



WIPO | MADRID

The International
Trademark System



Corrections

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**Geneva,
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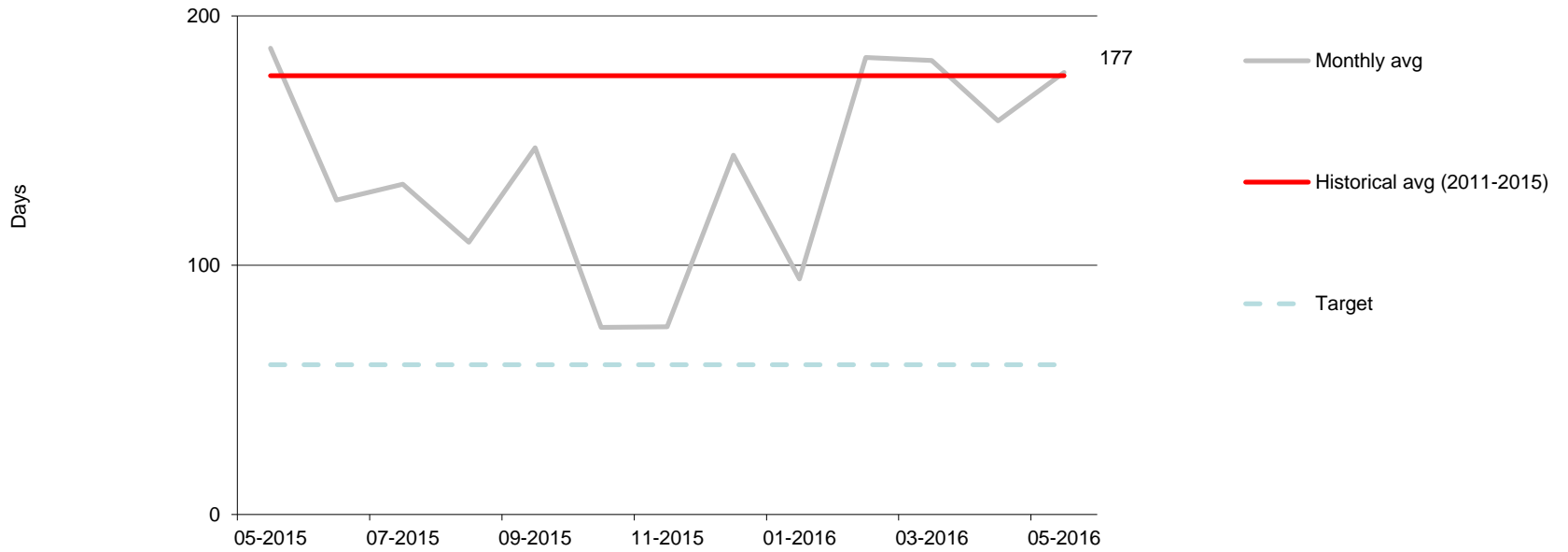
Main points

- Status in the IB
- What are we receiving?
- What should we correct?
- Rule 28 of the Common Regulations
- Substantive errors

