Roundtable
Irregularities

Asta Valdimarsdottir
Director, Operations Division, Madrid Registry
Brands and Designs Sector
WIPO

Geneva,
November 5, 2015
International Applications - Irregularities

Total Number of International Applications: 32,008 (January - August 2015)

- International applications with no errors: 20,948; 65%
- International applications with errors: 11,060; 35%
Breakdown of Irregularity letters in the Madrid system (January – August 2015)

- International applications filed: 32,008
- Total Number of Errors: 11,060
- Total Number of Irregularity Letters: 11,623

**Errors related to Rule 12 (Classification):**
- 770; 7%

**Errors related to Rule 13 (Indications of G&S):**
- 4'381; 38%

**Other Errors related to Rule 11(4) (Administrative errors):**
- 847; 7%

**Errors related to Rule 11(3) (Fees):**
- 2'509; 21%

**Applications with multiple errors:**
- 3'116; 27%
Classification

- Important part of the registration process

- Specify the products and services to which a trademark will apply and defines the scope of protection the trademark will enjoy
Classification is a balancing act

- Terminology that describe the products/services precisely enough – not too narrow and not too broad

- Avoid irregularities from the IB and refusals in designated Contracting Parties
Classification – role of the IB

- The IB shall register the international applications “with the classifications and grouping that the IB considers to be correct”.

- Different practices among Contracting Parties
The IB principles – Classification of G&S

- Alphabetical list of the NICE classification
- Explanatory notes to the NICE classification
- The “General remarks” for G&S in the NICE classification
- The class number defines the scope of the product/service (with exceptions)
- Internal guidelines
Principles – Classification of G&S

- Internal guidelines - examples
- Singular/Plural terms
- AU, GB or US English accepted indifferently
- Brackets and inversions
- Doubles

- Obvious spelling errors – correct ex officio?
Examples - irregularities

Too vague terms

IT services in class 42

Incomprehensible terms – Rule 13(2)(b)

- “administrative goods and office wares” in class 35
- “unti-inject water pipe month” in class 7

Linguistically incorrect/ incomprehensible - Irregularities?

- “live jackets” in class 9 > “life jackets”
- “jackets of hood” in class 25 > “hooded jackets”
Inconsistent practices - examples

- Nice alphabetical list
  - Many Contracting Parties accept the full list
  - Some Contracting Parties reject terms in the list
- Nice class headings
  - Many Contracting Parties accept all the terms in the Class headings
  - Some Contracting Parties reject terms
- Brackets
  - Acceptable or not
- Duplicates
  - Accepted or not
Discrepancy?

- Five of the eleven terms are rejected by OHIM but will not change in the Nice version 2016

- Class 7: machines and machine tools
- Class 37: repair
- Class 37: installation services
- Class 40: treatment of materials
- Class 45: personal and social services rendered by others to meet the needs of individuals

- Terms accepted by WIPO but refused by EU states and OHIM
Discrepancy?

- 6 terms were changed *in the class headings*, examples:
  - plastic materials for packaging [not included in other classes] > plastic materials for packaging
  - …precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes > precious metals and their alloys

- Are the old terms acceptable?