



# TRADEMARK EXAMINATION MANUAL 2023

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**Royal Government of Bhutan**

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## **1. INTRODUCTION**

The Trademark Registry under the Department of Media, Creative Industry and Intellectual Property are responsible for the registration, protection and promotion of trademarks in the country. It was established in 1997 becoming the first registry to register IP (Intellectual Property) titles. The trademark registration system is governed by the Industrial Property Act of the Kingdom of Bhutan 2001, the Industrial Property Rules 2001 and WIPO (World Intellectual Property Organization) administered treaties and agreements to which Bhutan is a member viz. Paris Convention for Protection of Industrial Property, Madrid Agreement Concerning the International Registration of Marks and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

The registration of trademark applications is technical and legal in nature. As such, the trademark examiners or IP officials require a sound knowledge of the trademark subject matter as well as of the registration system which comprises various examination phases viz. formality examination, substantive examination, publication, opposition, refusals, etc.

With the gradual increase in trademark filings both from national as well as international applicants, it has become imperative for the registry to develop this manual to assist the trademark examiners in their critical role of examining trademark applications. As a comprehensive guide, the manual encompasses 11 chapters with detailed information on practices and procedures relating to filing, examination, registration etc. It spells out step-by-step procedures to be followed in the registration of trademarks. Further, the classification procedures set out in this manual are based on the best practice of the registry and trademark offices around the world. In addition, simplified key procedures of the Madrid system such as procedures to be followed as Office of Origin and Office of Designated contracting party are clearly spelled out in the manual.

This manual would be a valuable resource for trademark examiners equipping them with adequate information to enable them to make informed and consistent examination decisions thereby leading to a high-quality trademark registration system.

## 2. CHAPTER 1: GENERAL INFORMATION

### 1.1. *Contacts of the office*

Industrial Property Division  
Department of Media, Creative Industry and Intellectual Property  
Ministry of Industry, Commerce and Employment  
Thimphu  
P.O Box 140

### 1.2. *Business hours*

The Registry is open to the public from 9.00 am to 1.00 pm and 2.00 pm to 5.00 pm each day from Monday to Friday. If the last day for filing a document falls on a Saturday, a Sunday or on a public holiday, the document may be filed on the next day following the Saturday, Sunday or public holiday.

### 1.3. *Who may apply for a mark?*

The following are eligible to apply for a mark:

- *A person who uses or intends to use the mark on the product or services for commercial purposes;*
- *“Person” includes an individual, a company, an incorporated or unincorporated body of persons, society, partnerships firms, government, a Trust etc.*
- ***Company:** A company shall make an application for registration of a mark in its corporate name.*
- ***A Partnership/Joint Venture/other Firm:** An application from a partnership may be filed in the name of the partnership firm, or in the names of the partners in the partnership. However, any new addition or deletion of the name of a partner subsequent to the date of application will mean a change in the partnership.*
- ***Joint Applicants/Owners:** Application may be made in the name of two or more persons as joint owners of the mark. The terms “joint applicants” or “joint owners” reflects the relationship of multiple applicants as to a particular mark, but do not identify a particular type of legal entity. Joint*

*applicants are not the same as a joint venture or a partnership. A joint venture or a partnership is a single business applicant that owns the mark.*

- **Trust:** *Application shall be made in the name of a trust, represented by its managing trustee/chairman etc trading as XYZ.*
- **Government:** *Any undertaking/company owned or controlled by Government shall make an application for registration of the mark in the name of the undertaking or company.*

### **1.3.1. Foreign applicants**

Where an applicant's ordinary residence or principal place of business is outside Bhutan, the application shall be routed through a legal practitioner resident and practising in Bhutan or a person registered in the prescribed manner as an industrial property agent.

The appointment of an agent shall be by a power of attorney on Form 16 which shall be signed by the applicant or, if there are more than one, by each applicant.

The address of the agent shall, for all purposes connected with the Act and Rules be treated as the address to which communications to the person or persons who appointed the agent shall be transmitted.

### **1.4. Fees payable**

*Section 26(1), Rule 37*

- 1.4.1.** The regulations prescribe the fees payable in respect of items listed in the fee schedule
- 1.4.2.** The applicant shall produce the original receipt of the payment along with the documents.
- 1.4.3.** Each document shall be checked to determine whether or not the full fee that it attracts has been paid. This involves checking the original receipt along with the documents and fees payable against each Form.

**1.4.4.** After confirming the correct fees, a copy of the receipt shall be kept in the application file.

## **1.5. Classification of goods/services**

### *Rule 36*

**1.5.1. The Purpose of the Classification:** The applications should contain the details of goods and services classified according to the Nice classification. This is to facilitate searching for the same/similar earlier marks. Goods and services are classified based on the Nice edition in effect at the time of application. Changes are not made retrospectively to existing registrations or applications.

**1.5.2. A clear and accurate description** of the goods and/or services claimed is an important aspect of any trademark application, because it determines the scope of the application and any resulting registration.

**1.5.3. Correct classification** of the goods and/or services claimed is also important because it facilitates accurate searching for conflicting trademarks. While the office provides information on classification matters, the onus is on the owner or their agent to describe their goods and/or services correctly and to apply for registration in the correct classes.

## **1.6. Industrial Property Administration System (IPAS)**

IPAS is a system that is being used to automate the procedures in the registration of marks. Except for receiving the applications and documents in hard copy, the procedures following these documents are processed in the IPAS. The reports are generated by the system in which the templates are inserted into the server. For the purpose of using this system, separate training along with the understanding of the workflow of trademark registration shall be required for the new users.

## **1.7. Electronic Document Management System (EDMS)**

EDMS is a file storage software set up to store the increasing number of applications and to address the space constraint in storing physical files. It is also developed to function as a backup of the files as the physical files become unusable after a certain period. Unlike in the past, where physical files were referred to in processing trademark registration, the EDMS enabled the office to view the files electronically.

### 3. CHAPTER 2: FILING REQUIREMENTS FOR AN APPLICATION

*Sections 26, 30, Rules 37, 38, 39, 40, 43*

#### 2.1. **Application for registration shall be made as below:**

- 2.1.1. The application shall be on TM Form 7 in hard copy.
- 2.1.2. The details in the form must be in English.
- 2.1.3. The details must be neatly handwritten or typewritten or printed on A4 size papers.
- 2.1.4. Except in the case of affidavits, the contents of the documents must be provided only on one side of each sheet.
- 2.1.5. Clear Representation of all the marks within the specified size of 8cmx8cm.
- 2.1.6. If the application relates to a Collective Mark:
  - *it should be indicated in the application form and*
  - *submit the Regulations governing the use of the collective mark*
- 2.1.7. Description of the mark specifying/ identifying the features in the representation that is claimed for registration.
- 2.1.8. If the mark is Non-English words/characters:
  - *Translation of each word(s)/ characters and the word(s)/ characters taken together as a whole (translation will indicate its meaning if any in the English language)*
  - *Transliteration of words/characters (A transliteration will indicate what the word sounds like in the original language in English)*
- 2.1.9. If colours are claimed, description and specification of the colours should be filed and the represented mark should be in colours.
- 2.1.10. If the applicant wishes to disclaim the right to exclusive use of any part of the mark or limit the rights under the claimed mark, the applicant can do so. However, it is not mandatory and the applicant may be asked to during the examination.

**2.1.11.** If an application claims priority(6 months) under the Paris Convention a declaration shall be required in accordance with Annexure A (i) & (ii) of the application form. The following details shall be required to claim priority:

- *the date of the earlier application (mandatory during declaration)*
- *the State/office in which the earlier application was filed (mandatory during declaration)*
- *the number of the earlier application (may submit during the declaration if known or within the next 3 month)*
- *Class numbers and specifications of the earlier applications (may submit during the declaration if known or within the next 3 months)*
- *A certified copy of the earlier application(s), goods/services, together with translation where necessary may be submitted during the declaration or submitted within the next 3 months or may request for further time extension.*

**2.1.12.** Nice Class number and the Specifications of goods and/or services for which the registration is sought. A single application can contain more than one class.

Example of correct classification:

- *Class 29: Dairy products namely cheese*
- *Class 41: Provision of sports facilities, all being outdoors.*

The Nice class numbers above are Class 29 and Class 41.

The specifications against the class numbers are Dairy products namely cheese and the Provision of sports facilities, all being outdoors.

**2.1.13.** The required filing fee shall be paid along with the application and for multi-class applications, fees payable shall be multiplied by the number of classes. A copy of the fee receipt shall be retained with the office for records.

**2.1.14.** Applicant details shall contain the following

- Full name
- Address (including Postal Code and country)
- Nationality
- Telephone/Mobile No (with area code)
- Fax No (with area code)
- Email address
- Details if it relates to the following

- If the body is corporate, give the corporate name and country of incorporation.
- In the case of Partnership, give names and nationality of all partners, the trading style and the nature of registration.
- In the case of Trust, give the names of the Managing Trustees.
- If there is more than 1 address, state the fact and give the address of the principal place of business.
- Country of incorporation/constitution: Country and location where the business is established
- Trade Description (should be ticked): Merchant/Manufacturer/Service Provider

**2.1.15.** If the applicant has neither a place of business nor residence in Bhutan an Agent is required with the following details:

- Name of Agent
- Addresses (including Pin/Postal code and Country)
- Nationality
- Telephone/Mobile No (with area code)
- Fax No (with area code)
- Email address
- Power of Attorney (POA) may be attached, or the applicant can make a reference to the General Power of Attorney already existing with the office. Further, if the POA is not available during the filing of an application, the agent can be furnished within 2 months from the filing.

**2.1.16.** Declaration mentioning the dates of Use and Intended use of the mark should be indicated.

**2.1.17.** The application form shall be signed by the applicant and if an agent is used, the application may be signed by the agent.

***Office action:***

- The office shall calculate the fees based on the fee schedule prescribed under the Rules and issue authorisation for payment of fees under the revenue head FAIPR in RTIO, Thimphu.
- The office shall check whether all the requirements above have been completed by the applicant during the filing of an application
- Upon fulfilling the above requirements an application number and a

filing date generated by IPAS shall be issued. The application number and filing date shall be printed on the first page of the application and issue a copy of the application to the applicant and retain the original copy in the file.

- If the application is filed without or with insufficient fees, it shall be deemed not to have been filed.
- No application number or filing date will be issued otherwise

#### **4. CHAPTER 3: DATA CAPTURE & MAINTENANCE OF FILES**

##### **3.1. *Data capturing in IPAS***

**3.1.1.** All the information from the application on Form 7 shall be appropriately captured into the IPAS

**3.1.2.** In case of marks with figurative elements, the mark shall be scanned appropriately and uploaded into the IPAS

##### **3.2. *Scanning for EDMS***

**3.2.1.** All the documents relating to an application will be scanned and uploaded with specific files.

**3.2.2.** The documents above would include both input and output documents relating to a trademark application.

##### **3.3. *Maintenance of files***

**3.3.1.** After the information from an application is captured into the IPAS, a file is created for an application and the application number shall be marked on the cover of the file.

**3.3.2.** All other input and output documents relating to the particular application shall be filed in the specific file.

## 5. CHAPTER 4: FORMALITIES EXAMINATION

### *Sections 27 (1) (a)*

The office examines applications to confirm that they contain the essential minimum data specified by the trademark regulations. These data include:

#### 4.1. *Review of the application form 7*

##### 4.1.1. Representation of the Mark

###### 4.1.1.1. *Word marks:*

A word mark includes letters (either lower or upper case), words (either in lower or upper case letters), numerals or punctuation marks. The mark represented shall be typewritten and clear.


*Examples:*

- *you,*
- *DON'T DREAM IT*
- *DRIVE IT*
- *? WHAT IF!*
- *TS 840*

###### 4.1.1.2. *Figurative marks:*

- a) A figurative mark consists of
  - exclusively figurative elements;
  - a combination of verbal and figurative;
  - verbal elements in non-standard fonts;
  - verbal elements in colour;
  - letters from non-English alphabets;
  - Combinations of the above.
- b) The representation must be clear and within the specified size (8cm X 8cm)
- c) Be of quality that ensures all the features of the mark are clear and suitable for reproduction.
- d) Check the description of the mark specifying the features in the representation that is claimed for registration. This would normally apply if the mark has many features such as the shapes/packaging/colours etc. which are difficult for the examiners to comprehend as to what is actually the mark that is to be registered. The description provided will be the endorsements and, taken together with the representation, will help to define the scope of the registration.

*Example:*

Mark	Description of the mark
	The word “Rishta” in a stylised script on a diamond-shaped background with a shadow effect and the words “Premium Quality” in a smaller font on a rectangular block positioned above the word “Rishta” and below the upper point of the diamond shape.

#### **4.1.2. Classification of figurative elements of the mark.**

At this stage, after having checked the clarity with the representations, the marks with figurative elements shall be classified according to the Vienna Classification. The figurative elements are classified to ensure:

- Proper search of the databases during examination using the codes provided under the classification.
- For the purpose of classifying under the Vienna Classification, the latest version of the classification will be used.

#### **4.1.3. If the mark is Non-English words/character**

**4.1.3.1. Derivation/invented:** May normally apply to the words/characters marks. If the marks are not an ordinary words/characters, the office must ensure that the applicant mentions the source of the words/characters as to whether the mark is from certain language or if it’s an invented.

**4.1.3.2. Representation of words/characters:** These words/characters must be written in the form clearly.

**4.1.3.3. Translation of each word(s)/ characters and the word(s)/ characters taken together as a whole:** If these words/characters can be translated, the translation must be for each word(s)/ characters followed by the translation of all the word(s)/ characters together and show the meaning.

*Example of translation*

French word	Translation
BONJOUR	hello, good morning, good afternoon, regards

- 4.1.3.4. Transliteration of words/characters:** Ensure that the text that are not English to be transliterated to English. Example if the mark is Chinese or Japanese characters, the applicant has to provide transliteration in English.

*Example of representation of characters, translation and transliteration of marks*

Chinese representation	characters	Transliteration	Translation
华		Hua	magnificent, splendid, flowery
文		Wen	language, culture, writing
华文		Hua Wen	Chinese language

Japanese representation	characters	Transliteration	Translation
アップル		APPURU	Apple
硝子		GARASU	Glass

**4.1.4. If the mark claims colours the following shall be checked:**

**4.1.4.1.** Represented mark should be in that colour

**4.1.4.2.** Description of colour components in the mark

*Example: The mark consists of a red colour applied to upper half of the bottle, and a green colour applied to lower half as illustrated in the representation on the application.*

**4.1.4.3.** Specification of colour codes, if any

*Example: Green, Pantone 368 C, anthracite, Pantone 425 C, orange, Pantone 021 C*

**4.1.5. If the application has claimed Priority (6 months) under the Paris Convention, the following shall be checked:**

**4.1.5.1.** Whether a declaration is completed in Annexure A (i) & (ii) of the application form.

**4.1.5.2.** The date of the earlier application

**4.1.5.3.** The State/office in which the earlier application was filed

**4.1.5.4.** Ensure that the number of the earlier application is available within 3 months from the filing date if it's not mentioned during the filing

**4.1.5.5.** Ensure that the class numbers and specifications of the earlier applications are submitted within 3 months from the filing date if it's not submitted during the filing.

**4.1.5.6.** Ensure that the copies of the earlier application(s), goods/services are:

- Certified by that country's office
- Translated into English
- Submitted within the 3 months from the filing date or within the date of time extension if any.

**4.1.6. Checking the Nice Class number and the specifications of goods and/or services.**

**4.1.6.1.** Checks that each of the goods and services is clear and precise enough;

**4.1.6.2.** Checks that each term is proper to the class in which it is applied for;

**4.1.6.3.** Check the specification in relation to the class number

*Example: if the application contains the following classification:*

- Class 29: Dairy products namely cheese
- Class 41: Provision of sports facilities, all being outdoors

*Check specification in class 29 whether it relates to Dairy products and Check specification in class 41 whether it relates Sports services.*

*Example: if the application contains the following classification:*

- Class 33: Beer, wine and tea

Check the term under class 33 which only contains Wine, thus the classification should be corrected as below:

- Class 30: Tea
- Class 32: Beer
- Class 33: Wine

Where the class numbers and specification do not match and additional class (es) are involved, an additional class fee is payable for each additional class and has to be paid within 30 days to retain the filing date.

**4.1.7. Checking the fees payable as follows:**

**4.1.7.1.** Copy of the money receipt

**4.1.7.2.** Tally the total amount in line with the number of classes

*Example: if an application relates to 1 class, the fees payable is Nu. 1000, and if an application relates to 45 classes, the fees payable is Nu. 45,000 (1000x45)*

#### 4.1.8. Applicant in the application must be identified correctly.

The person applying the trademark must be identified clearly as failure to properly identify the proprietor of the trademark may cause difficulties in future actions concerning the trademark such as citations in the course of examination, questions of proprietorships etc.