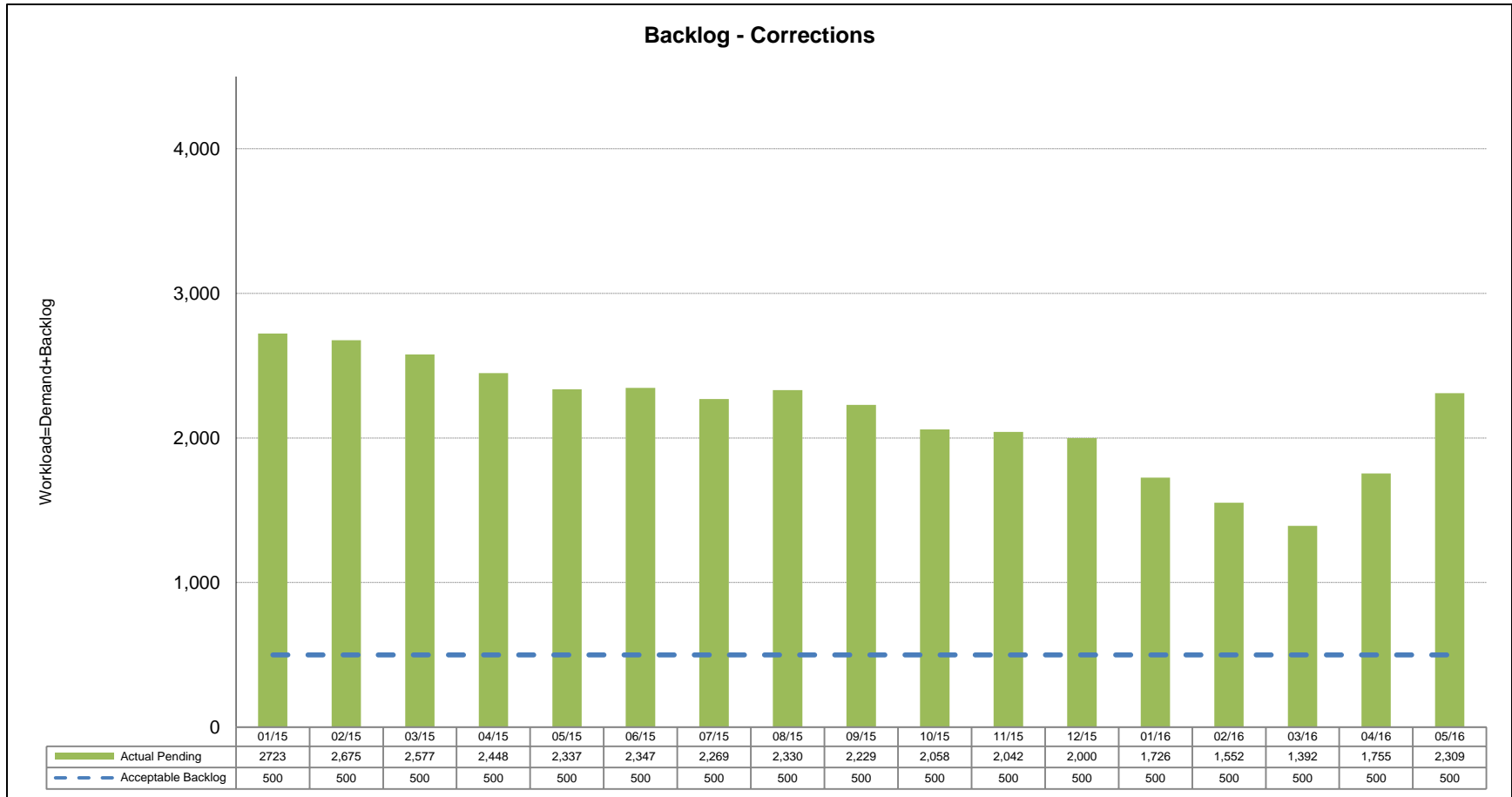
THE STATUS

Backlog

Pendency - Corrections



Corrections pending



Figures

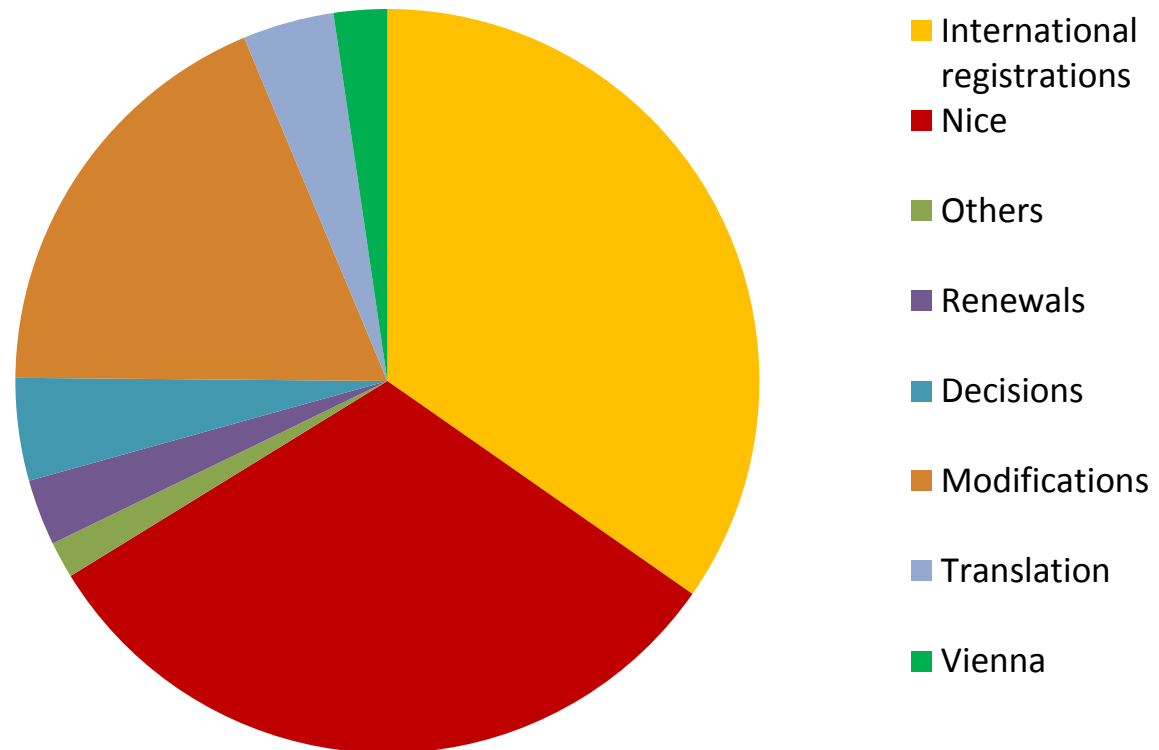
- Correction requests in 2016
 - The first 5 months – 14% less than in 2015
 - On average 250 per month
 - 5% are declared by the Offices, but 17% are related to errors by Offices

Since July 2015

- 2.721 requests
 - 33% International registrations
 - 30% Nice
 - 22% Modifications
 - 5% Translation
 - 3% Vienna

Correction requests from Offices

**% Corrections from Requesting Office 2016
as at 1 June 2016**



Majority of the errors

■ Address of the holder, representative	34%
■ Name of the holder, representative	20 %
■ List of designated parties	15 %
■ Reference number or date	13 %

Despite the set back - improvements

- Thoroughly analyze all incoming requests from holders, representatives and Offices
- Many are not acceptable
- A new MM form for corrections – MM21
 - Not mandatory
 - Will help in analyzing the errors and managing the work

MADRID AGREEMENT AND PROTOCOL CONCERNING THE
INTERNATIONAL REGISTRATION OF MARKS

REQUEST FOR THE CORRECTION OF A RECORDING

(Rule 28 of the Common Regulations)

IMPORTANT

1. The use of this form is not compulsory. It is made available for the convenience of holders of international registrations and Offices of Contracting Parties.
2. Errors made by the International Bureau can be corrected at any time.
3. Errors made by an Office can be corrected only if a request for correction, presented by that Office, is received by the International Bureau within **nine months** from the date of publication of the recording in the International Register which is the subject of the correction.
4. Errors made by the applicant, holder or representative cannot be corrected.

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WHAT SHOULD WE CORRECT?

What is a correction ?

- A change in the International Register when an error in the international registration is detected.

- Therefore a correction can only be made if:
 - A fact which has to be corrected is already recorded in the IR;
 - A fact is subject of an error.

