

# The Experience of Accession to the Madrid System & the Current Situation in Singapore

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Louis Chan  
Director / Legal Counsel (Trade Marks)  
Intellectual Property Office of Singapore  
Tokyo, Japan  
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## Joining the Madrid System & Administering it at the National Level

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- ◆ Legislation
- ◆ Accession Documents
- ◆ Training
- ◆ Publicity
- ◆ Operations
- ◆ Summary of Work Processes

### Current Situation in Singapore

- ◆ Filing Statistics
- ◆ Perspectives from Office, Proprietors and Agents

## Legislation

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- ◆ implement the Madrid Protocol
- ◆ give legal effect to the Common Regulations
- ◆ prescribe forms and fees
- ◆ amend Trade Marks Act & enact Trade Marks (International Registration) Rules 2000

## Accession Documents

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- ◆ Determination of declarations to be made to WIPO
  - extension of time period to 18 months to notify refusals
  - receipt of individual fees for designations and renewals

## Training - *internal*

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### ◆ Training of Madrid study team

- Training at WIPO, Geneva
- Study visits to
  - Swiss Federal Institute of Intellectual Property, Bern
  - UK Patent Office Trade Marks Registry, Wales

### ◆ Training of IPOS officers

- International Registrations Division
- Customer Service Officers
- General Staff

## Training - *external*

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### ◆ Training of TM agents and TM owners

- Workshop on Procedures of the Madrid Protocol in September 2000
  - WIPO experts
  - IPOS
- Dialogue session for TM agents prior to implementation
- Ongoing continual training – workshop on overview of Madrid Protocol & procedures

# Publicity

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- ◆ Notices in Trade Marks Journal
- ◆ Announcement on IPOS website
- ◆ Press statements
- ◆ Brochures
- ◆ Hotline

## Operations - *Drafting of new IPOS forms*

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- ◆ New transactions
  - transformation of international registrations
  - replacement of national registrations
- ◆ New forms introduced
  - transformation and replacement forms
- ◆ New fees
- ◆ New work processes

## Operations - *Integration of processes*

### IPOS as Designated Office

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- ◆ IRs designating Singapore are treated the same as national applications – no difference in examination standards or treatment
- ◆ Computerised trade mark processes
  - Electronic communication (data on IRs designating Singapore transmitted electronically by IB)
  - Until 2007, single class registration system; now multi-class registration system
  - All Madrid applications assigned a National TM number
  - Public trade mark database contains both national & Madrid
  - Substantive examination – absolute & relative
  - Publication for opposition

## Operations - *Issuance of notifications*

### IPOS as Designated Office

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- ◆ Letter Generator System
  - Notifications of Refusal of Protection
  - Notifications of Refusal of Protection based on Opposition
  - Reserve Right Letters
  - Final Decision following a Refusal
  - Statements of Grant of Protection
- ◆ Letters are sent to IB via twice weekly courier
- ◆ Fully electronic communications system under consideration

## Operations - *Tracking reports*

### IPOS as Designated Office

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- ◆ Computer System generates reports to track
  - Opposition to IR
  - Outcome of Legal Proceedings
  - 18-month deadline to issue Notification of Refusal to IB

