

■ Roundtable

Corrections in the International Register (IR)

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**Geneva,
November 5, 2015**

Discussion points

- Legal framework - Rule 28 of the Common Regulations
- Status in Operation Division and improvement plans
- Operational challenges related to corrections
 - What are we receiving? Requests to correct:
 - Errors by the IB (obvious, not clear)
 - Errors by Offices (correctible within 9 months, correctible after 9 months)

Rule 28 (I)

- 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 IR

Rule 28 (II)

- No time limit for correction if the error is done by the IB
- No correction of errors made by the holder
- Notifications are sent to the holder, Designated Offices and the Office of Origin (if the request was not coming from a Designated Office)
- Offices can refuse the correction:
Rules 16 and 18ter apply

Status in Operations Division

- 2080 pending corrections
- Most of them from 2014 and 2015
- The IB receives 7 - 238 correction requests per week
- The average number is 130 per week

Further improvements

- Thoroughly analyze all incoming requests
- Improve the communication to users and Offices
- Form for requesting a correction

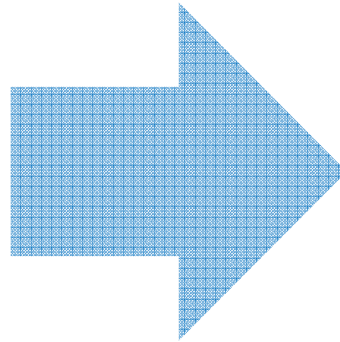
Operational challenges and requests for corrections

- No official form – letters and emails
- New optional form will be available soon
- From holders/applicants, Offices, internal & third parties
- All requests need to be analyzed
- Many are not acceptable

Processing corrections (I)

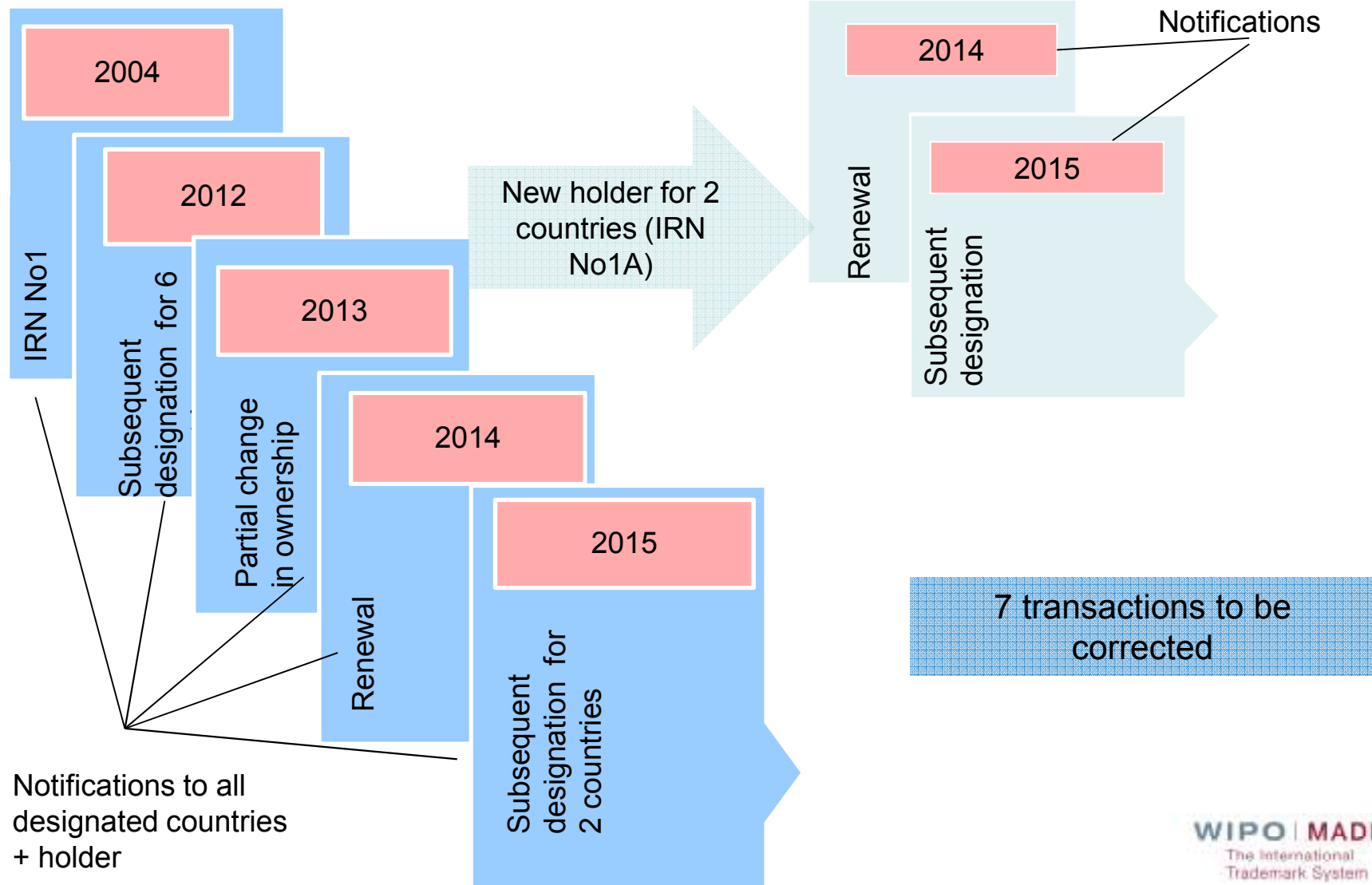
2015

Request for correction in
list of goods and services
(from 2004). Nice ed. 8



IB actions?

