

## **Foreword**

The articles of the Gulf Cooperation Council (GCC) Trademark Law<sup>1</sup> (GCC Trademark Law), and the Implementing Regulations (Regulations) govern the registration, enforcement, and commercialisation of trademark rights throughout the GCC member states.<sup>2</sup>

Although a unified law, the GCC Trademark Law and Regulations do not enable trademark registration in multiple GCC member states through a single application or process. Registration requires the filing of a separate application with the trademark registration authority in each GCC state where protection through registration is required. The registration of trademarks in the Kingdom of Bahrain is administered by the Trademark Office, Directorate of Foreign Trade & Industrial Property, which is part of the Ministry of Industry and Commerce.

Each GCC Member State will individually implement the GCC Trademark Law and the Implementing Regulations. In the Kingdom of Bahrain, the GCC Trademark Law and Implementing Regulations took effect on 29 May 2016.<sup>3</sup>

The Kingdom of Bahrain is also a signatory to the Paris Convention,<sup>4</sup> Madrid Protocol,<sup>5</sup> Trademark Law Treaty (TLT)<sup>6</sup> and Nice Agreement.<sup>7</sup> Where the provisions and obligations under these affect the rules and regulations of the GCC Trademark Law and Regulations this will be mentioned in these guidelines.

## **Purpose of this guide**

A trademark may be registered in the Kingdom of Bahrain by means of a direct application to the Trademarks Office of the Kingdom of Bahrain; a 'national' trademark, and through the international trademark system of the Madrid Protocol; the 'Madrid System'.

This guide sets out the requirements and procedures in obtaining the registration of a trademark under the 'Madrid Protocol', the 'Regulations Under the Protocol

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<sup>1</sup> Law No. 6 of 2014 with Approval of the Law (Regulation) of Trademarks in the Cooperation Council for the Arab States of the Gulf.

<sup>2</sup> Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates (UAE).

<sup>3</sup> Ministerial Decision No. 65 of 2016.

<sup>4</sup> Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979).

<sup>5</sup> Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007) and the Regulations under the Protocol as in force on February 1, 2023.

<sup>6</sup> Trademark Law Treaty (adopted at Geneva on October 27, 1994).

<sup>7</sup> Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (as amended on September 28, 1979).

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Relating to the Madrid Agreement Concerning the International Registration of Marks' (Regulations under the Protocol) and the 'Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks' (Administrative Instructions).

As a member of the Madrid System, the Trademark Office of the Kingdom of Bahrain perform two distinct roles; as an **Office of Origin** and as the **Office of a designated Contracting Party**:

### Office of Origin

This is the office through which an application for an international registration under the Madrid Protocol is filed.

As an Office of Origin, the Trademarks Office of the Kingdom of Bahrain will receive applications for the registration of an international trademark, from individuals and legal entities eligible to use the office. As part of this role the Trademarks Office of the Kingdom of Bahrain will be required to add information, such as the date of receipt of the international application to the international application form. See **Information to be added to the international application by the Office of Origin** in these guidelines.

The most significant role the Trademarks Office of the Kingdom of Bahrain must undertake is the completion of the declaration 'certifying' the international application. See **Certification of the international application by the Office of Origin** in these guidelines.

In addition to the certification, the Office of Origin needs to undertake a check of the application form to ensure compliance with the administrative requirements and that all of the required information is fully and correctly completed. In particular, the Trademarks Office of the kingdom of Bahrain must ensure that the applicant or applicants meet the eligibility requirements to use the Trademarks Office of the Kingdom of Bahrain as an Office of Origin- see **Applicant - eligibility to use an office as the Office of Origin** in these guidelines. In some instances, this check will look at the same information considered during the certification, but the check is for different requirements. See **Check of the international application form by the Office of Origin** in these guidelines.

### Office of a Designated Contracting Party

This the receiving office for international registrations from trademark owners in other Madrid Protocol States or territories of regional organizations seeking protection (designating) the Kingdom of Bahrain.

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In its role as an Office of a Designated Contracting Party, the Trademark Office of the Kingdom of Bahrain will undertake the substantive examination of the trademark for which protection is sought. This examination is under the trademark law as it is applied in the Kingdom of Bahrain for applications filed directly with the Trademarks Office. Information on the requirements for registration can be found in the Examination Guidelines.

### The Madrid System

The Madrid international trademark registration system enables trademark owners to obtain trademark protection in multiple jurisdictions through a single application to the International Bureau of the World Intellectual Property Organisation (WIPO).

The Madrid System is a mechanism to extend the protection of a trademark that has already been filed and/or registered in one member of the Madrid System to any other member (or members) of the Madrid System. This earlier filing may be an application, a registration commonly and collectively referred to as a 'basic mark'.

International applications cannot be filed directly with the International Bureau. They can only be filed through a trademarks office of a State or regional organization that is a member of the Madrid System. A trademark owner is free to decide which member State or regional organization provided they meet the eligibility requirements to use the trademark registration office of that particular State or regional organization. For more information see **Eligibility to use the Madrid System** in these guidelines.

### The role of WIPO in the Madrid System

The Madrid System is administered by WIPO through its International Bureau. The International Bureau only conduct examination on formalities and does not complete any 'substantive' examination to determine whether a trademark qualifies for protection, or whether an identical or similar mark has already been registered, either on the International Register or in any other trademarks register.

The International Bureau provides a single point at which the application (including fees) can be received, checked for compliance with the requirements ('formalities'). If the application is in order, the International Bureau will register the trademark in the International Register.

Registration by the International Bureau does not provide protection for the trademark in any of the member States or regional organizations. It is for the States

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or regional organizations where the applicant for the international registration requires protection to determine whether protection can be granted.

The International Bureau publish the registrations in the International Gazette<sup>8</sup>. A copy of the Gazette advertisement is forwarded to the trademark office in each member State or regional organization where the applicant has indicated they require protection in their international trademark application. The trademark offices will decide whether the international registration can be protected by applying the same rules and requirements used in assessing trademarks filed directly with them.

Detailed guidance on the ‘substantive’ examination of an application for registration of a trademark in the Kingdom of Bahrain may be found in the **Examination Guidelines**.

### Membership of the Madrid System

The Madrid System is governed by the Madrid Protocol, the Regulations under the Protocol and the Administrative Instructions<sup>9</sup>.

States may become members of the Madrid System by joining the Madrid Protocol, or both the Madrid Agreement and the Madrid Protocol, but it is no longer possible to join only the Madrid Agreement<sup>10</sup>. Intergovernmental organizations that collectively represent multiple States, such as the OAPI<sup>11</sup> and the European Union can access the Madrid System through membership of the Madrid Protocol.

### Contracting parties

States and intergovernmental organizations that have joined the Madrid System are collectively referred to as Contracting Parties. Click here to see a list of the [Madrid Contracting Parties](#).

The Kingdom of Bahrain is a contracting party through having ratified the Madrid Protocol on 15 September 2015. Membership of the Madrid System came into effect in the Kingdom of Bahrain on the 15 December 2015. From this date, holders of trademarks applied for or registered in the Kingdom of Bahrain have been able to use the Madrid System to gain protection for their trademarks in any other State or with any organization that is also a member of the Madrid Protocol.

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<sup>8</sup> The application will be translated so that it is available in the three official languages of the Madrid System, English, French and Spanish.

<sup>9</sup> Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as in force on February 1, 2023)

<sup>10</sup> As of October 11, 2016, it is no longer possible for any State to join only the Madrid Agreement. See Information Notice 34/2016 - [https://www.wipo.int/edocs/madrdocs/en/2016/madrid\\_2016\\_34.pdf](https://www.wipo.int/edocs/madrdocs/en/2016/madrid_2016_34.pdf)

<sup>11</sup> African Intellectual Property Organisation (OAPI)

## **Designated contracting parties**

When indicated (designated) in an international application or subsequently in an international registration, as a State or intergovernmental organization where the trademark owner requests protection for the trademark, the Contracting Party becomes known as the 'Designated Contracting Party'. The Kingdom of Bahrain has been able to be designated under the Madrid Protocol since 15 December 2015.

## **The Madrid Union**

The States and intergovernmental organizations which are contracting parties to the Madrid Protocol form the membership of the Madrid Union.

## **Using the Madrid System - Basic mark and Office of Origin**

### **Basic mark**

The Madrid System is a means to extend the protection of an earlier trademark filed with a State or an intergovernmental organization that is a member of the Madrid Protocol to other States or intergovernmental organizations that are also members. This earlier trademark is known as the 'basic application,' 'basic registration' or simply the 'basic mark'.

An international application may be based on an application filed with the Office of origin or a registration with that Office.

The basic mark and the international application must 'correspond'. As an Office of Origin, the Trademarks Office of the Kingdom of Bahrain must certify that certain details in the international application filed with the office, such as the applicant, representation of the mark and goods or services, etc., correspond with the basic mark or marks.

The Office may use some flexibility in deciding whether the representation of the mark in the basic application or basic registration 'correspond'. Any difference in the basic mark and the reproduction in the international application that has the effect of creating a different overall impression will mean that the Trademarks Office cannot certify that the international application. See **Certification of the international application by the Office of Origin** in these guidelines.

### **Dependency**

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An international application filed through the Trademarks Office of the Kingdom of Bahrain will be based on one or more basic applications or basic registrations filed with the Trademarks Office. For a period of five years from the date of the international registration there is a link known as ‘dependency’ between the basic mark and the international registration.<sup>12</sup>

Where an action which results in a reduction of the scope of the basic mark takes place in this five-year period (or is initiated in this period with the final decision taking place later<sup>13</sup>), this will affect the international registration. Where no such action takes place – or is initiated in this period – the international registration will be independent of the basic mark(s).

Where the Trademarks Office of the Kingdom of Bahrain has acted as the Office of Origin for an international trademark application, it has a responsibility to monitor the basic marks during this period of dependency, and report to the International Bureau, where necessary.

Should a basic mark be cancelled, renounced, revoked, invalidated or lapse within this five-year period, or in the case of a basic application, be rejected or is withdrawn, this will affect the protection given by the international registration to the same extent. This will be the case even if the international registration has been transferred to a new holder.<sup>14</sup> Any limitation of the goods or services covered by the basic mark will have the same effect on the international registration.

As the Office of Origin, the Trademarks Office of the Kingdom of Bahrain must notify the International Bureau of changes to the basic mark during this five-year period. See **Ceasing of effect** in these guidelines.

### Office of Origin

An international application must be presented to the International Bureau by the Office of Origin.<sup>15</sup> If the International Bureau receives an application directly from the applicant or their representative, the application will not be accepted as being properly filed. The application will be returned directly to the party that submitted the application without being considered along with any fees paid.<sup>16</sup>

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<sup>12</sup> Article 6(3) Madrid Protocol)

<sup>13</sup> Article 6(3)(i)(ii) and (iii) of the Madrid Protocol

<sup>13</sup> Rule 9(1) Regulations under the Protocol

<sup>13</sup> Rule 11(7) Regulations under the Protocol

<sup>14</sup> Article 6(3) Madrid Protocol

<sup>15</sup> Rule 9(1) Regulations under the Protocol

<sup>16</sup> Rule 11(7) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

An applicant may use any member as their Office of Origin, provided they have a basic application or basic registration filed with that office, and they are entitled to file through that member.

The Office of Origin will be the authority responsible for the registration of trademarks in a State, or in an intergovernmental organization that is a member, or 'contracting party' to the Madrid System. In the Kingdom of Bahrain, the Office of Origin is the Trademark Office, Directorate of Foreign Trade & Industrial Property, which is part of the Ministry of Industry and Commerce.

### **Applicant - entitlement to use an office as the Office of Origin**

To be entitled to use the international trademark system, the owner of the trademark must be able to meet one (not all) of the following requirements<sup>17</sup>:

- be a national of one of the member States of the Protocol, or
- be domiciled in one of the member States of the Protocol, or
- have a real and effective industrial or commercial establishment<sup>18</sup> in one of the member States of the Protocol, or
- be a national of a State that is part of a Contracting Organization to the Protocol, or
- be domiciled in the State that is part of a Contracting Organization to the Protocol, or
- have a real and effective industrial or commercial establishment<sup>7</sup>, in State that is part of a Contracting Organization to the Protocol.

The applicant must indicate the basis on which they consider they have an entitlement to file an international application under the Madrid System. The Office of Origin should check the validity of the entitlement claimed before submitting the international application to the International Bureau.

Where there is more than one named applicant, the entitlement claim entered should relate to the first named applicant (the individual/natural person or entity named in Part 2 of the international application). The entitlement for the other applicants should be entered on the 'Continuation Sheet for Several Applicants'.

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<sup>17</sup> Article (2)(1)(i) Madrid Protocol

<sup>18</sup> Whether a person has a real and effective commercial establishment is determined under domestic law



### **National - the Madrid Protocol**

Under the Madrid Protocol, the description 'national' is intended to include both natural and legal persons<sup>19</sup>. Whether a trademark owner is a national of a particular State or a region represented by an intergovernmental organization is to be determined according to the law applying in the particular State or region.

### **National of the Kingdom of Bahrain<sup>20</sup>**

The Trademark Law in the Kingdom of Bahrain permits a trademark to be registered by any person having legal status as an individual (a 'natural' person) holding the nationality of a GCC state. A trademark may also be registered by a legal entity such as a corporate body,<sup>21</sup> representative, etc., holding the nationality of a GCC Member State.