## Operations - *Administrative issues*

### IPOS as Designated Office

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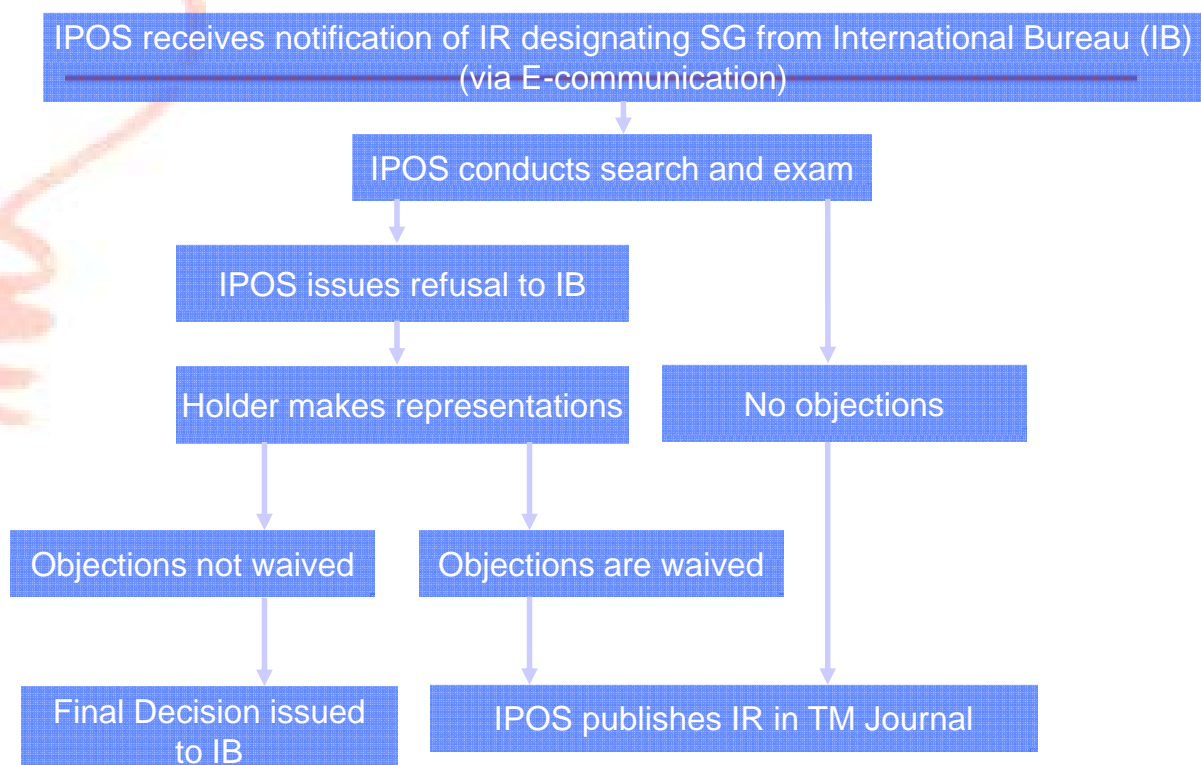
- ◆ Need to update the National Register for recordation of assignments, change of name of holders, correction notifications etc
- ◆ Initial difficulty of integrating the data into our system
  - ⇒ different forms
  - ⇒ different manner of presenting information

