


Experience from a National Office
Accession, Operation, Advice, Plans and Implementation

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Accession

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Singapore's Accession to the Madrid Protocol

31 July 2000

- Singapore acceded to Madrid Protocol

31 October 2000

- Madrid Protocol came into operation in Singapore

SG's Declarations under the Madrid Protocol

Regulation	Declaration Type
Article 5(2)(b)	Time limit for refusal: Extension to 18 months
Article 5(2)(c)	Possible notification of refusals based on an opposition after the 18-month time limit
Article 8(7)(a)	Individual fees
Rule 7(2)	Declaration of intention to use the mark
Rule 20bis(6)(b)	Recording of licenses provided for in the domestic law, but the recording of licenses in the International Register has no effect
Rule 34(2)(b)	The Office accepts to collect and forward fees to the International Bureau




Preparation for accession

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Training

- Study team
 - Training at WIPO, Geneva
 - Study visits to:
 - Swiss Federal Institute of Intellectual Property
 - UKIPO
- IPOS officers
 - International Registration Division
 - Customer Service Officers
 - General Staff



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Training

- TM agents and TM owners
 - Sep 2000: Workshop on procedures of the Madrid Protocol
 - WIPO experts
 - IPOS officers
 - Dialogue session with TM agents prior to implementation
- Continuous training
 - 2007: Briefing on Madrid procedures e.g. completing Form MM2, calculating of fees payable to WIPO

Operation

Manpower

- Initial
 - 2 Madrid examiners
- Current
 - 17 Madrid examiners

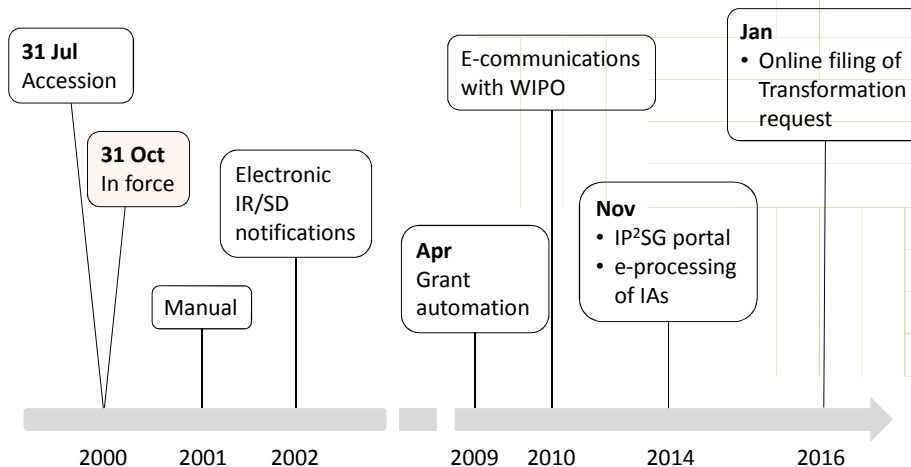
Changes to System following Accession

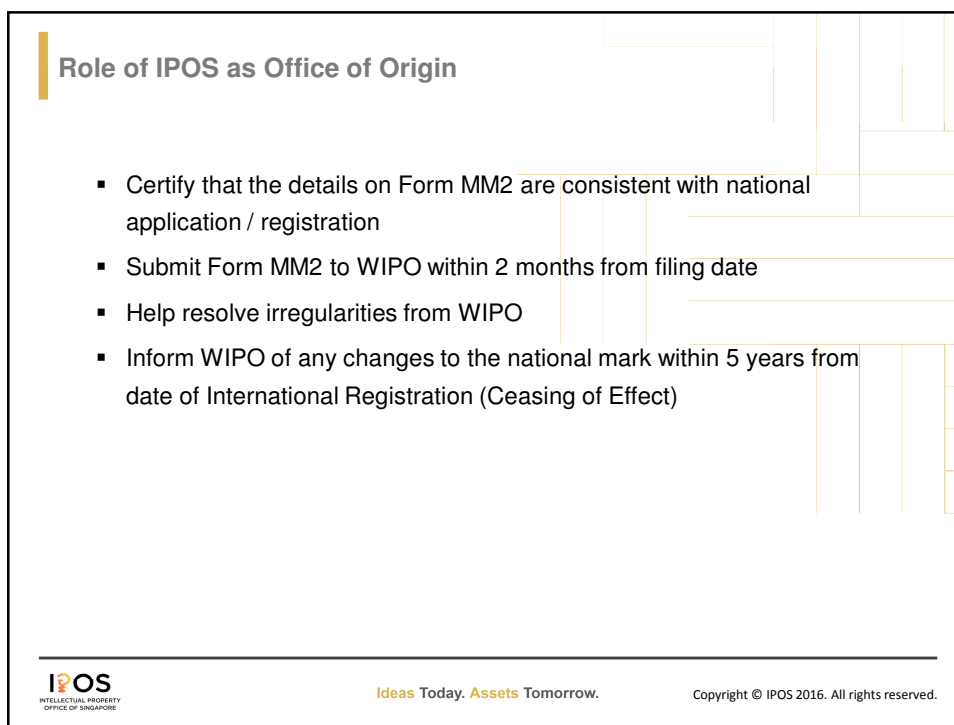
- Difficulty of processing multi-class IR using a single-class system
 - Classes are separated into different TM numbers.
 - System coordinates to send out a single grant after publication of each class that is tied to one IR
- Trade Marks Act amended in 2007 to allow for multi-class registration system.
 - IT system was enhanced to cater for multi-class applications.

Changes to System following Accession

- Enhanced system to cater for Madrid processes
- Tracking system to ensure IPOS is keeping to timelines
 - MM2
 - Irregularities from WIPO
 - Provisional Refusals
 - Limitation notices

State of Digitisation Since Singapore's Accession to Madrid Protocol





Things to note for International Applications

- If European Union is designated, a second language is required
 - If USA is designated, a separate Form MM18 (Declaration of intention to use the mark) is required
 - Some countries may require fees to be paid in 2-parts (Cuba and Japan)
 - Cannot apply for series of marks
 - Classification of goods / services:
 - based on the prevailing edition of the Nice Classification at the time of filing the IA, **not** at the time of filing the national application.
- Example
- NCL 9 (2007 – 2011), “vending machines” were classified in Class 9.
 - NCL 10-2016, “vending machines” are now classified in Class 7.

Things to note for International Applications

WIPO's Fee Calculator

<http://www.wipo.int/madrid/en/fees/calculator.jsp>

As there may be fee revisions from time to time, a re-calculation of the fee payable, just before the actual filing date of the application, is advisable.

Role of IPOS as Designated Office

- Examination of International Registration (IR) / Subsequent Designation (SD)
- Issue Provisional Refusal of Protection
- Issue Notifications informing of Opposition Period
- Issue Statement of Grant of Protection or Confirmation of Final Refusal
- Update changes to the IR (Cancellations, Corrections, Limitations, Transfer of Ownership etc)

Things to note for International Registrations / Subsequent Designations


- Description of goods and/or services
 - Objections may be raised against vague descriptions eg. "personal and social services rendered by others to meet the needs of individuals".
- Change of class is not allowed
 - WIPO determines the classification of goods / services.
 - Change of class can only be effected through a correction notice issued by the IB.



Ongoing developments

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Ongoing developments

- Building a business-friendly and process-efficient system
 - Simplifying application procedures, processes and forms
- IT system improvements
 - 100% electronic filing system
 - Paperless correspondence system

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