The GCC is not a 'contracting' organization of the Madrid System, and not all members of the GCC are members of the Madrid System. The broader eligibility of the domestic law in the Kingdom of Bahrain that allows GCC nationals to file an application based on their nationality cannot apply to applications under the Madrid System. To be entitled to file an application for an international registration through the Trademark Office of the Kingdom of Bahrain on the basis of 'nationality' requires that the applicant hold the nationality of the Kingdom of Bahrain.

For an individual (natural person), nationality will be taken as the nationality entered on their certificate of birth or passport. Where dual nationality is held, for the purposes of applying for a national and international trademark registration using the Kingdom of Bahrain as the Office of Origin, this must include the nationality of the Kingdom of Bahrain.

In the case of a legal entity, the nationality will be the country or State where the named entity is officially recorded, such as an official register or tax record, etc. For example, a named applicant that is a foreign subsidiary of another company will use the nationality of the country in which the subsidiary is registered. To be eligible to make an international application under the Madrid Protocol using the Bahrain Trademark Office, the legal entity will need to be officially recorded as an authorized business in the Kingdom of Bahrain.

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<sup>19</sup> The meaning is understood to correspond with the description in Article 2 of the Paris Convention.

<sup>20</sup> In respect of individuals, nationality will be determined under the Bahraini Citizenship Act of 1963 (as amended)

<sup>21</sup> As defined by Bahrain Commercial Companies Law (Law 21 of 2001) (as amended).



## **Domiciled**

Being “domiciled” can have different meanings and different requirements depending on the relevant domestic legislation of a member State or intergovernmental organization. For the purposes of filing an international trademark application under the Madrid System ‘domiciled’ is to be determined according to the law applying in the particular State or intergovernmental organization.

### **Domiciled in a GCC Member state**

In respect of a ‘national’ trademark the GCC Trademark Law permits registration by ‘foreigners’ providing they are ‘residing in a GCC Member State’ and are ‘authorized to practice commercial, industrial, craft or service business.’<sup>22</sup>

The GCC is not a ‘contracting’ organization of the Madrid System, and not all GCC states are members of the Madrid System. Therefore, the requirements for filing an international trademark application using the Trademark Office of the Kingdom of Bahrain as the Office of Origin are different to those for a national trademark. To file an application for an international registration through the Kingdom of Bahrain on the basis of ‘domicile’, a trademark owner must be domiciled in the Kingdom of Bahrain.

### **Domiciled in the Kingdom of Bahrain**

Where the entitlement to use the Trademarks Office of the Kingdom of Bahrain as the Office of Origin for an international trademark application is based on being ‘domiciled’, it is reasonable to infer that the trademark owner does not hold the nationality of the Kingdom of Bahrain; they are regarded as ‘foreigners.’

In determining what is meant by ‘domiciled’ in the Kingdom of Bahrain, it is helpful to look to the domestic trademark legislation that applies in the Kingdom of Bahrain. This permits registration of ‘national’ trademark by ‘foreigners’ provided they are ‘residing’ [in a GCC Member State].<sup>23</sup> From this it is reasonable to infer that the same conditions apply to applications for an international trademark registration, and that in assessing the entitlement to use the Trademark Office of the Kingdom of Bahrain as the Office of Origin, ‘domiciled’ means ‘resident’.

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<sup>22</sup> Article 5(2) GCC Trademark Law

<sup>23</sup> Article 5(2) GCC Trademark Law. As well as qualifying by being a ‘resident’ the Article 5(2) a trademark owner be ‘authorized to practice commercial, industrial, craft or service business.’ This is not a requirement Madrid Protocol. Nevertheless, to make an international trademark application a trademark owner must have filed for the same trademark with the Trademark Office in the Kingdom of Bahrain, and by necessity, must be carrying-on a commercial, industrial, craft or service business in the Kingdom of Bahrain.

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Accordingly, for the purposes of filing an application for an international trademark registration through the Trademark Office of the Kingdom of Bahrain, an individual will be considered 'domiciled' if they are legally resident in the Kingdom of Bahrain.

A legal entity will be regarded as being domiciled in the Kingdom of Bahrain where the named entity is officially authorized and recorded, such as an official register or tax record, etc. in the Kingdom of Bahrain. For example, a named applicant that is a foreign subsidiary of another company will use the nationality of the country in which the subsidiary is registered. Information on the legal requirements for the authorized operation of a commercial or industrial enterprise may be found here:

<https://bahrainbusinesslaws.com/all-laws/all-laws>

### **Trademark owner with multiple 'State' or 'Organization' qualification**

It is possible for a trademark owner to have more than one entitlement to use the Madrid System, such as by being a national of a State (or intergovernmental organization) that is a member of the Protocol, and by the fact that they are living or have an industrial or commercial establishment in a different member State of the Protocol.

For example, a trademark owner holding the nationality of the Kingdom of Bahrain is living or has an industrial or commercial establishment in Oman. The trademark owner would qualify by:

- being a national of a State that is a member of the Madrid Protocol
- being domiciled in a State that is a member of the Madrid Protocol, and,
- having an industrial or commercial establishment in a State that is a member of the Madrid Protocol.

A trademark owner that has a connection with several States, or organizations that are members of the Madrid System, may choose which entitlement to use as the Office of origin. However, the earlier filing used as the 'basic' mark must be with the Trademark Office of the indicated entitlement.

For example, a trademark owner holds the nationality of the Kingdom of Bahrain. The trademark owner is living in Oman where they own and operate an industrial or commercial establishment. The trademark owner applied to register their trademark in the Kingdom of Bahrain.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- On 'nationality' and residence/commercial activity, the trademark owner can choose between the Kingdom of Bahrain and Oman as the Office of Origin.
- As the basic mark has been filed with the Trademarks Office in the Kingdom of Bahrain, this registration authority must be used as the Office of Origin for any application under the Madrid System.

### More than one named trademark owner

Where two or more individuals or legal entities are named as owners of a basic mark, they may jointly file for an international trademark application. In fact, where the basic mark was applied for or registered jointly by two or more individuals or legal entities, an application for an international registration may only be filed in the name of all of them.

To use the Trademark Office of the Kingdom of Bahrain as an Office of Origin, each named applicant must be entitled to use the Kingdom of Bahrain as the Office of Origin. This may be by being either a national, resident or operating a real and effective industrial or commercial activity in the Kingdom of Bahrain. The named applicants need not have the same entitlement, for example, one may qualify by being a national of the Kingdom of Bahrain, another on being legally resident in the Kingdom of Bahrain.<sup>24</sup>

## Applying for an international trademark using the Trademark Office of the Kingdom of Bahrain

### The International Application<sup>25</sup>

The international application must be presented to the International Bureau by an Office of Origin<sup>26</sup> using the prescribed form<sup>27</sup> (MM2). The Madrid Application Assistant is the electronic version of the official MM2 form. The Madrid Application Assistant records all the information required to complete an international application in an intuitive and linear manner. Once completed, the international application will be made available in a PDF format ready for the applicant to submit to the Office of origin for certification. This form is available on WIPO's website - <https://efiling.madrid.wipo.int/application-assistant/home.xhtml>.

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<sup>24</sup> Rule 8(2) Regulations under the Protocol

<sup>25</sup> Rule 9 Regulations under the Protocol

<sup>26</sup> Rule 9(1) Regulations under the Protocol

<sup>27</sup> Article 3 Madrid Protocol and Rule 9(2)(a) Regulations under the Protocol

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The Trademark Office of the Kingdom of Bahrain requires that the international application form be completed in English.<sup>28</sup>

It is the responsibility of the office that receives an international application to ensure that the application for the international registration has been submitted using the correct form.

The form is to be submitted to the Trademarks Office of the Kingdom of Bahrain using the Electronic Industrial Property Services ePortal. The Electronic Industrial Property Services ePortal may be found at <https://service.moic.gov.bh/ipd/login>

### Payment of fees

#### The handling fee

There is a fee payable to the Trademark Office of the Kingdom of Bahrain for the work the Office will do in relation to the international application. This is not a fee for the international trademark application, but an administrative fee – the handling fee – for the processing (checking and certifying) of the international trademark application by the Trademark Office.

#### International application and registration fees

The fees for an international application for an international trademark application filed through the Trademarks Office of the Kingdom of Bahrain are to be paid by the applicant directly to the International Bureau. The Trademark Office of the Kingdom of Bahrain does not collect and forward fees on behalf of the International Bureau.

If an applicant for an international registration fails to pay the correct fees, they will receive an irregularity notice from the International Bureau. This notice will contain a payment deadline (typically 3 months) after which the application will be deemed abandoned.

Separate fees are to be paid for the international application or registration. These consist of:

- The basic fee
- Fees for the designations, which will either be a standard fee (complementary and supplementary fees) or an individual fee (

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<sup>28</sup> Under the provisions of Rule 6(1) the Trademark Office can ‘prescribe’ which of the three official languages shall be used.

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The amounts of the fees payable in connection with an international application or registration are those set in the Schedule of Fees s which can be found here:

[international application fees](#) The International Bureau provides an online 'fee calculator' which can be used to estimate the fees payable before filing an international application. The fee calculator can be accessed here: [Fee Calculator](#)

### Basic fee

The basic fee is payable for all international trademark applications regardless of the number of classes. The fee has two levels depending on whether the mark (representation of the trademark) is in 'black and white' or in 'color', with a higher fee payable for marks in represented in color.

### Individual fee

A member (Contracting Party) of the Madrid Protocol may choose to receive an 'individual fee' in place of the 'complementary fee'.<sup>29</sup> This individual fee is payable where an international trademark application includes a request for extension to that member. The Kingdom of Bahrain has elected to receive individual fees.

The individual fee may not be higher than the amount which the member would be entitled to receive for an equivalent national registration. Details of the members of the Madrid Protocol that have elected to have an individual fee can be found here: [Individual fees](#)

### Supplementary fee

In addition to the Basic fee, a Supplementary fee is payable for each class of goods and services beyond three classes where one or more of the designations in the international application are members under the standard fee regime. The 'standard' fee regime is where the Contracting Party has not declared that it wishes to receive 'individual' fees.

### Paris Convention

As a contracting party to the [Paris Convention](#) for the Protection of Industrial Property (Paris Convention), the Kingdom of Bahrain must offer individuals or businesses that hold the nationality of another contracting party the right to apply for

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<sup>29</sup> Article 8(7)(a) Madrid Protocol

the registration of a trademark under the same terms and conditions as they would give to those holding Bahraini nationality.<sup>30</sup>

Nationals of States that are not contracting parties of the Paris Convention are similarly entitled to register a trademark if they are legally resident or have a real and effective industrial or commercial establishment in a State that is a member of the Paris Convention.<sup>31</sup>

Whilst this provides a route to a national trademark registration in the Kingdom of Bahrain, an application for an international trademark registration may only be filed using the Trademark Office of the Kingdom of Bahrain where the individual (natural person) or legal entity is entitled through having a connection with the Kingdom of Bahrain.<sup>32</sup>

A list of members (Contracting Parties) to the Paris Convention can be found [here](#).

### **Submitting the application for an international trademark registration**

#### **Electronic Industrial Property Services ePortal**

The Kingdom of Bahrain has an Electronic Industrial Property Services ePortal which must be used to submit an application for an international registration. The application must be made using the official form prepared for this purpose<sup>33</sup> which can be completed and submitted using the ePortal.

The Electronic Industrial Property Services ePortal may be found at <https://service.moic.gov.bh/ipd/login>

#### **Access to the Electronic Industrial Property Services ePortal**

To be able to use the Electronic Industrial Property Services ePortal, the user must either have a registered and activated account with the ePortal or be in possession of an advanced eKey and have set up a 'user profile.'

#### **Registration**

Registration is required for Industrial Property agents. These may be part of a general law firm authorised and qualified to provide intellectual property services,

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<sup>30</sup> Article 2 of the Paris Convention for the Protection of Industrial Property.

<sup>31</sup> Article 3 of the Paris Convention for the Protection of Industrial Property.

<sup>32</sup> Article 2(i)(ii) Madrid Protocol

<sup>33</sup> Article 3(1) Madrid Protocol and Rule 9(2)(a) Regulation under the Protocol

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qualified agents that specialise in and provide intellectual property services, and commercial companies that have persons suitably qualified in intellectual property.

Registration is also required in the case of Institutions and Commercial Registration (CR) holders. This includes non-commercial institutions, government agencies, associations or clubs, and Gulf nationals with a commercial activity in the Kingdom of Bahrain but do not have a smart card issued by the Kingdom of Bahrain.

### **Access via an eKey**

Access via an eKey is available to Enterprises and Individuals. An individual, or representative of an enterprise must have obtained an Advanced eKey in order to access the ePortal. A Standard eKey is not sufficient. The holder of a suitable eKey will be asked to complete a user profile containing basic contact details.

Information and guidance on the requirements and procedure for registration for use of the ePortal or in gaining access to the ePortal via an eKey may be found in the **ePortal Guidelines**.

### **Logging-in to the Electronic Industrial Property Services ePortal**

The Electronic Industrial Property Services ePortal can be found at <https://service.moic.gov.bh/ipd/login><sup>34</sup>. The ePortal is available for use in both Arabic and English.