## Operations - *Other Concerns*

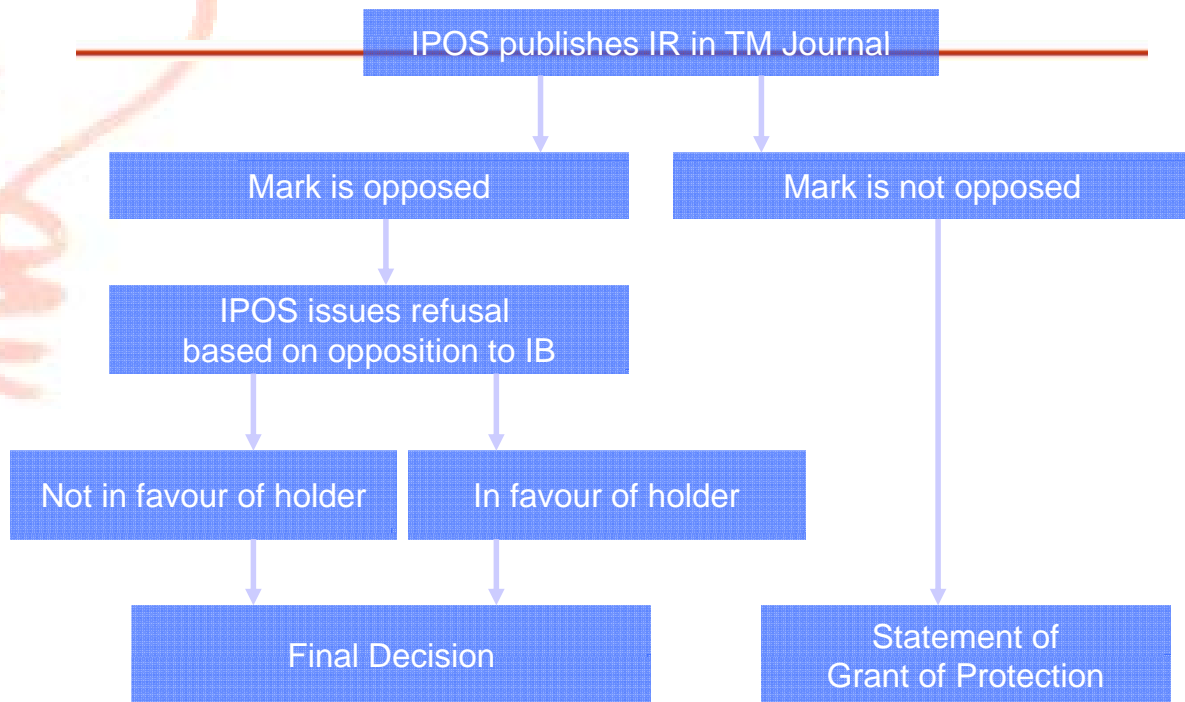
### IPOS as Designated Office

- ◆ Non-obligatory processes
  - ⇒ ICGS conformity
  - ⇒ Publication for opposition purposes
  - ⇒ Statements of Grants of Protection (previously non-obligatory but obligatory after 1 Sep 2009)

## Work Processes – IPOS as Designated Office



## Work Processes – IPOS as Designated Office



## Operations - *Other processes* IPOS as Office of Origin

- ◆ Processing of international applications – Form MM2E -
  - Only formality checks; no substantive examination
  - Computerised system
    - Database containing details of IA
    - Generation of letters
      - acknowledgement letter to applicant
      - letter informing applicant that IA has been submitted to IB
    - Statistics program
      - no. of IAs filed through SG
      - designated countries where SG is office of origin



## Operations - *Collection and transmission of fees payable to IB*

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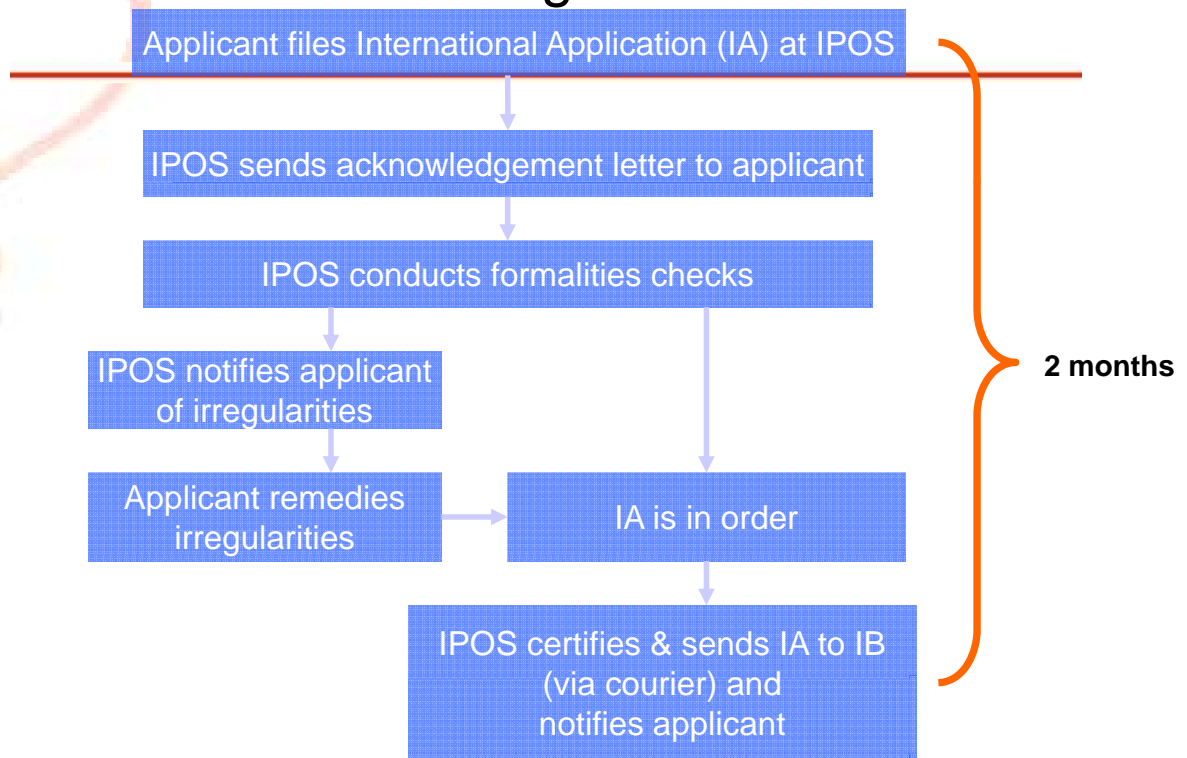
- ◆ Then...
  - ⇒ fees collected and paid to IB in Swiss francs via bank draft
  
