



Intellectual
Property
Office

Partial Cancellations

Typical issues at the UK IPO

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Intellectual Property Office is an operating name of the Patent Office

Main issues:

- Changes to the scope of protection.
- Changes to terms objected to and corrected under national law.
- Partial cancellations that are total cancellations of the UKIR.
- Sub Des Births and Cancellations at the same time.
- Errors and corrections.

Changes to the scope of protection

- Original application has “Mice embryos” in Class 31, Cancellation changed it to “Animal embryos” which is wider than the original term.
- 1662883 - The partial cancellation adds the term "scoreboards" to Class 21. For the UK, scoreboards are in 9 (Electronic scoreboards) if they're electric and in Class 20 if they're not (Score display apparatus [boards])
- 1654817 - LIN received in September added “none of the aforesaid relating to gambling or betting.” Cancellation in November removes the limitation from the Class. The applicant has filed a MM6 asking for changed to be made, which has now been overwritten by the cancellation. Should we follow the cancellation or the applicant’s wishes?
- If these were corrections of the birth we could reopen and re-examine the case, however, as a cancellation cannot be challenged, the designation could be declared invalid if challenged by a third party.

Changes to terms objected to and corrected under national law

- “*Provision of a website* featuring information on business administration and marketing” is only acceptable in Class 42 in the UK
- Following an objection, the term is reworded in the UK designation to read “Provision of information on business administration and marketing *via a website*” which is now acceptable in Class 35.
- COE reverse the wording and reinstated the objectionable term:
 - “Provision of a website featuring information on business administration ~~and marketing~~”
- Its not clear whether we can retain our national wording where the cancellation removes the UK wording.

Partial cancellations that are total cancellations of the UKIR

- Currently we have a number of cases on the UK register that do not have any goods and services due to a partial cancellation of the IR being a total cancellation of the UKIR.
- Our national examination system treats a subsequent designation as a separate entity (WO000000, WO010000) so the original IR never dies or is used again.
- The rights are undefendable and unenforceable as they are not linked with any goods so the dates of conferred protection cannot be used in any contentious proceedings.

Sub Des with limitations and Cancellations at the same time.

- Subsequent designation of an IR where the G&S are limited for the UK designation, but the message also contains a cancellation of the original case. These are all contained in one message and it can be unclear which goods and service are relevant to the UK designation.
- This leaves us at risk of under protecting or over protecting the UK designation as its not clear.

Errors and corrections.

- We received a cancellation that instructs us to amend Class 9 to read:

“Business promotion services provided by audio/ visual means; computerised business promotion; on-line advertising services; publicity and sales promotion services; graphic advertising services; advertising; provision of space on web-sites for advertising goods and services; advertising via electronic media and specifically the Internet; compilation of advertisements for use as web pages on the Internet; computerized file management; presentation of multimedia applications for others.”

- Clearly these are services proper to Class 35 not Class 9.
- As WIPO is unable to question a ceasing of effect and will record it as is, this leaves us in a tricky position with an incorrectly classified designation on the register until the correction is arranged.

Any Questions?