Full name of the Applicant, i.e., the name of the individual, corporation, partnership, or other entity that owns the mark, not the person or firm completing the application

should be identified. Further, the correct address of the applicant which will be included in the registration certificate should be ensured.

The office should ensure that the proprietor of the trademark is provided in an application according to the standards below:

- **Individual:** The **Full** name of the applicant is required, such as the Last Name, First Name, Middle Initial/Name and the application must set forth either the business address or the residence address
- **Companies:** The **Full** name under which a company is incorporated is required accompanied by business address.
- **Partnership/Joint venture/other Firm:** If a partnership, joint venture, or other firm has been organized under a particular business name, the application should be filed in that name. If it has not been organized under a business name, the names of the members should be listed as though they composed a company name. Further, the address of the business needs to be set forth and not the addresses of the partners or members.
- **Joint owners:** If joint or multiple applicants own the mark, the application must name each of the joint applicants, and must set forth the citizenship (or the state or nation of organization) of each of the joint applicants. An application by joint applicants must be verified by all the applicants, since they are individual parties and not a single entity. The application should also include addresses of each applicant.
- **Trust:** Where the applicant is a trust the application shall be made in the name of a trust, represented by its managing trustee/chairman etc trading as XYZ.
- **Government Departments:** Where the applicant is a government department, full name of the department followed by 'Royal Government of Bhutan'

**4.1.9. If the applicant has neither a place of business nor residence in Bhutan an Agent is required with the following details:**

- 4.1.9.1. The agent/address for service provided in the application should be those which are registered with the DOMCIIP for all the international applications filed under National filing system unless an international applicant has a commercial establishment or is a resident of Bhutan.
- 4.1.9.2. Details of the agents listed in the application and the Power of Attorney shall be cross checked.
- 4.1.9.3. If the Power of Attorney (PoA) is not attached, nor a reference to the General Power of Attorney already existing with the office is made during the filing of application, the office shall ensure that the PoA is filed within 2 months from the filing date.

**4.1.10. Declaration and signatures**

- 4.1.10.1. Ensure that the dates of Use and Intended use of the mark is indicated in the declaration
- 4.1.10.2. Application shall be signed and dated through a declaration in the form by the Applicant/Agent.
- 4.1.10.3. When an agent is used by Joint applicants, verification from each applicant is required. Verification can be in the form of signing the Power of Attorney by all the applicants.

**4.1.11. Application for Registration of Collective marks**

If the Application for registration as a collective mark has been indicated on Form 7 the following shall be checked besides other details indicated under the formality examination:

- 4.1.11.1. A copy of the Rules governing the use of the collective mark duly certified by the applicant is submitted. No legalization of such certification is required.
- 4.1.11.2. Ensure that the Rules governing the use of collective mark mentions the following;
  - The name and objective of association
  - Representation of the mark and description of the mark features
  - List of goods and services on which the mark will be used
  - Common characteristics or quality of the goods or services, mode of manufacture of goods, etc.
  - Goods and services evaluation process

- The persons authorized to use the mark and the nature of control the applicant would exercise over the use
- Condition of membership of the association
- Conditions of use of the mark
- Sanctions against misuse of the mark
- Procedure for dealing with appeals against the use of collective marks

**Office actions:**

- The applicant should be invited to comply with the formality requirements through a formality examination report. The formality examination report shall be generated through the IPAS in the template which is available in the IPAS server. The timeline for meeting the formality requirements is 30 days or may file for time extension. Where the formality requirements are not met, the office must refuse the application as not being in accordance with the Act and Rules.

**6. CHAPTER 5: SUBSTANTIVE EXAMINATION OF TRADEMARK APPLICATIONS**

*Sections 27(1) (b), Rule 44*

**5.1. Introduction and scope**

Examination of Trademark application will cover examination as to compliance with:

**5.1.1.** Filing requirements are governed by procedure prescribed under the Industrial Property Act of the Kingdom of Bhutan 2001 and the Rules.

**5.1.2.** Substantive requirements for registrability of the mark. In particular, the examiner will scrutinize the application as to-

- whether the application has been filed in the manner as prescribed in the Rules
- whether any same/similar mark in respect of same/similar goods/services is there on record
- whether the trademark applied for registration can be accepted for registration under the Act
- whether any restriction, condition or limitation is required to be imposed.

**5.2. Objection and argument**

Where the examiner finds that an absolute ground for refusal exists, a reasoned objection must be issued which specifies all the individual grounds for refusal and

provide clear and distinct reasoning for each ground separately. Objections must be raised as early and as completely as possible.

The examiner should carefully consider the arguments submitted by the applicant. The examiner should equally consider, of her/his own motion, new facts or arguments that plead in favour of acceptance of the mark. This is because the application can only be refused if, at the point in time the decision is taken, the examiner is convinced that the objection is well founded.

Where the applicant has not submitted any arguments, and provided that the examiner has not found any reasons for her/his own motion that might change her/his view, the application will be refused by a notification which will include/or refer the original objection letter(s).

If the applicant contests the reasons given in the refusal, the refusal should first provide the original reasoning given, and then address the arguments of the applicant. Where the examiner needs to provide new facts or arguments to sustain a refusal, the applicant must be given the opportunity of commenting on this before a final decision is taken. Where the applicant tries to overcome the objection by restricting the list of goods and services, it may be accepted or it is possible that the restriction raises a new ground for refusal, for example, deceptiveness in addition to descriptiveness.

Almost all absolute grounds for refusal, and in particular the most pertinent ones of lack of distinctiveness, descriptiveness, genericness and deceptiveness, have to be assessed with respect to the goods and services actually claimed. If an objection is raised, the examiner must specifically state which ground (s) for refusal applies to the mark in question, in relation to each claimed good or service.

### **5.3. Definition which has a bearing on examination**

#### **5.3.1 Section 24 (1) "mark" means any visible sign capable of distinguishing the goods ("trademark") or services ("service mark") of an enterprise**

The word "**mark**" is thus intended to be interpreted broadly and no type of sign is automatically excluded from registration. The expression is a positive requirement that a sign must possess a capacity or ability to distinguish goods or services of one person from those of others before it is elevated to the status of trademark. For registration, it must possess a distinctive character.

### 5.3.1.1 “Capable of distinguishing the goods or services”

The words “capable of distinguishing” must be construed by reference to the essential function of a trademark. A mark which has a direct reference to the character or quality of the goods/service is considered as inherently not capable of distinguishing. If the reference to the character or quality is only indirect or suggestive, the mark may be considered as possessing sufficient degree of inherent capacity to distinguish. The fundamental principle is that “business should not obtain any monopoly in the use of words as trademarks to the detriment of the members of the public, who, in the future and in connection with their goods might desire to use them”.

### 5.3.1.2 Why is Being Distinctive so Important for a Trademark?

Being distinctive earns legal recognition and consumer recognition. When a business obtains common law rights and legal recognition in a trademark depends on the **distinctiveness** of the mark. “A business will obtain rights in the mark **upon first use only** if the mark is **inherently distinctive**. If the mark is not inherently distinctive, a business may obtain ownership rights in the mark when the mark attains a secondary meaning.” Thus, distinctiveness may be inherent or acquired. 6.3.1-3. “Distinctiveness”

The distinctiveness of the mark refers to how easily customers identify a mark with the associated products (goods) or services. If a trademark is made up of words that are commonly being used by others, especially by others in the same field because the words are necessary descriptive words, the mark is easily confused with other marks and is not distinctive (also known as a weak trademark). For instance, someone registering a trademark for a bank with the word BANK, INTERNATIONAL and NATIONAL or other common words that are used in bank names cannot stop others from using a bank in their name because it is not a distinctive term that is associated with one unique source.

Often the term ‘distinctiveness’ is used as part of the term ‘**acquired distinctiveness**,’ another term for secondary meaning. An applicant of a ‘not distinctive’ proposed mark who seeks registration with the Trademark Registry must show acquired distinctiveness by establishing, through evidence of promotion, long use, advertising expenditures, and breadth of distribution or sales figures, that the public has come to recognize the proposed mark as an indicator of source.

**Weak trademarks** are often marks that are often used by third parties, dictionary words, geographic words or other terms that are hard for any party to claim exclusively.

#### **5.4 General guide to examination**

The distinctiveness of a mark can generally be categorized into one of five categories which fall along a spectrum of distinctiveness. From most distinctive to least distinctive, these categories are:

- ❖ FANCIFUL
- ❖ ARBITRARY
- ❖ SUGGESTIVE
- ❖ DESCRIPTIVE
- ❖ GENERIC

Marks that are fanciful, arbitrary, or suggestive are considered distinctive enough to function as trademarks and thus can be registered. On the other hand, if a mark is descriptive, it can function as a trademark only if it has obtained secondary meaning and thus can be registered. A generic mark can never be a trademark.

##### **5.4.1. Fanciful marks**

Fanciful marks are which have been invented/coined for the sole purpose of functioning as a trademark and have no other meaning than acting as a mark. These invented/coined words should not have any meaning in relation to the description of goods or services. Fanciful marks are considered to be the strongest type of mark.

*Examples:*

- EXXON (petroleum products)
- KODAK (imaging products)
- XEROX (business processes/photocopying)

##### **5.4.2. Arbitrary marks**

An arbitrary mark utilizes already available words/signs having a common meaning that has no relation to the goods or services being sold.

Examples: arbitrary mark that has no particular connection with the products.

- SALTY (telephone), the term "salt" has no particular connection with such products.
- APPLE (for computers)
- LOTUS (for software)
- SUN (for computers)

### 5.4.3. Suggestive marks

A suggestive mark hints at or suggests the nature of a product or service or one of its attributes without actually describing the product or service.

Suggestive marks can possess an inherent element of sales appeal and will require less education of the public than coined or arbitrary marks. Suggestive marks are common due to the inherent marketing advantage of tying a mark to the product in a customer's mind.

Suggestive marks are often difficult to distinguish from descriptive marks, since both are intended to refer to the goods and services in question. Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods. Descriptive marks allow one to reach that conclusion without such imagination, thought or perception. Putting this distinction into practice clearly is one of the most difficult and disputed areas of trademark law.

Examples:

- AIRBUS (suggestive for airplanes)
- MICROSOFT (suggestive of software for microcomputers)
- NETSCAPE (suggestive of software which allows traversing the "landscape" of the Internet)
- SILICON GRAPHICS (suggestive of graphic oriented computers)
- PLAYSTATION (video console)
- SUNNY (heaters).

### 5.4.4. Descriptive marks

Descriptive marks are those which

- Specify the name of the goods or services, or
- Describe an ingredient, quality, characteristic, feature, purpose, function or use of the specified goods or services.

*Example:*

- COLD AND CREAMY (ice cream)
- SHOELAND (shoe store)
- COMPUTERLAND (computer store)
- SALTY (saltine crackers)
- DIGITAL (computers)

The examples above merely describe a product/services or one of its ingredients or attributes and is too weak to function as a trademark. What is initially a

descriptive word may, however, later become protectable as a trademark if it acquires a secondary meaning. In other words, if a descriptive word is used exclusively as a trademark for some years, it may, in addition to having the primary meaning that is descriptive of the product, come to identify the mark as being associated with a single source of origin for that product.

Example of a descriptive word that has acquired a secondary meaning and become protectable as a trademark is SHARP for televisions.

#### **5.4.5. Examination of Suggestive and Descriptive Marks**

As explained above suggestive marks and descriptive marks are often difficult to distinguish although, suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods, while descriptive marks allow one to reach that conclusion without such imagination, thought or perception.

In order for the suggestive and descriptive marks to be registered as a trademark some assessments are required as, in the course of trade, anyone should be able to use words which describe a product or service. The following assessment shall be used for examination of these marks.

- 5.4.5.1. ***The Mark Must be Examined as a Whole:*** The mark cannot be dissected and its individual parts be examined separately for descriptiveness. The mark will be considered descriptive if, as a whole, it describes an ingredient, quality, characteristic feature, purpose or use of the specified goods or services. Certain elements of the mark may be disclaimed, but it is the overall level of distinctiveness, which must determine whether the mark is registerable.
- 5.4.5.2. ***No Imagination:*** The examiner should not need to exercise his/her imagination to determine the type of goods or a characteristic of the goods described by the trademark. If such thinking is needed to generate a descriptive meaning, it is likely that the mark has enough distinctiveness to be registerable.
- 5.4.5.3. ***Test:*** The test to be applied is: Does the average consumer understand the term to describe an ingredient, quality, characteristic, feature, purpose, function or use of the goods or services of the applicant?
- 5.4.5.4. ***Examination of Goods or Services:*** The Examiner should examine the goods or services for which registration is sought and consider the manner in which the mark is used or intended to be used to establish a determination of descriptiveness. Also of relevance is the actual or likely effect of use of the mark on the average purchaser of the goods or services. Sources used in examining for descriptiveness will include

dictionaries, databases, Internet searches, industry literature, surveys, and other such sources to show a general understanding of the words/designs of the mark.

**5.4.5.5. Acquired Distinctiveness:** A descriptive term can acquire distinctiveness through use; evidence of acquired distinctiveness must be shown in order for a descriptive term to be registerable. A generic term is never registerable because it is incapable of being or becoming distinctive of the goods or services of one person or business.

If a proposed mark consists entirely of an essential feature of a product, it should be unregistrable. A single functional element of a combination of elements, however, should not necessarily defeat an application. The application should be denied only if the functional elements dominate the mark.

#### **5.4.6. Generic terms**

Generic terms are words or symbols commonly used to describe an entire type of product or service rather than to distinguish one product or service from another. For purposes of examination, a generic “mark” is a common descriptive term for a particular good or service or words that are the accepted and recognized description of a class of goods or services or is a generic household name for products. Such generic terms can include former trademarks (such as ESCALATOR, ZIPPER) that are in common use as the name of a type of product by multiple sources.

“*Genericide*” occurs when a mark is used widely and indiscriminately to refer to a type of product or service, rather than the service or product of one company. For example, “Escalator” was originally a protected trademark used to designate the moving stairs manufactured by a specific company. Eventually, the word became synonymous with the very idea of moving stairs and thus lost its protection. Such terms do not function as source identifiers and should be left free for use by competitors. Combining a generic term with other terms may sometimes result in a protectable composite mark. However, often, the generic term must be disclaimed and may grant trademark registration for the composite mark.

Terms which are generic should not be considered the subject of a trademark and should never be registered. However, examiners should not consider marks to be generic if an applicant can prove that the mark covers merely the preferred “brand” of a particular type of service, i.e., there is still recognition by consumers of the mark as a particular source of goods or services. This will allow for preservation of well-known marks, which are in danger of becoming generic. Where an applied-for mark is well known through extensive use, but has never

been registered, consideration can be given to policing efforts by the applicant as relevant in an evaluation as to whether the mark is presently generic, or is still functioning as a trademark to identify source.

Generic terms normally include:

- a) Marks which were originally legally protected trademarks, but have been genericized and have lost their legal status due to becoming generic terms.

*Examples:*

- ESCALATOR (originally a trademark of Otis Elevator Company for moving staircase)
- THERMOS (Originally a Thermos GmbH trademark for a vacuum flask)
- FLIP PHONE (Originally a trademark of Motorola)
- VIDEOTAPE (Originally trademarked by Ampex Corporation an early manufacturer of audio and video tape recorders)
- SELLOTAPE (British brand by Henkel for transparent, cellulose-based, pressure sensitive adhesive tape)
- Marks which were originally legally protected trademarks, but have subsequently lost legal protection as trademarks due to abandonment, non-renewal or improper use.
- ZIPPER (Originally a trademark of B.F. Goodrich for use in rubber boots)
- ZIP CODE (Originally registered as a service mark)
- APP (Trademark claimed by Apple, Inc.)
- MULTIBALL (Used to refer to a state on a pinball machine where two or more balls are present on the playfield simultaneously and can be accessed by the flippers).

- b) Marks which are still legally protected as trademarks, at least in some jurisdictions but are sometimes used by consumers in a generic sense.

*Example:*

- POST-IT (for sticky note is still a legally recognized trademark of 3M but is genericised by consumers)
- POWERPOINT (Still a Microsoft trademark for slide show presentation programs but is genericised by users as PowerPoint)
- JEEP (for Compact sport utility vehicle is a trademark of Chrysler but is genericised by consumers)
- PHOTOSHOP (for Photo manipulation by Adobe Systems is Commonly used as a verb to generically describe digital manipulation)

- or compositing of photographs)
- XEROX (for Photocopier or to make a photocopy of Xerox company has become a generic word for 'photocopy')
  - VASELINE (for Petroleum jelly, petrolatum of Unilever often used as generic word for cold cream)
  - WALKMAN (for Personal stereo of Sony Corporation often used generically for any portable stereo player)
  - BAND-AID (for adhesive bandage by Johnson and Johnson)
  - CHAPSTICK (for lip balm by Wyeth Consumer Healthcare)
  - JACUZZI (for hot tub whirlpool bath by Jacuzzi)
  - MEMORY STICK (for flash memory storage by Sony)
- c) Other generalized terms that are accepted and recognized description of a class of goods or services.