Rule 28

- The IB shall correct an error in the IR *ex officio* or upon request from a holder or an Office
- An error attributable *to an Office* and the correction of which *would affect the rights* deriving from the international registration – may be corrected if the request is received *within 9 months* from the date of publication of the entry in the International Register

Errors by the IB

- If there is a discrepancy between a document filed by an Office and a fact recorded in International Register
- If there is a discrepancy between a document filed by the holder and a fact recorded in the International Register
- Errors related to Vienna and Nice Classification

Example – classification

- International registration including
"Adhesive bands for medical use" in Class 10.

Error by the IB, should be in Class 5, based on "**Adhesive bands for medical purposes**" in Class 5 of the Alphabetical List (Basic No. 050294).

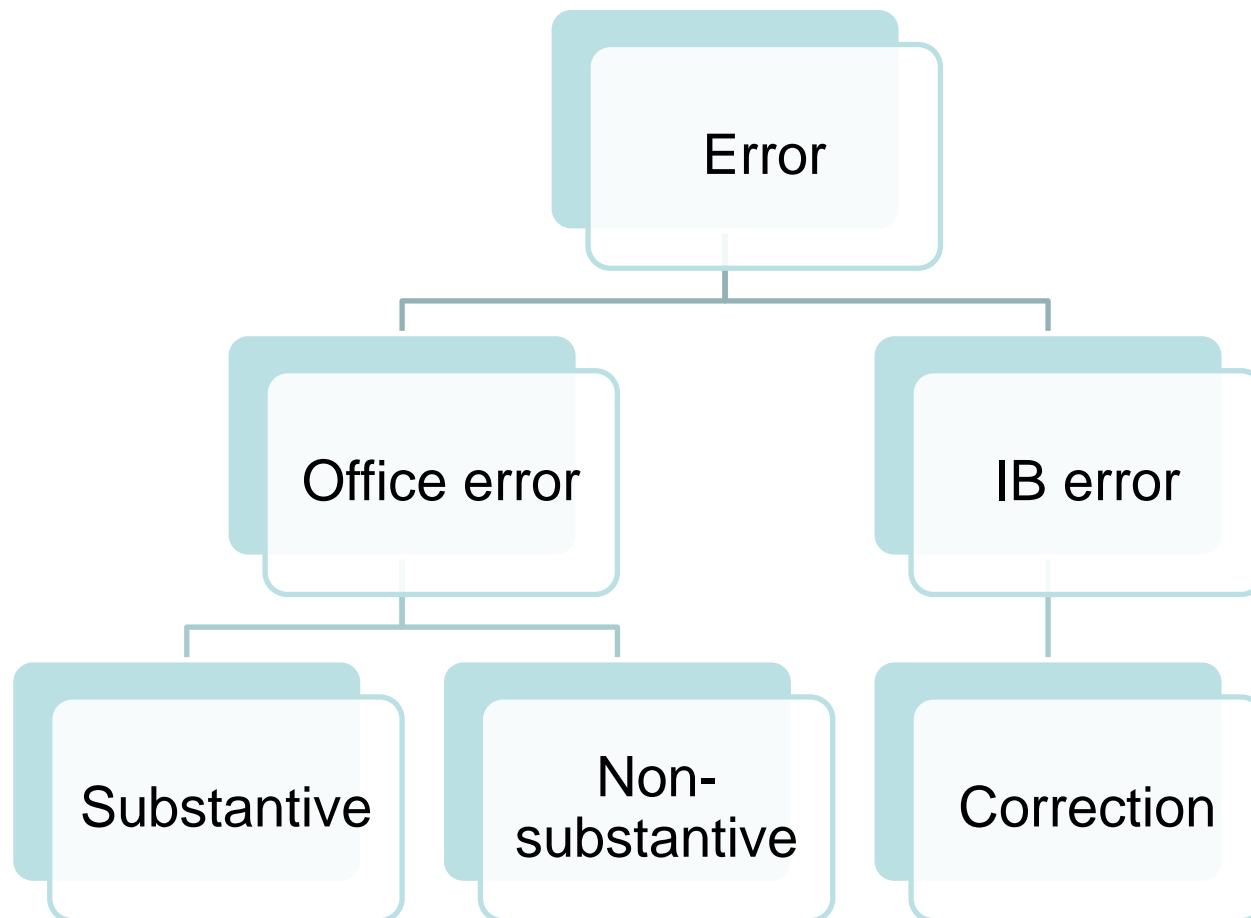
Errors by Offices

- Errors from an Office that do not affect the rights deriving from the IR (non substantive elements) can be corrected at any time by a request of an Office only.
- Errors from an Office that affect the rights deriving from the IR (substantive elements) can be corrected at the request of that Office only within 9 months from the date of the publication.

