore or is a permanent resident)

- **Box 3(a)(iv)**
  x Address for correspondence
  x Letterbox
  x Warehouse
  x Fake, temporary, fraudulent or fictitious establishments
Form MM2 Online Filing Pointers

Part 4: Entitlement to file

A real and effective industrial or commercial establishment – how to determine?

- Assessment of all relevant factors on a case-by-case basis

- Factors for consideration (non-exhaustive):
  - Establishment of a place in Singapore to conduct the applicant’s business
  - Conducting of industrial/commercial activities on a regular basis
  - Applicant’s involvement in solicitation or advertising/promotion of its business
  - Employment of employee(s) in Singapore to look after the applicant’s affairs
  - Employment of agent(s) to conduct the applicant’s business in Singapore

[New “Guidelines for the Determination of a Real and Effective Industrial or Commercial Establishment” (last update: Sep ’17) available at www.ipos.gov.sg > “Protecting your ideas” > Trade Mark: “Application Process” > “Applying to register a Trade Mark outside Singapore” > “Pre-filing Checklist” > “If you are filing an international application via the Madrid Protocol from Singapore, do you meet the following criteria?”]
Part 6: Priority Claimed (if based on >1 basic applications/registrations)

**Indicate basic application/registration trademark number**

**Ensure basic application/registration filing date is correct**

**Select “No” as each basic filing only forms part of the IA**

**State the basic application/registration Class no. and goods/services to be used as priority claim in IA**
## Form MM2 Online Filing Pointers

### Parts 7, 8 and 9: Colour(s)

#### PART 7

(d) □ The mark consists of a color or a combination of colors as such.

#### PART 8

<table>
<thead>
<tr>
<th>Color(s) Claimed</th>
</tr>
</thead>
<tbody>
<tr>
<td>(a) □ The applicant claims color as a distinctive feature of the mark</td>
</tr>
<tr>
<td>Color or combination of colors claimed</td>
</tr>
<tr>
<td>(b) Indication, for each color, of the principal parts of the mark that are in that color (as may be required by certain designated Contracting Parties)</td>
</tr>
</tbody>
</table>

#### PART 9

(e) Description of the mark (where applicable)
<table>
<thead>
<tr>
<th>Types</th>
<th>Tick</th>
<th>Indicate</th>
</tr>
</thead>
<tbody>
<tr>
<td>Colour(s) as a trademark</td>
<td>Part 7(d)</td>
<td>Part 8(a): Colours used</td>
</tr>
<tr>
<td></td>
<td>Part 8(a)</td>
<td>Part 9(e): Basic mark precise non-conventional mark description</td>
</tr>
<tr>
<td></td>
<td>Part 9(e)</td>
<td></td>
</tr>
<tr>
<td>Conventional mark in colour(s)</td>
<td>Part 8(a) [optional]*</td>
<td>[optional]</td>
</tr>
<tr>
<td></td>
<td></td>
<td>Part 8(a)*: Colours used</td>
</tr>
<tr>
<td></td>
<td></td>
<td>Part 8(b)*:</td>
</tr>
<tr>
<td></td>
<td></td>
<td>- The principal parts in each of the colour used; or</td>
</tr>
<tr>
<td></td>
<td></td>
<td>- Colour limitation clause</td>
</tr>
<tr>
<td>Colour limitation</td>
<td>-</td>
<td>Part 8(b): Basic mark colour limitation clause</td>
</tr>
</tbody>
</table>

*Encouraged to fill in if designating United States of America and Philippines*
Part 12 or 14: Payment options

- Applicant has a current account with the International Bureau (IB)
- IB will deduct the amount from the account
(i) Identity of party effecting payment: aids WIPO in tracing IA payment

(ii) WIPO receipt: within 10 days of telegraphic transfer

(iii) Telegraphic transfer

(iv) Applicable within Europe only
Part 12 or 14: Payment options – telegraphic transfer

- File Form MM2 before telegraphic transfer:
  - Secure MM2 filing date as IA date

Encouraged to provide an indication that payment will be made after filing.
Part 12 or 14: Payment options