*Examples:*

- KEROSENE for combustible hydrocarbon liquid
- MART a market or trading centre.
- SOFTWARE for part of a computer system that consists of encoded information or computer instructions, in contrast to the physical hardware from which the system is built.
- SMARTPHONE for Mobile phones which includes functions similar to those found on personal computers.
- SALT for sodium chloride
- EMAIL for electronic communication program first invented by a company called Email. When other companies made similar programs and the public started calling the process 'email, emailing'. The public no longer sees it as an indication of origin, they see it as the common name of the service they are using.

## **5.5. Examination of various kinds of marks**

### **5.5.1. Word marks**

Word marks that merely describe the related goods or services do not meet the required level of distinctiveness to be registerable. Generally for trademark purposes, there are at least three classes of words such as dictionary words, names, and invented words. The following is a discussion of distinctiveness issues related to certain types of word marks:

#### **5.5.1.1. Letters and Numerals:**

Provided that they function to identify the source or origin of goods and services, letters and numerals should be registerable as trademarks. Distinctiveness, and not the total number of letters/numerals in the mark, should be determinative. Such distinctiveness may be inherent or acquired. Alphanumeric marks do not have to be pronounceable to be protected. Letters or numerals should not be registerable if they are either non-distinctive, or deceptively misdescriptive of the nature or quality of the respective goods or services.

The overall distinctiveness of marks incorporating letters and numerals may be enhanced by the addition of stylized font and/or design features. However, where the letters or numerals that form part of a design are non-distinctive or merely descriptive or lack distinctiveness, a requirement for a disclaimer of the exclusive use of those letters or numerals apart from the trademark as a whole may be required.

Trademarks that are sufficiently inherently capable to distinguish that they are prima facie capable of distinguishing; and can be accepted without evidence of use.

#### *Examples:*

- MOST COINED WORDS such as KODAK, SURELOCK (12), CLICKFAST(6)
- EXTINCT GEOGRAPHIC NAMES
- UNLIKELY GRAMMATICAL CONSTRUCTIONS particularly those that incorporate a misspelling such as SHOPRITE (42), BESAFE (9), GROWOOL (1)
- SLOGANS with only indirect reference such as COLOUR ME BEAUTIFUL (3), PARDON OUR SCAFFOLDING (6)
- EXPRESSIONS not in local common use in respect of the goods/services: MUSCLE MACHINE (28), PORKY BITS (29), OFF THE WALL (25)

#### **5.5.1.2. Laudatory Marks:**

Laudatory marks contain an expression about the quality of the product or service. Laudatory terms refer to a superior quality of the respective goods/services, as well as the inherent quality of the goods/services. Example: Terms such as 'light', 'extra', 'fresh', 'hyper light' for goods that can be extremely light. In addition, figures may refer to the quality of a product, such as '2000' refers to the size of the motor or '75' refers to the horse power of the motor.

Some words may be unacceptable for a vast range of items, but may be

acceptable for others e.g. **HIGH TECH** would **not be** acceptable for use in connection with any **technical items**, such as computer but it may be accepted for other goods e.g. foodstuff. **CLASSIC** would not be acceptable for furniture or cars, but may be acceptable for medical apparatus like scanners. Laudatory marks should not be registered in the absence of acquired distinctiveness.

#### **5.5.1.3. Names of Colors:**

Word marks that consist solely of the name of a single color are likely to lack the required inherent distinctiveness for registrability unless the particular color is unusual or unlikely to be needed for use by competitors for the goods concerned. Generally, if the color itself is needed in the trade, the word should not be registerable even if acquired distinctiveness can be shown.

*Example* of a word mark for the name of a color found to be distinctive.

**“PEA-GREEN” for travel services**

&

**“Red and White” for cigarettes.**

#### **5.5.1.4. Personal and company names:**

The registration of personal names will depend on the commonness of it. If the trademark consists of a frequently occurring surname or given name it may not have sufficient capability of distinguishing for prima facie acceptance. However, regard should be given to the nature of goods or services and also to the way in which the trademark is represented. If either is sufficiently unusual, it will be considered capable of distinguishing.

**The signature of an applicant:** The signature of an applicant is always registrable. The fact that it is the applicant’s signature should be made clear by way of an endorsement to that effect.

#### **5.5.2. Marks for pharmaceutical substances**

When a trademark is applied for goods and/or services related to pharmaceuticals, Examiners need to conduct search to determine if the mark consists of an International Nonproprietary Name (INN). An INN identifies a pharmaceutical substance or active pharmaceutical ingredient by a unique name that is globally recognized and is public property. INN's are formally placed by the World Health Organization (WHO) for universally available in the public domain, hence their designation as "nonproprietary".

If a trademark filed for pharmaceutical substances is identical or deceptively similar to a notified INN for a pharmaceutical substances or other generic drug

name, the trademark would not be capable of distinguishing the goods of that proprietor from similar substance also identified under INN. In addition if the trademark were to be used on goods with different constituents, it would be deceptive. Thus, the trademark shall be refused from registration. The latest version notified by WHO shall be searched during the examination.

### 5.5.3. Device (design)marks

Device marks are independent of language and can serve to distinguish the origin of goods or services even in societies where literacy is low.

- A trademark may consist solely of a device which is common to the trade and will be considered to have insufficient capability to distinguish unless it is depicted in a special or fanciful manner.

*Example*, the following representation of grapes and vine leaves for wine would not be considered capable of distinguishing one trader's wine from that of another.



Other *examples* of devices common to trade which are not distinctive are:

- Cats and dogs for petfood
- Orchard scenes for fruit
- Representation of a cow for milk products
- A device which is just a depiction of the goods upon which, or in connection with which, it will be used will not be acceptable.
- For example, an ordinary device of wheel barrow for wheelbarrows would not be prima facie capable of distinguishing any one trader's wheelbarrows in the marketplace.
- **Portraits, pictures and representations of the applicant** are always registerable. The fact that it is the representation of the applicant should be clear by way of endorsement to that effect.

### 5.5.4. Colour marks

In order to constitute a trademark, a color or combination of colors must be

capable of distinguishing the goods of the applicant, and must be perceived by the purchasing public as identifying and distinguishing the goods on which it is used and indicating their source.

Although it is not impossible for a single color to be fanciful in connection with goods or services, a single color ordinarily will lack sufficient distinctiveness to be registerable, unless a substantially acquired distinctiveness through past use prior to the filing date is demonstrated. Color combinations may be inherently distinctive, or they may gain distinctiveness through use.

Determining if sufficient distinctiveness exists for registration will depend on the appearance of a mark, including color. For example, a device mark consisting of a circle divided into two colors may possess sufficient distinctiveness without showing of acquired distinctiveness. On the other hand, the same two colors individually, apart from the design, would not have the same trademark impact, and would need support from past use to be registerable.

For marks consisting of a single overall color the applicant must satisfy the examiner that the overall color is not functional or generic for the goods/services, such as those colors needed by competitors providing the same goods/services as those of the application.

#### **5.5.5. Composite marks.**

5.5.5.1. A “composite” mark may consist of:

- A word or words combined with a design or designs.
- Can also consist solely of words, when there are separable word elements.
- Can consist solely of separable design elements.

5.5.5.2. An unregistrable component of a composite mark is subject to a disclaimer. However, if the composite mark is “unitary”, the unregistrable component need not be disclaimed.

*Example* of composite mark with disclaimer:

- ESTEE LAUDER FOR MEN for cologne (disclaimer to FOR MEN). The descriptive prepositional phrase FOR MEN appears separable from the rest of the mark and does not create a distinct meaning independent of the meaning of the separate elements.
- COMFY. COZY. COTTON for bed sheets and blankets (COTTON). The

punctuation after each term physically and conceptually separates the terms such that each stands alone.

*Example* of unitary marks:

- TIP YOUR HAT for hats, (no disclaimer required). The verb renders the mark a unitary phrase.
- LET'S PUT YOU TO WORK! For employment agency services (no disclaimer required). The verb and the punctuation at the end create a unitary sentence.

5.5.5.3. When two descriptive terms are combined, whether the composite mark is also descriptive depends on whether the combination of terms evokes a new and unique commercial impression.

*Example:*

- SCREENWIPE – generic for pre-moistened antistatic cloths for cleaning computer screens

5.5.5.4. If combination of terms creates a unitary mark with a unique, non-descriptive meaning it is registrable.

*Example:*

- SUGAR & SPICE – not merely descriptive for bakery products
- SNO-RAKE – not merely descriptive for a snow removal hand tool

## **5.6. PROCEDURE OF EXAMINATION OF GOODS AND SERVICES**

### **5.6.1. Requirement of Correct classification and Clear specification**

The rights gained from registration of a trademark are governed by the goods and/or services specified on the Register. This has implications particularly in relation to infringement action and in relation to searches done by examiners.

In the event of legal action for infringement of a registered trademark, it is essential that the Court is able to determine the exact scope of the goods and/or services covered by the specification.

The specification and classification of goods and services have implications when considering conflicting trademarks. If a pending or registered trademark has an incorrect class number or an unclear specification it may not be found or considered in a search of the trademark database.

### **5.6.2. Examination of Goods or Services.**

The Examiner shall examine the goods or services for which registration is sought and consider the manner in which the mark is used or intended to be used to establish a determination of descriptiveness. Also of relevance is the actual or likely effect of use of the mark on the average purchaser of the goods or services. Sources used in examining for descriptiveness will include dictionaries, databases, Internet searches, industry literature, surveys, and other such sources to show general understanding of the words/designs of the mark.

### **5.6.3. Description of the Goods or Services.**

The goods and/or services in an application should be described clearly, with specificity, so it can be easily understood what goods/services are sought to be protected. The description of goods/services selected and utilized by the applicant should be accepted unless:

- It would be unclear to the public what the goods/services in the registration protect; or
- Goods or services clearly are misclassified according to the applicable governing classification system, in which case a proper reclassification should be proposed by the examiner.

### **5.6.4. Use of Class Headings and Vague specification discouraged**

Office should disallow the use of ‘class headings’ of the Nice Classification and the expressions “all goods”, “all services”, “all other goods”, “all products in the class”, “all other services” or vague and non-specific descriptions. While it is ultimately the responsibility of owners and/or their agents to file specifications which meet these requirements, Examiners must check that goods and services are adequately described and correctly classified.

### **5.6.5. Comparison of the Goods and Services**

The comparison of the goods and services must be based on the wording indicated in the respective lists of goods/services. Once the wording of the goods and services to be considered has been identified, their meaning must be determined.

In some cases the exact meaning is immediately obvious from the list of goods and/or services of the marks where a more or less detailed description of the goods and services will often be given. For example, the wording belts, being articles of clothing excludes by definition safety or industrial belts.

In cases of doubt about the exact meaning of the terms used in the list of goods

and/or services, these terms have to be interpreted both in the light of the Nice Classification and from a commercial perspective. Therefore, belts in Class 25 are due to their classification articles of clothing.

Clothing, for instance, refers to ‘clothes collectively’ (see e.g. Oxford English Dictionary) and thus to items worn to cover the body, such as shirts, dresses, pants, etc. Although the definition found in standard dictionaries does not explicitly exclude footwear, the fact that it appears in the Nice Classification as a separate item in the same Class 25 leads to the conclusion that clothing and footwear are not identical but similar.

However, that does not mean that two general indications of one class heading can never be considered identical. As mentioned above, the structure of the class headings is not uniform. Some general indications included in the class headings may encompass others.

*Example 1:*

- Meat and poultry in class 29.
- Temporary accommodation and youth hostel services in class 43
- Pasta and spaghetti in class 30

*Example 2:*

- Earlier mark’s Jeans and later mark articles of clothing in Class 25. The goods are considered identical.
- Earlier mark’s bicycles and later mark’s vehicles in Class 12. The goods are considered identical.

The later applicant may, however, restrict the list of goods/services in a way that excludes identity but could still lead to similarity.

- The earlier mark’s jeans (Class 25) are included in articles of clothing (Class 25). The applicant restricts the specification to articles of clothing, excluding jeans. The goods are no longer identical but remain similar.
- The earlier mark’s bicycles (Class 12) are included in vehicles (Class 12). The applicant restricts the specification to vehicles, namely automobiles. The goods are no longer identical or similar.

*Example 3:*

- The latter mark covers vehicles (general indication) as well as bicycles, aircraft, trains (included in vehicles). Where the earlier mark is protected for bicycles, identity will be found with respect to vehicles and to bicycles but not for aircraft or trains.

*Example 4:*

- If two categories of goods/services coincide partially ('overlap') there might be identity if:
  - a) They are classified in the same class;
  - b) It is impossible to clearly separate the two goods/services.

Earlier goods	Later goods	Coinciding part
Outdoor clothing for women.	Clothing made of leather	Outdoor clothing for women made of leather
Components and spare parts for land vehicles	Vehicle seats 3	Seats for land vehicles
Bread	Long-life bakery products.	Long-life bread
Electric kitchen utensils	Thermometers 4	Electric kitchen thermometers
Soap	Cleaning preparations	Soaps for cleaning purposes
Scientific instruments	Optical instruments	Scientific optical instruments, e.g. microscopes
Online banking services	Commercial banking services	Online commercial banking services

5.6.6. **Objections** shall be raised in following cases:

5.6.6.1. Where goods/services are similar/identical to existing similar/identical marks.

- Unless the goods/services are amended, the application may be refused.

5.6.6.2. Where registration is sought for 'class headings' and the expressions "all goods", "all services", "all other goods", "all products in the class", "all other services" or vague and non-specific descriptions as these descriptions are too vague and do not constitute a proper list of goods or services.

- The application may be refused, unless the applicant justifies the specification through evidences -is by the use of the mark or the applicant intends to make use in respect of all such goods.

5.6.6.3. If the applicant submits a long list of goods/services which is not grouped under class numbers or classified at all.

- Then the examiner should simply object, and ask the applicant to provide the list in a form that complies.

5.6.6.4. Where the Examiner considers that there is a need to amend the list of goods and services it should, if possible, discuss the issue with the applicant. Whenever reasonably possible the Examiner should offer a proposal for a correct classification.

*Examples:*

Where there is a need to amend the classification, the office will send a reasoned communication pointing out the error(s) detected in relation to the list of goods and services. The applicant will be requested to amend and/or to specify the list and the office may propose the way in which the items should be classified.

<b>Not a clear and precise term</b>	<b>Example of a clear and precise term</b>
Goods of common metal not included in other classes (Class 6)	Construction elements of metal (Class 6) Building materials of metal (Class 6)
Machines (Class 7)	Agricultural machines (Class 7) Machines for processing plastics (Class 7)
Goods in precious metals or coated therewith (Class 14)	Works of art of precious metal (Class 14)
Repair (Class 37)	Shoe repair (Class 37) Repair of computer hardware (Class 37)
Installation services (Class 37)	Installation of doors and windows (Class 37) Installation of burglar alarms (Class 37)

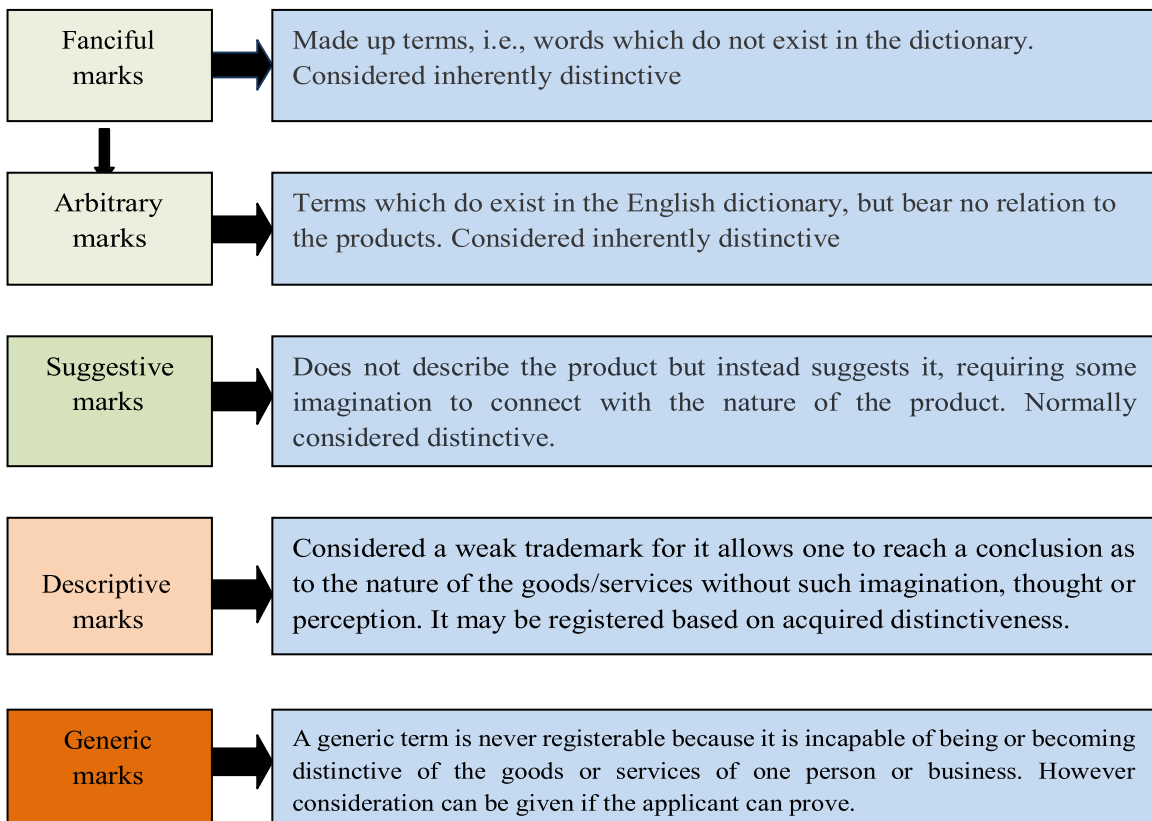
*Examples of **Acceptable use***

Class 29: Dairy products namely cheese and butter	This would restrict the goods to only cheese and butter and exclude all other dairy products.
Class 41: Provision of sports facilities, all being outdoors.	This would restrict the services to cover only outdoor facilities and exclude any indoor facilities.
Class 25: Clothing, all being underwear	This would restrict the goods covered to only that which is considered underwear and will exclude all other types of clothing.

