

Irregularities

The Madrid International Registration System



Irregularities in applications under Madrid International Registration System – 2012

| | Total | % |
|----------------------------------|--------|-------|
| International Applications filed | 44,010 | |
| Number with Errors | 14,128 | 32.1% |



Irregularities in applications under Madrid International Registration System – 2012

| | UK | % |
|----------------------------------|-------|-------|
| International Applications filed | 1,559 | |
| Number with Errors | 733 | 47.0% |



Irregularities in applications under Madrid International Registration System – 2012

| | | Total | % |
|---|--|--------|--------|
| International Applications filed | | 44,010 | |
| Number with Errors | | 14,128 | 32.1% |
| Total irregularity letters issued by WIPO | | 15,934 | 100.0% |
| Irregularity letters breakdown | Errors related to Rule 12 (Specification irregularities) | 1,681 | 10.5% |
| | Errors related to Rule 13 (Goods & services too vague) | 4,466 | 28.0% |
| | Errors related to Rule 11(3) (Fees) | 4,007 | 25.1% |
| | Other errors related to Rule 11(4) (Administrative errors) | 1,468 | 9.2% |
| | Applications with multiple errors | 4,312 | 27.1% |



Irregularities in applications under Madrid International Registration System – 2012

| | | UK | % |
|---|--|-------|--------|
| International Applications filed | | 1,559 | |
| Number with Errors | | 733 | 47.0% |
| Total irregularity letters issued by WIPO | | 850 | 100.0% |
| Irregularity letters breakdown | Errors related to Rule 12 (Specification irregularities) | 64 | 7.5% |
| | Errors related to Rule 13 (Goods & services too vague) | 155 | 18.2% |
| | Errors related to Rule 11(3) (Fees) | 188 | 22.1% |
| | Other errors related to Rule 11(4) (Administrative errors) | 78 | 9.2% |
| | Applications with multiple errors | 365 | 42.9% |



Rule 12 links back to Rule 9

Rule 9(4)(a)(xiii)

[Contents of the International Application]

Goods and services shall be...

- ✓ indicated in precise terms – preferably using NICE;
- ✓ grouped in the appropriate NICE classes;
- ✓ each group preceded by the number of the class;
- ✓ presented in class order.



Causes of classification errors

Madrid regulations require:

Goods and Services to be indicated in precise termspreferably using the words appearing in the Alphabetical List of the said (NICE) Classification.



Causes of classification errors

But Nice is not always precise:

Nice Classification:

Mats* in Class 27 and also Classes 16, 20, 21 & 24

And is not an exhaustive list....

Madrid Goods & Services manager:

Mats also in Classes 9, 17, 19, 20, 21, 24 & 28.

Harmonised list shows

Mats also in Class 10



Causes of classification errors

“Mats for effervescent bath massage”



Mats for effervescent bath massage?

NICE Classification:

‘Massage apparatus’ - Class 10

‘Hydromassage bath apparatus’ – Class 11

‘Whirlpool-jet apparatus’ – Class 11

‘Spa baths [vessels]’ – Class 11

Is Class 10 correct?



Consequences....

Delay....

Expense...

Loss of registration



Other causes of classification irregularities...

Practice

Interpreting the class number as adding to the classification:

“Mats” without any further explanation becomes acceptable in Class10



Other causes of classification irregularities...

There will be circumstances when the Class number will be important...

Many legal systems prohibit widening of a specification after filing.



Other causes of classification irregularities...

“Civil engineering” is applied for in Class 37

Madrid G&S manager shows this in Class 42

However...there are civil engineering services in Class 37 ... Madrid G&S manager lists:

“Construction and maintenance services relating to civil engineering” in Class 37



Other causes of classification irregularities...

Check boxes: *Check this box if you claim the alphabetical list....*

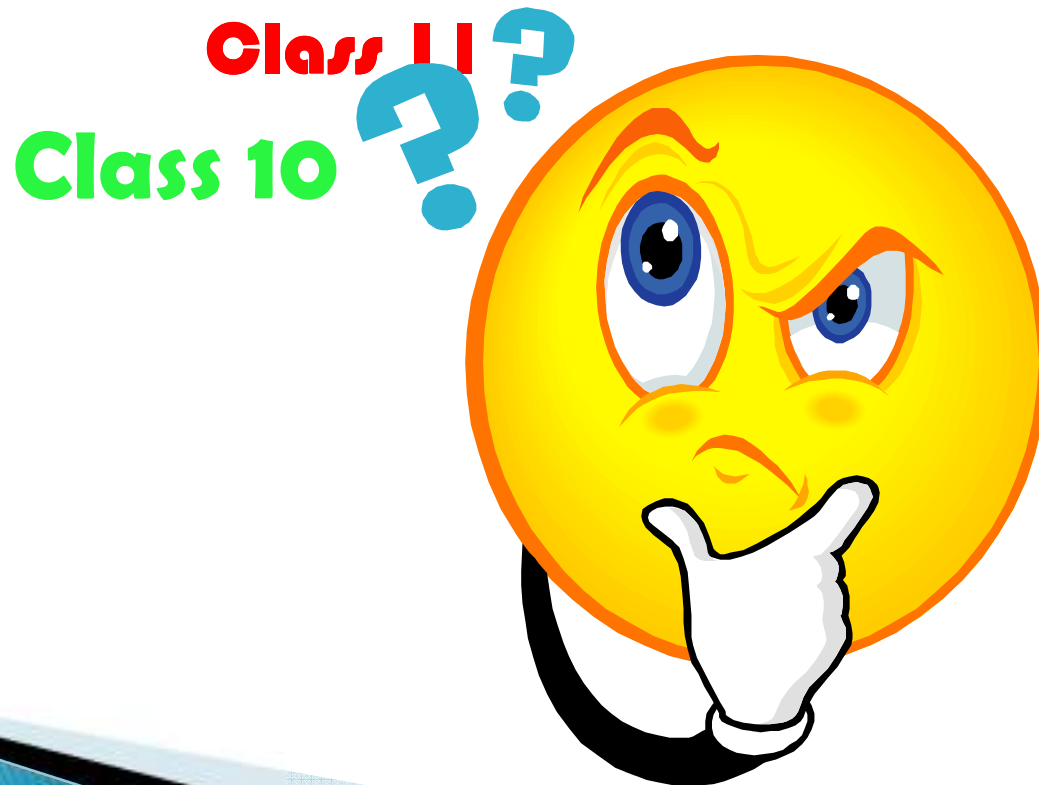
Statements: *“All goods in Class X”*
“All services in the Nice Alphabetical list”

These have the same effect as the use of Class numbers - and same problem in that they do not indicate the Goods and Services “in precise terms”.



In conclusion....

Even though we all use the Nice classification,
that doesn't mean we find the same answer...



In conclusion....

It is in all our interests to have harmony in classification listings and classification practice.