After entering their login details at the Electronic Industrial Property Services ePortal landing page, all users will be taken to the following page:

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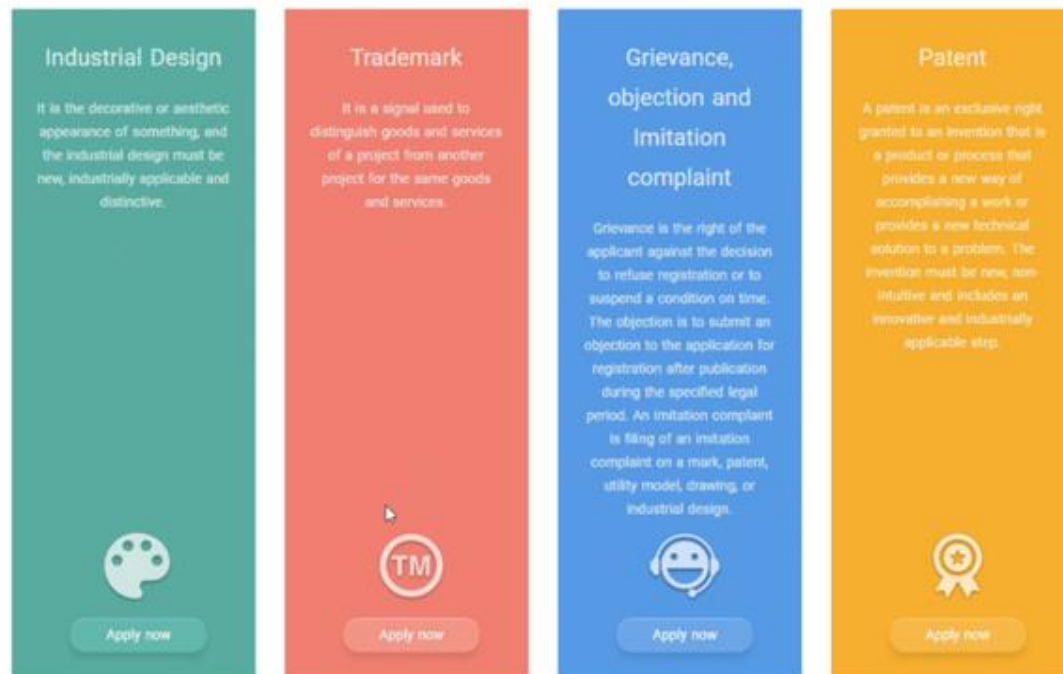
<sup>34</sup> If a VPN is being used the hyperlink may not open.



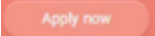
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### Electronic Industrial Properties Services

It is the creative work of human thought and includes every intellectual product related to trademarks, patents, drawings, industrial designs and other branches of industrial property. The industrial property protection system helps to reconcile the interests of the innovator and the public by ensuring an environment in which creative and innovative activity can continue and thrive for the benefit of all.



From this page a range of industrial property actions can be initiated. The column headed Trademarks is where an application for registration of a trademark (national and international) must be completed.

The ePortal must be used where there is a requirement to use a 'form prepared for this purpose' and is also where any required fees can be paid. Clicking the cursor on  at the bottom of the column headed TRADEMARKS will open a screen listing the actions can be undertaken:

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### Trademark Services

Mark registration statuses		Renewals and changes		Other processes	
Application for registration of national mark	100-200 BHD →	Renewal	650-750 BHD →	Amendment / cancelation / withdrawal	150 BHD →
Payment of Publication fee for one or more mark	50-100 BHD →	Changes / Assignments related to Owner	150 BHD →	Initial request for a mark examination	100 BHD →
Payment of Registration fee for one or more mark	500 BHD →	Changes related to Representative	150 BHD →	Copy / Inquires	100 BHD →
		License / Mortgage	200-300 BHD →	Process related to International Mark	20-100 BHD →

Under the column headed 'Other processes' there is a section 'Process related to International Mark'. This is where the application for an international registration is started.

### Trademark Services

Mark registration statuses		Renewals and changes		Other processes	
Application for registration of national mark	100-200 BHD →	Renewal	650-750 BHD →	Amendment / cancelation / withdrawal	150 BHD →
Payment of Publication fee for one or more mark	50-100 BHD →	Changes / Assignments related to Owner	150 BHD →	Initial request for a mark examination	100 BHD →
Payment of Registration fee for one or more mark	500 BHD →	Changes related to Representative	150 BHD →	Copy / Inquires	100 BHD →
		License / Mortgage	200-300 BHD →	Process related to International Mark	20-100 BHD →

At the end of the section that is an arrow. Clicking the cursor on the arrow will open the following screen from which an international application may be started:

### Process related to International Mark

1

2

3

4

Application type \*

- Choose one of these available applications -

Start

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

A number of actions related to international trademarks can be started from this screen. To start the application for an international registration, click the cursor on the down arrow at the end of the 'Application type' field. This will open a drop-down menu.

**Process related to International Mark**

1 2 3 4

**Application type \***

Choose one of these available applications -

- Administration fees for filing an international application
- Request to transfer International registration to national registration of Trademark and Service Marks
- Request to transfer International registration to national registration of Collective Mark, Certification Mark, Public Beneficiaries and Professional Institutes Mark
- Replacement of National or Regional registration with International registration

Start

The drop-down menu lists four actions that can be started:

### 1. Administration fee for filing an international application

This option is used to make an application for an international registration under the Madrid System and pay the fee for processing the international application by the Trademarks Office of the Kingdom of Bahrain.

### 2. Request to transfer international registration to national registration of Trademark and Service Marks

This option is used to request the transformation of an international trademark registration into a national trademark registration in the Kingdom of Bahrain. See the section in these guidelines on **Transformation**

### 3. Request to transfer international registration to national registration of Collective Mark, Public Beneficiaries and Professional Institute Mark

This option is used to request the transformation of an international trademark registration into other forms of national trademark (Collective mark, Public Beneficiaries and Professional Institute Mark) in the Kingdom of Bahrain. See the section in these guidelines on **Transformation**

### 4. Replacement of National or Regional registration with international registration

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

This option is used where the holder of an international registration wishes to request the Trademark Office to take note in its Register that a national registration has been replaced by an international registration. See the section in these guidelines on **Replacement**.

**The sequence of actions and information required in the Electronic Industrial Property Services ePortal will be the same regardless of the option selected in the 'Application type' menu. For convenience, these guidelines show the process and information required in making an application for the registration of an international application.**

### Applying for an international trademark

To start the process of making an application for an international registration, click the cursor on 'Administration fee for filing an international application'. This identifies for the ePortal the type of application that is to be made.

**Process related to International Mark**

1 2 3 4

Application type \*

Administration fees for filing an international application

Application type	Administration fees for filing an international application
Application fee	20 BHD

Start

The text 'Administration fee for filing an international application' should now be shown in the 'Application type' field and also in the section beneath. The fee payable for the application will also be shown. This will be paid later in the application process.

Clicking the cursor on **Start** will initiate the process identified in the 'Application type' field. As the option selected here is 'Administration fee for filing an international application' the following screen will open:

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

### Administration fees for filing an international application

Application no. [ 19827 ]

**General Remarks**

- Submit a letter addressed to the Trademark Office in the Arabic language includes the following information:
  1. Type of action required and its date.
  2. Mark number and class.
  3. Data of the current owner in Arabic and English.
  4. Name & Signature of the applicant.
  5. Fill out the MM2 form and attach it with the request. The form can be obtained from WIPO <https://www.wipo.int/madrid/en/forms>

Back Continue

Under the heading General Remarks, this screen sets out that trademark owner (or their authorized representative) must provide a letter, in Arabic, with the application for an international registration. The letter must include the following information:

1. Type of action required and its date
2. Mark number and class
3. Data of the current owner in Arabic and English
4. Name and signature of the applicant
5. Fill out the MM2 and attach it with the request. The form can be obtained from the WIPO website (see below)

This letter is not the application for an international registration nor is it a requirement from the Madrid Protocol,. It is a requirement set by the Trademarks Office of the Kingdom of Bahrain when being used as an Office of Origin.

As indicated in point 5 under General Remarks, the Form MM2<sup>35</sup> must be used to apply for an international trademark registration. The form will be attached in the next screen of the Electronic Industrial Property Services ePortal.

The Form MM2 can be accessed at <https://www.wipo.int/madrid/en/forms/> When the page opens on the WIPO website, click the cursor on the link [Additional downloadable forms](#). The Form MM2 can be downloaded as a Word doc or PDF and

<sup>35</sup> Article 3(1) Madrid Protocol ‘Every international application under this Protocol shall be presented on the form prescribed by the Regulations under the Protocol’.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

edited offline or completed online as an editable PDF and then downloaded and saved.

The screenshot shows the WIPO Madrid System Forms page. The header includes the WIPO logo and navigation links: Media, Meetings, Contact Us, IP Portal, and English. Below the header is a search bar and a navigation menu with links: IP Services, Policy, Cooperation, Resources, About IP, and About WIPO. The main content area is titled "Madrid System Forms" and includes a paragraph about managing international trademark registrations using downloadable Madrid System forms. There is a "Stay informed!" section with a link to sign up for news alerts. A "Downloadable forms" section lists links for "Notes on filing forms PDF", "Completing editable PDF forms", and "Download all forms ZIP". A "Continue" button is visible in the top right corner.

Guidance on the completion of the Form MM2 can be found on this page [here](#). The filing requirement relating to designate contracting parties can change. It is advised that these notes be read before completing a Form MM2.

Having completed and saved the letter and Form MM2, click the cursor on [Continue](#). This will open the following screen where the letter and completed form can be attached

The screenshot shows the "Administration fees for filing an international application" screen. At the top, there is a progress bar with four steps: 1, 2, 3, and 4. Step 2 is currently selected. Below the progress bar, the text "Application no. [ 19827 ]" is displayed. The main section is titled "Attachments \*" and includes a sub-header "Please attach the required documents such as the power of attorney (if any)". There is a table with two columns: "File name" and "File Description". Below the table, there is an "Add" button. At the bottom right, there are "Back" and "Save & continue" buttons.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Click the cursor on **Add** This will open the following screen where the files to be attached can be selected.

**Administration fees for filing an international application**

Application no. [ 19827 ]

**Attachments \***  
Please attach the required documents such the power of attorney (if any)

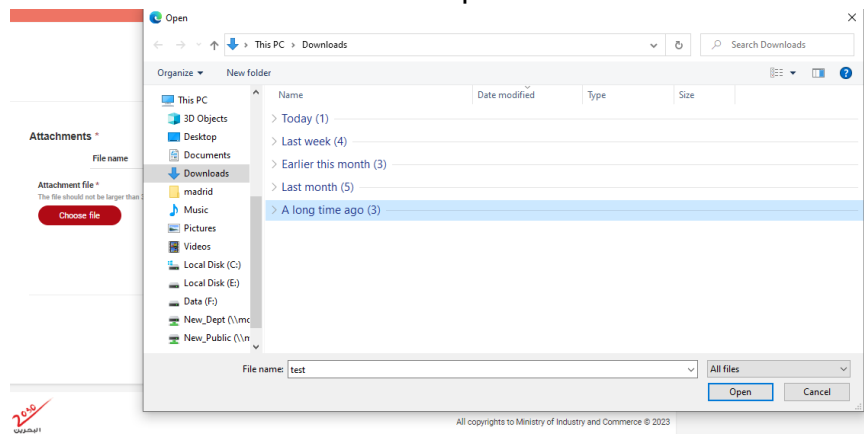
File name	File Description
<b>Attachment file *</b> The Attachment file should not be larger than 30 MB <b>Choose file</b> Delete	<b>File Description *</b> Administration fees for filing an international application

Cancel Attach

Back Save & continue

Clicking the cursor on **Choose file** will open the computer file directory enabling the selection of a file (form) to be attached.

Click the cursor on **Delete** to return to the previous screen.



To attach the letter and Form MM2, click the cursor on the file names allocated when they were saved.



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

### Administration fees for filing an international application

Application no. [ 19827 ]

**Attachments \***  
Please attach the required documents such the power of attorney (if any)

File name	File Description
<b>Attachment file *</b> The file should not be larger than 30 MB <button>Choose file</button> <button>Delete</button>	<b>File Description *</b> Administration fees for filing an international application

Cancel Attach

Back Save & continue

After each file has been attached, a brief description must be entered in the 'File description' field. This will be a description of the request being made, for example 'Filing an international application' and 'Letter for international application'

After choosing a file and entering a brief description of the file, click the cursor on The file will not be attached until this is done.

Attach

Clicking the cursor on Attach without an entry in the 'File description' field will disable the function to attach the file until the 'File description' field has been completed,



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

### Administration fees for filing an international application

1 — 2 — 3 — 4

Application no. [ 19827 ]



**Attachments \***  
Please attach the required documents such the power of attorney (if any)

File name	File Description	
27_02_23_12PM_13_QF301e_44599_25311_003-543932.DOC	Administration fees for filing an international application	 

[Add](#)

[Back](#) [Save & continue](#)

When successfully attached, each file name and 'file description' entered will appear in a list under 'File name' and the allocated description under 'File Description.' After attaching each file, the next file can be attached by clicking the cursor on [Add](#) until the required files are listed.


When a file has been successfully attached, these two icons will appear at the end of each of attached files  

### Renewal during the last year of the protection period and on the date of expiry of protection.

1 — 2 — 3 — 4


Application no. [ 19832 ]

**Attachments \***  
Please attach the required documents such the power of attorney (if any)

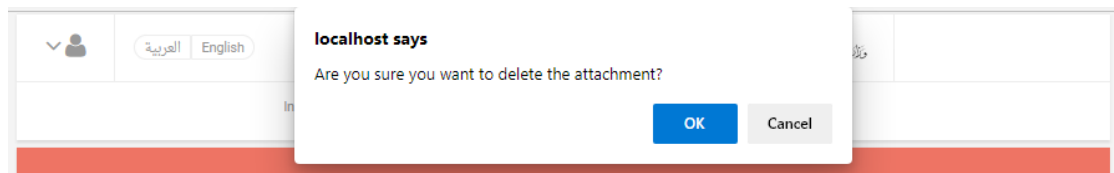
File name	File Description	
15_03_23_13PM_11_Request_to_renewal_a_registered_mark.docx	Renewal during the last year of the protection period and on the date of expiry of protection.	 