Processing corrections (II)



What can be corrected

- An error in a fact recorded in the IR
- An error can relate to any transaction and to any of the information recorded in the IR
- Requests to cancel/modify/expand/limit MM forms before they have been recorded in the IR **cannot** be considered a correction
- Such requests by holders or Offices should be processed as part of the initial request to which they relate

Who can make errors?

- Errors can be made by the IB or the Office of the contracting party
- Mistakes by holders are not errors from the correction process point of view

IB errors

- IB errors
 - Obviously correctable
 - Not clear (rule 12 and rule 13)

IB errors – clearly correctible (I)

Dear Sir or Madam,

We notify that the notification of aforesaid international registration contains an error concerning the name of the holder.

The name of the holder has to be registered as follows (blank space between “h.c.” and “F.”):

Dr. Ing. h.c. F. Porsche Aktiengesellschaft

IB errors – clearly correctible (II)

Incorrect Information:

511 International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) - NCL(10-2015)

01 Chemical additives for food; chemical ingredients for use in the manufacture of foods; chemical preparations for use as ingredients for foods; chemical preparations for use in the food industry.

05 Nutritive substances; dietetic foods and supplements; medicated food additives and supplements; dietary supplements; all of the aforesaid goods including omega-3 (**dha**) oils, oils from fish, algae and plant sources including those in oil or microencapsulated form.

29 Edible oils and fats including omega-3 (**dha**) oils, oils from fish, algae and plant sources, including those in oil or microencapsulated form.

Correct Information:

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IB errors in List of Goods & Services (I)

- Requests related to rule 12 and 13 of the Common Regulations.
- Should this always be accepted? Currently no time limits to request a correction in such cases apply

IB errors in List of Goods & Services (II)

■ Requests by Offices received in the IB in 2015:

No 1 'Vitamin beverages' is classified in 32; should be in Class 5 based on the entry in the Alphabetical List for 'Vitamin preparations' in Class 5

Date of international trade mark registration – 2013

Number of designated countries – 55. Currently protection granted in 36

No 2 'Interior design of yachts and private jets' is classified in Class 37; should be in Class 42 based on the entry in the Alphabetical List for 'design of interior decor' in Class 42

Date of international trade mark registration – 2012

Number of designated countries – 15. Currently protection granted in 12

Errors by Offices (I)

■ Errors correctible anytime:

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

■ Correctible within 9 months:

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.

■ Not clear?

Errors by Offices – correctible within 9 months (I)

Due to a clerical error made by our Office, the following data was omitted from the file that was transmitted to you:

On 26/11/2013, the Office sent a Notification of ceasing of Effect, in which class 24 was removed (published by WIPO on 10/04/2014, 2014/13 Gaz). However, as there was an appeal pending, class 24 should not have been removed. Therefore, please reinsert class 24 in the list of goods and services.

Please proceed to the necessary correction in the International trade mark Register accordingly.

Errors by Offices – correctible within 9 months (II)

Due to a clerical error made by our Office, the following data was omitted from the file that was transmitted to you:

Please add Belarus (BY) to the list of designated countries.

Please proceed to the necessary correction in the International trade mark Register accordingly.

Errors by Offices – correctible anytime

Dear Sir or Madam,

We notify that the application for international registration contained an error concerning the address of the holder.

The address of the holder has to be registered as follows:

Wegenerstraße 13
89231 Neu-Ulm

We therefore ask you to be so kind and rectify the International Register accordingly.

Errors by Offices – not clear

■ Substantial?

Dear Sir/Madam

This Office incorrectly filed IR **1260073** based on **Australian** TM 1571075. The IR application was forwarded to WIPO stating that the mark was a **Collective mark, certificate mark or guarantee mark**. This was a certification error on this Office's part and the mark should have been filed as an Individual mark. It would be appreciated if all reference to **Collective mark, certificate mark or guarantee mark** could be removed from the application as this is now causing issues with examination in the designated countries. It would be appreciated if you could confirm that this correction can be actioned at this stage.

I apologize for any inconvenience caused and please contact me if you require any additional information in order to complete this correction

Errors by Offices – not clear

■ Requests from Offices regarding mistakes by holders:

In chapter 9e (description of the mark) and in chapter 9f (verbal elements of the mark) is has to be changed so it will have the following ammadments (anything has to be erased is marked as Bald and underlined):

Either the word "oeight" and **or** the logo which consists of the letter O and the number 8 where the 8 is joined at the bottom right of the letter O (the number 8 is smaller in scale to the letter O). There is also on the top right, not connected to the letter O, a curved line from the upper right to the lower left. **The logo and the word "oeight" can be together or separate.**