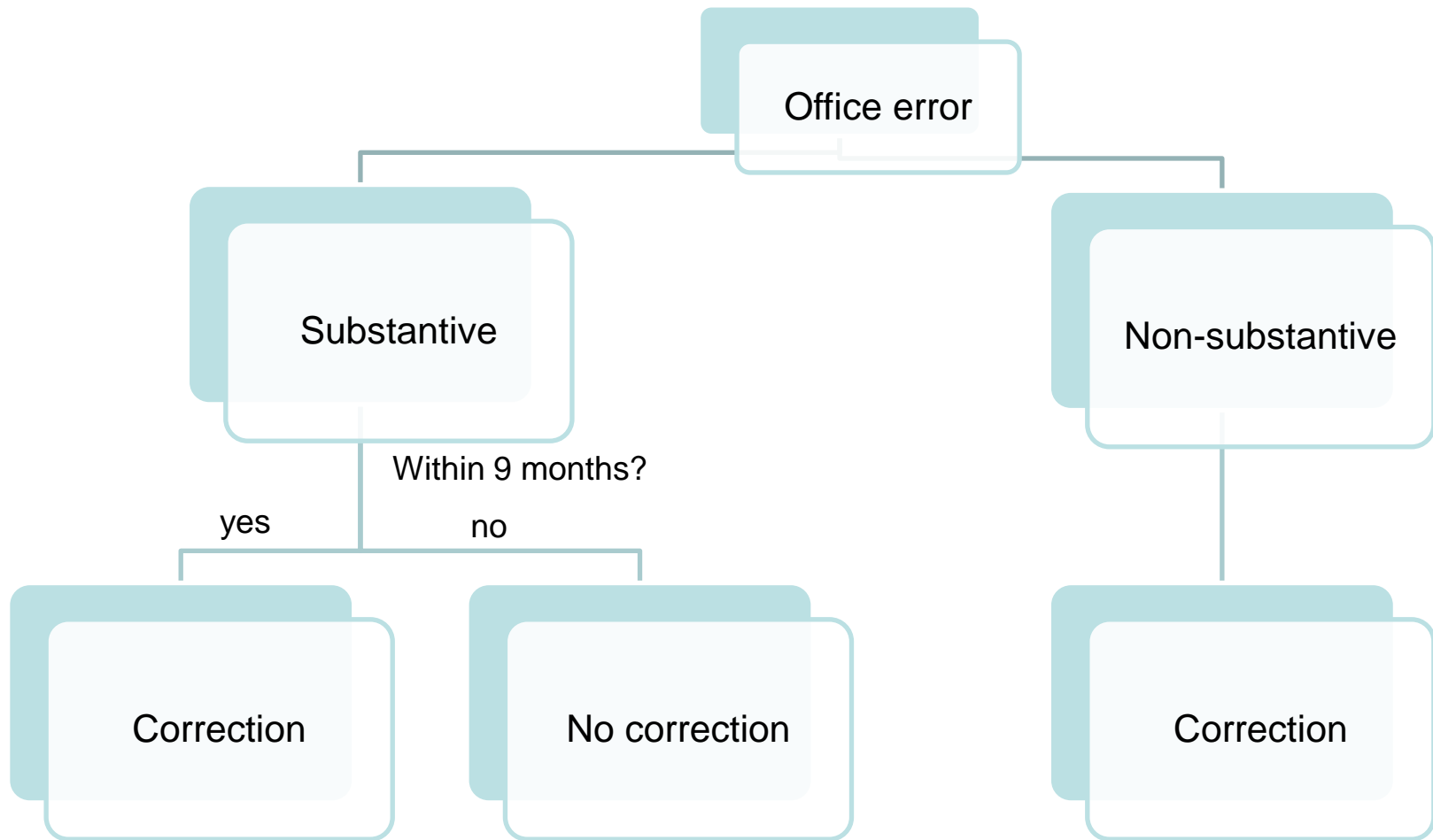
Example – not acceptable request

- A request for a correction from a holder
- Two designated Contracting Parties missing in the Registration Certificate
- Where the error was by the Office of Origin – the request needs to be submitted by that Office within 9 months from the date of publication of the entry in the International Register

Admissible request?



Admissibility



Substantive errors?

- The Guide to the International registrations of Marks
(paragraph B.II.70.03)

“This time limit does not apply to errors made by the IB [...].
Nor does it apply to non-substantive errors **such as those concerning the name or address of the holder or obvious mistakes in the list of goods and services**”

Substantive errors?

- A questionnaire to the Members of the Madrid System who participated in the last Roundtable (56).
- 30 Members responded
- We asked which errors, the Members consider to be:
 - errors the correction of which would affect the rights deriving from the international registration (substantive errors);
 - errors the correction of which would not affect the rights deriving from the international registration (non-substantive errors);
 - attribution of particular errors to be either substantive or non-substantive

Conclusions – from the survey

Substantive	Non substantive	Substantive for majority of Members	Diverse opinions
Filing date/date of subsequent designation	Information about representative (name, address, contact info.)	Color claim (16)	All other elements of IR. Mentioned most often:
Priority date and list of G&S in the priority claim (if the scope of protection is broadened)	Minor typo errors	Type of trademark (18)	<ul style="list-style-type: none"> • Declaration of "mark in standard characters"