**5.7. Substantive examination of marks in line with the act covers:**

- Categorization of the marks: It is important for an examiner to first categorise where the applied mark falls before carrying out the examination. The categorization will assist in making a decision during the examination. (Refer more details in section 6.3. General guide)
- Absolute Grounds (Marks which are not prima facie “capable of distinguishing” the goods/services of one person from those of another person) Section 25 (3) (i) to (iv)
- Relative Grounds (conflict with prior trademark rights filed/registered/well-known). Section 25 (3) (v) and (vi)

**5.7.1. Chart of five categories from most distinctive to least distinctive and examination guide**



**5.7.2. ABSOLUTE GROUNDS EXAMINATION Section 25 (3) A mark cannot be validly registered if it is:**

5.7.2.1. (i) incapable of distinguishing the goods or services of one enterprise from those of other enterprises;

The basis of this section is that a business should not obtain a statutory monopoly through registration in a word that another business might legitimately wish to use. A competitor should of course be entitled to make bonafide use of the word, to describe his goods or services. If a word, however, through use has become clearly associated in public mind with the goods/service of a particular business, then it could not be legitimately used as a trademark by a competitor. For this purpose, the onus is on the applicant to show by cogent evidence that the trademark, by reason of use has acquired distinctiveness in relation to his goods or services.

The Section prohibits (prima facie) the registration of trademarks which are devoid of any distinctive character. Its purpose is to prohibit generally registration of marks which do not identify and distinguish goods or services of one person from those of others.

***“Acquired distinctiveness=Secondary meaning”***

Trademark which offends against Section 25 (3) (i) of the Act may still be registered if it can be shown that on the date of application, the mark has in fact acquired a distinctive character as a result of the use made of it.

OR

A descriptive trademark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source

The section implies the possibility that certain words, although primarily descriptive of the character or quality of the goods or service, may – by reason of use – lose their descriptive meaning and acquire a secondary distinctive meaning so that they indicate that the goods/service in connection with which they are used are goods made by a particular manufacturer.

A mark that is said to have acquired a distinctive character must be shown to have come to operate as a guarantee of origin. For that to be so consumers must rely on it as a means of returning to the same undertaking if their experience of its products is positive, or to avoid that undertaking if their experience is negative.

### ***Seeking Evidence of acquired distinctiveness***

Evidence may be called for by the examiners

- Upon outlining the grounds for prospective refusal where reasonable grounds is/are available for objections.
- Where the examiner is unable to complete his or her prima facie examination of the application without further information from the applicant and considers that evidence of the mark in use may assist the application, he or she will invite the applicant to submit such evidence.
- Normally it will be more efficient to raise an objection and then to give the applicant an opportunity to file information, documents and/or evidence in order to overcome the objection.

### ***Forms of Evidence of acquired distinctiveness:***

Evidence of secondary meaning or acquired distinctiveness may include specific sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark as a source identifier, long use, affidavits, and any other evidence that establishes the distinctiveness of the mark as an indicator of source.

The office will decide each case on its own merits-whether or not the evidence is sufficient to show acquired distinctiveness is dependent of the facts of each registration application.

5.7.2.2. (ii) contrary to public order or morality;

### **Referred to as Scandalous Marks.**

Scandalous marks are those likely to offend accepted principles of morality.

Provided the “scandalous” term is capable of functioning as a trademark, the test for registerability should be whether a substantial body of the population would understand the mark applied for to consist of scandalous, immoral or offensive matter in relation to the respective goods or services.

The scandalous element has to be something that is obvious and up front in the trademark. A mere suggestion within the trademark or a vague possibility that someone might find it offensive is not sufficient.

Below are non-exhaustive categories of marks which would be contrary to public order or morality.

- ***Words or symbols of religious significance***  
Marks consisting of or comprising words or symbols of great religious significance will face an objection depending on the goods or services claimed for registration. The examiner will look at the context of the use of the mark and the identified goods or services from the perspective of the specific group that considers the word or symbol to be sacred. If the identified religious group is not offended by the trademark usage, the mark is acceptable.
- ***Marks containing racial, ethnic or religious disparagement***  
Marks consisting of any disparagement to race, ethnic or religious group will be refused for registration without regard to the goods or services claimed for registration, even if the identified racial, ethnic or religious group does not represent a majority of the general public.
- ***Marks with profane content***  
Marks comprising of profane matter are likely to be refused without regard to the goods or services claimed. Words such as “BITCH” and “BULLSHIT” are regarded as profane.
- ***Marks suggesting or promoting illegal activity***  
Marks advocating illegal activity are considered offensive and will be refused registration.

*Examples:* Marks which have criminal connotations, those which exhibit racial, religious or discriminatory characteristics would be refused.

*Examples:* Use of religious symbols or names (Buddha) as trademarks is likely to undermine/offend religious values and sentiments. Names of Gods/Goddesses which are also used as personal names may be considered as personal names unless accompanied by the device of such God/Goddess for registration purposes.

If the examiner believes that the mark falls within the above explanation, an objection should be raised and the burden of proof shifted to the applicant to provide satisfactory evidence to the contrary.

- 5.7.2.3. (iii) likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;

### Referred as Misdescriptive Marks

The expression “misdescriptiveness” is to be construed to exclude from registration of trademarks that

- Misrepresent/improperly describe the character or nature of the goods/services **AND**
- Consumers are likely to believe the improper description and rely upon that improper description in making a purchasing choice

An important criterion is whether there is any real potential for deception of the public. The test is whether there is a real prospect of a purchaser of the goods/user of the service would be misled as to the characteristics and or nature of the goods/services. It would include marks which give rise to an expectation which will not be fulfilled (given the content of the specification/classification). Example: If words or devices used in the mark suggest it is manufactured in an area that is famous for the quality of the specified goods, and the goods are made elsewhere, objections will be raised.

An objection will generally only be raised where the mark leads to a **clear** expectation which is **clearly contradictory** to, for instance, the nature or quality or geographical origin of the goods.

- i) In order to determine whether a trademark is misdescriptive,
  - it is first necessary to determine whether the term is descriptive of some goods/services.
  - The test may be whether the trademark (or a term within the trademark) conveys an immediate idea of, for example, an ingredient, quality, characteristic, function or feature of the goods or services.
  - If the term immediately conveys such an idea, but the idea is false, then the trademark is deceptively misdescriptive and is unregistrable.

ii) Where the trademark explicitly or implicitly misdescribes:

- a) Place names or devices of a geographical nature where the place has a reputation for the goods or services,  
OR
- b) A particular kind, quality, quantity, intended purpose or other characteristics, and the goods are not restricted to the goods of that origin or characteristic, then, subject to a proviso that there must be real potential for deception of the public, an objection should be raised.

Where an objection is raised on (a), the registration should be refused for the goods or services having their reputation in the place name or devices of a geographical nature. Where an objection is raised on (b), acceptance may be obtained after suitable restriction of the goods (subject to the distinctiveness of the trademark as a whole).

Examples of marks that were found to be deceptive with regard to the claimed goods/services

- **LACTOFREE** for lactose

The nature of the sign would immediately lead the relevant consumer to believe that the product in question, i.e. 'lactose', does not contain any lactose. It is clear that if the good being marketed under the sign 'LACTOFREE' is actually lactose itself, then the mark would be clearly misleading. Thus objection shall be raised.

- **"Youth Glow"** for cosmetics

The mark would not lead to any real expectations that, its use by elderly customers would restore a youthful skin tone. However if a mark appears to be the name of a university, and yet the institution does not award any recognized qualification, it may be deceptive, since a "university" is an institution of higher education having authority to award bachelors' and higher degrees.

5.7.2.4. (iv) identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or, official sign or hallmark adopted by, any State, intergovernmental organisation or organisation created by an international convention, unless authorised by the competent authority of that State or organisation; (the provision may also be included in the relative grounds searches)

Flags, Coats of Arms, Emblems, Official Signs, Abbreviations, and Names of International Intergovernmental Organizations

There are provisions in the Paris Convention Article 6ter regarding the registerability of flags, coats of arms, emblems and official signs, etc. as trademarks or elements of trademarks. Article 6ter concerns trademarks, but its purpose is not to regulate their protection as subjects of industrial property but rather to exclude them from becoming such subjects in certain circumstances.

The

member states of the Paris Convention are free to apply these provisions also to service marks.

A trademark may not be registered if it includes coats of arms, flags or other official emblems, abbreviations, names or symbols of intergovernmental or international organizations, official seals, signs or hallmarks, the use of which is forbidden by law without authorization by the competent authority. Examples of abbreviations of such names are EFTA, UNESCO and WHO.

The competent authority referred to here is that of the country or state whose emblems, official signs and hallmarks are involved. These authorities may allow the use of such emblems, signs or hallmarks in certain trademarks, probably of their own citizens.

The examiners shall where necessary search the 6ter database at <https://6ter.wipo.int/struct-search?lang=en> and compare the applied marks.

6ter databases contain Armorial bearings, flags, other emblems, official signs and hallmarks that belong to member states and which have been communicated to WIPO. In the case of flags, such communication is not mandatory.

### **5.7.3. RELATIVE GROUNDS EXAMINATION Section 25 (3) A mark cannot be validly registered if it is:**

Relative grounds means the reasons set down in the Trademark Act for refusing to register a mark by considering it in relation to other earlier trademarks.

‘Earlier trademarks’ means:

- A registered trademark in Bhutan, the application for registration of which was made earlier than the trademark in question, taking into account (where appropriate) the priority claimed in respect of the trademark; or
- An application for registration of trademark has been made and is pending in Bhutan; or
- A trademark which, at the date of application for registration of the trademark in question or (where appropriate) of the priority claimed in respect of the application, was a well-known trademark
- A trademark comprising flags, coats of arms, emblems etc. deposited under Article 6ter of the Paris Convention.

‘Well-known trademarks’ means:

- Any registered trademark that is well-known in Bhutan; or
- Any unregistered trademark that is well known in Bhutan and that

belongs to a person who:

- Is a national of a Convention country or
- Is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Bhutan.

- 5.7.3.1. (iv) identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or, official sign or hallmark adopted by, any State, intergovernmental organisation or organisation created by an international convention, unless authorised by the competent authority of that State or organisation;
- 5.7.3.2. (v) identical with, or confusingly similar to, or, constitutes a translation of, a mark or trade name which is well known in Bhutan for identical or similar goods or services of another enterprise, or if it is well-known and registered in Bhutan for goods or services which are not identical or similar to those in respect of which registration is applied for, provided, in the latter case, that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use;
- 5.7.3.3. (vi) identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

The above provisions in the Act provide that a mark shall not be registered if it conflicts with an earlier trademark in essentially three categories of cases:

- a) Where the marks and goods or services are identical. In such a case, there is a presumption of confusion;
- b) Where there is similarity of marks or of goods or services resulting in a likelihood of confusion on the part of the public; or
- c) Where an earlier mark has a reputation and use of the later mark would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

#### **5.7.3.4. Conflict with the earlier trademarks**

In order to find the earlier trademarks that are in the Registry's database and to compare if it conflicts with the marks that have been filed later, the following method shall be followed.

**a) Search - Compiling a Group of earlier trademarks**

If a mark ("claimed mark") meets registerability requirements following absolute examination, a search should be undertaken to determine the existence of identical/similar marks in respect of goods/services identical /similar to those of the application of the claimed mark. While conducting a Search on a mark which is not in English, the following searches shall be made:

- Non-English (mark),
- Translation of Non-English mark and
- Transliteration of Non-English mark.

Similarity is assessed on first impressions of look, sound and idea of the mark. If a similar mark is located by the search ("located mark(s)"), the examiner must, considering all marks in their entireties, evaluate whether the goods to be sold or services to be provided under the claimed mark are likely to be confused as originating from the same source as the goods sold or services provided under the located mark(s).

The preliminary step of searching the database for marks with similarities to the claimed mark involves two distinct searches:

- a search for similarities in word elements, characters, numerals etc.;
- and a search for similarities in device elements.

If the applicant's mark is a word and a device, for example the word CAFEREE and the device of a Coffee cup, two distinct searches for earlier marks must be made. First, a search for earlier marks that include words with similarities to CAFEREE and a separate search for earlier marks that include devices of coffee cups.

*Examples* below explain the scope of searches for word, characters and numbers and searches for devices.

***Visual and phonetic similarities***

A search for words must take into account marks with visual and phonetic similarities:

- PELICAN
- PELIKAN
- PELICON

### **Words translated**

Although conceptually similar, word marks that are expressed in different languages are unlikely to be regarded as similar as the overall impression of the marks is likely to be different.

- 馬
- HORSE
- CHEVAL (French)

However, if the words appear with a device, the device element in the marks may make them similar as a whole. We search separately for devices to take account of this:

- 馬 and star device
- HORSE and star device
- CHEVAL and star device



If in the examiner's judgment, confusion of the relevant segment of the purchasing public is likely to occur according to the standards listed below, the located mark(s) should be cited to the applicant in the Examination Report as a bar to the registration of the claimed mark.

### ***b) Examination - Factors Involved in Assessing Likelihood of Confusion***

The suggested factors to be included in an evaluation of likelihood of confusion are as follows:

- ***Comparison of the Appearance, Sound, Connotation and Commercial Impression of the Marks***

Marks should be compared in their entirety, and not dissected into elements unless these elements are likely to cause confusion as to the source of the goods/services associated with the respective marks. For example, similarities in the beginnings of the marks, and differences of only one or two letters between the marks should be taken into account.

It is proper to take into consideration the relative strength of a prior mark in assessing whether registration of a later applied-for mark is likely to cause confusion with the prior mark. The existence of an identical or closely similar

distinctive mark should normally bar registration of a subsequently applied- for mark, unless other factors, such as, but not limited to, the nature of the pertinent goods or services, channels of trade, and sophistication of the consumer are such that confusion would be unlikely.

When comparing composite marks composed of both words and devices, either portion may generally be considered to be dominant, and there should be no definite rule on this issue. The strength or attractiveness (i.e., comparative size of the device element and meanings) of the word and the device portions of the particular mark(s) in relation to the goods or services must be evaluated. In some cases, a distinctive design may clearly function as the dominant portion of a mark, barring registration of all marks containing a confusingly similar design, even if the word portions of the marks are clearly different.

- ***Well known Mark***

In accordance with Section 25 (3) (v) and, in the spirit of Article 6bis of the Paris Convention, well-known or famous marks of domestic or foreign third parties known to the examiner even if not registered, should be included in the confusion analysis.

- ***Comparison of Goods and Services***

Another factor in determining whether granting the registration of similar marks is likely to lead to confusion among the purchasing public is a comparison of the similarity or dissimilarity and type of goods or services described in a located mark.

However, there should be no per se refusal to register because two similar marks are to be used on or in connection with goods/services which are similar or are in the same or related classes. In a fair evaluation of all relevant confusion factors, including actual conditions in the marketplace, the factor of similar or related goods/services may not be dispositive.

Additionally, where the goods of the claimed mark and located mark(s) are dissimilar, the examiner should consider in the confusion analysis that in some cases (for example, clothing and fragrance), goods emanating from a single source are sold commonly to the same purchaser group in a complementary or pre-packaged way.