- ◆ Now...
  - ⇒ From 2 Jan 2008 with amendments to IB's administrative procedures, fees paid directly by applicant to IB's bank account
  
- ◆ Forms MM2E, once certified, transmitted to IB by courier

## Operations - *Other processes* **IPOS as Office of Origin**

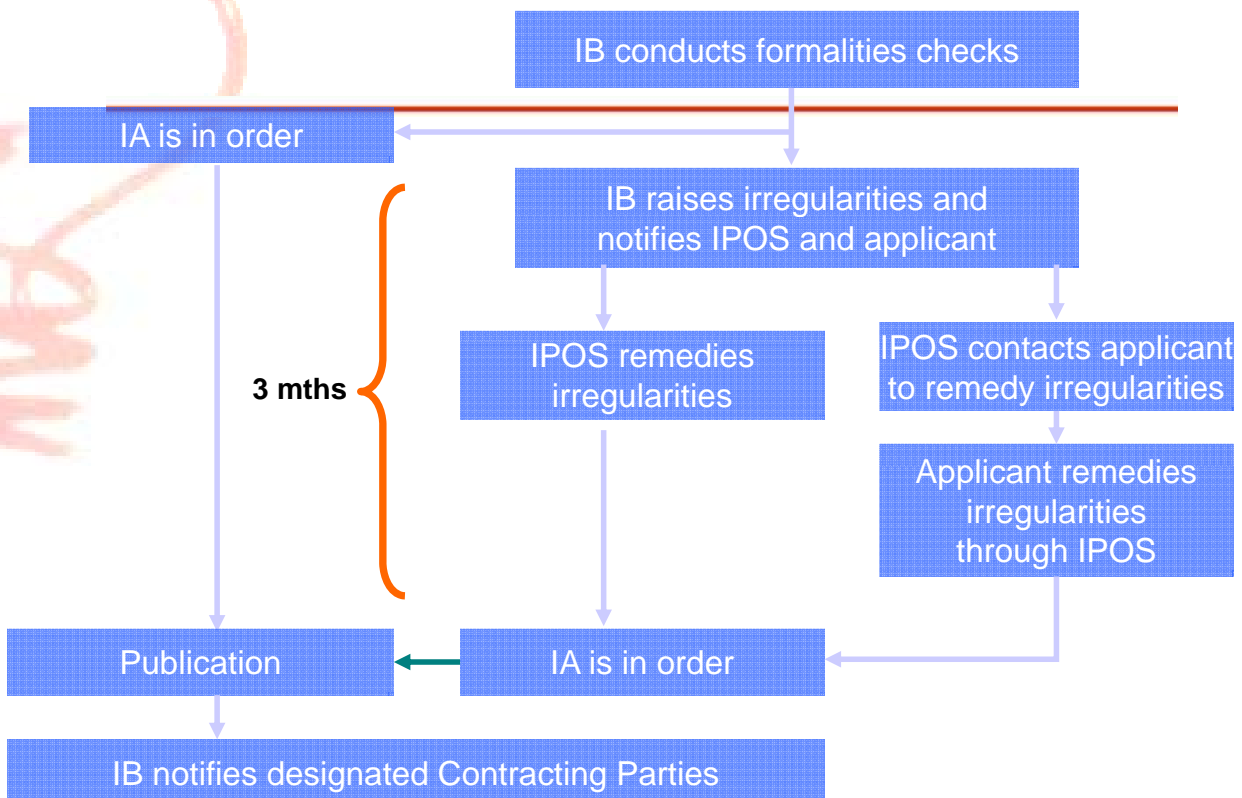
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- ◆ Central attack
  - Tracking reports
    - 5 years dependency period
    - Status report
    - Amendment report
    - Legal proceedings report

