



Internal Oversight Division

Reference: IOD-INV-2018-15

Management Implication Report

February 12, 2018

1. FACTS

1. As part of a recent inquiry, the Internal Oversight Division (IOD) found that changes to an international trademark record had been made *ex officio* by the International Bureau to correct an error in the classification of some of the goods for which protection had been sought.
2. Specifically:
 - (a) A Contracting Party (national office) notified the International Bureau of its refusal to grant protection in view of a partial classification error;
 - (b) Internal discussions followed in the Madrid Registry team, which resulted in a conclusion that some of the goods for which trademark protection was sought had indeed been registered under the wrong class;
 - (c) The International Bureau corrected the International Registry accordingly, *ex officio* under the provisions of Rule 28 of the Common Regulations and the Guide to the International Registration of Marks, Part B, Chapter II, paragraphs 70.01 and 70.02(b); and
 - (d) The correction involved an additional class of protection, and the corresponding additional registration fee was charged to the holder.

2. ISSUES

3. Irrespective of the substantive propriety of the correction made in this case, the following potential systemic issues were identified by IOD:

(A) PROCEDURAL COMPLIANCE

4. The Guide to the International Registration of Marks, Part B, Chapter II, paragraph 70.02(b) provides:

“Where there is an obvious error in the International Register and the correction sought is likewise obvious, in the sense that a reader would recognize that there was an error and that nothing else could have been intended other than what is offered as the correction, the error will be corrected as soon as it comes to the attention of the International Bureau”.

5. However in the present case, based on the documentation available, IOD observed that:

- (a) While some national offices refused to grant protection, others processed the application without objecting to the registration classes chosen; and
 - (b) The holder of the international registration consistently disputed, on technical grounds, the propriety of the correction made.

6. Overall, the documentation reviewed by IOD in relation to this *ex officio* correction lacks clarity as to why the error in question was rightfully considered as “obvious”.

(B) CLIENT SERVICE AND REPUTATION

7. In addition, the practice of effecting *ex officio* corrections to the International Register without prior consultation and/or notification of the concerned holder(s) may carry a risk of client dissatisfaction, especially when the corrections made affect the scope of the protection or entail additional costs to the holder.

3. RECOMMENDATION

8. In view of the foregoing:

The Madrid Registry should reexamine, and revise if and as appropriate, its practice of correcting "obvious errors"¹ in the International Register. In particular, whenever such corrections are requested or otherwise envisaged, additional consideration should be given to: (1) justification of the "obvious" nature of the correction; and (2) adequate and timely communication with holders when the correction may affect the scope of the protection or entail additional fees.

(Importance: High)

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¹ Within the meaning and as per provisions of the Guide to the International Registration of Marks, Part B, Chapter II, paragraph 70.02(b).

TABLE OF RECOMMENDATIONS

No.	Recommendation	Responsible unit/manager	Deadline for implementation	Management comment and action plan
1	<p>The Madrid Registry should reexamine, and revise if and as appropriate, its practice of correcting “obvious errors” in the International Register. In particular, whenever such corrections are requested or otherwise envisaged, additional consideration should be given to: (1) justification of the “obvious” nature of the correction; and (2) adequate and timely communication with holders when the correction may affect the scope of the protection or entail additional fees.</p> <p>(Importance: High)</p>	Mr. Qiangqiang Li, Principal Examiner, in cooperation with (1) Ms. Xiaoling Pei, Quality and Training Officer; and (2) Mr. Fabio Scappaticci, Business Project Manager.	June 2019	<ol style="list-style-type: none">1. The operational documentation, in particular the applicable Standard Operating Procedures, need to be revised to reflect more faithfully the standard of review for corrections as provided for in the applicants guide.2. Examiners need to be sensitized to the need to comply with the updated documentation.3. Examiners should be encouraged to seek advice from the Goods and Services Database Section for the purpose of deciding whether the standard of review for corrections has been met in the case of issues concerning Rule 12.4. Before implementing the change in the Register, examiners should communicate with holders about the intended correction.5. If the holder resists the intended correction, the Madrid Legal Division should be consulted before making a final decision.6. If the final decision is to implement the intended correction against the wishes of the holder, this should be first discussed between the Legal Division and the holder.