



# ROLES AND JOBS OF TRADEMARK AGENTS AND SPECIALISTS RESPONDING TO THE NOTIFICATION OF PROVISIONAL REFUSAL FROM THE DESIGNATED CONTRACTING PARTY(DCP), etc.

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# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Role of the Office of a DCP

- The role of the designated Office will follow from the domestic legislation, which set the conditions for protecting a trademark
- Offices of DCPs may communicate the status of protection of a mark through various statements in the course of their examination
  - Provisional refusal – Rule 17
  - Interim status – Rule 18*bis*
  - Statement of grant of protection – Rule 18*ter*(1)
  - Final decisions – Rule 18*ter*(2) and (3)
  - Further decision – Rule 18*ter*(4)
  - Invalidation – Rule 19

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## The Notification of Provisional refusal from DCPs

- The contracting states concerned may refuse protection under their respective national legislation within one year or 18 months.
  
- The procedure following the notification of a provisional refusal of protection is determined by the Office of the DCP concerned and is carried out directly between the holder and the Office.
  
- It does not involve WIPO. All the information required to follow up with the Office is in the notification of provisional refusal issued by the Office.
  
- The Notification includes:
  - the grounds for refusal;
  - time limit for requesting review or appeal;
  - authority to which such request for review or appeal should be made;
  - whether or not the assistance of a local representative is mandatory.

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## How to respond to Notification of Provisional Refusal

(1) When the applicant wishes to file an argument against the refusal:

⇒ Necessary to file a response with the DCP which has issued the Refusal (generally through a local representative) .

(2) When the refusal can be overcome by limiting goods/services:

⇒ ▪ Filing an amendment with the DCP which has issued the Refusal (generally through a local representative)

- or -

▪ Filing MM6 <the request for a limitation of the list of goods and services> with WIPO directly.  
(You may also be required to correspond to DCP timely. - Ex. US)

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Top designated Contracting Parties (DCPs)

<b>Contracting Parties</b>	<b>2012</b>	<b>2013</b>	<b>2014</b>
China	20,120	20,275	20,309
European Union	16,889	17,598	17,270
United States of America	16,411	17,322	17,268
Russian Federation	16,634	18,239	16,573
Japan	12,493	13,179	12,814
Switzerland	13,464	13,215	12,759
Australia	10,753	11,675	11,533
Republic of Korea	10,090	10,967	10,402
Turkey	9,656	9,838	9,513
Mexico	-	5,095	8,533

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 1. China- General

Examination Procedure	Absolute and relative grounds
Time Limit for Responding to Provisional Refusal (*see special note on next page)	Filing a review before the TRAB (Trademark Review and Adjudication Board) within a period of <b>15 days from</b> the date on which the holder/representative, <b>received</b> the notification of refusal <b>from the IB.</b>
Republication	The Office <b>does not</b> republish notifications of international registration, subsequent designation or renewal received from the International Bureau.
Opposition Procedure	<b>3 months</b> starting on the first day of the month following the date of publication <b>in the WIPO Gazette</b> (non-extendable)
Local representation	Required (when corresponding to the refusal.) PoA required.

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## China- Notes

### ▪ **Time Limit for Responding to Provisional Refusal (\*)**

- When the date of receipt of the notification is **illegible** or **absent**, the request for review of refusal may be presented within 30 days from the date where the notification was sent by the IB
- Any supplementary evidence referred to in a request for review shall be submitted to the Board **within 3 months** from the date upon which the request was presented.

[http://www.wipo.int/edocs/madrdocs/en/2011/madrid\\_2011\\_19.pdf](http://www.wipo.int/edocs/madrdocs/en/2011/madrid_2011_19.pdf)

### ▪ **Two types of Refusal: Total refusal or Partial refusal**

- **Description of Goods and Services**-The Office may accept all the class headings, but **it is advisable** to list particular goods/services of interest.