- ***Comparison of Trade Channels***

This factor should measure the likelihood of whether confusion is likely when the

same purchasers will encounter the goods/services of the claimed mark and the located mark. The facts of each case should be evaluated concerning confusion. No specific formula of products meeting in the trade, manufacturing, wholesaling or retailing market should per se prohibit concurrent registration of similar marks, whether or not the goods upon which the marks are being used, are related. For example, in very sophisticated markets or for very expensive items, goods may generally be sold under somewhat similar marks without consumer confusion, as compared with inexpensive goods, which are more likely to be purchased on impulse, without careful examination by the purchaser as to source or origin.

- ***Status of the Register and Concurrent Use***

Clearly, if multiple marks containing a similar word or design element can and have co-existed on the Register in the name of different proprietors without apparent confusion among the relevant purchasers, such evidence is in favor of an applicant for registration of an additional such mark.

In Bhutan where there are provisions for opposition proceedings, the owners/users having earlier rights than the applicant will have an opportunity to object to additional registrations.

- Any Other Established Fact Probative on the Issue of Whether the Claimed Mark is Likely to be confused with the Cited Mark(s). The mark may be examined for any other fact probative issue to determine a likelihood of confusion with cited marks.

#### **5.7.4. Examination of Collective Marks**

A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

- a) All the provisions that apply for examination of ordinary trademarks will apply in the examination of a collective mark, however, the following considerations may be given to a collective mark.
- b) Collective marks must be examined for distinctiveness just like in the case of “ordinary” trademarks. When considering the distinctiveness of a collective mark it is important to appreciate that the distinguishing function of collective marks differs from that of “ordinary” trademarks.

Unlike an “ordinary” trademark, which, distinguishes the origin of goods or

services of one trader from those originating from another trader, collective marks serve to distinguish the origin of goods or services of members of a particular association from the goods or services of non- members.

- c) Geographical names (and other such signs or indications) are usually not registrable as "ordinary" trademarks if it is likely to be required by other traders to designate the geographical origin of the goods or services sought for registration.

Notwithstanding the provisions on trademark, a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name)

#### **5.7.4.1. Specification of goods and/or services for collective marks**

As with "ordinary" trademarks, collective marks must be filed in respect of specific goods and/or services in the appropriate classes under the Nice classification for International Classification of Goods and Services.

5.7.4.2. Must be examined if the collective mark (examined from the details in the application and Regulations governing the use)

- Is owned by an association of persons not a partnership.
- Belong to a group and its use thereof is reserved for members of the group.
- Ensures compliance with certain quality standards by its members who may use the collective mark.
- Primary function is to indicate a trade connection with the association or
- organization that is the proprietor of the mark.

#### **5.7.4.3. Examination of the Regulations Governing the Use of Collective mark**

##### **a) Requirement of the regulation**

An applicant seeking registration of a collective mark must file a copy of the regulations governing the use of the collective mark with the Registry, failing which, the application shall be treated as withdrawn.

#### **b) Content of regulations**

Minimum content required in the regulations are:

- Who is authorized to use the mark;
- The conditions of membership of the association and, where they exist;
- The conditions of use of the mark; and
- Any sanctions against misuse

It is to be noted here that in examining the regulations, the Office has a role in ensuring that the regulations are not contrary to public policy or morality

#### **c) Amendment of Regulations**

If the regulations filed by the applicant do not meet the statutory requirements, the Office will inform the applicant and give the applicant an opportunity to make representations or file amended regulations, within a specified period.

If the applicant responds within the specified period but fails to satisfy the Office that those requirements are met, or file the regulations that have been amended so as to meet those requirements, the application will be refused

If the applicant fails to respond within the specified period, the application shall be treated as withdrawn

The filing of the amended regulations shall be made on Form 18 with the requisite fee and must be accompanied by a copy of the amended regulations.

#### **d) Amendment of Regulations by the Applicant on their own.**

Once a collective mark has been accepted and published for opposition purposes, any amendment of the regulations governing the use of a registered collective mark (including any schedules attached to it) is not effective unless and until the amended regulations are filed with the Office and is accepted. This means that the Office has to examine the amended regulations in the same way as newly filed regulations.

Where the Office considers it appropriate, the amended regulations will be published for opposition purposes. In fact, this will be the case in most if not all cases, save where the amendment is insignificant or minor. If no oppositions are received, the regulations will become effective.

#### **5.7.5. Examination of Priority under Paris Convention**

The effect of the right of priority is that the date of priority will count as the date of filing of the trademark application for the purposes of establishing which rights take precedence.

Examination of all applications for registration that claim convention priority is routinely expedited. This is intended to minimize the risk that a conflicting trademark with a priority claim will be overlooked in the examination of other applications.

Should the examination of an application claiming convention priority reveal a conflicting application with a later priority date, then this will also be expedited and the application with the convention claim raised as a citation. If the application is already under examination, then the late citation will be raised. If a conflicting application with a later priority date has already been accepted, then the Registrar may revoke acceptance of that application.

The Office will check that the priority documents contain the same mark, refer to the same applicant and have the same product or service.

#### **5.7.6. Searching online databases for registration of mark**

In general, the office searches the registry database for locating similar or identical marks which are already filed or registered. Internet searches need not be carried out for every case and should be conducted where the examiner has identified a descriptive meaning from the usual references such as dictionaries or subject-specific websites identified as suitable reference sources, or because the examiner has suspicions that an apparently non-descriptive word(s) has come to be used in trade as a description or other doubts

However, searching online databases of other countries may assist an examiner in determining the registrability of a mark and provide guidance. Online databases search of various countries is available under the following link. <http://www.wipo.int/branddb/en/index.jsp>. Further, an examiner can also search databases of individual countries to assist in the decision making.

The online databases are useful among others for the following:

- Guide in registering different kinds of marks
- Whether to register a particular mark and how its done in other countries
- What kind of conditions/disclaimers etc. are provided for registering certain marks

- Assist in determining a well-known/famous mark
- Useful information on the practice of other countries that could be replicated.

## 6. CHAPTER 6: DISCLAIMERS

### *Rule 44 (2)*

#### **6.1. *The purpose of disclaimer***

Where disclaimers are permitted or required in accordance with Rule 44 (2), disclaimers may serve as a means of preventing one party from obtaining exclusive rights in certain non-distinctive components of a mark that otherwise would be distinctive and registerable as a whole. Examples of such non-distinctive components that may be incorporated in an otherwise distinctive mark include descriptive or generic matter, terms common to the trade, and geographical terms or surnames not having trademark significance. In general terms the owner of a registered trademark has no right to the exclusive use of part of the trademark they have registered - he or she has the exclusive right to use and authorize the use of the trademark **as a whole**.

#### **6.2. *Voluntary and mandatory disclaimers***

Disclaimers may be given voluntarily by the applicant in its application to register the mark, provided the mark, as a whole is not disclaimed. Examiners may ask for the disclaimer of any component of a trademark which is not independently registerable, for example, due to its descriptiveness or its being generic.

#### **6.3. *The effect of disclaimers***

**6.3.1.** Disclaimers are ineffective in overcoming objections that:

- The whole of a mark is descriptive or generic; or that
- The mark is scandalous, deceptive, or confusing.

**6.3.2.** Disclaimers do not prejudice or affect the right of a registrant

- To defend its mark through passing off or other common law remedies or unfair competition or
- To seek registration, without disclaimer, of a previously disclaimed component.

A disclaimer is a concession that the disclaimed component is not per se distinctive, and is one factor to be weighed in determining confusion. However, in an infringement analysis, it is the totalities of the components of a mark that must be considered, including any disclaimed components.

#### **6.4. Disclaimer of descriptive or generic terms**

##### **6.4.1. Form of Disclaimer:**

Wording of the Disclaimers can be in the form of:

“The applicant disclaims the right to exclusive use of [disclaimed component] apart from the mark as a whole.”

Each descriptive or generic unit, of however many components, should be separately disclaimed.

*Example:*

- TOFFEE and CRISP should be separately disclaimed in the mark TOFFEE CRISP, but the words RED WINE should be disclaimed as a phrase in the mark JUMBO'S RED WINE.

*Example of a disclaimer involving a representation/figure is:*

- The applicant disclaims the right to exclusive use of the representation of wine bottles per se apart from the mark as a whole (where the application covers wine and wine bottles appear in the mark).

##### **6.4.2. Use of Hyphenated and Compound Words and Disclaimers**

A disclaimer of a descriptive or generic portion of a mark may be considered more appropriate where the term is separated from the remainder of the mark.

Example - Disclaimer may not be required for:

- WINTERWINE or WINTER-WINE, although WINE must be disclaimed for WINTER WINE (all for wine).

##### **6.4.3. The Extent of a Disclaimer**

Any or all components of a mark may be disclaimed separately, provided there is something distinctive about the mark as a whole.

Example:

- TOFFEE CRISP for a candy bar (each word is disclaimed separately).

To avoid cluttering the Register, but subject to context, disclaimers should not be requested for insignificant words, prepositions, articles, conjunctions, and the like, for example, “brand”, “product”, “in”, “and”, “a”, “company”, “Ltd.”, “Inc.” and “the”.

##### **6.4.4. Disclaimers and Proof of Acquired Distinctiveness**

Disclaimers are not required for components that have been registered independently upon proof of distinctiveness by the same applicant (or its

predecessor-in-title) for the same goods or services.

Disclaimers may be suggested by the applicant when all the words of the trademarks are non distinctive and the trademark as a whole is non distinctive.

**Office actions:**

- The Examiner will give a consolidated 'Examination Report' mentioning the objections (if any), accepting application for registration; or accepting the application with or without any restriction, condition or limitation on the use of trademark.
- A search report shortlisting conflicting marks in the registry's database will be attached to the Examination Report in case of prior conflicting marks. The examiner will mention all existing deficiencies in the application and will raise all applicable objections to the acceptance of application for registration of trademark.
- The applicant is required to respond to the examiner's objection(s) within a period of two months (2 months) from the date of receipt of Examination Report.
- The reply to the Examination Report together with evidence of use of the trademark in Bhutan and other documents attached with the reply will be duly considered. In case the objections cannot be waived an opportunity for a hearing will be given to the applicant upon a request by the applicant.
- The application will thereafter be accepted with or without any restriction, condition or limitation on the use of trademark; or as the case may be, it will be refused for registration.
- The decision as to acceptance or refusal of the application will be communicated to the applicant. The accepted application will thereafter be advertised in the Trademark Bulletin.

**7. CHAPTER 7: WITHDRAWAL, CORRECTION, OWNERSHIP CHANGES AND TIME EXTENSION**

**7.1. Withdrawal of applications**

*Section 26 (3), Rule 42*

- 7.1.1. The applicant may withdraw the application at any time during its pendency
- 7.1.2. The withdrawal of the application shall be made by a written declaration signed by the applicant and submitted to the Registrar.
- 7.1.3. The application fee shall not be refunded if the application is withdrawn.
- 7.1.4. Acknowledgement letter for the withdrawal shall be sent with a copy in the

file

## **7.2. Correction of errors/amendments**

*Section 38 (1), Rule 56 (1), (2)*

Applicants are permitted to correct the formalities data for the purpose of:

- Correcting Errors
- Overcoming Objections

A correction is a formal change made by an applicant or registrant to any aspect of a pending application or registration. It may be administrative or substantive in nature, and in the form of a change, an addition, or a deletion. A correction may also be filed to overcome an objection by the Office or help resolve a dispute with a third party. Examples include a change of name and address, a restriction to the specification of goods or services, and an amendment to the trademark itself.

**7.2.1.** Corrections of errors may be done by the Registrar on his own on the following elements

- translation or transcription
- clerical error
- mistake in any application or document filed with the trademark registry
- or any recording effected pursuant to the Act and the Rules

**7.2.2.** Corrections of errors may also be done by the Registrar upon receipt of a request in writing on Form 18 by applicant for the following elements

- Corrections under number 1 above
- or any change in name, address
- or description of the proprietor
- or licensed user
- or striking out any goods/services from the stated specification

**7.2.3.** Corrections made shall be communicated in writing to all interested persons, and, where considered necessary, shall be published by the Registrar.

### **NOTE:**

#### **a) Corrections/Amendments to the Mark**

Corrections to the mark in an application should not be allowed at any time if it would materially alter the character of the mark as originally filed. The general test of whether a correction comprises material alteration is:

- Whether the mark would have to be re-advertised in order to fairly give notice to the public for purposes of opposition or cancellation.
- the addition of an element to a mark would require an additional search of the office records

If it involves either of the two above, it would constitute a material alteration and should not be allowed at any time.

However, deletion from the mark which is of informational matter, which is not a component of the mark itself, alcoholic content, volume and weight of the product, etc. should be allowed.

#### **b) Corrections to the Specification**

Additions or changes to the specification of goods that broaden the scope of goods as originally filed should be prohibited at all times.

Additions or deletions as to words in the specification of goods which do not broaden the original scope should be allowed at all times because it does not prejudice the rights of others.

### **7.3. *Changes in ownership; license contracts***

#### *Section 34, Rule 52*

- 7.3.1.** Change in the ownership of the Registration/Application of a mark or collective mark shall be received by the registry in writing from the applicant on Form 15 with prescribed fees. Accordingly, the registry shall do the following;
- 7.3.2.** Record the changes
- 7.3.3.** Publish the changes
- 7.3.4.** The changes will have no effect against third parties if its not filed and recorded with the registry
- 7.3.5.** Any change in the ownership of the registration/application of a collective mark, shall require previous approval by the Minister.
- 7.3.6.** A change in ownership of the Registration of a mark or a collective mark shall, however, be invalid if it is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the mark or collective mark is intended to be used or is being used.

**7.3.7.** Any license contract concerning a registered mark, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference thereto. The license contract shall have no effect against third parties until such recording is effected.

**7.4. Extension of time**

*Section 38 (2), Rule 56 (3)*

**7.4.1.** Time extension for doing any act or taking any proceeding under this Act and the Rules shall be granted if the registry is satisfied that the circumstances justify it. Extension request shall be received by the registry on Form 19 with prescribed fees.

**7.4.2.** Notice of extension shall be issued to the parties concerned.

**7.4.3.** The extension may be granted though the time for doing the act or taking the proceeding has expired.

**9. CHAPTER 8: PUBLICATIONS**

*Section 27 (2) (a), 29 (1) (c), 37 (2)*

*Rule 46, 48 (4), 49 (3), 50 (iv), 51 (4), 52 (2), 56 (2)*

The Official Bulletin shall include all the publications provided for in this Act as below:

**8.1. Marks that are successful in the examination**

Trademark applications that are examined and accepted unconditionally or subject to any conditions or limitations to which the applicant does not object shall be published for a period of three months. The following details shall be included in the publication.

- the filing date and, where applicable, priority date;
- the representation of the mark;
- the goods or services in respect of which the registration of the mark is requested with an indication of the corresponding class or classes of the International Classification;
- the name and address of applicant; and
- the name and address of the local agent, if any, in the case of a foreign applicant;
- and such other particulars as the Registrar may consider necessary.
-

### **8.2. Publication of registered mark**

The publication of reference to the registration of a mark shall contain the following details

- the application number of the mark;
- the name and address of the registered owner;
- the name and address of the agent, if any;
- the filing date and date of registration
- if priority has been claimed and the claim has been accepted, the priority date, and the country or countries in which or for which the earlier application was filed; and
- the list of goods or services in respect of which the registration of the mark had been made with an indication of the corresponding class or classes or the International Classification.

### **8.3. Publication of renewed mark**

Renewal of the mark shall be published with the following details

- the registration number of the mark;
- the date of renewal and the date of expiry;
- the name and address of the registered owner; and
- the list of goods or services in respect of which the mark has been registered with an indication of the corresponding class or classes of the International Classification.

### **8.4. Publication of collective marks**

Publication of a reference to the registration of the collective mark, in addition to requirements of (number 2 above), shall also include a summary of the regulations appended to the registration

### **8.5. Publication of invalidation**

Any invalidation of a registration of a mark shall be published as soon as possible.

### **8.6. Publication of changes in ownership**

The publication of the change of ownership shall specify

- the title of protection concerned;
- the filing date, the priority date, where applicable, and the date of registration or grant;
- the owner and the new owner; and
- the nature of the change of ownership;

### **8.7. Publication of corrections of errors**

Corrections made shall be published where considered necessary by the Registrar

## **9. CHAPTER 9: REGISTRATIONS AND RENEWALS**

*Section 27 (3), 28, Rule 48, 49*

### **9.1. Registration of a mark**

Registration represents the successful end-point for an application for registration of a trademark that has been accepted. In a legal sense, registration gives the owner the right to use, license, or sell the mark within Bhutan for the goods or services for which it has been registered.

- A trademark becomes registered,
  - after the trademark has been accepted for registration,
  - and passed the opposition period, including any opposition proceedings or appeals
  - applicant is notified of the payment of registration fee,
  - and the appropriate fee has been paid on Form 12,
  - and certificate of registration issued on Form 12A.
  - The registration is identified by the number that was allocated to the application at the time of filing.
  