# Work Processes – IPOS as Office of Origin



# Work Processes – IPOS as Office of Origin



## Operations - *Manpower requirements*

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- ◆ Madrid team started with 1 legal officer, 2 examiners & 2 support staff
- ◆ Today, the Madrid team consists of 10 examiners and 4 support staff
  - ⇒ Increase in no. of IRs designating SG since SG first acceded to the Madrid Protocol
  - ⇒ accession by additional key trading partners such as the USA

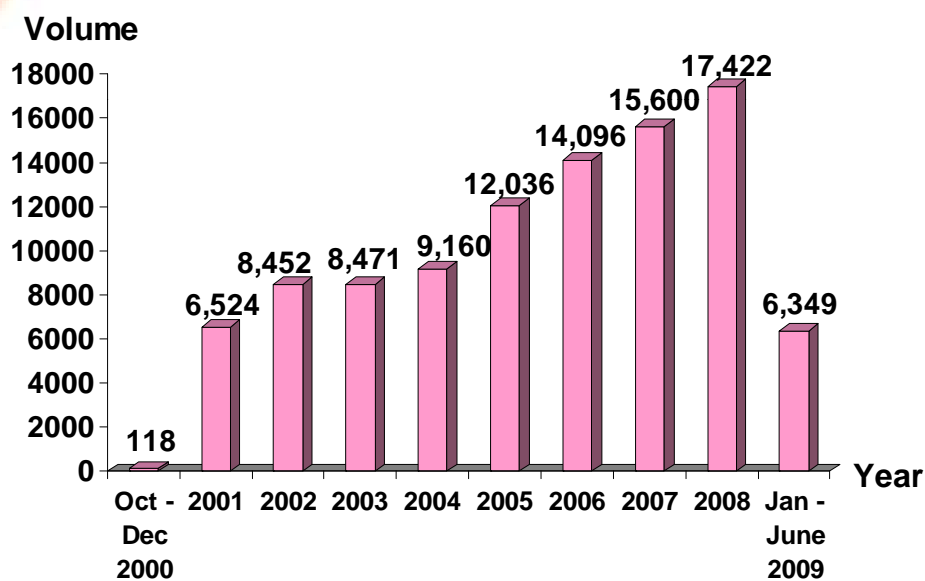
## Feedback

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- ◆ Some concerns raised by users of the Madrid Protocol
  - Assistance of agents still necessary if refusal raised by IPOS
  - Costs involved in appointment of agents
  - Madrid Protocol route still more expensive than filing nationally?
  - Long examination time by some offices
  - Despite formality checks by IB, designated offices still raise ICGS objections
  - No possibility of division under Madrid system

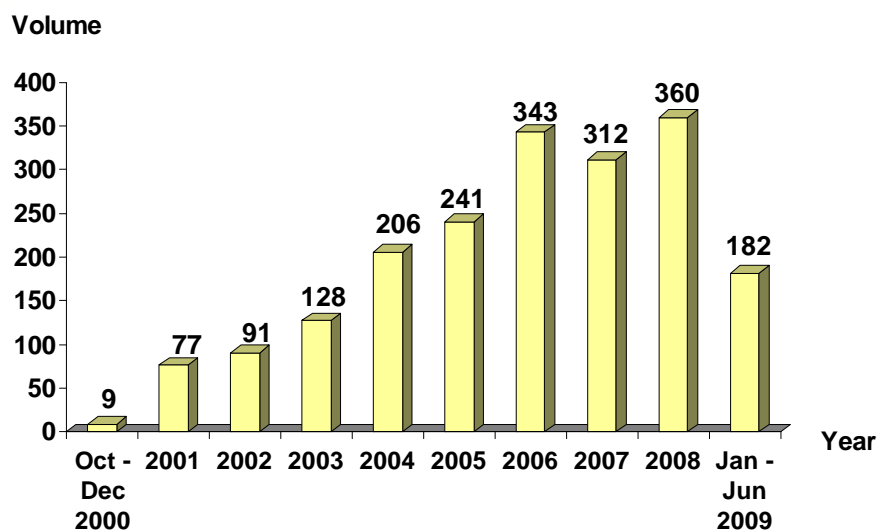
# No. of SG designations

(by no. of classes)  
(31 October 2000 to 30 June 2009)