Ex. “Clothing, footwear, headgear” (Class heading for class 25 )

– The mark **would not cover** “socks, scarves, gloves, or belts”


# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## China- Total refusal (example)

**NOTIFICATION OF EX OFFICIO REFUSAL**  
Notified to the International Bureau of  
the World Intellectual Property Organization (WIPO)  
under Rule 17 (2) and 17 (5)(e) of the Common Regulations

I. Office which pronounces the refusal:  
Trademark Office  
State Administration for Industry and Commerce

1, Chama Nanjie, Xichengqu,                      Tel: 8610-63219000  
Beijing, 100055  
People's Republic of China                      FAX: 8610-68050285



II. Date of the refusal pronounced: 2015/10/26

III. Our reference number: \_\_\_\_\_

IV. International registration number: \_\_\_\_\_

V. Date of notification to China: 2014/12/11

VI. Basic national registration number: \_\_\_\_\_  
Basic national application number: \_\_\_\_\_

VII. **The mark is refused for all the goods and/or services.**

VIII. Reason(s) of refusal:  
The mark consists of an indication that has direct reference to the quality of the products.

IX. Applicable legal provisions of the refusal:  
Article(s): (See the excerpts of the laws and regulations)  
Trademark Law Article 11(i)(2)

X. Reference to review of refusal:


- Time limit for review: within 15 days from receipt of this notification.**
- Competent authority: Trademark Review and Adjudication Board under the State Administration for Industry and Commerce.
- The application for review shall be filed through a qualified Chinese agency or attorney. (A list of qualified agencies and attorneys in Chinese can be found at <http://www.ctmo.gov.cn> or <http://sbj.saic.gov.cn>)

## Partial refusal

**NOTIFICATION OF EX OFFICIO REFUSAL**  
Notified to the International Bureau of  
the World Intellectual Property Organization (WIPO)  
under Rule 17 (2) and 17 (5)(e) of the Common Regulations

I. Office which pronounces the refusal:  
Trademark Office  
State Administration for Industry and Commerce

1, Chama Nanjie, Xichengqu,                      Tel: 8610-63219000  
Beijing, 100055  
People's Republic of China                      FAX: 8610-68050285



II. Date of the refusal pronounced: 2015/10/29

III. Our reference number: \_\_\_\_\_

IV. International registration number: \_\_\_\_\_

V. Date of notification to China: 2014/12/25

VI. Basic national registration number: \_\_\_\_\_  
Basic national application number: \_\_\_\_\_

VII. **The mark is refused for the following goods and/or services:**  
35: Retail services or wholesale services for clothing; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for electrical machinery and apparatuses; retail services or wholesale services for building materials; retail services or wholesale services for printed matter; retail services or wholesale services for kitchen equipment, cleaning tools and washing utensils; retail services or wholesale services for bladed or pointed hand tools, hand tools, hardware (other than "razor strops, sharpening steels and whetstones").

VIII. Reason(s) of refusal:  
Retail and wholesale services are not acceptable in China for the purpose of trademark registration.

IX. Applicable legal provisions of the refusal:  
Article(s): (See the excerpts of the laws and regulations)  
Trademark Law Article 22&30

X. Reference to review of refusal:

- Time limit for review: within 15 days from receipt of this notification.**
- Competent authority: Trademark Review and Adjudication Board under the State Administration for Industry and Commerce.
- The application for review shall be filed through a qualified Chinese agency or attorney. (A list of qualified agencies and attorneys in Chinese can be found at <http://www.ctmo.gov.cn> or <http://sbj.saic.gov.cn>)



# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 2. EU

Examination Procedure	Absolute grounds. OHIM also carries out ex officio search for prior rights in the CTM Register and in certain national registers only on request.
Time Limit for Responding to Provisional Refusal	<b>2 months</b> from <b>the date of issue</b> of the provisional refusal <b>by OHIM</b> .
Republication	Republication in the CTM Bulletin in part M.1 at <a href="https://oami.europa.eu/eSearch/#advanced/bulletins">https://oami.europa.eu/eSearch/#advanced/bulletins</a> in all official languages of the European Union.
Opposition Procedure	<b>-Between the 6<sup>th</sup> and 9<sup>th</sup> month</b> , following the date of republication in the CTM Bulletin (non-extendable). -If admissible, 2 month “cooling off” period begins (can be extended by 22 months)
Local representation	Required (when corresponding to the refusal). PoA may be requested by OHIM.

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.