- The certificate of registration of a mark on Form 12A shall include the following details:
  - the representation of the mark;
  - the number of the mark;
  - the name and address of the registered owner;
  - the name and address of the agent, if any;
  - the filing date;
  - the date registration /certificate issue date
  - the particulars of any Convention priority claimed (priority date and country);
  - the class numbers and the goods and/or services specified in the application at the time of registration;
  - details of colours claimed in respect of the application, if any;
  - any disclaimers/conditions imposed on the registration, if any

## **9.2. Renewal of registration of a mark**

A trademark registration may be renewed at ten-year intervals dating from the original filing date of the application for registration. There is no limit on the number of times a registration may be renewed.

- ***Renewal ('early' or 'on-time') shall be subject to the following conditions:***

- upon a renewal request by the applicant on Form 13
- the request for renewal shall be made during the six-month period preceding the expiry of registration (after 9 years and 6 months of registration)
- the request shall be signed by the registered owner/agent
- upon payment of the prescribed renewal fee
- The prescribed renewal fee shall be Nu.1000 multiplied by number of classes.
- 'early' renewal shall renew the registration for a period of ten years from the date of expiry

- ***Grace period for Late Renewal***

A trademark may still be renewed up to six months after its date of expiry and shall be subject to the following conditions

- upon a renewal request by the applicant on Form 13
- the request for renewal may also be made within six months from the expiration of the last registration (10 years + 6 months)
- the request shall be signed by the registered owner/agent
- upon payment of the prescribed renewal fee and surcharge fees
- the prescribed renewal fee shall be Nu.1000 multiplied by number of classes.
- the prescribed surcharge fees shall be Nu.200
- late renewal still renews the registration for a period of ten years from the date of expiry
- Office shall not consider deemed abandoned the trademark from the register for a period of six months after the expiration of the last registration.

- ***Renewal certificate of registration of a mark on Form 13A shall include the following details:***

- Registration number

- Date of renewal and date of expiry
  - Name and address of the registered owner
  - the class numbers and the goods and/or services specified in the application at the time of registration
- **Failure to renew:**
    - If the registration of a trademark is not renewed, then it ceases to have effect after the date of expiry. The Registrar will remove/consider deemed abandoned the trademark from the Register six months after the date of expiry.
    - an action for infringement may not be brought in respect of an act that would
    - otherwise constitute infringement of a registered trademark, but which occurred during the period after the registration expired, and before it was renewed
    - For the purposes of citation of the unrenewed registration against an
    - application for registration, the unrenewed registration will continue to be cited during the six month period following the date of expiry within which a request for late renewal of the registration may still be filed.

**Office action:**

- If the renewal is filed in accordance with a) and b) above, the renewal certificate shall be generated and issued with the details inc).
- Must note that the next expiry date will be calculated from the last date of expiry for both the renewals occurring under a) and b). Any infringements filed by the registered owner after the expiry of registration and before the end of grace period, if it's not renewed may not be considered.
- Unrenewed registration shall be considered for citation against an application for registration during the grace period.
- After the grace period and if the registration is not renewed, the mark shall be considered deemed abandoned and shall not be cited against an application for registration. (New application for the same mark from different/same applicant shall be accepted).

## 10. CHAPTER 10: MADRID SYSTEM

### Relevant resources

- Trademark provisions under the Industrial Property Act of the Kingdom of Bhutan 2001 and Rules.
- Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement
- Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto
- The Common Regulations and Administrative Instructions are available at [http://www.wipo.int/madrid/en/legal texts](http://www.wipo.int/madrid/en/legal%20texts).

### *Interpretation of Terms*

- **“Madrid Protocol”** means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989;
- **“Madrid Agreement”** means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891;
- **“Common Regulations”** means the regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement and it is usually referred as the Common Regulations
- **“International application”** means an application for international registration filed under the Agreement or the Protocol or both, as the case may be;
- **“International registration”** means the registration of a mark effected under the Agreement or the Protocol or both, as the case may be;
- **“International Bureau”** means the International Bureau of the World Intellectual Property Organization;
- **“International Register”** means the official collection of data concerning international registrations maintained by the International Bureau, which data the Agreement, the Protocol or the Regulations require or permit to be recorded, irrespective of the medium in which such data are stored;
- **“Basic application”** means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that constitutes

the basis for the international application for the registration of that mark;

- “**Basic registration**” means the registration of a mark that has been effected by the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;
- “**Designation of Bhutan**” means a request made in an international registration (either in the international application or subsequently) for extension of protection to Bhutan under Article 3ter(1) or (2) of the Madrid Protocol;
- “**Subsequent designation**” means the request for extension of protection (“territorial extension”) under Article 3ter(1) or (2) of the Agreement or under Article 3ter(1) or (2) of the Protocol, as the case may be, or such extension as recorded in the International Register.
- “**Date of the designation of Bhutan**” means the date of an international registration resulting from an international application in which Bhutan was designated or the date of a subsequent designation of Bhutan, as the case may be.
- “**Contracting Party**” means any country party to the Agreement or any State or intergovernmental organization party to the Protocol;
- “**Gazette**” means the periodical gazette referred to in Rule 32 of the Common Regulations;
- “**Holder**” means the natural person or legal entity in whose name the international registration is recorded in the International Register;
- “**Notification of Provisional Refusal**” means a declaration by the Office of a designated Contracting Party, in accordance with Article 5(1) of the Agreement or Article 5(1) of the Protocol;
- “**Office**” means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in Article 9quater of the Agreement or Article 9quater of the Protocol, or both, as the case may be;
- “**Office of Origin**” means the Office of the country of origin defined in Article 1(3) of the Agreement or the Office of origin defined in Article 2(2) of the Protocol, or both, as the case may be; and

#### ***Summary of the Role of DOMCIIP***

- Receiving, checking and certifying, forwarding and administering new international applications filed under the Madrid system which are based on Bhutan national trademarks. (office of origin)
- Receiving, examining and processing international trademarks which designate Bhutan under the Madrid Agreement and Protocol. (Designated office)
- Updating records to reflect changes to the details of international

- registrations, where those details are relevant to Bhutan.
- Providing information and advisory services on the international system.

## **10.1. Procedures: Bhutan as the office of origin**

### ***10.1.1. Brief description of the Madrid system***

It is a procedural treaty providing for the international registration of trademarks. Under the system, a trademark owner can obtain an international registration, by filing a single application (called an international application) and paying one set of fees, to seek protection of the trademark in several countries that are party to the system. The list of countries where one can seek protection is available at [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=8](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=8).

The Madrid system offers an alternative to filing separate applications directly with individual countries where trademark owners intend to seek registration.

### ***10.1.2. Advantages of the Madrid System***

The advantage of using the system is that applicants may protect their trademarks in several countries simultaneously by means of a single international application filed at their own national trademark office. Further, the applicant uses only one language (English) and pays only in a single currency. The trademark owner enjoys similar benefits when the registration has to be renewed or changed i.e. a single request, in a single language accompanied by payment in a single currency.

### ***10.1.3. Filing an International Application***

An international application must be presented to the International Bureau (IB) through the national trademark office of a Madrid system member state where local protection of the trademark has been sought. This office is known as the Office of Origin for international application and in the context of this manual would be DOMCIIP.

International applications can be filed through DOMCIIP if the applicant meets the following requirements:

- a) The applicant or applicants must:
  - be a citizen of Bhutan; or
  - have a business in Bhutan; or
  - be domiciled in Bhutan; or
  - have a real and effective industrial or commercial establishment in Bhutan; and

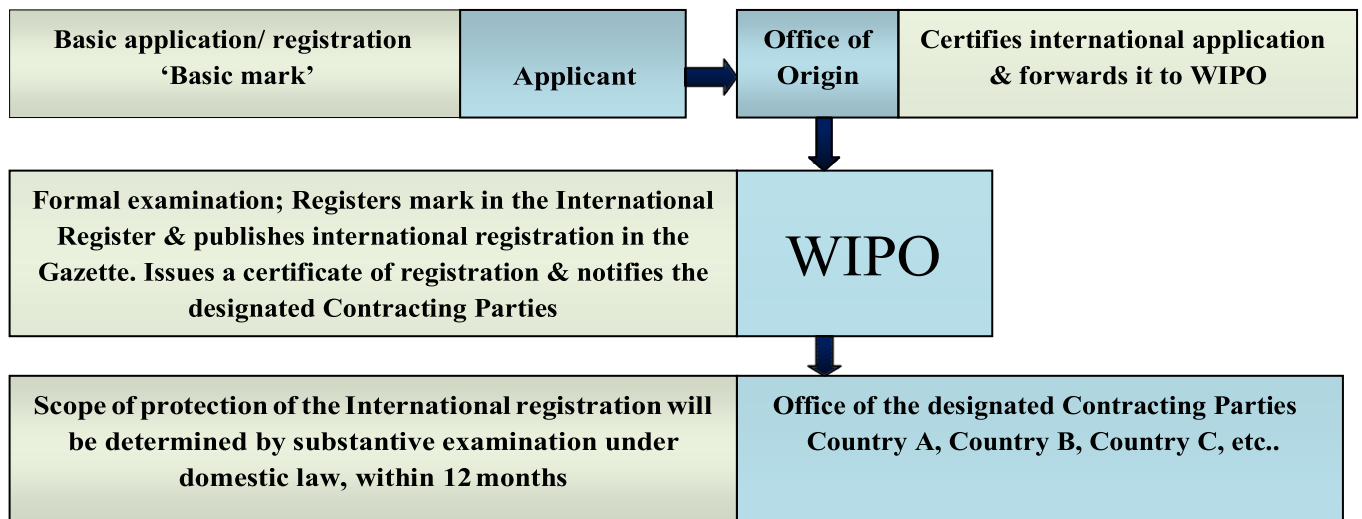
- b) The applicant or applicants must have a trademark application or registration with DOMCIIP (known as the basic mark) for the mark that is sought to be protected in the international application.

The international application must be filed via the national trademark office where the basic mark is held as it is required to certify that the information contained in the application form accords with the details of the basic mark(s). When certified, the application can then be passed to WIPO.

At WIPO a formalities check of the application will be carried out and the mark is translated into the three languages of the system, English, French and Spanish. The mark is then registered and details of the registration will be published in the WIPO Gazette of International Marks.

The IB then notifies the national trademark office of each Contracting Party in which protection of the mark has been requested (also known as the designated Contracting Party). Each country will examine the mark according to their national systems and must inform WIPO within a set time limit whether or not the mark may be protected in that country. Notifications of provisional refusals in designated contracting parties will be published in the WIPO Gazette and also forwarded to the applicant for the mark.

### THE INTERNATIONAL TRADEMARK REGISTRATION PROCESS



#### 10.1.4. International Application Form (MM2)

International applications must be made on the official WIPO form MM2 which may be obtained from the WIPO website. The form MM2 should be submitted to

DOMCIIP in hard copy (paper form).

MM2 forms must be completed in typescript as WIPO does not accept hand-written forms. All MM2 forms submitted to DOMCIIP must be accompanied by Continuation Sheet 8 (CS8) to enter an address for service in Bhutan for the purposes of the international application. For more detailed information on how to complete the form, please refer to WIPO's explanatory notes for the Form DOMCIIP will charge a handling fee for every MM2 form submitted. The applicant may designate one or more Contracting Parties, but not the member state where the international application originates from. For example, if the international application originates from Bhutan, the applicant cannot designate Bhutan in the list of Designated Contracting Parties.

#### **10.1.4.1. Special cases**

- a) Where the United States of America is designated, it is compulsory for the applicant to lodge the form MM18 containing the declaration of intention to use the mark.
- b) Where the European Union (EU) is designated, the applicant must indicate an additional second working language before the Office of the European Union, known as the Office for Harmonization in the Internal Market (OHIM). The other four official languages of OHIM are French, German, Italian and Spanish. The second language serves as a language in which third parties may lodge opposition and cancellation proceedings before OHIM.

#### **a) Seniority claim (where the European Union is designated)**

The Community Trademark System (CTM system) is a unified trademark registration system in Europe, whereby one registration provides protection in all member states of the EU. The CTM system allows the owner of a registered trademark in an EU member state to claim seniority of that earlier mark when the owner applies for registration of an identical mark with OHIM as long as the goods and/or services claimed are covered by the earlier mark. Seniority claim has the sole effect under the CTM Regulation that, where the proprietor of the Community trademark surrenders the earlier trademark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trademark had continued to be registered. To claim seniority, applicants are required to lodge the WIPO form MM17 together with the international application form. They will have to indicate:

- a) each member state in or for which the earlier mark is registered;
- b) the date from which the registration was effective;

- c) the number of the registration; and
- d) the goods and services for which the earlier mark is registered.

#### **10.1.5. Fees for International Applications**

The fees to be paid to obtain an international registration comprise:

- a) A basic fee (note that this fee is higher where the reproduction of the mark is in colour);
- b) A complementary fee for each designated country which does not require an individual fee, or an individual fee for those designated countries that require it; and
- c) A supplementary fee (for each class of goods and/or services over three classes in the international application. This fee does not apply if all the designated countries have individual fees.

WIPO Fee Calculator at <http://www.wipo.int/madrid/en/fees/calculator.jsp> will help to estimate international application fees.

Fees must be paid in Swiss francs (CHF) and further information about the fees under the Madrid system and the payment methods is available at <http://www.wipo.int/about-wipo/en/finance/madrid.html>.

##### **10.1.5.1. Basic fee**

WIPO charges a basic fee for all international applications.

- The fee is based on whether the mark sought for registration is in black and white or in colour.
- The basic fee for a black and white reproduction of the mark is 653 Swiss francs.
- If a coloured reproduction of the mark is lodged, the basic fee payable is 903 Swiss francs.
- It does not matter that the applicant intends to limit the mark to colour(s) or claim colour(s) as a trademark or claim colour as a distinctive feature of the mark. As long as the mark is in colour(s), the higher fee is payable.

##### **10.1.5.2. Complementary fee**

Applicants must pay a Complementary fee for each designated Contracting Party which opts to charge complementary fee instead of an Individual fee. The complementary fee set by WIPO is 100 Swiss francs for each designated Contracting Party. This means that if there are seven designated Contracting Parties which collect Complementary fee, the complementary fee will be 700

Swiss francs.

#### **10.1.5.3. Supplementary fee**

For Contracting Parties that charge a complementary fee and where the application contains more than 3 classes, a supplementary fee of 100 Swiss francs is payable for each additional class.

The fee will be charged where at least a Contracting Party that collects complementary fee is designated and the amount charged will depend on the number of classes applied beyond the first 3 classes. For instance, if there are five designated Contracting Parties with two of them charging complementary fee and application is filed for 10 classes, the supplementary fee will be 700 Swiss francs. The supplementary fee is only applicable to Contracting Parties that charge a complementary fee. Hence if the applicant only designates Contracting Parties that charge individual fees, it would not be necessary to pay supplementary fees.

#### **10.1.5.4. Individual fee**

Bhutan has opted for complementary/ supplementary fees although number of countries have opted to receive an individual fee instead of complementary / supplementary fees.

The quantum of the individual fee varies for each Contracting Parties and depends on the number of classes and type of mark applied for (in particular, certification and collective marks have a higher fee). Some Contracting Parties that require an individual fee may also request for fees to be paid in two parts, the first part at the time of filing the international application and the second part at a later date, which is determined in accordance with the law of that Contracting Party. The list of individual fees, including information on Contracting Parties that have a two-part fee is at: [http://www.wipo.int/madrid/en/madridgazette/remarks/ind\\_taxes.html](http://www.wipo.int/madrid/en/madridgazette/remarks/ind_taxes.html)

#### **10.1.6. Certifying process**

All international applications must be sent to the IB by the Office of Origin. The IB will not accept any international applications directly from applicants or their agents. This is because the Office of Origin must certify:

- The filing date of the international application; and
- That the details on the international application accord with those on the basic mark.

#### **10.1.6.1. Filing date of International Application**

As the Office of Origin, DOMCIIP is responsible for certifying, among other things, the filing date of the international application.

Where the international application is certified and forwarded to the IB within **two months** from receipt by DOMCIIP, the date of receipt by DOMCIIP will be the date recorded for the resulting International Registration. Otherwise, the filing date of the international application will be the date on which the IB receives the international application. This filing date will, upon registration of the mark by the IB, become the international registration date. Rights acquired by protection of the mark will start from this date.

A later filing date may also be accorded to an international application by the IB if there are deficiencies in the form MM2 and the deficiency is not rectified within the stipulated time. When this happens, the priority claim, if any, may be lost if the later filing date is more than 6 months after the priority date.

#### **10.1.6.2. Certification of particulars**

This process requires the office to ensure that the basic trademark(s) and the international application details are same. The following shall be checked:

- The applicant of the international application and the owner of the basic mark are the same
- The addresses are the same or the differences explained
- The marks are same.