- File Form MM2 before telegraphic transfer

  Payment to be made within 2 months of Form MM2 submission to IPOS
## Other WIPO Forms

### National vs Madrid forms

<table>
<thead>
<tr>
<th></th>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Application</strong></td>
<td>TM4</td>
<td>MM2: International application</td>
</tr>
<tr>
<td></td>
<td></td>
<td>MM4: Subsequent designation</td>
</tr>
<tr>
<td><strong>Holder</strong></td>
<td>CM2: Change in holder’s name/address</td>
<td>MM9: Change in holder’s name/address</td>
</tr>
<tr>
<td></td>
<td>CM8: Transfer of ownership</td>
<td>MM5: Change in ownership</td>
</tr>
<tr>
<td><strong>Agent/Representative</strong></td>
<td>CM2: Change in agent’s or representative’s name/address</td>
<td>MM10: Change in representative’s name/address</td>
</tr>
<tr>
<td></td>
<td>CM1: Appoint, change or remove agent</td>
<td>MM12: Appoint new representative</td>
</tr>
</tbody>
</table>
Other WIPO Forms

Form MM4: Subsequent designation (SD)

- Expansion of geographical scope of existing IR to other Contracting Parties

- Submission methods:
  1. Submit paper Form MM4 through Office of Origin
  2. Submit paper Form MM4 directly to WIPO
  3. Submit request via WIPO’s e-Subsequent Designation platform (*Highly encouraged*)
     - Faster mode of submission compared to paper submission
     - E-payment directly to WIPO via a credit card or a WIPO Current Account
Form MM4: Subsequent designation (SD)

Note:
The following Contracting Parties have declared under Article 14(5) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks:

If an IR filing date is earlier than any of the following Contracting Parties’ date of accession to the Madrid Protocol, no SD based on that IR could be lodged in that Contracting Party:

<table>
<thead>
<tr>
<th>Contracting Party Declared under Article 14(5)</th>
<th>Date of Accession</th>
</tr>
</thead>
<tbody>
<tr>
<td>Estonia</td>
<td>18 August 1998</td>
</tr>
<tr>
<td>India</td>
<td>8 April 2013</td>
</tr>
<tr>
<td>Namibia</td>
<td>31 March 2004</td>
</tr>
<tr>
<td>Philippines</td>
<td>25 April 2012</td>
</tr>
<tr>
<td>Turkey</td>
<td>1 October 1998</td>
</tr>
</tbody>
</table>
**Other WIPO Forms**

**Renewal and Subsequent designation**

- **IR filing date**
- **Renew IR**
- **File SD**
- **IR expiry date** +10 years protection

**SD not yet filed**

- SD protected only till current IR expiry date.

**SD filed after renewal**

- Should effect SD after renewal.

**Renewal IR**

- IR expiry date = IR renewal effective date +10 years protection to IR.
Renewal and Subsequent designation

- Filing of renewal application before a SD doesn’t necessarily guarantee that the SD will be renewed.

- Especially so if the renewal effective date falls after the lodgement date of the Form MM4.

Solution:

- Fill in Part 7A of the manual form; or
Other WIPO Forms

Renewal and Subsequent designation

Solution:

- E-subsequent designation form

- This option only appears if the SD is made within 3 months before the expiry date
Other WIPO Forms

Form MM5: Change in ownership

- Current owner ("Transferor") \(\rightarrow\) New owner ("Transferee")

- Types:
  - Total change in ownership
    - Multiple IRs per form allowed (same transferor \(\rightarrow\) same transferee)
  - Partial change in ownership:
    - Single IR per form
    - In respect of some goods/services; or
    - In respect of some Designated Contracting Parties in the IR

- Requirements:
  - All transferee(s) must be entitled to file IAs in the Contracting Party (or Parties) he/she seeks to be recorded as the new holder
  - Via Form MM5, and requisite fees to be transmitted to WIPO
Other WIPO Forms

Form MM5: Change in ownership

- Submission methods:
  1. By transferor:
     - to be submitted to WIPO directly; OR
     - through the Office of the Contracting Party where the transferor or transferee is entitled to file
  2. By transferee:
     - to be submitted to the Office of the Contracting Party where the transferor or transferee is entitled to file

As direct submission of Form MM5 to WIPO by the transferor does not require any supporting documents (e.g., deed of assignment), processing is relatively more expeditious as compared to the other methods.
Singapore as the Designated Office
Example:

Class 1
Chemicals; Bacteria for improving skin diseases.