## EU-Notes

- **Two types of Refusal: Total refusal or Partial refusal**
- **Description of Goods and Services-**
  - All terms considered too broad or too vague, and lacking clarity and precision will be objected to.  
(As a result of the ruling in C-307/10 "IP Translator")
  - Eleven non-acceptable Nice class headings-  
6, 7, 14, 16, 17, 18, 20, 37(Repair; Installation services),40, 45.
  - Tools such as TMclass (<http://tmclass.tmdn.org/ec2/>) are available and should be used to avoid possible refusal

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

OHIM- Total refusal (example-a part of the 1<sup>st</sup> page)

Partial refusal

 OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)  
OPERATIONS DEPARTMENT

W110

**Notification of ex officio provisional total refusal of protection (Article 5 of the Madrid Protocol, Rule 17(1) and (2) of the Common Regulations under the Madrid Agreement and Protocol, and to Rule 113 CTMIR)**

Alicante, 02/12/2015

*International registration number:* [REDACTED]

*Name of the Holder:* [REDACTED]

*Trade Mark:* [REDACTED]


Protection of the above-mentioned mark is provisionally refused for the European Community for all the services covered by the designation of the European Community.

**I. Grounds:**

The trade mark you have applied for is not eligible for registration under Article 7(1) (b) and (c) and Article 7(2) CTMR.

The mark applied for consists of the words [REDACTED] and is considered objectionable for:

**Class 44** *Providing health information and advice relating to diet, weight loss, diet planning and lifestyle wellness via a website.*

 OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)  
OPERATIONS DEPARTMENT

W110

**Notification of ex officio provisional partial refusal of protection (Article 5 of the Madrid Protocol, Rule 17(1) and (2) of the Common Regulations under the Madrid Agreement and Protocol, and to Rule 113 CTMIR)**

Alicante, 10/09/2015

*International registration number:* [REDACTED]

*Name of the Holder:* [REDACTED]

*Trade Mark:* [REDACTED]

The trade mark you have applied for is partially not eligible for registration under Article 7(1)(b) and (c) and Article 7(2) CTMR.

**I. Grounds**

The mark applied for consists of the words [REDACTED] and is considered objectionable for:

**Class 16** *Document files [stationery]; folders for paper.*

The distinctive character and descriptiveness of a trade mark must be assessed, first, in relation to the goods or services in respect of which registration of the sign is sought and, second, in relation to the perception of the section of the public targeted, which is composed of the consumers of those goods or services (judgment of 27/11/2003, T-348/02, 'Quick', paragraph 29).

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 3. US

Examination Procedure	Absolute and relative grounds
Time Limit for Responding to Provisional Refusal	<b>6 months</b> (not extendable) from <b>the date of issue</b> of the provisional refusal <b>by the USPTO</b> (The “mailing date” found on the provisional refusal cover sheet issued by WIPO).
Republication	The Office <b>republishes</b> in the USPTO TM Official Gazette (OG) notifications of IR, subsequent designations or renewals received from the IB.
Opposition Procedure	<b>30 days</b> from the date of publication in the USPTO OG (extendable).
Local representation	Local representation is not required (The trademark Holder can directly response to the USPTO). Any representative, however, must comply with national regulations on representation before the USPTO.

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## US-Notes

- **Two types of Refusal: Total refusal or Partial refusal**
- **Description of Goods and Services**
  - The class headings are basically **not** acceptable.
  - Only the headings in **class 15** (musical instruments) and **class 23** (yarns and threads for textile use) are acceptable.
  - Advisable to use **“Acceptable Identification of Goods and Services Manual”**, available on the USPTO website.
- USPTO has announced **“Tips for Holders of International Registrations Seeking Extension of Protection to the United States of America: Avoiding Provisional Refusals”**  
[http://www.wipo.int/edocs/madrdocs/en/2009/madrid\\_2009\\_4.pdf](http://www.wipo.int/edocs/madrdocs/en/2009/madrid_2009_4.pdf)

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## US- Total refusal (example-a part of the 1<sup>st</sup> page)

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. [REDACTED]  
MARK: [REDACTED] \* [REDACTED] \*

CORRESPONDENT ADDRESS:  
[REDACTED]  
Tokyo 105-0004  
JAPAN

APPLICANT: [REDACTED]  
CORRESPONDENT'S REFERENCE/DOCKET NO.: N/A  
CORRESPONDENT E-MAIL ADDRESS: [REDACTED]

CLICK HERE TO RESPOND TO THIS LETTER:  
[http://www.uspto.gov/trademarks/fees/response\\_forms.jsp](http://www.uspto.gov/trademarks/fees/response_forms.jsp)

OFFICE ACTION  
STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. [REDACTED]

**STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION:** TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL **FULL REFUSAL** NOTIFICATION WITHIN 6 MONTHS OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1st Refusal Note."