List of G&S (if the scope of protection is broadened)	Obvious mistakes in the list of G&S?		<ul style="list-style-type: none"> • Description of color or combination of colors claimed (text)
Reproduction of the mark			<ul style="list-style-type: none"> • Disclaimer for "disclaiming protection for element(s) of the mark"
			<ul style="list-style-type: none"> • Name of the holder/contact details/legal nature
			<ul style="list-style-type: none"> • Information on basic application/registration

Reproduction of a mark

- Answers suggest that changes to the reproduction of a mark are substantive as soon as:
 - the image differs significantly,
 - change to the mark is material, or
 - distinctive character of the mark is altered

- Practical examples suggest that interpretation of this criteria vary between the Members

Reproduction of the mark

Examples from Offices

Substantive or not?

Substantive



Non-substantive



Reproduction of a mark

Examples from Offices

Substantive



Non-substantive



Reproduction of a mark

Examples from Offices

Non-substantive



Non-substantive

■ Percy & Reed' vs. Percy + Reed

Substantive

■ RANIER vs. RAINIER

Possible conclusions

- IB should consider the following elements of international registrations to be substantive:
 - filing date/date of subsequent designation
 - priority date and list of G&S (if the scope of protection is broadened)
 - list of G&S (if the scope of protection is broadened)
 - reproduction of the mark

- Information regarding the representative should be considered non-substantive

For consideration

- What about the other errors? Name of the holder etc.
- How shall the IB treat requests for corrections under Rule 12 which are submitted after 9 months?
- Shall **all** the requests for corrections of IB errors be corrected? Evaluation of the overall effects of the potential correction (date of an error, acceptability in DCP's, potential legal effects of a correction)?

- Next steps?