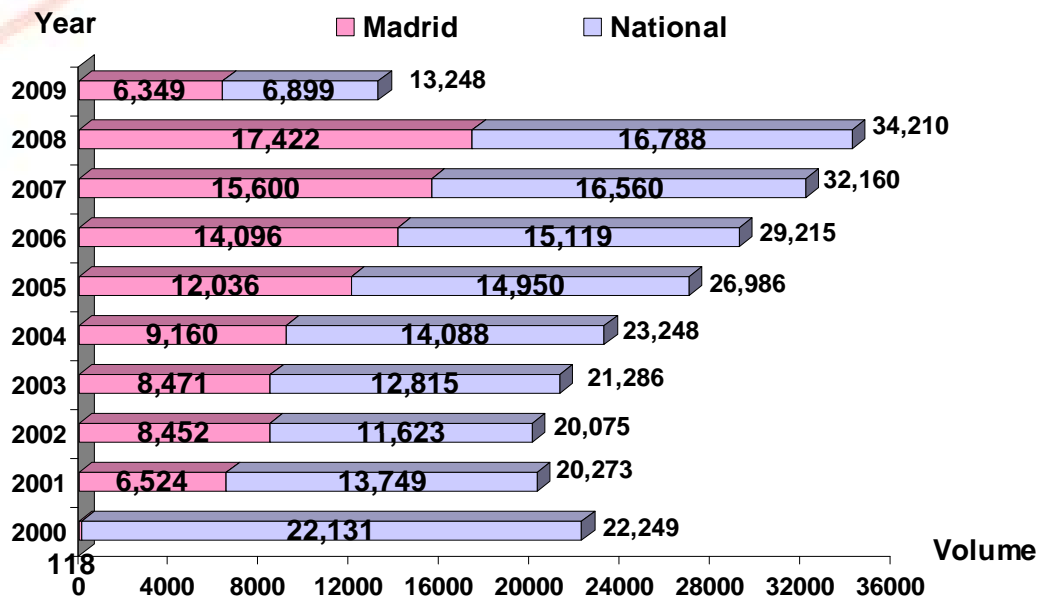
# No. of international applications

(by no. of classes)  
(31 October 2000 to 30 June 2009)



## No. of Madrid and National applications

(by no. of classes)  
(31 October 2000 to 30 June 2009)



## Current Situation in Singapore

### ◆ Office (IPOS)

- ⇒ Opened door for more filings via designations
- ⇒ Working on fully computerised system including eComms with IB
- ⇒ Madrid team matured - bridge gap by training national examiners to be Madrid examiners
- ⇒ Generally more experienced with Madrid processes & communications
- ⇒ Good working relationship between IPOS & IB to resolve working level issues

## Current Situation in Singapore

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### ◆ Trade Mark proprietors

- ⇒ Madrid system useful and attractive – generally lower costs, and ease of filing and subsequent administration, & more certainty
- ⇒ Relatively low local usage due to the interests of local proprietors who are interested in Asia & Asean but not many are members – China, Japan, Korea, Vietnam & Singapore
- ⇒ Anticipate greater usage with accession of other Asian & ASEAN countries

## Current Situation in Singapore

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### ◆ Trade Mark agents

- ⇒ Revenue from first filing activities fallen
- ⇒ Compensated by other ancillary work
  - ⇒ prosecution of office actions of designated cases
  - ⇒ pre-filing searches, licencing contracts, opposition & invalidation proceedings etc

# Developments at WIPO

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## Singapore actively involved in Madrid Working Group Meetings at Geneva

- ⇒ Statements of Grant of Protection compulsory for all Contracting Parties with effect from 1 September 2009
- ⇒ Study of future of Madrid System in Dec 2009
  - ⇒ reconsideration of basic mark requirement
  - ⇒ possibility of
    - ⇒ self designation
    - ⇒ division of applications
    - ⇒ additional filing languages apart from French, English and Spanish

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# Thank you!

<http://www.ipos.gov.sg>