If the international application cannot be certified, the applicant or the applicant's agent will be notified of the irregularities in writing including the following:

- Suggestions to resolve the irregularities, where possible; and
- A reminder that the filing date of the international application will be lost if both the international application and the office's certification are not received by the IB within two months of the date DOMCIIP received the application.
- If the international application is in order and has been certified, DOMCIIP will transmit the international application to the IB electronically

#### **10.1.7. Action Taken by the IB**

Upon receiving the international application, the IB will conduct a formalities examination. In formalities examination, the IB checks that all filing requirements have been complied with, that the classification of the goods and services listed on the international application is correct and that all appropriate fees have been paid. **This is not a check as to the validity or acceptability of the mark** but

simply a formalities check.

#### **10.1.7.1. Irregularities in the international application**

If the IB identifies irregularities in an international application, the IB will notify both the Office of Origin and the applicant by way of an irregularity notice. The irregularities must be remedied either by the DOMCIIP or the applicant, depending on their nature.

The IB will highlight the nature of the irregularities in the notice, giving a three-month deadline to remedy them. If the irregularities are not rectified during the prescribed period, the international application is considered abandoned. This deadline is not extendable.

#### **10.1.7.2. Types of irregularities**

The applicant may deal with the IB directly on any irregularities relating to fees. However, if the irregularity may only be remedied by changing the contents of the application, then that irregularity must be responded to by the Office of Origin. For example, if IB holds the view that the description of goods does not comply with the Nice classification, the IB will issue an irregularity notice with proposed alternative description to the Office of Origin. The Office of Origin will liaise with the applicant on the issues raised by IB and the office will then inform IB of the applicant's response accordingly.

If the irregularity relates to a classification of goods and services, the IB may propose a reclassification which could require additional class fees.

For irregularities concerning terms which are

- deemed to be too vague for the purposes of classification,
- incomprehensible, or
- linguistically incorrect,

The IB may suggest a rewording or deletion of the objected terms. If the Office of Origin and the applicant are able to remedy the irregularity within the given deadline, the IB will make the changes. However, if no acceptable proposal is received by the IB within the deadline, the IB will include the term in the international registration but with a proviso that they consider the term to be too vague for classification purposes, incomprehensible or linguistically incorrect. It is then left to the individually designated Contracting Parties to object to the objectionable terms.

#### **10.1.8. Registration**

If the international application is in order, the IB will assign it an international registration number and publish it in the WIPO Gazette as an international registration (IR). A Certificate of Registration will be sent to the applicant who is now known as the “holder” of the international registration. The IB also advises the Office of Origin of the IR number. Although the international application is registered upon the completion of the formalities examination, this does not amount to protection of the mark in the designated Contracting Parties, as the international registration is still subject to substantive examination in those countries.

#### **10.1.9. Subsequent Designations**

If the owner of an international registration wishes to extend protection of his trademark to other Contracting Parties, in addition to those already designated, he can subsequently designate more Contracting Parties in the same international registration. Subsequent designations may only be made after the international application has resulted in an international registration.

Subsequent designation is made using the WIPO Form MM4. Unlike international applications, subsequent designations need not be filed through the Office of Origin but may be filed directly with WIPO. In fact, direct filing with WIPO is recommended.

Similar to an application for international registration, the IB will conduct formalities check on the subsequent designation filed. Applicants will be given three months to rectify any irregularities. Once the formalities check is complete, the subsequent designation will be registered and published in the WIPO Gazette. Details of the subsequent designation will be sent to the newly designated Contracting Parties. The acquired rights in each newly designated Contracting Party will start from the date of subsequent designation.

The period of protection under the subsequent designation will expire on the same date as the international registration. For example, if an international mark has already been registered for 9 years and the subsequent designation is filed at the end of the ninth year, the mark will only be protected for one year in the newly designated Contracting Parties. Example an international registration mark is registered on 15 June 2000 and the designated country is Switzerland. A subsequent designation is filed on 1 January 2009 and the country designated is France. The protection of the mark in Switzerland and France expires on the same date, ten years after the date of international registration which would be

15 June 2010.

#### **10.1.10. Dependency and Central Attack**

For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the mark applied for or registered in the Office of Origin (i.e. the basic mark). The period of five years is known as the “dependency period” and the consequence of it is the ceasing of the effect of the international registration which may be partial or full.

As the Office of Origin, DOMCIIP needs to notify the IB when:

- A basic trade mark ceases to exist within this period; or
- The scope of the basic trademark is restricted during this period; or
- The basic trademark ceases to exist or is restricted as a result of an action which commenced within this period.

DOMCIIP must therefore monitor Bhutan's basic trademarks for any of the following changes:

- a) The basic trademark application is refused, withdrawn or treated as withdrawn
- b) The scope of the basic trademark application or registration is restricted (i.e. some of the goods and/or services are deleted)
- c) The basic trademark registration is cancelled, revoked or invalidated
- d) The basic trademark registration is not renewed

Once notified, the IB cancels the international registration to the same extent, and notifies all designated countries as well as the holder of the International Registration. After the expiry of the dependency period, the international registration becomes independent of the basic application(s) or the basic registration(s). This means that any challenge or withdrawal of the basic application or basic registration will not have an impact on the international registration.

There is no separate dependency period for subsequent designations. The only dependency period is the one which runs from the date of the international registration. For instance, the date of international registration is 1 February 2010 and the date of subsequent designation is 1 February 2012. The dependency period for both the international registration and subsequent designation is within five years from the date of the international registration.

The international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees directly to the WIPO.

#### **10.1.11. Transformation into National Application**

If an international registration is cancelled as a result of the ceasing of effect of the basic application or the basic registration, the holder of the international registration can apply to transform international registration into one or more national applications (in the designated Contracting Parties). This is known as “transformation”.

The process of transformation helps to mitigate the vulnerability of the five-year dependency feature in the Madrid system, as the national applications resulting from this transformation will be treated as if they had been filed on the date of the original international registration. In other words, the filing date of the international registration is not lost upon cancellation of the international registration, if it is transformed into national applications.

To qualify for transformation, the holder must apply for transformation within three months of the date of the cancellation of the international registration. Transformation may take place only where the international registration has been cancelled, in respect of all or some of the goods and services at the request of the Office of Origin. When this happens the Office of Origin will inform the IB. After the international registration has been cancelled, the holder will have three months from the date of cancellation to file the transformation request directly with the designated Contracting Parties. Transformation is not available where international registration has been cancelled at the request of the holder. If an international registration originating from Bhutan has been cancelled and the applicant wishes to transform it to a national application in the designated Contracting Parties, the applicant will have to file the request for transformation with the respective designated Contracting Parties. It is to be noted that the transformation process and requirements may differ between the Contracting Parties.

#### **10.1.12. Changes affecting the International Registration**

The International Register is kept at WIPO. Therefore WIPO must be informed of changes relating to international registrations. Most of these changes can be filed directly with WIPO by the holder of the international registration.

##### **10.1.12.1. Change of Ownership (MM5)**

The holder of an international registration may transfer ownership of the

international registration to another party (i.e. the transferee).

To do so, the holder must use the official WIPO form MM5 and a fee in Swiss francs is payable.

The request may be presented to the IB by the holder directly, or through the national trademark office of the holder or the national trademark office of the transferee. In order for the transfer to be recorded on the international register, the transferee must also be entitled to own the mark under the Madrid system.

This means that the transferee must:

- have a real and effective industrial or commercial establishment; or
- be domiciled in the contracting party, or
- be a national of the contracting party.

The condition known as the entitlement to hold the mark must be indicated on the form MM5.

#### **10.1.12.2. Limitation, Renunciation and Cancellation (MM6, MM7 & MM8)**

To restrict the scope of protection of an international registration, the applicant may choose to record a limitation, renunciation or cancellation with the IB.

The differences are:

- **Limitation:** Limits some of the goods and services in some or all of the designated Contracting Parties.
- **Renunciation:** Affects all the goods and services in some but not all of the designated Contracting Parties.
- **Cancellation:** Cancels some or all of the goods and services in respect of all designated Contracting Parties.

<b>Process</b>	<b>Goods and services</b>	<b>Contracting parties affected</b>
Limitation	Some	Some or all
Renunciation	All	Some but not all
Cancellation	Some or all	All

Although a limitation and a cancellation have much in common, there is one important difference. If some goods and services have been removed following a limitation, the applicant can lodge a subsequent designation if protection for these goods and services is required in the future. The goods and services are not permanently removed from the international registration. Similarly, goods and services that have been renounced can be designated again.

A cancellation, on the other hand, removes the goods and services permanently from the international registration. The applicant will not be able to apply for a subsequent designation to seek protection of the cancelled goods and services. The only way to do so is by filing a fresh international application.

- **Limitation of the list of Goods and Services (MM6)**

The official form to record a limitation is the official WIPO Form MM6 and a fee is payable for each Contracting Party to which the limitation applies.

This form may be presented directly to the IB by the applicant or through the national office of the applicant. Once the limitation is recorded and published in the WIPO Gazette, the notification of limitation will be sent to the Contracting Parties concerned.

- **Renunciation (MM7)**

If the applicant no longer wishes to protect his mark in one or more (not all) designated Contracting Parties, the applicant may lodge the official WIPO Form MM7 to request for a complete withdrawal for protection of a mark in those countries. It should be noted that if the applicant wishes to renounce the mark in all the designated Contracting Parties, the applicant should request for a cancellation rather than a renunciation.

The form may be sent directly to the IB or through the national office of the applicant. A request to record a renunciation is free of charge.

Like a request to record a limitation, the renunciation will be recorded and published in the WIPO Gazette before the notifications are sent to the relevant Contracting Parties.

- **Cancellation of the International Registration (MM8)**

Cancellation affects some or all of the goods and services in all the designated countries.

The applicant may lodge the official WIPO Form MM8 to request for a cancellation. Upon cancellation, the goods and services are removed from the international registration permanently.

The applicant will have to indicate on the form if the cancellation is in respect of some or all of the goods. If the cancellation relates to specific goods and/or services, the applicant will have to list these goods and/or services in part 4(b) of

the form.

The completed form may be submitted directly by the applicant or through the national office of the applicant. A request to record a cancellation is free of charge.

The request will be published in the WIPO Gazette and all the designated Contracting Parties will be notified accordingly.

#### **10.1.12.3. Renewal (MM11)**

Renewal of an International Registration is due 10 years from the date of the International Registration. The IB will send the holder an unofficial reminder six months before the IR is due for renewal.

This may be done by way of letter or by using the official renewal form MM11. Alternatively, renewals may also be filed electronically via WIPO's website.

It is possible to renew the IR six months after the expiry of the registration. However, if renewal requests are filed during this six-month grace period, a surcharge would be added to the renewal fees. Applicants are encouraged to file the renewal directly with WIPO. If the renewal is filed through DOMCIIP, a handling fee is payable.

#### **10.1.12.4. Change in Name and/or Address of the Holder (MM9)**

Where there has been a change in the name and/or address of the holder, Form MM9 is to be used to record the change and a fee in Swiss francs is payable. Applicants can lodge one form to effect the change for several international registrations that belong to them. The request may be lodged directly with the IB by the holder or through the national office of the holder.

#### **10.1.12.5. Appointment of a Representative (MM12)**

Appointment or change of a representative may be done at any time via a simple letter or Form MM12. Such communication may be presented to the IB by the new representative, the applicant or the representative on record. If it is presented by the representative on record, it must be signed by the holder or the new representative. One form or letter may be used for multiple international registrations. However, all the international registrations affected must be clearly stated.

#### **10.1.12.6. Change in Name and/or Address of Representative (MM10)**

To update the details of the applicant's representative on record, the request may

be made by way of a simple letter or MM10. This form is free of charge and one form may be lodged for multiple international registrations. However, all the international registration numbers of the affected international registrations must be specified. The form may be sent directly to the IB or through a national office. It must be noted that Form MM10 may only be used to amend the details of the agent or representative on record. It cannot be used to appoint a new representative.

#### **10.1.13. Replacement of National Registration**

An international registration may replace an existing national registration in any of the designated Contracting Parties under certain circumstances. When this happens, the international registration will substitute the national registration. For replacement to take place, the international registration must:

- Have been granted protection in the relevant country;
- Be in respect of the same mark;
- Be held by the same holder; and
- Cover all the goods and services listed in the national registration.

Although replacement is deemed to happen automatically if the above conditions are met, it is only recorded by the designated country if a request to record is made.

### **10.2. *Procedures: Bhutan as designated office***

In the same way that holders of trademarks in Bhutan may use their national mark as a basis for an international registration seeking protection in other member countries of the Madrid system, holders of marks in other member countries may use their national trademarks as a basis for an international registration designating Bhutan.

DOMCIIP receives weekly electronic notifications from the IB containing the details of new international registrations/ subsequent designations designating Bhutan. These electronic notifications are uploaded through the Madrid uploader into the IPAS which is then processed.

#### **10.2.1. Examination of International Registrations/ Subsequent Designations designating Bhutan**

##### **10.2.1.1. Same examination procedure as National applications**

International registrations/ subsequent designations designating Bhutan are examined in the same way as national applications which are filed directly with DOMCIIP. The international registrations/ subsequent designations are examined for registrability in accordance with the Trademark Provisions under the Industrial Property Act of the Kingdom of Bhutan 2001 and Rules.

#### **10.1.1.2. Provisional Refusal of Protection**

If the international registration / subsequent designation does not comply with the provisions of the law, DOMCIIP will notify the IB that protection of the mark has been refused in Bhutan.

This notification, known as a Provisional Refusal, must be sent to the IB within the applicable time limit of 12 months from the date of notification of the international registration / subsequent designation. Once the Provisional Refusal has been sent to the IB, the IB will forward it to the holder of the international registration / subsequent designation or the holder's representative.

If DOMCIIP does not notify a Provisional Refusal to the IB within the applicable time limit, DOMCIIP would lose the right to refuse protection to the international registration/subsequent designation, and the mark will therefore be deemed to be registered in Bhutan.

As with national applications, DOMCIIP will routinely expedite international registrations with a priority claim in order to minimize the risk of registering earlier filed trademarks which are similar or identical but without a priority claim.

There are two kinds of refusal

- Provisional Refusal based on Ex officio examination may also be issued if the examiner has objections in line with the Industrial Property Act of Bhutan.
- Provisional Refusal based on Opposition may also be issued if a third party files a Notice of Opposition opposing the mark from being registered in Bhutan.

If DOMCIIP has examined an international registration / subsequent designation and found no grounds for refusal, it may issue a Statement of Grant of Protection.

#### **10.2.2. Acceptance of International Registration/ Subsequent Designation designating Bhutan**

If there are no objections to the international registration / subsequent designation designating Bhutan, or where there are objections and the objections

have been overcome, the international registration / subsequent designation shall be published for opposition purposes in the DOMCIIP Trademark Bulletin for a period of three months as similar to the national trademark applications.

### **10.2.3. Corrections from WIPO**

Under Rule 28 of the Common Regulations, where the IB, of its own volition or at the request of the holder or of an Office, considers that there is an error in the information recorded on the International Register, it will correct that information accordingly. The IB's practice with regard to the correction of international registration is as follows:

- where there has been an error on the part of the IB, the error will be corrected;
- where there has been an obvious error and nothing else could have been intended other than what is offered as the correction, the error will be corrected as soon as the error comes to the IB's attention; and
- where there is an objective error in a fact recorded in the International Register. While the holder of the international registration or the Office may request for the correction of the international registration, the request for correction should be submitted by the Office of Origin of the Contracting Party in the event that the error results from a discrepancy between a document filed with the IB and what is recorded in the register of that particular Contracting Party.

Accordingly, an error which is attributable to an Office and the correction of which would affect the rights deriving from the international registration may be corrected only if a request for correction is received by the IB within nine months from the date of publication of the entry in the International Register.

There may be instances where the corrections would widen the scope of the list of goods and services originally filed. Additionally, there could even be instances where the corrections would result in a change to the representation and identity of the mark. In such cases, the international registration / subsequent designation designating Bhutan may need to be re-examined. Also, in the event new goods or services appear in the international registration / subsequent designation after a correction, the international registration / subsequent designation will have to be re-examined in respect of those new goods and services. However, corrections which limit the scope of a mark are acceptable and will not need to be re-examined.

If the mark has been corrected substantially, it will be necessary to re-start the

examination procedure with the corrected mark. If the international mark has already been published, it will be necessary to withdraw the publication.

#### **10.2.3.1. Processing of Correction notifications by DOMCIIP**

If a correction notice has been received, DOMCIIP will make the necessary amendment. In cases where the correction involves the replacement of the original mark with a new mark, the mark will have to be re-examined. A recalculation of the 12-month time limit may be necessary.

If the correction results in a new objection, DOMCIIP will issue a Provisional Refusal following a Correction Notice to the IB.

Where a correction notification is received after an international registration / subsequent designation has been published in the Trademark Bulletin for opposition, a further publication may be made in the Corrigenda section of the bulletin stating the details of the correction after the correction notice has been processed. Types of corrections which may be processed could relate to:-

- International Registration Date, Subsequent Designation Date, International Registration, Notification Date, Subsequent Designation Notification Date
- Name and/or Address of Holder
- Mark
- Mark Type
- Goods/Services
- Priority Details
- Transliteration, Translation, Disclaimer, Color Claim, Mark Description.