**This is a PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**SUMMARY OF ISSUES** that applicant must address:

- Identification of Goods and Services
- Information Request

**SEARCH OF OFFICE'S DATABASE OF MARKS**

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).

**IDENTIFICATION OF GOODS AND SERVICES**

The goods/services are:

Class 16: Albums for photographs; almanacs; aquarelles; book ends, not furniture; booklets in the field of art, design, culture, music, motion picture films

## Partial refusal

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. [REDACTED]  
MARK: [REDACTED] \* [REDACTED] \*

CORRESPONDENT ADDRESS:  
[REDACTED]  
5067 Köln  
FED REP GERMANY

APPLICANT: [REDACTED]  
CORRESPONDENT'S REFERENCE/DOCKET NO.: N/A  
CORRESPONDENT E-MAIL ADDRESS: [REDACTED]

CLICK HERE TO RESPOND TO THIS LETTER:  
[http://www.uspto.gov/trademarks/fees/response\\_forms.jsp](http://www.uspto.gov/trademarks/fees/response_forms.jsp)

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. [REDACTED]

**STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION:** TO AVOID PARTIAL ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO **THIS PROVISIONAL PARTIAL REFUSAL** NOTIFICATION WITHIN 6 MONTHS OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional partial refusal is the "Create/Mail Date" of the "IB-1st Refusal Note."

**This is a PROVISIONAL PARTIAL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application that applies to **only the following goods: vacuum pumping system**. See 15 U.S.C. §1141(c). See below in this notification (hereafter "Office action") for details regarding the provisional partial refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**PARTIAL REFUSAL FOR IDENTIFICATION OF GOODS**

The identification of goods is indefinite and must be clarified because "vacuum pumping systems" is overly broad. See TMEP §1402.01. The applicant must indicate the specific nature of the goods. The word "system" in the identification of goods is indefinite and must be amended to (1) list the primary parts or components of the system and (2) describe the nature, purpose, or use of the system. TMEP §1401.05(d). Applicant should use common generic terms to specify the parts or components of the system. See TMEP §§1402.01, 1402.03(a). Applicant should also classify the system in the same international class as its primary parts or components. TMEP §1401.05(d). Applicant may adopt the following identification, if accurate:

Vacuum pumps, oil-free vacuum pumps, vacuum pumping systems comprised of [indicate specific goods]. (Class 7)

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); see TMEP §1402.06 *et seq.*, 1402.07.

For your assistance and convenience, the "Acceptable Identifications of Goods and Services Manual" may be searched at the Office's global network computer website address of <http://www.uspto.gov/web/trm/mim.html>.

**FAILURE TO RESPOND—ABANDONMENT OF GOODS**

If applicant does not respond to this Office action within the six-month period for response, **the following goods in International Class(es) 7 will be deleted from the application: vacuum pumping systems**. The application will then proceed with the following goods in International Class(es) 7 only: Vacuum pumps, oil-free vacuum pumps. See 37 C.F.R. §2.65(a)-(a)(1); TMEP §718.02(a).

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 4. Russia

Examination Procedure	Absolute and relative grounds.
Time Limit for Responding to Provisional Refusal	<b>6 months from the date</b> of the notification of provisional refusal <b>sent by the Russian Office</b> to the applicant/representative
Republication	The Office <b>does not</b> republish notifications of international registration, subsequent designation or renewal received from the IB
Opposition Procedure	N/A (However, a so-called “informal opposition” can be filed at the examination stage.)
Local representation	Required (when corresponding to the refusal.)

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Russia-Notes

- **Notification of Provisional Refusal is issued in French.**
- **Two types of Refusal: Total refusal or Partial refusal**
- **Description of Goods and Services**
  - The class headings **are not** acceptable.





# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 5. Japan

Examination Procedure	Absolute and relative grounds
Time Limit for Responding to Provisional Refusal	3 month from date of issue of notification of provisional refusal (extendable for 1 month)
Republication	The Office <b>republishes</b> notifications of international registration, subsequent designation or renewal received from the IB
Opposition Procedure	Post-grant opposition period 2 months from publication in the National Official Gazette of Trademarks (non-extendable).
Local representation	Required (when corresponding to the refusal.)

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Japan-Notes (1)

- JPO issues **only Total Refusal** (**No partial refusal** is issued, even if the provisional refusal concerns some of goods/services) – If you do **not** take any action against the refusal, protection in Japan is **totally refused**.
- Basically, the Class Headings are **not** acceptable.
- Provisional Refusal is issued when an overly broad range of goods/services (basically **more than 8 similar group codes**) are designated in each class:  
Three measures to overcome:
  - (1) Establishing that the Holder is carrying out the business connected with the designated goods/services in Japan using material evidence and arguments;
  - (2) Restricting goods/services so that the number of “Similar Group Codes” can be **7 or less** per class;
  - (3) Submitting documentary evidence (both “Declaration of Intent-to-Use the mark” and “Business Plans”) in connection with the designated goods/ services.
- The Examiner may suggest an amendment at Item VI in the Notification, but it is **just an Example**.

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Japan-Notes (2)

### ▪ Second Part of the Individual Fee

-JPO, as well as Cuba, has adopted an individual fee **consisting of two parts** in accordance with Rule 4(3)(a) of the Common Regulations under the Madrid Protocol.

-If the second part of the individual fee is not paid within the prescribed period, **the designation of Japan** in the international registration **will be cancelled**.

-The second part of the individual fee has to be paid within the prescribed period mentioned in the "NOTIFICATION OF SECOND PART OF INDIVIDUAL FEE" which will be sent by IB with "STATEMENT OF GRANT OF PROTECTION.

-The second part of the individual fee has to be paid **directly to the IB of WIPO**, not to the **JPO** . (Japanese Attorneys **cannot** pay the fees) .

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 6. Singapore

Examination Procedure	Absolute and relative grounds
Time Limit for Responding to Provisional Refusal	<b>4 months</b> from the date of notification of refusal <b>by the Singapore Office</b> (extendable).
Republication	(No information on WIPO's web site)
Opposition Procedure	<b>2 months</b> commencing on the day of publication of the mark in the National Trademark Journal (extendable).
Local representation	Hiring a local attorney is not mandatory, but an address for service in Singapore must be provided.


# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Singapore- Notes

- Two types of Refusal: Total refusal or Partial refusal
- Description of Goods and Services
  - Description “personal and social services rendered by others to meet the needs of individuals” in Class 45 is considered to be vague, and thus not acceptable.
  - The Office accepts the other class headings of the Nice Classification.

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

Singapore- Partial Refusal (example-1<sup>st</sup> page)

  
INTELLECTUAL PROPERTY  
OFFICE OF SINGAPORE



In reply please quote our reference  
Your reference : N.A.  
Our reference : 2015/1515468854Q  
Date : 08 December 2015  
Writer's direct number : +65 6330 2742

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
INTERNATIONAL REGISTRATIONS DEPARTMENT  
34, CHEMIN DES COLOMBETTES, 1211 GENEVA 20  
SWITZERLAND



Dear Sir/Madam

**NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION TO THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION ACCORDING TO ARTICLE 5 OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

- Office making the notification:**  
Intellectual Property Office of Singapore (IPOS)
- International Registration Number:**  
.
- Trade Mark Number(s) issued by the IPOS for this International Registration:**  
Trade Mark Number :  
Class Number(s) : 44
- Name of holder of the International Registration:**  
.
- Ground(s) of the Provisional Refusal:**  
Specification of goods and/or services objection  
  
5.1 We note that you have applied for protection of the mark for goods and/or services in Class 44. However, we have raised objections under rule 19(2)(b)(ii)(A) of the Trade Marks Rules as the following goods and/or services do not follow the guidelines provided under the International Classification of Goods and Services (ICGS):  
  
a) "hosting a patient support call center regarding gene and cellular immunotherapies and transplantation" - The description appears to be analogous to "call centre services (customer service or telephone answering)" in Class 35. For clarity, please consider amending to "medical consultancy services regarding gene and cellular immunotherapies and transplantation provided via a patient support call center". Alternatively, please clarify the



INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
51 Bras Basah Road, #01-01 Manulife Centre, Singapore 189554  
T +65 6339 9616 F +65 6339 0252 W www.ipos.gov.sg  
A statutory board of the Ministry of Law  
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(2<sup>nd</sup> page)

nature of the services and how it is proper to this class, or propose a rewording for our consideration.