[Add](#)

[Back](#) [Save & continue](#)

Clicking the cursor on  will delete the file from the 'Attachments' list. Before the deletion is completed, a pop-up message will ask for confirmation, asking 'Are you sure you want to delete the attachment?'

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain



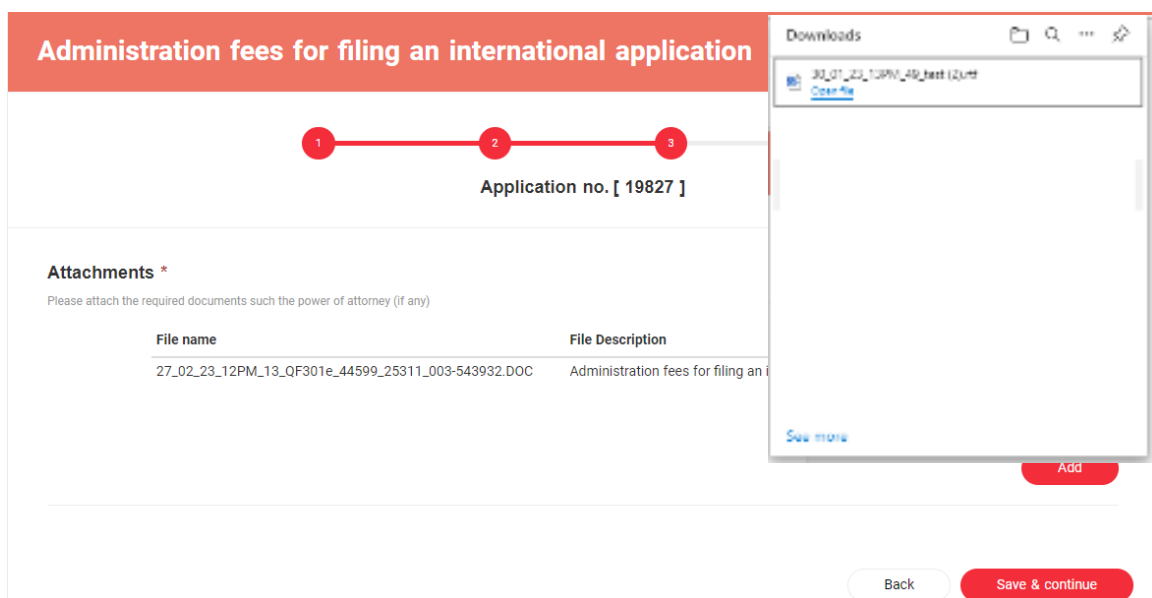
To proceed with the deletion, click the cursor on

**OK**

To stop the deletion of the file, click the cursor on

**Cancel**

Clicking the cursor on  enables the attached file to be downloaded and reviewed.

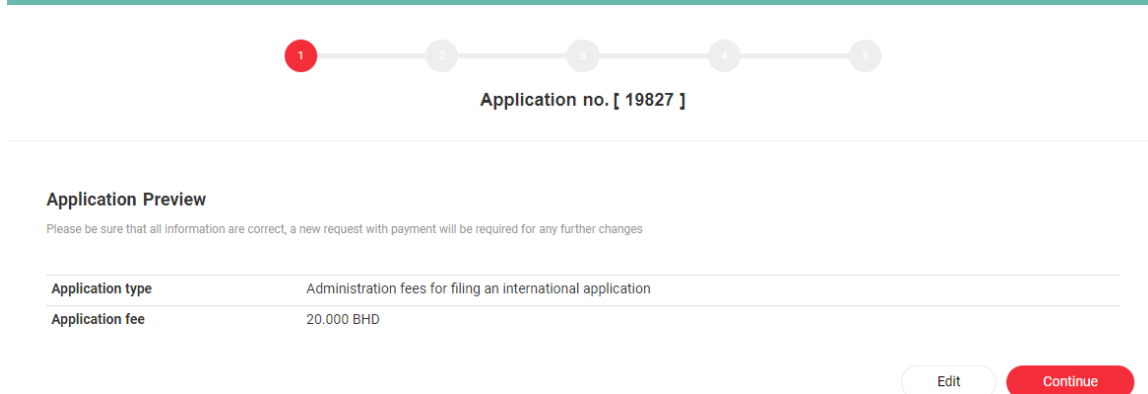


When the files containing the letter and Form MM2 have been attached and listed, save the attachments to the application by clicking the cursor **Save & continue** on

This will open a 'preview' screen where the application for renewal can be checked:

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

### Preview before confirmation



The screenshot shows the 'Preview before confirmation' screen. At the top, there is a progress bar with five steps. Step 1 is highlighted in red, while steps 2 through 5 are grey. Below the progress bar, the text 'Application no. [ 19827 ]' is displayed. The main content area is titled 'Application Preview' and includes a note: 'Please be sure that all information are correct, a new request with payment will be required for any further changes'. Below this, there is a table with two rows: 'Application type' with the value 'Administration fees for filing an international application' and 'Application fee' with the value '20,000 BHD'. At the bottom right, there are two buttons: 'Edit' and 'Continue'.

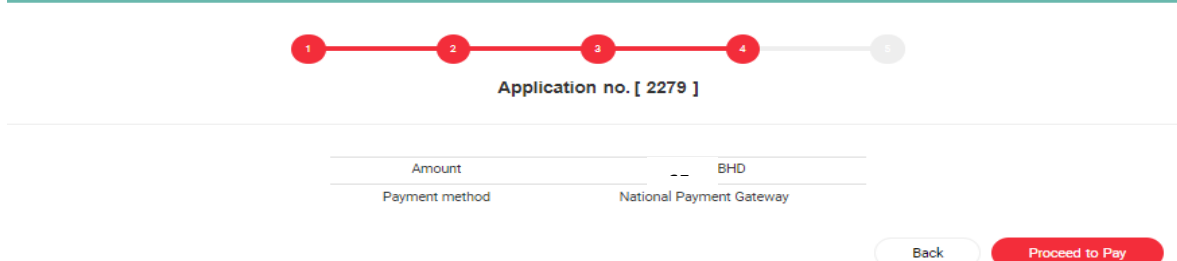
Application Preview	
Please be sure that all information are correct, a new request with payment will be required for any further changes	
Application type	Administration fees for filing an international application
Application fee	20,000 BHD

[Edit](#) [Continue](#)

Should the details not be correct, clicking the cursor on Edit will return to the first page of the application process.

If the details are correct and the request for renewal is to proceed, click the cursor on [Continue](#). This will open a Payment screen where the process to pay the prescribed fee is started.

### Payment



The screenshot shows the 'Payment' screen. At the top, there is a progress bar with five steps. Steps 1 through 4 are highlighted in red, while step 5 is grey. Below the progress bar, the text 'Application no. [ 2279 ]' is displayed. The main content area has two rows: 'Amount' with the value '--- BHD' and 'Payment method' with the value 'National Payment Gateway'. At the bottom right, there are two buttons: 'Back' and 'Proceed to Pay'.

Amount	--- BHD
Payment method	National Payment Gateway

[Back](#) [Proceed to Pay](#)

To continue and pay the fees, click the cursor on [Proceed to Pay](#) of Bahrain for the processing of the international application. Separate fees are to be paid for the international registration. See the section of the guidelines on **Payment of fees**.

To continue and pay the fees, click the cursor on [Proceed to Pay](#)

This will open a screen in the National Payment Gateway. The first step is to select the method to be used to make the payment<sup>36</sup>.

<sup>36</sup> These pages of the payment system are only available in Arabic.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

التعليمات الشروط والأحكام



معلومات الدفع

اسم الخدمة  
رقم مرجع الدفع  
المبلغ الإجمالي

خدمة تسجيل الملكية الفكرية  
الرقم الشخصي: 0  
BHD 100.000


اختيار طريقة الدفع

 بطاقة الائتمان

 بطاقة الصراف الآلي

إلغاء

التعليمات الشروط والأحكام





معلومات الدفع


اسم الخدمة  
رقم مرجع الدفع  
المبلغ الإجمالي

خدمة تسجيل الملكية الفكرية  
الرقم الشخصي: 0  
BHD 100.000

اختيار طريقة الدفع


 بطاقة الائتمان


 بطاقة الصراف الآلي

 بيفت

إلغاء

Click the cursor on the icon to select the preferred payment method. This will show the method selected in red.

Clicking the cursor on  will open the following screen where details related to the selected payment method must be entered:



**BENEFIT PAYMENT GATEWAY**  
07-04-2022 09:38

INTELLECTUAL PROPERTY  
https://www.Bahrain.bh

Amount  
Card Type  
Card Number  
Expiry Date  
Card Holders Name  
PIN

BD 650  
Debit  
  
MM YY  
YYYY


## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

After entering the information relating to the chosen payment source, clicking the cursor on **Pay** will proceed with the payment. Clicking the cursor on **Cancel** will abort the transaction and return to the payment method selection screen.

If the payment is successful a 'Payment receipt' screen will open:

**Payment**

**Payment Receipt**



Your application has been successfully processed. Thank you for using the electronic services of the trademarks office.

Application no.	Receipt no	Service
19832	2160	Administration fees for filing an international application


You may print this page or make a note of the application number for reference purpose

**Done**


It is advised that the payment receipt (screen) be printed, or a note made of the application and receipt number. An email will be sent to the email address used for the application confirming completion of the registration for the ePortal.

Clicking the cursor on **Done** open the following screen confirming the submission of the request:

**Application under review**



Application no. [ 19832 ] - File No. [ 2160 ]



IPD has been informed of your application. Once your application gets approved you will be notified to proceed with the application.

**Back**

This confirms that the international; application has been submitted to the Trademarks Office of the Kingdom of Bahrain and will be processed by the Trademarks Office. This review is an 'administrative' check and not a 'substantive' examination of the application.

## **Office of Origin responsibilities in relation to an International Application**

As an Office of Origin, the Trademarks Office of the Kingdom of Bahrain will have responsibilities in respect of the international applications that it receives. The primary responsibility is its role in ‘certifying’ the international application. Just as important is the office’s role in checking the completeness and accuracy of the information entered by the applicant(s), as any errors or omissions will result in an irregularity being issued by the International Bureau.

The Trademarks Office is also required to enter certain information into the international application, which again, if missing will result in an irregularity notification from the International Bureau.

### **Certification of the international application by the Office of Origin**

An international trademark application must be certified by the Office of Origin before being sent to the International Bureau.<sup>37</sup> The Trademark Office must sign the declaration that is part of the international application.<sup>38</sup>

The person signing the Office of Origin declaration on behalf of the Trademarks Office of the Kingdom of Bahrain is confirming that particular information appearing in the international application ‘corresponds’ with the particulars in the basic application or basic registration<sup>39</sup>.

It is possible that over time certain details of the basic mark can change, the certification is taken as confirmation that the details correspond at the time of the certification. See the section of these guidelines **Certification of the international application by the Office of Origin**

### **Checking the international application**

In addition to the certification, there is a requirement for the Office of Origin to check both the completeness of the information entered in the international application and compliance with any administrative or legal requirements. In particular, the Trademarks Office must ensure the entitlement of the applicants to use the Trademark Office of the Kingdom of Bahrain as the Office of Origin for an international application.

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<sup>37</sup> Article 3(1) Madrid Protocol

<sup>38</sup> Rule 9(2)(b) Regulations under the Protocol

<sup>39</sup> Rule 9(5)(d) Regulations under the Protocol



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

This check falls to the Trademark Office either because the information is within the knowledge of the Office, or simply because an international application containing such errors should not be forwarded to the International Bureau. See the section of these guidelines headed **Office of Origin check of the of the international application**

### Information to be added to the international application by the Office of Origin

#### Name of Office of Origin and office reference

At the beginning of the international application form under the heading 'For use by the Office of Origin, there is a field for the office to enter a reference (if any) that the Trademarks Office has allocated to the international application.

For use by the Office of origin:

Office's reference (optional):

#### 1. NAME OF THE OFFICE OF ORIGIN

Bahrain

▼

In all cases, the Trademark Office must complete Part 1 of the international application form. This requires the selection of the 'Name of the Office of Origin.' This requires the entry of the name of the member State or intergovernmental organization for whom the Office of Origin is the authorized office for trademark registration. For an international application where the Trademarks Office of the Kingdom of Bahrain is the Office of Origin, 'Bahrain' is selected from the drop-down menu opened by clicking the cursor on the down arrow at the end of the field.

#### Details related to the basic marks

In addition to the information to be confirmed in the certification, in Part 5 of the international application form the Trademark Office of the Kingdom of Bahrain as the Office of Origin must either indicate the details of the basic mark (if not entered by the applicant) or validate the details if Part 5 has been completed by the applicant.<sup>40</sup>

<sup>40</sup> Article 3(1)(i) and/or Article 3(1)(ii) Madrid Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

### 5. BASIC APPLICATION OR BASIC REGISTRATION

Basic application number:	<input type="text"/>	Date of the basic application (dd/mm/yyyy):	<input type="text"/>
Basic registration number:	<input type="text"/>	Date of the basic registration (dd/mm/yyyy):	<input type="text"/>

- where the basic mark is an application, the Trademark Office must indicate the date and number of the basic mark.<sup>41</sup>
- in the case of a basic mark that has achieved registration, the Trademark Office must indicate the date of registration and registration number and the date of application and number of the application from which the registration resulted<sup>42</sup>

### Certification of the International Application by the Office of Origin

To file an application for the registration of an international trademark, a trademark owner must have a 'basic' mark or marks<sup>43</sup>. A basic mark can be an application or a registration and must have been filed with the office through which the international application is made.