It is to be noted that not all correction notifications from the IB will require action on the part of DOMCIIP. For example, there may be corrections for the inclusion or deletion of certain member countries from the designation list, or for the limitation of the list of goods and services which are not applicable to Bhutan.

It is possible to receive more than one correction notification in an international registration. A second or subsequent correction notification may be issued by the IB to correct the details of the earlier corrections. The correction history is available for viewing in IPAS along with the other details of the mark.

#### **10.2.4. Provisional Refusal of Protection of International Registration/ Subsequent Designation designating Bhutan**

The Provisional Refusal will indicate the grounds for refusal of protection together with a copy of the relevant laws in support of the objections. If any confusingly

similar marks are cited, the details of these marks will also be attached to the Provisional Refusal.

The Provisional Refusal must state all the grounds on which the Provisional Refusal is based and if the refusal does not relate to all the goods and services of the international registration, it must state the goods and/or services which are affected by the refusal. The Provisional Refusal will also provide guidance to the holder if he wishes to request a review or file a notice of appeal against the Provisional Refusal. A time limit for such requests will also be indicated therein. DOMCIIP imposes a two month deadline for the holder to respond to the Provisional Refusal. A time extension may be filed. The two month deadline is calculated from the date of the Provisional Refusal.

The IB will record the information contained in the Provisional Refusal and will forward it to the holder of the international mark or to his agent in the country of origin. The Provisional Refusal is also available for viewing online at WIPO's ROMARIN database (<http://www.wipo.int/romarin/>).

#### **10.2.5. Irregularity Notice from WIPO on Provisional Refusal**

The Provisional Refusal from the Office must meet the following conditions, among others:-

- it must contain the international registration number;
- it must indicate the grounds for the refusal; and
- it is sent within the 12 month time limit;

If any of the above conditions are not met, the IB will send an Irregularity Notice to the Office highlighting the irregularities and will also inform the Office that the notification of Provisional Refusal is not valid. Where the irregularity relates to the contents of the notification, the Office may send a further notification in which the irregularity has been rectified, provided that this further notification is sent within the applicable time limit.

#### **10.2.6. Time Limit for notifying Provisional Refusal**

Any member country of the Madrid system has the right to refuse protection of international registration. The Provisional Refusal of protection must however be received by the IB within 12 month time limit. The time limit is from the notification date of the international registration or a subsequent designation. This applies to all notifications of Provisional Refusal of protection whether based on grounds refused ex officio by the Office or based on opposition.

In general, an Office which has not notified a Provisional Refusal to the IB within

the appropriate time limit loses the right to refuse protection.

#### **10.2.6.1. Late Provisional Refusal based on Opposition possible**

A Provisional Refusal based on opposition may be notified to the IB after the end of the 12 month time limit. However, the member country must, before the expiry of the 12 month time limit, have informed the IB that there is a possibility that oppositions may be filed after the expiry of this time limit. Further, the notification of Provisional Refusal based on an opposition must have been sent to the IB before the expiry of:

- the period of one month from the expiry of the opposition period, or
- the period of seven months from the beginning of the opposition period, whichever is earlier.

#### **10.2.7. Opposition filed near the end of the 12 Month Time Limit**

Where an Office has informed the IB that the opposition period will expire within 30 days before the end of the 12 month period, a Provisional Refusal that is based on an opposition filed within those 30 days, may be notified to the IB within one month of the opposition being filed.

Where an Office fails, before the expiry of the 12 month time limit, to notify the IB of the possibility of late Provisional Refusals based on opposition, the IB will disregard the Provisional Refusal and inform the Office accordingly. Similarly, where a Provisional Refusal based on opposition is notified after the end of the 12 month period, and the prior notification of this possibility had not been given or had been given too late, the IB will disregard the Provisional Refusal and inform the Office accordingly.

##### **10.2.7.1. Address for service in Bhutan**

Upon receiving the Provisional Refusal of protection issued by Bhutan from the IB, the holder may request for a review of the Provisional Refusal. The request for review must include an address for service in Bhutan (registered agent) to which all correspondences will be sent by DOMCIIP.

##### **10.2.7.2. Two month deadline**

A Provisional Refusal of protection comes with a two month deadline for the holder to respond.

If the holder of the international registration does not respond with his submissions before the deadline the international registration faces two possible

outcomes:-

- If the international registration has been partially refused, the mark will be accepted and published only for those goods / and or services not affected by the provisional refusal.
- If the international registration has been refused totally, the refusal will become final for all goods / and or services.

#### **10.2.8. Publication of International Registration**

Every international registration / subsequent designation designating Bhutan which has been accepted for protection will be published in Trademark Bulletin and are open to opposition for a period of three months. The Trademark Bulletin will be published in DOMCIIP, MoEA websites and a soft copy shall be available for all interested persons.

#### **10.2.9. Opposition to International Registration**

International marks are subject to the same opposition procedures as national marks. The opponent must file Form TM 10, together with a Statement of Grounds of Opposition and the relevant fees. When an opposition action is initiated against an international mark which has been published, DOMCIIP will issue a Provisional Refusal based on opposition to the IB. A copy of Form TM 10 and the Statement of Grounds of Opposition will be attached to the Provisional Refusal of protection based on opposition.

#### **10.2.10. Protection of International Registration**

If there are no oppositions or where there are oppositions and the proceedings are resolved in favor of the holder, the international registration designating Bhutan will be registered.

It should be noted that no registration certificates are issued by DOMCIIP with regard to protected international marks in Bhutan. Instead, one of the following statements on the final status of the mark will be issued to the IB to inform on the conclusion of the proceedings in Bhutan.

##### **10.2.10.1. Statement of Grant of Protection where no notification of Provisional Refusal has been communicated**

With effect from 1 September 2009, an Office which has examined an international registration in which it is designated and found no ground for refusal must issue a Statement of Grant of Protection (“Statement of Grant”).

A Statement of Grant will be issued under this only if the mark is registered within the 12 month time limit from the date of notification of the international registration/subsequent designation.

However, the Statement of Grant will not be issued where the mark is registered after the 12 month time limit as the international registration will be regarded as protected in Bhutan. The Statement of Grant allows WIPO to close the case without the need to wait till the end of the 12 month period. WIPO will record and publish the Statement of Grant before forwarding the Statement of Grant to the holder.

#### **10.2.10.2. Statement of Grant of Protection following a Provisional Refusal**

If a Provisional Refusal of protection has been issued in respect of the international registration and protection of the mark is eventually granted whether wholly or partially, a statement would be issued indicating either:

- that the provisional refusal is withdrawn and protection of the mark is granted for all the goods and services for which protection is requested; or
- the goods and services for which protection is granted.

#### **10.2.10.3. Confirmation of Total Provisional Refusal**

If a total Provisional Refusal of protection has been issued in respect of the international registration and the total Provisional Refusal is maintained, a statement will be issued confirming the refusal of protection for all the goods and services i.e. that there is no protection accorded in Bhutan.

#### **10.2.11. Date of completion of registration procedure**

For the purposes of Rule 18 of the International Registration Rules, the date of completion of the registration procedure is the date on which the Statement of Grant is issued or one day after 12 months from the date of the notification of the international registration / subsequent designation, in a case where no Statement of Grant and no notification of Provisional Refusal has been communicated. This means that use of the mark must commence within five years from this date or the registration stands to be revoked.

#### **10.2.12. Collective marks**

International applications may be filed for collective marks in Bhutan. As the international application form does not distinguish between various types of marks, the holder must specify the type of protection applied for in which if not specified, DOMCIIP will raise a provisional total refusal of protection. The reason for this is that Bhutan only accepts collective marks and do not accept

certification/guarantee marks. It is also a requirement under the Industrial Property Act of the Kingdom of Bhutan 2001 that regulations governing the use of collective mark are filed.

#### **10.2.13. Priority Claims**

Where priority is claimed, a statement to that effect appears in the notification of International Registration / Subsequent Designation. DoMCIIP will verify that the priority date falls within six months of the international registration / subsequent designation date.

#### **10.2.14. Cancellations**

##### **10.2.14.1. Cancellations effected for all the Goods and/or Services**

When the IB notifies DOMCIIP that the international registration has been cancelled for all goods and/or services at the request of the Office of Origin, DOMCIIP will keep in view the notification of cancellation from the IB for four months to allow time for transformation, if requested by the holder.

Under Article 9quinquies, holders of international registrations may file an application to transform an international registration / subsequent designation (cancelled at the request of the Office of Origin) into a national or regional application, within three months from the date on which the international registration was cancelled, provided certain conditions are met.

When DOMCIIP receives an application to transform all or some of the cancelled goods and / or services within the three month period, it will ensure that the application is submitted by the same holder of the international registration, the application relates to all or some of the cancelled goods and / or services and the application for the identical mark.

The cancelled goods and/or services as applied for in the transformation application will then form the subject of a new national trademark. The transformed national application or registration retains any priority date(s) applicable to the goods and/or services from the international registration.

The process of examination, opposition or registration, whichever applicable, will continue with regards to the newly transformed national trademark.

##### **10.2.14.2. Cancellations effected for some of the Goods and/or Services**

Partial cancellations, that is, cancellations which relate to only some of the goods and services of an international registration at the request of an Office of Origin,

are processed as similar to a) above. The difference is that only those goods and services in the international registration which are affected by the cancellation will be deleted from the international registration and eligible for transformation. Those goods and/or services not affected by the cancellation will remain in the International Registration.

#### **10.2.14.3. Updating Cancellations**

DOMCIIP will process the cancellation notice from the IB in the following manner:

- In the case of a partial cancellation at the request of the Office of Origin, the goods and services partially cancelled will be deleted from the international registration designating Bhutan.
- In the case of a full cancellation at the request of the Office of Origin, the status of the international mark will be set to "Withdrawn" for pending mark and "Cancelled" for registered mark

#### **10.2.14.4. Transformation of a Cancelled International Registration into National Application**

Where, during the five year dependency period following the date of international registration, the national application or registration on which IR is based is refused or cancelled, the Office of Origin is required to request that the international registration be cancelled, to the same extent.

The IB will then notify all designated Contracting Parties of the cancellation. Where the international registration designating Bhutan is cancelled whether for all or some of the goods and services at the request of the Office of Origin, the holder is given the possibility to obtain protection of his mark in Bhutan by transforming it into a national application within three months from the date of cancellation of the international registration. If the holder chooses to do so, the filing date of the international registration is preserved. This is known as transformation.

The transformed national application will be treated as though it had been filed on the date of the international registration or the date of the subsequent designation, provided that:-

- the national application is filed within three months from the date on which the international registration was cancelled;
- the transformed national application is for the same mark and for the same or no wider goods and services than the international mark; and
- all national filing requirements, including payment of fees, have been met.

The transformed national application shall also enjoy the priority which was enjoyed by the international registration. Holders who wish to transform their cancelled international registrations to national applications in Bhutan may do so by completing Form TM 7 with the requisite fee.

If the transformation application is successful, the international registration / subsequent designation in national register will reflect the new national trademark number, under the field "Transformation Application under Madrid system". Likewise, it will also be indicated in the register that the new national trademark has been transformed from an international registration.

Transformation may take place only where the international registration has been cancelled, either partially or totally in respect of the goods and services, at the request of the Office of Origin. It is not available where the international registration was cancelled at the request of the holder/owner.

#### **.2.16. Replacement of National Registration with International Registration**

A national registration in Bhutan is, under certain conditions, deemed to be replaced by an international registration of the same mark. These conditions are:-

- both the national registration and the international registration are in respect of the same mark;
- both the national registration and the international registration are in the name of the same holder;
- all the goods and services listed in the national registration are also listed in the international registration; and
- the international registration is extended protection in Bhutan on a date later than the date of the national registration.

Therefore, if the holder of the international registration designating Bhutan already owns an existing Bhutan national registration(s), it is possible for the holder to replace the national registration(s) with the international registration if the conditions above are met.

While the list of goods and services in the national registration must also be listed in the international registration, the international registration need not have an identical list of goods and services. The list of goods and services in the international registration may be broader in scope than that of the national registration. However, it cannot be narrower.

As replacement is deemed to take place automatically as long as the above

conditions are met, there is, technically, no action required by the holder. However, such replacement will only be recorded by a particular designated country if a request to record is made. Such a recordal is necessary for the information of the third parties. As such, the holder is advised to request DOMCIIP to record on the national register the fact that the national registration has been replaced by the international registration. Notwithstanding the replacement, it will be in the interest of the holder of the international registration to renew the Bhutan national registration(s) during the five-year period which the international registration is dependent on the fate of the basic application /registration.

The holder of the international registration wishing to record the fact of replacement on the register can do so by completing Form MP 2.

If the replacement application is successful, the international registration in national register will reflect the national trademark number that it replaces, the class number(s), the date of protection, the good and/or services that it replaces and the priority claim details (if any) under the field "Replacement Application under Madrid system".

Where DOMCIIP has taken note of the replacement in register, following a request made by the holder, it will also notify the IB accordingly. Such a notification will include the international registration number, the filing date, trademark number, the priority date (if any) and the goods and/or services of the national registration which has been replaced. The IB will record the indications so notified in the International Register and will also inform the holder. This information is also published in the WIPO Gazette.

#### **.2.16.1. Citation of Replaced National Application / Registration**

A reference to a replaced national registration in a citation against a later trademark application will continue to be maintained by the international registration which replaced the national registration. This is because the holder of the international registration enjoys the filing date and the priority date from the replaced national registration.

#### **.2.17. Change of Name and/or Address**

A request to record a change in the name and/or address of the holder must be presented on the official form MM9(E) established by the IB.

The request may be presented to the IB directly by the holder or through the

Office of the Contracting Party of the holder.

The IB records the change in the International Register and notifies the designated offices. It will also inform the holder and where the request was presented by an Office, that Office. When DOMCIIP receives such notifications, it will also update the change in the national register.

#### **.2.18. Change of Ownership**

A request to record a change in ownership must be presented on the official form MM5(E) established by the IB.

The request may be presented to the IB by the holder, through the Office of the Contracting Party of the (recorded) holder or through the Office of the Contracting Party of the new owner (transferee).

The change in ownership may relate to all the goods and services covered by the international registration, or to only some of those goods and services. Similarly, the change in ownership may be in respect of all the Contracting Parties designated or only some of them.

#### **.2.19. Renewal of International Registration**

Under the Madrid system, an international registration is valid for a period of 10 years from the date of the international registration. The international registration can be renewed every 10 years upon payment of the required fee.

The renewal of an international registration is a matter between the holder and the IB. The IB will send an unofficial notice, six months before the expiry of each 10-year term of protection, to remind the holder and representative (if any) of the impending expiry of the international registration.

WIPO has implemented the electronic renewal of international registrations which can be accessed under Forms at <http://www.wipo.int/madrid/en/forms> and also under the Online Services at <http://www.wipo.int/madrid/en/services/>. Renewals are also automatically uploaded into the IPAS during the uploading which is then required to be processed.

The IB records the renewal of the international registration in the International Register, by inscribing the date on which it was due. The IB will also notify the Offices of the designated Contracting Parties concerned and send a certificate to the holder. The relevant data concerning the renewal will also be published in

the Gazette. Apart from reflecting in its records of the extended term of protection of the international registration, an Office which is notified of the renewal needs to take no other action.

## 12. CHAPTER 11: DEFINITIONS

Sl. No.	Definitions
1.	<b>Registrar</b> (Section 44) <p>“<b>Registrar</b>” means the registrar of the Industrial Property. In Bhutan, the Department of Media, Creative Industry &amp; Intellectual Property is headed by a Director/Director General and is the authorized person to carry out works of the Registrar or the person assigned by him/her.</p>
2.	<b>Mark</b> (Section 24(i)) <p>“<b>Mark</b>” or “<b>Trademark</b>” means any visible sign capable of distinguishing the goods or services of an enterprise.</p>
3.	<b>Collective Mark</b> (Section 24 (ii)) <p>“<b>Collective Mark</b>” means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristics, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark.</p>
4.	<b>Trade Name</b> (Section 24 (iii)) <p>“<b>Trade Name</b>” means the name or designation identifying and distinguishing an enterprise.</p>
5.	<b>Agent</b> (Section 35 & Rule 53) <p>“<b>Agent</b>” means a legal representative practicing and resident in Bhutan and a person registered as IP agent in prescribed manner.</p>
6.	<b>International Classification of Good and Services</b> (Section 44) <p>“<b>International Classification of Good and Services</b>” means the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks as amended on September 28, 1979.</p>

7.	<b>Paris Convention</b> (Section 44))
	<b>“Paris Convention”</b> means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised.
8.	<b>Priority date</b> (Section 44)
	<b>“Priority date”</b> means the date of the earlier application that serves as the basis for the right of priority provided for the the Paris Convention.

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