Please note that no form or fee is required for an amendment to the specification of goods or services of an international registration designating Singapore.

**6. Goods and/or services affected by the refusal:**

This refusal applies to "hosting a patient support call center regarding gene and cellular immunotherapies and transplantation" in Class 44 of the international registration.

**7. Request for review:**

The holder of the international registration may file a request for a review of this refusal with IPOS.

The request for review must comply with the following:

- quote the International Registration number, relevant trade mark number(s), corresponding class number(s) and Singapore reference number(s).
- furnish an address for service in Singapore. The holder may appoint an agent by filing Form CM1.

Please note that any form(s) filed with the International Bureau of the World Intellectual Property Organization in response to this refusal, will not be treated as a request for a review of this refusal unless the above has been complied with.

**8. Extension of time:**

The holder may seek an extension of time to request for a review of this refusal by filing Form CM5.

**9. Deadline to observe:**



If the holder does not file a request for review or apply for an extension of time to do so by **8 April 2016**, the application for the refused goods and/or services indicated in paragraph 6 of this refusal will be treated as withdrawn (reinstatable).

**10. Reinstatement of an application that is treated as withdrawn (reinstatable):**

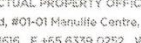

If the application becomes treated as withdrawn (reinstatable), the holder may request to reinstate the application by filing Form CM13 together with the request for review within six months from the deadline in paragraph 9.

Please note that reinstatement is not automatic. Reinstatement will be allowed only after we have conducted a new conflicting mark search and are satisfied that the mark to be reinstated does not conflict with any trade mark applications filed with IPOS prior to the filing of the required documents.

If the holder also does not request to reinstate the application in time, the application for goods and/or services that are not refused will proceed to publication.



INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
51 Bras Basah Road, #01-01 Manulife Centre, Singapore 189554  
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A statutory board of the Ministry of Law  
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# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 7. Vietnam

Examination Procedure	Absolute and relative grounds
Time Limit for Responding to Provisional Refusal	<b>3 months</b> from the date of notification of refusal <b>by the Vietnam Office.</b>
Republication	The Office <b>republishes</b> notifications of international registration, subsequent designation or renewal in the National Gazette
Opposition Procedure	The opposition period begins on the date the mark is published in the Industrial Property Gazette and ends on the date the decision is granted.
Local representation	Required (when corresponding to the refusal.)



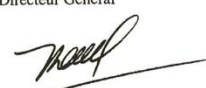
# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Vietnam - Notes

- **Notification of Provisional Refusal is issued in French.**
- **Two types of Refusal: Total refusal or Partial refusal**
- **Description of Goods and Services**
  - The class headings are acceptable.

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## Vietnam - Partial Refusal (example-1<sup>st</sup> page)

ARRANGEMENT DE MADRID CONCERNANT L'ENREGISTREMENT INTERNATIONAL DES MARQUES ET PROTOCOLE RELATIF À CET ARRANGEMENT REFUS PROVISOIRE DE PROTECTION	
notifié au Bureau international de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) conformément à la règle 17.1) du règlement d'exécution commun à l'Arrangement et au Protocole de Madrid	
I.	Office qui notifie le refus : <b>Office National de la Propriété Intellectuelle (NOIP)</b> 384-386 Nguyen Trai, Hanoi, VIETNAM
II.	No de l'enregistrement international faisant l'objet du refus : ...
III.	Nom et adresse du titulaire de l'enregistrement international faisant l'objet du refus :
IV.	Motifs du refus : La marque internationale antérieure citée:          Cl. 09,35,38,41,42,45
V.	Dispositions de la loi nationale applicables en la matière : Art. 74.2e de la Loi de la PI
VI.	<input type="checkbox"/> Refus pour la totalité des produits et services <input checked="" type="checkbox"/> Refus pour les produits et/ou services suivants : Cl. 09, 35
VII.	Recours contre la décision de refus provisoire : a) délai de recours: 3 mois à partir de l'envoi de ce refus par l'OMPI b) autorité à laquelle le recours sera adressé: <b>Office National de la Propriété Intellectuelle</b> 384-386 Nguyen Trai, Hanoi, VIETNAM c) assistance d'un mandataire local obligatoire: un mandataire en propriété industrielle au Vietnam
VIII.	Date à laquelle le refus a été prononcé : <b>27 Novembre 2015</b> 2014/47 TDH13
IX.	Signature ou sceau officiel de l'Office qui notifie le refus : Directeur Général   Tran Viet Thanh