As the Office of Origin, the Trademarks Office of the Kingdom of Bahrain is required to certify that the certain information entered in the international application corresponds to the particulars (at the time of the certification) in the basic mark or marks. The Trademarks Office must sign the declaration at Part 13 of the international application (shown below) before transmitting the application to the International Bureau.<sup>44</sup>

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<sup>41</sup> Article 3(1)(i) Madrid Protocol

<sup>42</sup> Article 3(1)(ii) Madrid Protocol

<sup>43</sup> An international application can be based on two or more basic applications or basic registrations – see the section of these guidelines on 'Basic marks'

<sup>44</sup> Article 3 3(1) Protocol relating to the Madrid Agreement

**13. CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY  
THE OFFICE OF ORIGIN**

(a) Certification. The Office of origin certifies:

(i) That the request to present this application was received on (dd/mm/yyyy):

(ii) that the applicant named in item 2 is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be,

that any indication given in item 7(d), 9(d) or 9(e)(i) appears also in the basic application or the basic registration, as the case may be,

that the mark in item 7(a) corresponds to the mark in the basic application or the basic registration, as the case may be,

that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, or the mark in the basic application or basic registration is applied to be or is protected in color, a color claim is included in item 8 or that, if color is claimed in item 8 without having being claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and

that the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

(b) Name of the Office:

(c) Name and signature of the official signing on behalf of the Office:

*By signing this form, I declare that I am entitled to sign it under the applicable law.*

(d) E-mail address of the contact person in the Office:

Certification is not a substantive examination of the international application to determine whether it meets the requirements for registration, either on the international trademarks register, or the register of the members designated in the

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

international application. The certification is simply a confirmation that at the time of certification, particular details entered in the international application correspond with the details of the basic mark.

In setting the nature of the link between the basic mark or marks, and the international application, the Madrid Protocol uses the word ‘correspond’ but does not give any definition of what this means, such as ‘similar’ or ‘identical’. This is because the interpretation of whether details correspond is a matter for the Office of Origin to determine. The international Bureau does not itself undertake any comparative check on the accuracy or validity of the certification.

The certification process can be summarized as ensuring that it is:

- the same applicant or applicants
- applying for an international registration
- in respect of a ‘corresponding’ trademark (to the basic mark or marks – including any claims
- for a list of goods or services that is covered by the basic mark or marks.

### (i) The date on which the Office of origin received the international application

In certifying the international application, the Trademark Office must insert the date on which it received (or is deemed to have received) the international application.<sup>45</sup> This must be inserted in Part 13(a)(i) of the international application form.

MM2 (E), page 12

#### 13. CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN

(a) Certification. The Office of origin certifies:

(i) That the request to present this application was received on (dd/mm/yyyy):



There are no specific requirements that an international application must satisfy before being given a date of receipt by the Trademarks Office of the Kingdom of Bahrain as the Office of Origin. However, for the Trademark Office to be able to fulfil its responsibility to ‘certify’ the international application, certain ‘basic’ information must be provided.

<sup>45</sup> Article 3(1) Madrid Protocol and Rule 9(5)(d)(i) Regulations under the Protocol

In particular, and corresponding with the rules in the Regulations under the Protocol,<sup>46</sup> the Trademarks Office of the Kingdom of Bahrain will require the following basic information before an international application will be accepted as having been received by the Trademarks Office:

- (i) indications allowing the identity of the applicant to be established and sufficient to contact the applicant or the representative, if any

All international applications must include an e-mail address of the applicant and/or a representative appointed by the applicant to represent them.

- (ii) the Contracting Parties which are designated

- (iii) representation of the mark

- (iv) the indication of the goods and services for which registration of the mark is sought,

An international application will not be considered as having been received by the Trademark Office of the Kingdom of Bahrain until it has all of the information required to be able to certify the application. The Trademarks Office will contact the applicant or their representative to inform them of any irregularity, and how and by when the matter must be resolved.

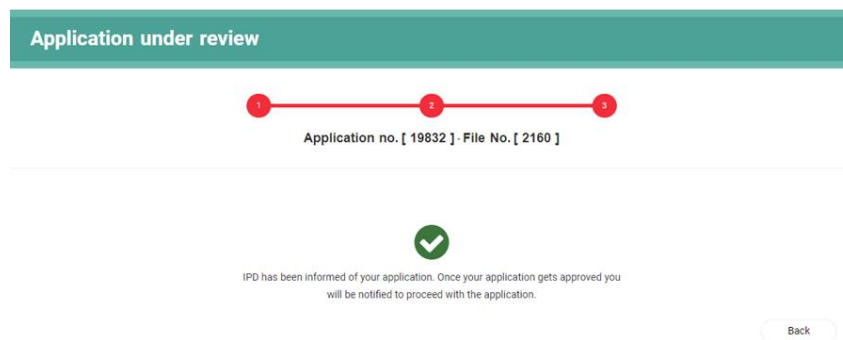
### **Delay in the Trademarks Office receiving the international application**

In the normal course of events, establishing the date that an international application was received by the Trademark Office of the Kingdom of Bahrain will not present a difficulty. When submitting the international application using the Electronic Industrial Property Services ePortal, the international application should be received, and the date logged by the Trademarks Office system at the time that the system issues the 'Application under review' confirmation.

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<sup>46</sup> Rule 15(1)(i)(ii)(iii)(iv) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain



Should the receipt of an international trademark application sent to the Trademarks Office of the Kingdom of Bahrain by an electronic registered delivery service (such as the Electronic Industrial Property Services ePortal) be subject to a delay, the Trademarks Office may accept the date it was sent as the date of receipt.

Evidence will be required establishing the sending of the international application by an identified sender (applicant for registration or their representative), a correctly identified addressee, and the date and time of sending. This is unless there is evidence to the contrary.<sup>47</sup>

**(ii) The applicant or applicants named in the international application are the same as the applicant or applicants named in the basic mark or marks**

In an application for registration of a trademark submitted to the Trademark Office of the Kingdom of Bahrain, an individual (natural person) must enter their given legal name such as entered on their certificate of birth or passport. Where the application is being made by a legal entity, the requirement is for the application to be made using the name under which the entity is recorded such as an official register or tax record, etc.

This corresponds with the requirements for an international application which, for an individual requires the name to include the family (or principal) name and the given (or secondary) name(s) as customarily used by that person. There is one difference in that in an international application the names must be entered in the order in which they are customarily used. If the name or names in the basic mark(s) are not shown in this order, provided they are the same name components they may be deemed to correspond with the format of the international application.

In the case of an international by a legal entity, the full official designation must be given, for example, 'XYZ, a limited liability company (LLC)'. This is the requirement

<sup>47</sup> Article 7(4) Law on Electronic Communications and Transactions Promulgated by Decree No. 54 of 2018

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

for a national application that will be the basic mark so should not present a difficulty in certifying the applicant(s).

### More than one named trademark owner

Where the basic mark was applied for or has been registered jointly by two or more individuals or legal entities, an application for an international registration may only be filed in the name of all of them.

Where two or more individuals or legal entities are named as owners of a basic mark, they may jointly file for an international trademark application using the Trademark Office of the Kingdom of Bahrain. Each named applicant must be entitled to use the Trademark Office of the Kingdom of Bahrain as the Office of Origin by being either a national, resident or operating a real and effective industrial or commercial activity in the Kingdom of Bahrain.

The named applicants need not have the same entitlement with the Kingdom of Bahrain, for example, one may qualify by being a national of the Kingdom of Bahrain, another on being legally resident in the Kingdom of Bahrain.<sup>48</sup> If there is more than one applicant, the number of applicants must be entered.

### 2. APPLICANT<sup>1</sup>

If there is more than one applicant, indicate the number of applicants and complete the "Continuation Sheet for Several Applicants".

Number of applicants:

(a) Name:

(b) Address:

<sup>1</sup> If there is more than one applicant, indicate the details for the first applicant only and provide the details requested in the "Continuation Sheet for Several Applicants" attached to this form.

<sup>48</sup> Rule 8(2) Regulations under the Protocol



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Only the name and address of the first applicant must entered on the form. The name(s) and the address(es) of the other applicant(s) should be provided in the “Continuation Sheet for Several Applicants”.

### **Name in characters other than Latin**

An international trademark application filed through the Trademarks Office of the Kingdom of Bahrain is to be completed in Arabic and English, in the case of English using Latin characters. This should enable the Trademark Office to certify that a named applicant for an international trademark correspond with the named applicants in the basic mark.

However, where the applicant for the basic mark is an individual, and their name contains characters other than Latin characters, a transliteration into Latin characters must be used in the international application form. This transliteration must follow the phonetics of the English language.

A legal entity that has a name in characters other than Latin characters, the transliteration may be replaced by a translation into English.

The Trademark Office will certify that the transliteration of the named applicant(s) for an international trademark correspond with the named applicant(s) in the basic mark.

### **(iii) that, where any of the following indications appears in the international application, the same indications appear also in the basic mark:**

- an indication that the mark consists of a color or a combination of colors as such

Where the international application concerns a mark consisting solely of color or colors without any defined shape or connection with a figurative element (such as a word or logo), the applicant will check the box at Part 7(c) of the international application form. The Trademark Office must certify that this corresponds with the basic mark or marks.

(c) ☐ The mark consists exclusively of a color or a combination of colors as such, without any figurative element.


There is no corresponding check box in an application to register a purely color trademark in the Kingdom of Bahrain. To be able to certify that checking the box at Part 7(c) in the international application corresponds with the details of the basic

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mark applied for in the Kingdom of Bahrain of Bahrain, the basic mark must firstly have been identified as a 'Visual mark – name and logo'.

There will be no information entered in the 'Information related to the mark', 'Trademark language' or 'Trademark name' fields of the basic mark as these are required when the mark contains figurative or word elements.

An entry will have been made in the 'Color description' field stating that the mark consists of a color or colors, and a graphic uploaded showing a color or colors with no words or other figurative matter, for example:

Graphic of the visual mark	Color description
	The mark consists of the color Black (PANTONE 19-0303 TCX Black) and Yellow (Pantone PMS 109) represented in alternating vertical stripes of equal width.

If the box at Part 7(c) of the international application is unchecked but there is an entry in the 'Color description' field of the basic marks, this may indicate that there is color in the basic mark, but the mark is not only color. For example:

A basic mark consisting of the word **MONSAL** shown in these colors may have an entry in the 'Color description' field stating that 'The mark consists of the word MONSAL represented in the colors red and blue'. In such a case this is not a color mark and the check box at Part 7(c) must not have been completed in order for the international application and basic mark(s) to correspond.

- **an indication that the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark**

This part of the certification by the Trademarks Office relates to Part 9(d) of the international application 'Miscellaneous Indications'. By checking the box, the applicant is required to indicate whether the mark is one of the following:

(d) **Where applicable, check the relevant box(es) below:**


- ☐ Three-dimensional mark
- ☐ Sound mark
- ☐ Collective mark, certification mark, or guarantee mark

### Three-dimensional mark

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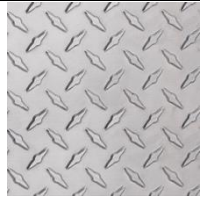
There is no corresponding check box in an application to register a three-dimensional trademark applied for in the Kingdom of Bahrain. To correspond with the international application, a basic mark filed with the Trademarks Office in the Kingdom of Bahrain must have indicated that the 'Mark type' is a 'Visual mark'.

In the 'Description of the Mark' field of the basic mark there must be an entry indicating, directly or indirectly, that the mark has a 3-dimensional form. The 'graphic' will show a representation of a mark with 3-dimensions. For example:

Mark	Example of description
	<p>The trademark consists of the 3-d shape of a container</p> <p><i>or</i></p> <p>The trademark consists of shape of a container</p>

In the above instance, the first description directly mentions that the mark is a 3-dimensional shape. In the second alternative description, the fact that the mark is 3-dimensional is not stated but can be ascertained from the use of the word 'shape' in the description and that the graphic has 'perspective' - 3-dimensions.


That the mark is 3-dimensional may not be obvious from the graphic, but indicated in the description, in the above case by the use of the word 'raised'.

Mark	Example of description
	The mark consists of the appearance of a repeating raised diamond pattern applied to the surface of floor tiles.

In both of the above instances, the Trademark Office will be able to certify that the mark applied for with the Trademarks Office in the Kingdom of Bahrain (the basic mark) corresponds with the indication 'Three-dimensional mark' indicated in the international application by checking the box at Part 9(d).

Care needs to be taken as what appears to be a 3-dimensional mark may just be a vehicle for a different mark. In the following example the mark is not the shape, but the color, the shape shows the use of the color:

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Mark	Example of colour description
	The trademark consists of the colour green identified as PMS 348C, applied to the cap of a container

That there are other elements in the 3-dimensional mark such as words or colors does not change a mark from being 3-dimensional provided the applicant has indicated in the 'Description of the mark' that the mark has a 3-dimensional form.

### **Sound mark, Collective, Certification or Guarantee mark**

#### **Sound mark**

Where the international application has the box checked to indicate the mark is a 'Sound mark', this will correspond with the basic mark applied for with the Trademark Office of the Kingdom of Bahrain where the 'Mark type' has been indicated as a 'Non-visual mark – audio mark'.