Class 5
Pharmaceutical preparations.

- Objection:
  - The underlined description suggest a medical function
  - Analogous to “bacteria for medical or veterinary purposes” in Class 5
Specification Objection

Reply options

1. Reword
   - Bacteria for improving skin diseases for industrial or scientific use

2. Limitation request to WIPO
   - Not treated as response to provisional refusal for IPOS
   - Reply letter to IPOS needed

3. Transfer to Class 5
   - Not allowed

4. MM21
   - Request for correction to WIPO
   - Reply letter to IPOS needed
Minor Objection

Clauses or obvious misspelling in specification of goods/services

- IPOS may propose a clause, reword holder’s clause or correct the misspelling in provisional refusal
- 4 months deadline to reply + 6 months reinstatement period
- Holder may either:
  - Reply to IPOS with an address for service in Singapore; or
  - Not reply and wait until the reinstatement period is over
- IPOS will endorse clause/correct misspelling if there is no reply and request for reinstatement after deadline
- IR/SD proceed to publication
Transformation

- Cancelled IR/SD → National application/registration

- Requirements:
  - Cancellation of IR/SD at the request of Office of Origin
  - Request within 3 months from date of recordal of cancellation
  - Goods/services requested to be transformed must be identical/narrower in scope than cancelled goods/services
  - Form MP1 and fees to IPOS
Transformation

- Effects:
  - Remedy to cancellation resulting from ceasing of effect of or central attack to basic mark
  - Cancelled goods and/or services continues to exist in designated office’s register as a national application/registration
  - Transformed application/registration continues to enjoy earlier filing/priority date of cancelled IR/SD
Replacement

- National registration replaced by protected IR/SD

- Requirements:
  - Same mark filed by same holder protected by National and Madrid systems
  - Extension of IR/SD takes effect after National filing date
  - All goods/services in National registration found in protected IR/SD
  - Protected IR/SD must be identical or broader in scope than National registration

- Holder can file Form MP2 (FOC) with IPOS to record replacement details

---

Class 35 and 42

Later filing/priority date
Class 16, 18, 35 and 42

IR/SD portion that replaces the national registration will enjoy the earlier filing/priority date of national registration
Replacement

- Effects:
  - Holder holds the choice to maintain and renew:
    - only one registration (i.e. protected IR/SD); or
    - both registrations (protected IR/SD and National registration)
## Replacement Examples

### Example 1

<table>
<thead>
<tr>
<th>Class 25 (IR)</th>
<th>Class 25 (National)</th>
<th>T-shirts; shorts; pants.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Clothing</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Replacement request **acceptable**

### Example 2

<table>
<thead>
<tr>
<th>Class 25 (IR)</th>
<th>Class 25 (National)</th>
<th>T-shirts; shorts; pants.</th>
</tr>
</thead>
<tbody>
<tr>
<td>T-shirts</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Replacement request **unacceptable (further restriction required)**

**Reason:** Goods “shorts; pants” in National registration not found in IR

**Solution:** Applicant may file Form CM3 to IPOS to delete “shorts; pants” in National registration before replacement

### Example 3

<table>
<thead>
<tr>
<th>Class 25 (IR)</th>
<th>Class 25 (National)</th>
<th>T-shirts; shorts; pants.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Dresses</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Replacement request **unacceptable (further restriction not possible)**

**Reason:** Goods in National registration not found in IR
Replacement

- Tip:

  ≤ 5 years from IR filing date…..
  - IR/SD is dependent on fate of basic mark
  - Ceasing of effect or central attack of basic mark → cancellation of IR/SD
  - Better to renew National registration during this 5 year dependency period
  - Retains protection in territory concerned via National registration even if IR/SD is cancelled
THANK YOU