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## 8. Republic of Korea (South Korea)

Examination Procedure	Absolute and relative grounds
Time Limit for Responding to Provisional Refusal	<b>2 months</b> from the date on which the refusal was issued (extendable).
Republication	The Office <b>republishes</b> notifications of international registration and subsequent designation or renewal received from the International Bureau, where there are no reasons for refusal
Opposition Procedure	2 months from the date of <b>national</b> publication.
Local representation	Required (when corresponding to the refusal.)

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## South Korea- Notes

- KIPO issues **only Total Refusal** (**No partial refusal** is issued, even if the provisional refusal concerns some of goods/services) – If you do **not** take any action against the refusal, protection in South Korea is **totally refused**.
- The Office **does not** accept all the alphabetical lists of goods/services in the NICE classification

# Responding to the Notification of Provisional refusal from the Designated Contracting Party (DCP), etc.

## South Korea (example)

Issuing number: 8-5-2015-004386305      34, chemin des Colombettes P.O.Box 181211  
Issuing date: 11/12/2015      Geneva 20, Switzerland  
World Intellectual Property  
Organization(WIPO)International Bureau

NOTIFICATION OF EX OFFICIO PROVISIONAL REFUSAL  
TO THE INTERNATIONAL BUREAU OF WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)  
UNDER RULE 17(1) OF THE COMMON REGULATIONS

1. Office Making the Notification:

Korean Intellectual Property Office (KIPO)  
189 Cheongsu-ro, Seo-gu, Daejeon Metropolitan City, 35208, Republic of Korea

2. International Registration Number (Date of Registration/Subsequent Designation):

3. Name and Address of the Holder:

4. Goods/Services Affected by this Provisional Refusal:

All the designated goods/services

※ Please note that there is no provision in the Korean Trademark Act allowing the examiner to delete Ex Officio the designated goods/services refused by the ground(s) for the Provisional Refusal and to grant protection for the remaining goods/services.

5. Grounds for the Decision:

- Lack of distinctiveness
- Conflict with another person's earlier application(s) and/or registration(s)
- Vagueness and/or broadness of the designated goods/services
- Unconformity to "a single application for a single trademark rule"
- Other grounds

※ Please refer to item 9 for the details

6. Provisions of the Korean Trademark Act applicable to the Grounds:

Article 10(1)

7. Date on which the Provisional Refusal was pronounced (Time Limit):

11/12/2015(11/02/2016)

# Maintenance Requirement

## United States

- Affidavit/declaration of use in commerce is required to be filed with **USPTO**
  - between fifth and sixth year after issuance of Certificate of Registered Extension of Protection;
  - before the expiration of 10th year after registration; and
  - all subsequent 10-year intervals from the date of the registration of the extension of protection.

## Philippines

- Declarations of actual use of the mark with evidence is required to be filed with **the Office of the Philippines,**
  - within 3 year from the date of the international registration or the date of the recordal of the subsequent designation of the Philippines;
  - within 1 year following 5 years from the date on which protection was granted in the Philippines; and
  - within 1 year following 5 years from the date of each renewal of the international registration.

# Replacement

- Where you have a prior national/regional registration with a Madrid member, you may request replacement
- May reduce costs related to renewals and local agents
- Requirements:
  - Both registrations must be the name of the same holder
  - Protection of the IR extends to the said CP
  - All the G&S in the prior registration are also listed in the IR
- You may request the Office to take note in its Register, to alert 3rd parties of your continuation of rights
- More details in Article 4*bis* and Rule 21



Thank you  
for your attention

Contact:  
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Web: <http://www.isshiki.com/index.html>