The mark may be provided in a single digital file which can consist of a sound recording in WAV or MP3 format. This must not exceed 5 MB in size and must comply with the relevant WIPO Standard relating to trademark information and documentation.<sup>49</sup>

#### **Collective mark, Certification mark, Guarantee mark**

Where the international application has the box checked to indicate the mark is a 'Collective, certification mark or guarantee mark', this will correspond with the basic mark applied for with the Trademark Office of the Kingdom of Bahrain where the 'Mark type' is shown as a 'Collective mark, or Control and inspection mark'

- **a description of the mark by words**

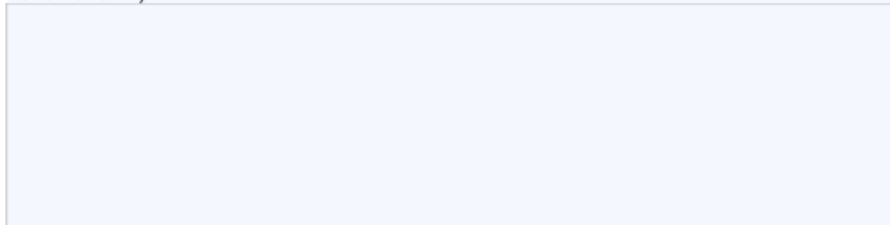
Part 9(e) of the international application enables the applicant to enter a description of the mark. Any descriptions entered in Part 9(e) must be in the language of the international application, which for an international application filed through the Trademark Office of the Kingdom of Bahrain is English.

The first field in Part 9(e)(i) must be completed where the basic mark includes a description of the mark that was a requirement for the application of the basic mark.

<sup>49</sup> Section 11bis of the Administrative Instructions

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- (e) **Description of the mark** (as it may be required for certain designations)
- (i) Description of the mark contained in the basic application or basic registration, where applicable (**only use this item** if the Office of origin requires to include this description in the international application for the purposes of item 13(a)(ii) of this form):



- (ii) Voluntary description of the mark (any description of the mark by words, including the description contained in the basic application or registration, if you were not required to provide this description in item (e)(i) above):



An application for registration filed with the Trademark Office of the Kingdom of Bahrain requires the applicant to provide a description of the mark where the mark is more than just a word or words in plain or standard lettering. Invented words are considered to be no different to ordinary dictionary words and only require a description where the mark includes figurative elements or a form of stylization.

The requirement for a national application filed with the Trademark Office of the Kingdom of Bahrain is for a 'very detailed description' of the mark<sup>50</sup>. This should be interpreted as requiring a description that sufficiently defines the mark being applied for.

Any description of a mark entered in an application filed directly with the Trademark Office of the Kingdom of Bahrain must be in Arabic which means that for the purposes of the international application, the mark description entered in the basic mark will need transliteration into English. The Trademarks Office of the Kingdom of Bahrain should validate the transliteration if one has been entered in the international application form by the applicant.

If there is no transliteration, or the Trademarks Office disagrees with the transliteration entered by the applicant, a final wording must be agreed with the applicant before the international application can be certified.

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<sup>50</sup> Article 3.3 Regulations under the Protocol.

### **Part 9(e)(i) of the international application**

To certify the basic mark corresponds with the international application will require the Trademarks Office of the Kingdom of Bahrain to ensure that:

- Part 9(e)(i) of the international application has been completed where the basic mark includes a description of the mark and that the transliteration of that description from Arabic to English is accurate, or
- Part 9(e)(i) does not contain a description of the mark where the basic mark does not have a description of the mark

If there is an entry in Part 9( e)(i) that is not part of the basic mark, the applicant may have entered the mark description in the wrong part of the international application form. If the intention had been to enter a 'voluntary' mark description, this should be entered in Part 9(e)(ii) of the international application. This should be confirmed with the applicant. The international application cannot be certified as corresponding with the basic mark until the description has either been removed from the international application or repositioned to the correct part.

### **Part 9(e)(ii) of the international application**

To comply with the requirements of a member designated in the international application, the applicant may need to include a description of their mark in the international application even though there is no such description of the mark in the basic mark. Where an applicant wishes to include a 'voluntary' description of the mark in the international application (that is not found in the basic mark or is a variation of a description given for the basic mark) they may do so in Part 9(e)(ii) of the international application. Provided the description is in English, the Trademark Office should accept the description without any review.

### **(iv) that the mark indicated in the form is the same as the basic mark**

At Part 7(a) of the international application form, the applicant must provide a reproduction of the mark that corresponds with the representation of the mark in the basic application or basic registration. The mark may be entered in the international application by any means (typed, printed, pasted, copy-pasted, etc.) according to the preference of the applicant.<sup>51</sup>

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<sup>51</sup> An Office of Origin may 'may prescribe' how the mark shall be included. The Trademark Office of the Kingdom of Bahrain does not have any requirements on affixing the mark to the international application

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In its role as the Office of Origin, the Trademarks Office of the Kingdom of Bahrain must certify that the reproduction of the mark in the international application corresponds with the representation of the basic mark or marks. The Office may use a limited amount of flexibility in reaching its decision.

If there is a difference in the basic mark and the reproduction in the international application, and that difference creates a different overall impression, the Trademarks Office cannot certify that the marks correspond.

To be able to certify that the mark shown in the international application corresponds with the representation of the mark in the basic mark, the graphic must first comply with certain practical requirements:

- where the representation of the mark in the basic mark is in black and white, the reproduction of the mark in the international application must also be in black and white
- where the representation of the mark in the basic mark is in color, the reproduction of the mark in the international application must also be in color (and the same colors)
- The reproduction of the mark in the international application must be clear enough for the purposes of recording, publication, and notification
- The applicants must provide a visual representation of the mark in or with the international application not exceeding 20 centimeters in either length or width
- As an alternative to providing a visual representation of the mark the applicant may provide a single digital file. This can consist of a visual representation in JPEG, PNG or TIFF format. The digital file must comply with the relevant WIPO Standard relating to trademark information and documentation

### Marks in standard characters

Where an international application concerns a mark in standard characters (in some members also referred to as 'word mark'), the applicant will check the box at Part 7(b).

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- (b) ☐ The applicant declares that the mark is to be considered as a mark in standard characters.

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There is no formal definition of what is meant by ‘standard characters.’ For the purposes of an Office of Origin certifying an international application, the decision on whether a mark is in ‘standard characters’ is a matter for that particular office.

In the Kingdom of Bahrain, the Trademarks Office considers a mark in standard characters to be a word or words, whether actual or invented, that are represented in a standard font or typeface; there is no form of stylisation or figurative element. The International Bureau will not question an office certifies that the mark shown in the international application is considered by that office to be in standard characters.

### Marks not in standard characters

The Trademark Office of the Kingdom of Bahrain will require a ‘graphic’ – a visual representation or image of the trademark for any mark that is not in ‘standard characters.’ This includes signatures, symbols, seals, drawings, images, packaging, figurative elements, or shapes and colours. Where a graphic is required, the box at Part 7(b) must not be checked to correspond with the basic mark.

A visual representation will also be required for a trademark consisting of a word or words where these are represented using a non-standard typeface or font, are in color, that have been represented in some unusual or stylised way or include a graphical element. For example:



Mark	Graphic required
<b>MONSAL</b> A standard plain black typeface (in this example Arial) with no embellishment or stylization.	<b>No</b>
<b>MONSAL</b>	<b>Yes</b>
<b>MONSAL</b>	<b>Yes</b>
<b>MONSAL</b> A fancy typeface such as shown, in an unusual or stylized way, require a graphic of the trademark to be uploaded.	<b>Yes</b>
<b>MONSal</b>  M O N S A L  Words shown in an unusual or stylized way, for example require a graphic of the trademark to be uploaded.	<b>Yes</b>





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<div style="border: 1px solid black; padding: 2px; display: inline-block;">MONSAL</div>	<b>Yes</b>
A word or words placed within a border even if the wording is in a standard, plain black typeface	




Where the filing of an application with the Trademarks Office of the Kingdom of Bahrain requires a graphic or visual representation, a mark in international application will require the same graphic to be certified as corresponding with the basic mark. It will not be acceptable to enter a word in a standard or plain face where the basic mark requires a graphic. For example

Basic mark	Unacceptable in an International application
	HELLO
	KWIKFIX
@ccess	access

When considering whether the basic mark and the international mark correspond, the Trademarks Office may take a flexible view in certain and specified circumstances. For example, where the reproduction of the mark is clearer (or more clearly defined):

Basic mark	International application
	<p>A clearer reproduction that corresponds with the basic mark. The visible elements are the same the overall impression is the same</p> <div style="text-align: center;">  </div>
Basic mark	International application

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	<p>Although clearer, this reproduction does not correspond with the basic mark as the word element is not clearly visible in the basic mark</p>		
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Minor differences between the representation of the mark in the basic application or registration and the reproduction in the international application may also be disregarded provided the overall impression created by the two marks is the same.

Where there appears to be a difference in the representation of the mark in the basic application or registration and the reproduction of the mark in the international application, the change should be considered in the same way as a request to amend a mark. If the representation in the international application is considered to 'profoundly alter' the essence of the representation of the mark in the basic application or registration, the international registration cannot be certified as corresponding with the basic mark.

Changes to any 'distinctive' elements of the representation of the mark in the basic application or registration or that affect the overall impression created by the mark will be considered to be more than a minor change. In such cases, the international application cannot be certified as corresponding with the basic mark.

As a general rule, the assessment of whether a change or addition profoundly alters the essence of a mark will be the same as when determining whether an application and an earlier filed trademark are substantially identical. If the representation of the mark in the basic application or registration and the representation of the mark in the international application are deemed to be identical (similar is not good enough) the international application may be certified. The following examples of decisions on requests to alter a trademark may prove helpful:

### Examples

#### 1. Registered trademark

**Otravin**

#### Refused amended trademark

**Otravine**

An application to modify the registered mark 'Otrivin' to 'Otrivine' was refused as the change in pronunciation was substantial. On appeal the tribunal agreed that the Registrar will check if the altered mark affects the scope of investigation for conflict with other marks. It was held that the

alteration of 'OTRAVIN; to 'OTRAVINE' by adding the 'E' might effectively change the look and pronunciation of the word and the scope of the examination for conflict with other marks.; OTRAVIN could not be observed as covering 'OTRAVINE' just as well<sup>52</sup>.

**2. Registered trademark**

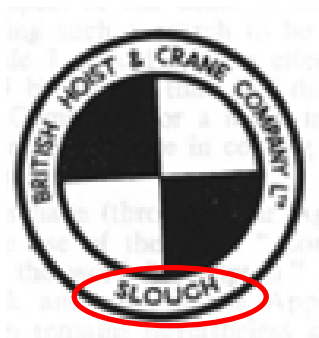
*Pelican*

**Accepted amended trademark**

*Pelikan*

An appeal against the refusal to allow a change of a trademark consisting of the English word 'Pelican' to the German equivalent 'Pelikan' was allowed.<sup>53</sup>

**3. Registered mark<sup>54</sup>**



Having moved their manufacturing facility from the municipality of Slough to the municipality of Compton, the registered proprietor applied to substitute the word "Slough" (highlighted in the red border) with "Compton". The Court upheld the refusal of the alteration on the ground that "Compton", being a well-known surname, might not be understood as having a merely geographical significance.

The Registrar said that an alteration is not necessarily admissible simply because it is minor as regards its physical relationship to the mark as a whole, and that "by 'identity' is meant the feature or features by which the mark will be recognised in its function of distinguishing the proprietor's goods from the similar goods of other traders". He considered that the introduction of an entirely new factor, namely a common surname, altered this identity.

<sup>52</sup> "Otrivin" trade mark (1967) RPC 613

<sup>53</sup> "Pelican" trade mark (1978) RPC 424

<sup>54</sup> British Hoist & Crane Co. Ltd's Trade Mark (1955) 72 RPC 66 (Ch.D.)

4. Registered trademark



Refused Amended trademark<sup>55</sup>



**Transliteration, translation, and meaning of words in the mark**

There are other indications related to a mark at Part 9(a), 9(b) and 9(c) that may be included in an international application. In its role as the Office of Origin the Trademarks Office is not required to certify this indication but ensuring it has been entered can avoid irregularities or provisional refusals.

A transliteration of the mark must be provided at Part 9(a) where the mark consists of contains characters other than Latin characters, or numerals other than Arabic or Roman numerals

**9. MISCELLANEOUS INDICATIONS**

- (a) ☐ **Transliteration of the mark** (this information is compulsory where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals):

The applicant may voluntarily include a translation of the mark into any or all of the three languages of the Madrid System. Whether they do so will depend on whether a translation is required by any of the members being designated. The Trademarks Office is not required to check or validate any translations entered.

- (b) **Translation of the mark** (as it may be required for certain designations; **do not** check the box in item (c) if you provide a translation):

(i) into English:

(ii) into French:

(iii) into Spanish:

<sup>55</sup> Seaforth Maritime Ltd's Trade Mark [1993] RPC 72

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Where the mark consists of or contains an invented word or words, the applicant may, should they so wish, indicate that the word(s) have no meaning by checking the box at Part 9(c). This can avoid provisional refusals being issued by members that require such clarification

- (c) ☐ **The words contained in the mark have no meaning** (and therefore cannot be translated; do not check this box if you have provided a translation in item (b)).

- (v) **that, if color is claimed as a distinctive feature of the mark in the basic mark, the same claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic mark, the mark in the basic mark is in fact in the color or combination of colors claimed**

If color is claimed as a distinctive feature of the mark represented in the international application, this must be indicated by checking the box at Part 8(a) of the international application form, and the claim entered in the box.

### 8. COLOR(S) CLAIMED

- (a) ☐ **The applicant claims color as a distinctive feature of the mark.**  
Color or combination of colors claimed:

- (b) **Indication, for each color, of the principal parts of the mark that are in that color (as it may be required for certain designations):**

Where color has been claimed as a distinctive feature of the mark in the basic application or registration, the same claim must be entered at Part 8(a) in order for the international application to be certified as corresponding with the basic mark.

Part 8(a) requires the entry of the common name of the colors claimed, for example 'Blue' and 'Red' defined by reference to a recognised color matching system such as Pantone, RAL, etc. For example, Red: Ral 2002' and 'Blue: Ral 5015'. A description of how the colors are used or distributed is entered in Part 8(b), for example in the following mark **MONSAL**

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### 8. COLOR(S) CLAIMED

- (a) ☒ The applicant claims color as a distinctive feature of the mark.  
Color or combination of colors claimed:

Red: Ral 2002  
Blue: Ral 5015


- (b) Indication, for each color, of the principal parts of the mark that are in that color (as it may be required for certain designations):

The letters MON represented in Red  
The letters SAL represented in Blue

### Color claimed as a distinctive feature of basic mark and the international application

A 'national' trademark application filed with the Trademarks Office of the Kingdom of Bahrain may contain an indication relating color under the headings 'Color description' and 'Registration requirements.' To determine whether there is a claim to color as a distinctive feature of the basic mark, the entries in these two sections of the basic mark sections will need to be considered alongside the representation of the mark.

An entry of a 'Color description' in the basic mark is used where the representation of the mark is in color but will not necessarily be a claim to color as a distinctive feature of the mark. In this example there is a mention of color but color is not being claimed:

Basic Mark	Color description
	The mark consists of the shape of a bottle represented here in the color green PMS 348C but color is not claimed

The 'Registration requirements' section of a basic mark is used where an applicant enters any statement regarding the mark, or elements of the mark to define the

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scope of protection being sought. This includes a claim to the color or colors as a distinctive feature of the representation of the mark. Where there is such a claim to color in the Registration requirements, the representation of the mark should be in color, and the color or colors mentioned. There should also be an entry in the 'Color description' section defining the colors of the basic mark by their common name, for example, red, blue, green and by reference to a recognised colour matching system such as Pantone, RAL, etc.

A claim to color is entered in Part 8(a) of the international application must be in the language of the international application, which for an international application filed through the Trademark Office of the Kingdom of Bahrain is English. As the Color description' and 'Registration requirements' in the basic mark are required to be completed in Arabic, this will require a transliteration of the 'Color description' entered in the basic mark. The Trademarks Office must validate the accuracy of the translations in order to be able to certify the international application.

### **Color not claimed as a distinctive feature of basic mark but claimed in the international application**

An international application may include a claim to color as a distinctive feature of the mark, but the basic application or registration has no claim to color. Provided the representation of the mark in the basic application is in the color or colors claimed in the reproduction attached to the international application, the Trademarks Office may certify the mark as corresponding with the basic mark.

### **(vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic mark at the time when the Office certifies the international application**

The Trademarks Office must certify that the goods or services listed in Part 10(a) and if entered, Part 10(b) of the international application correspond with the list of goods or services covered by the basic mark or marks. To be able to certify that the list of goods or services in the international application are covered by the scope of that of the basic mark(s), the Trademarks Office must be able to confirm that the goods or services mentioned in the international application:

- are the same goods or services listed in the basic mark(s) or,
- fall within broader terms included in the list of goods or services of the basic mark(s)

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In determining whether the list of goods or services in an international application correspond with the goods or services covered by the basic mark(s), the Trademarks Office must look at the descriptions and not rely on the Nice class.

### **More than one basic mark**

More than one basic mark may be used as the basis for the international application. Provided all the basic marks correspond with the international application, this allows for a list of goods or services in the international application combining all the goods or services listed in the basic marks.

The Madrid System is a 'multiclass' registration system, allowing for an international application to be filed containing goods or services in one or more of the Nice classes. In the Kingdom of Bahrain, a trademark application may only be made for one class of the Nice Classification, which means that a basic mark can relate one class only.

Provided the basic marks correspond with the international application in all other respects, the lists of goods or services from two or more basic marks in different classes of the Nice Classification may be inserted in an international application. The goods or services must be grouped according to the classes of the Nice Classification. Each group must be identified by the Nice class number and presented in the international application in numerical order according to the class number.

The International Bureau will use the version of the Nice Classification in force at the time of the filing of the international application. This may mean that where goods or services have been moved from one class to another, the Nice class of the goods or services in the basic mark(s) may be different in the current classification and consequently, the international application.

The Trademarks Office may certify the goods or services in the international application as 'corresponding' with the basic mark(s) where it is satisfied that the goods or services mentioned in the international application:

- changed class between the time of the filing of the basic marks and the making of the international application
- are the same goods or services listed in the basic mark(s) or,
- fall within broader terms included in the list of goods or services of the basic mark(s)



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The current and previous editions of the Nice Classification may be found here <https://www.wipo.int/classifications/nice/nclpub/en/fr/>

### Different goods or services listed for certain designated members

The list of goods or services entered in Part 10(a) of the international application is considered to be the 'main list', and unless indicated by the applicant, will be the list for which the applicant seeks protection in all of the members designated.

An international application may contain limitations of the list of goods and services.<sup>56</sup> Any limitation may be in respect of one or more of the members designated in the international application and may be different for each member as long as the limitation is within the scope of the main list.<sup>57</sup>

Where an applicant requires that for one or more of the members designated in the international application a limited list of goods or services is to be used, this will be entered in Part 10(b) of the international application.

(b) ☐ The applicant wishes to limit the list of goods and services in respect of one or more designations, as follows:

Designation:	Class(es) or class(es) and goods and services for this designation:

☐ If the space provided is not sufficient, check the box and use a **continuation sheet**.

Any list entered in Part 10(b) of the international application must correspond with the goods or services covered by the basic mark or marks.

The Trademarks Office must ensure that any limited list of goods or services entered by the applicant for particular designated members only includes goods or services

<sup>56</sup> Rule 9(4)(xiii) Regulations under the Protocol

<sup>57</sup> Rule 9(4)(xiii) Regulations under the Protocol

covered by the basic mark(s), either specifically by their description or in broader descriptions.<sup>58</sup> See also **International application contains ‘limitations’ to the goods or service** and **Limitations** in these guidelines.

### **Determining whether goods or services ‘correspond’**

In deciding whether the goods and services covered by the international application correspond with the goods or services of the basic mark(s) does not mean that the descriptions match exactly. The following provides guidance on the interpretation of descriptions of goods and services found in the Classification Guide.

### **Covered by a broader description**

Useful guidance on deciding what a description of goods or services covers can be found in various legal judgements from the United Kingdom:

‘When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.’<sup>59</sup>

By way of example, in determining whether the description “stationery” included paper fasteners with the common names ‘staples’:

‘... in order to answer that question, the first step I think is to look at the ordinary meaning of the word “stationery”, which as defined in the Oxford English Dictionary is: “the articles sold by a stationer; writing materials, writing table appurtenances, etc”. I feel no doubt that staples are stationery, according to the ordinary meaning of the word’<sup>60</sup>.

And in determining the meaning and scope of the description ‘printed matter’:

‘The specification of goods poses difficulties. “Printed matter” as a pure matter of language, I suppose, covers anything upon which there is printing. In a sense, every trade mark for whatever goods could also therefore be registered for printed matter if one reads “printed matter” perfectly literally. Every packet has printed matter on it. “Printed Matter” cannot in my judgment mean merely that the trade mark is printed on something. For example, if there is a registration for “printed matter” but the only use is on labels for, say,

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<sup>58</sup> Rule 9(5)(d) Regulations under the Protocol

<sup>59</sup> British Sugar PLC-v-James Robertson & Sons Ltd (1996 RPC 280)

<sup>60</sup> OFREX case (1963 RPC 169-171)

soap or bananas, there has not been use for printed matter. On the other hand, the kind of printed forms and other things produced by these proprietors seem to be perfectly well described as “printed matter”. People buy them for what is printed on them. However, there is a very big difference between that sort of printed matter and printed matter of a literary character<sup>61</sup>.’

So, for example:

Basic mark:	Class 25:	Clothing made of leather
International application:	Class 25	Clothing, clothing made of imitation leather, belts, purses and handbags

- **Clothing:** The ‘clothing’ listed in the basic mark is limited to clothing ‘of leather.’ The description ‘clothing’ in the international application covers clothing made of any material. The goods of the international application are broader than the basic mark and cannot be accepted as corresponding with the goods of the basic mark
- **Clothing made of imitation leather:** The basic mark covers clothing of leather but not ‘clothing made of imitation leather’. The goods of the international application are broader than the basic mark and cannot be accepted as corresponding with the goods of the basic mark
- **Belts:** The international application includes ‘belts’ which is not mentioned in the basic mark. The Nice Classification includes the description ‘belts [clothing]’ in Class 25 indicating that the description ‘clothing’ also covers ‘belts.’ The inclusion of ‘belts’ in the international application can be accepted as being within the broader description ‘clothing in the basic mark. However, the belts in the international application would need to be limited to ‘leather’ to correspond with the goods of the basic mark
- **Purses and handbags:** The international application cannot include ‘purses’ or ‘handbags’ as these items are not ‘clothing’ and therefore not covered by the basic mark. They may be considered as ‘related goods’ to the clothing listed in the basic mark but this does not qualify them to be included in the international application even if limited to being of leather. The goods must be covered by the description in the basic mark

### **International application contains fewer goods or service**

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<sup>61</sup> The MINERVA case (2000 FSR 734)

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

The list of goods and services in the international application does not have to include all the goods or services of the basic mark(s) and may use a different list of goods and services for each of the designated members. For example:

**Basic mark:** Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages

**International application:** Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages

For members designated that do not allow trademark registration in respect of alcoholic beverages, the international application may be for the “mineral and aerated waters”; the non-alcoholic part of the list of goods.

### **International application contains ‘limitations’ to the goods or service**

The international application may contain ‘limitations’ that do not appear in the list of goods or services of the basic mark(s). A ‘limitation’ in this sense is a way of further defining the goods or services such as by their intended purpose, material, etc. A ‘limitation’ may apply to some, or to all of the goods or services listed in the international application.

A limitation may also apply to specific members designated in the international application and may be different for different designated members. For example, in the case of an international application ‘Class 9 Thermometers’ and ‘Class 10 Thermometers’ designating the United States of America and the United Kingdom:

#### **Class 9: Thermometers**

Designating the United States, the thermometers would need to be limited (or defined) such as being ‘not for ‘surgical use’, ‘not for medical’, ‘not veterinary use’ etc. to be acceptable in Class 9.

Designating the United Kingdom, the thermometers would not need to be limited to be acceptable in Class 9.

#### **Class 10: Thermometers**

Designating the United States, the thermometers would need to be limited (or defined) such as being for ‘surgical use’, ‘medical’ ‘veterinary use’ etc. to be acceptable in Class 10.

## **Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain**

Designating the United Kingdom, the thermometers would not need to be limited to be acceptable in Class 10.

### **Office of Origin signature of the international application**

If the Trademarks Office as the Office of Origin is satisfied that the basic mark(s) and the international application correspond, and having entered the date on which the International application is accepted as having been received, the Trademark Office must insert:

- the official name of the Trademark Office of the Kingdom of Bahrain office at Section 13(b) of the international application form
- the name and signature of the official signing on behalf of the Trademark Office of the Kingdom of Bahrain at Section 13(c) of the international application form. By signing the international application form, the person is declaring that they are entitled to sign on behalf of the Trademarks Office of the Kingdom of Bahrain.
- the email address of the contact person in the Trademark Office of the Kingdom of Bahrain at Section 13(d) of the international application form. Whilst this may be the official named in Section 13(c), it may be the email address of a different official

### **Date of receipt given by the International Bureau**

The International Bureau must receive the international application within two months of the date given by the Trademarks Office of the Kingdom of Bahrain as the date on which it received the application. Provided the international application has been properly filed with the International Bureau, the date of receipt by the Trademarks Office of the Kingdom of Bahrain will become the date of the international registration.

If any of the following elements is missing from the international application this can, if not remedied within two months from the date of application, affect the date of the international registration:<sup>62</sup>

- indications allowing the identity of the applicant to be established and sufficient to contact them or the representative
- the designation of the members where protection is sought

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<sup>62</sup> Rule 15 Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- a reproduction of the mark
- the goods and services for which registration of the mark is sought

irregularity must be remedied (with the International Bureau) within two months of the date of the international application. If not remedied within this two-month period, the international application will be considered as filed on the date that the last of the missing element(s) reaches the International Bureau.

There are no specific requirements that an international application must satisfy before being given a date of receipt (filing) by an Office of Origin. However, for the Trademark Office to be able to fulfil its responsibility to 'certify' the international application, certain 'basic' information must be provided.

Accordingly, an international application will not be considered as having been received by the Trademark Office of the Kingdom of Bahrain until it has all of the information required to be able to certify the application. The Trademarks Office will contact the applicant or their representative to inform them of the problem, and how and by when the matter must be resolved.

### **Check of the international application form by the Office of Origin**

In addition to fulfilling the requirement to certify that the international application corresponds with the basic mark, the Trademarks Office should check the international application to try and avoid an irregularity being raised by the International Bureau.

There are particular irregularities that must be remedied by the Trademarks Office as the Office of Origin. These the irregularities are considered to be the responsibility of the Trademarks Office because an international application containing such defects should not have been forwarded to the International Bureau.<sup>63</sup>

There are other irregularities that either the Trademarks Office or the applicant may be required to remedy and particular irregularities that, because of their nature can only be remedied by the applicant.

### **Irregularities to be Remedied by the Office of Origin**

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<sup>63</sup> Rule 11(4) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Where there is an irregularity in an international application that is considered to be the responsibility of the Office of Origin, the International Bureau will send notification of the irregularity to the Trademarks Office and a copy to the applicant.

The Trademarks Office must remedy the irregularity within three months of the date of the notification of the irregularity. Failure to remedy the irregularity within this period will result in the international application being considered as abandoned.<sup>64</sup>

Where an international application is deemed to be abandoned, the international Bureau will notify the Trademarks Office as the Office of Origin and the applicant

An irregularity will be the responsibility of the Trademarks Office in the following circumstances:<sup>65</sup>

- **the international application has not been presented on the correct form**

The legal texts do not specifically mention the form to be used. The requirement is that the international application be made using the 'official form'<sup>66</sup> and that the form to be used shall be the form established by the International Bureau.<sup>67</sup> The forms established by the International Bureau are published and made available on the WIPO website.<sup>68</sup> For the purposes of making an international application, the Form MM2 must be used to make any international application.

- **the information in the international application has or not typed or printed**

Any communications addressed to the International Bureau must be in an electronically or machine produced text, including by typewriter.<sup>69</sup> This includes the completion of the international application form, and any other form required to complete a procedure.

- **the international application does not allow the identity of the applicant to be established or contact the applicant or the representative, if any,**

Where the international Bureau is not able to identify and contact the applicant (or their representative, if any) the international application cannot be given a date of

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<sup>64</sup> Rule 11(4)(b) Regulations under the Protocol

<sup>65</sup> Rule 11(4) Regulations under the Protocol

<sup>66</sup> Rule 9(2)(a) Regulations under the Protocol

<sup>67</sup> Section 2 Administrative Instructions

<sup>68</sup> Section 4 Administrative Instructions

<sup>69</sup> Section 6(a) Administrative Instructions

registration until the irregularity has been remedied.<sup>70</sup> Should this irregularity not be remedied within three months of the International Bureau notifying the irregularity, this will result in the International Bureau considering the international application as abandoned.<sup>71</sup>

### **Requirements for the identification of the applicant**

In the case of an individual (natural person), this must be the family or principal name (surname such as Smith or Ahmad) and the given or secondary name(s) (such as John, Hassan etc.) of the natural person<sup>72</sup>.

In the case of a legal entity, the name to be indicated is the full designation of the legal entity as officially registered<sup>73</sup> and include the legal status, for example, LLC or LLP.

The name of an individual that contains characters other than Latin must include a transliteration into Latin characters in the international application form. This transliteration must follow the phonetics of the English language.<sup>74</sup>

A legal entity that has a name in characters other than Latin characters, the transliteration may be replaced by a translation into English.

### **Address of the applicant or their representative**

An international registration must include both the geographical address of named applicant for the international registration, and their email address<sup>75</sup>. The geographic address and electronic email address must enable the prompt postal or electronic delivery of communications.<sup>76</sup> In particular, a geographic address must contain sufficient detail for the delivery of correspondence. For example:

- number or name of house, building
- street name or street number;
- name of municipality, rural locality
- postcode;
- country.

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<sup>70</sup> Rule 15(1)(i) Regulations under the Protocol

<sup>71</sup> Rule 11(4)(a)(i) Regulations under the Protocol

<sup>72</sup> Section 12(a) Administrative Instructions for the Application of the Protocol

<sup>73</sup> Section 12(b) Administrative Instructions for the Application of the Protocol

<sup>74</sup> Section 12(c) Administrative Instructions for the Application of the Protocol

<sup>75</sup> Rule 9(4)(a)(ii) and Rule 9(4)(iii) Regulations under the Protocol

<sup>76</sup> Section 12(d) Administrative Instructions for the Application of the Protocol



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

An applicant may include a telephone number and an alternative geographical and electronic email address for correspondence, but this is not a requirement.<sup>77</sup>

### More than one named applicant

Where a basic mark names two or more named applicants, the international application must be filed in the name of all of them<sup>78</sup>.

#### 2. APPLICANT<sup>1</sup>

If there is more than one applicant, indicate the number of applicants and complete the "Continuation Sheet for Several Applicants".

Number of applicants:

(a) Name:

(b) Address:

<sup>1</sup> If there is more than one applicant, indicate the details for the first applicant only and provide the details requested in the "Continuation Sheet for Several Applicants" attached to this form.

Where there is more than one named applicant, the international application the number of applicants must be indicated, and the name and addresses of second (or more) applicants entered in the "Continuation Sheet for Several Applicants".

One geographic address and one email address must be indicated as the point to which communications from the International Bureau are to be sent.<sup>79</sup> If an address is not indicated the International Bureau will use the first address (email and/or geographic) as the address for correspondence

### Designations

<sup>77</sup> Section 12(d) Administrative Instructions for the Application of the Protocol

<sup>78</sup> Rule 9(5)(d)(ii) and Rule 8(2) Regulations under the Protocol

<sup>79</sup> Section 13 Administrative Instructions

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

The applicant must designate (at least one) of the member States or intergovernmental organizations where protection is required.<sup>80</sup> This is to be done by checking the appropriate boxes in Part 11 of the international application.<sup>81</sup> The international application cannot indicate the territory of the State or intergovernmental organization in which the Office of Origin is located (self-designation).<sup>82</sup>

As the Kingdom of Bahrain is a member of the Madrid Protocol, the international application can only indicate States or regional organizations that are also members of the Madrid Protocol..

### Specific Requirements Applicable to Certain Members

Some members of the Madrid Protocol have specific requirements or conditions that apply when they are designated. Where a member has specific requirements, these will be indicated in the footnotes in the international application form available on the WIPO website.

Where the international application indicates the European Union or the United States of America as a member where protection is required, the Trademarks Office should check that the following information has been provided:

#### European Union

The applicant must select one of the five official languages of the European Union Intellectual Property Office as a second language.

If the **European Union** is designated, it is compulsory to indicate a second language before the Office of the European Union, among the following (check one box only):

☐ French    ☐ German    ☐ Italian    ☒ Spanish

Moreover, if the applicant wishes to claim the **seniority** of an earlier mark registered in, or for, a Member State of the European Union, the **official form MM17 must be annexed** to the present international application.

This second language must be different from English which is the required language for an international application filed through the Trademarks Office of the Kingdom of Bahrain.

#### United States

<sup>80</sup> Rule 15(1)(ii) Regulations under the Protocol

<sup>81</sup> Rule 9(4)(a)(xv) Administrative Instructions

<sup>82</sup> Article 3bis Madrid Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

A declaration of intention to use the mark must accompany any international application designating the United States by the completion of the additional form MM18.

If the EU is designated and a second language has not been indicated as required, the Trademark Office must remedy this by contacting the applicant before transmitting the international application to the International Bureau.

Similarly, where the United States of America are designated and a form MM18 has not been completed and submitted to the Trademarks Office with the international application, the Trademark Office must request and receive the completed Form MM18 before transmitting the international application to the International Bureau.

- **Representation of the mark**

As the Office of Origin, the Trademarks Office of the Kingdom of Bahrain must certify that the mark in the international application corresponds with the basic mark or marks. It is for the Trademarks Office to decide whether the marks correspond and to ensure that all qualifications or limitations in the basic mark(s) have been added to the international application.

Fuller details on the requirements concerning the ‘correspondence’ of the marks can be found under the section of these guidelines dealing with the requirements in certifying the international application.

On a practical level, there are certain ‘administrative’ requirements relating to the mark in the international application. If these are not followed this may result in an irregularity being received by the Trademarks Office of the Kingdom of Bahrain and result in the International Bureau not considering the international application as having been filed:<sup>83</sup>

- there must be a reproduction of the mark submitted with the application.
- where the basic mark is in black and white, the reproduction of the mark in the international application must also be in black and white
- the reproduction of the mark in the international application must be clear enough for the purposes of recording, publication, and notification
- the reproduction of the mark must be a two-dimensional graphic (this allows for a photographic reproduction)

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<sup>83</sup> Rule 15(1)(iii) Administrative Instructions for the Application of the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- a graphical (visual) representation of the mark may be used but must not be larger than 20cm by 20cm
- the mark may be provided in the form of a single digital file<sup>84</sup> containing:
  - a visual representation, in JPEG, PNG or TIFF format<sup>85</sup>
  - sound recording in MP3 or WAV format, not exceeding 5 MB in size<sup>86</sup>
  - motion or multimedia recording, in MP4 format, with AVC/H.264 or MPEG-2/H.262 codecs, not exceeding 20 MB in size<sup>87</sup>
- where the basic mark is in color, the reproduction of the mark in the international application must also be in color (and the same colors).

If the box at Part 8(a) has been checked there should be an entry in the field stating the color or colors by their common name defined by reference to a recognised color matching system such as Pantone, RAL, etc. A description of how the colors are used or distributed must entered in Part 8(b), for example in the following mark **MONSAL**

### 8. COLOR(S) CLAIMED

- (a) ☒ The applicant claims color as a distinctive feature of the mark.  
Color or combination of colors claimed:

Red: Ral 2002  
Blue: Ral 5015

- (b) Indication, for each color, of the principal parts of the mark that are in that color (as it may be required for certain designations):

The letters MON represented in Red  
The letters SAL represented in Blue

<sup>84</sup> Section 11*bis* Administrative instructions

<sup>85</sup> In accordance with the Recommendations for the Electronic Management of the Figurative Elements of Trademarks, WIPO Standard ST.67, adopted on May 4, 2012;

<sup>86</sup> In accordance with the Recommendations for the Electronic Management of Sound Marks, WIPO Standard ST.68, adopted on March 24, 201

<sup>87</sup> In accordance with the Recommendations for the Electronic Management of Motion and Multimedia Marks, WIPO Standard ST.69, adopted on December 4, 2020.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- an international application for a mark consisting solely of color or colors without any connection with a figurative element must be indicated by filling the check the box at Part 7(c) of the international application form:

(c) ☐ The mark consists exclusively of a color or a combination of colors as such, without any figurative element.

The reproduction of the mark must show the color claimed and must clearly be a mark that has no figurative element:



- **The indications of the goods and services for which registration of the mark is sought**

### **International application and Basic Mark(s) ‘correspond’**

As the Office of Origin, the Trademarks Office of the Kingdom of Bahrain must certify that the goods or services listed in Part 10(a), and if entered, Part 10(b) of the international application correspond with the list of goods or services covered by the basic mark or marks. This certification confirms that the goods or services mentioned in the international application:

- are the same goods or services listed in the basic mark(s) or,
- fall within broader terms included in the list of goods or services of the basic mark(s)

Certification does not concern the classification of the goods or services contained in the international application.

On receiving an international application, the International Bureau will examine the list of goods or services to ensure that they have been classified and entered in the international application according to the requirements of the legal texts.<sup>88</sup> In particular, the International Bureau will check that the international application:

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<sup>88</sup> Article 3(2) Madrid Protocol and Rule 9(4)(a)(xiii) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- includes the goods or services for which protection is sought
- indicates the goods or services by their name
- each description of a good or service has been classified according to the Nice Classification
- groups the goods or services in the appropriate class(es) of the Nice Classification
- shows the number of the class for each group of goods or services, and
- lists the classes in order

To avoid the notification of an irregularity, the Trademarks Office should, as far as is practical, also check that the international application fulfils these requirements before transmitting the application to the International Bureau. The following paragraphs provide guidance on the above-listed points:

### **Includes the goods or services for which protection is sought**

There must be a description of a good(s) or service(s) entered in the international application at Part 10(a) of the international application. If there is no entry in this part of the international application, the Trademarks Office cannot certify and transmit the international application to the International Bureau.

In the unlikely event that an international application is received by the International Bureau without any description of goods or services entered at Part 10(a) of the form, the international application will not be accepted. The International Bureau will send the Trademarks Office a notification requiring that the irregularity be remedied within two months of the date of the notification.

Should the missing descriptions of goods or services be provided to the International Bureau, but outside of the two-month period, the date of registration of the international application will be the date on which the missing information was received by the International Bureau<sup>89</sup>

### **- Insufficient space for goods or services in international application**

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<sup>89</sup> Rule 15(1)(iv) Regulations under the Protocol

If the space on the international application is insufficient for the list of goods or services, a continuation sheet should be used. If a continuation sheet is used, the box at the end of Part 10 of the international application must be checked to indicate there is a continuation sheet.

### **Indicates the goods or services by their name**

The descriptions of goods or services must be indicated in precise terms, and 'preferably using the words appearing in the Alphabetical List'<sup>90</sup> of the Nice Classification. The Nice Classification does not include a every conceivable description of goods or services that will be accepted in an international application. Where there is doubt over the acceptability of a description of goods or services, or the correct class, the Madrid Goods and Services Manage (MGS) should be consulted. Access the MGS [here](#)

In many cases, a description of goods or services will be found in a mainstream dictionary, or a specialist or trade-related reference work. Terms that are in clearly in common use in particular trades will be acceptable in an international application even if they have not yet reached the Nice Classification or the MGS database, although this is dependent on the view of International Bureau.

Descriptions such as 'All goods in this class', and 'All services in Class X' do not indicate goods or services 'by their name' and are not to be accepted.

Descriptions should be sufficiently precise so that the type or nature of the goods and services can be clearly identified, for example:

#### **Machines**

The description "machines" without further qualification describes any type of machine and cannot be understood or correctly classified without further detail, for example, by Indicating the end use of the machine:

Agricultural machines

Calculating machines

Addressing machines

Indicating a class, for example, 'Machines in Class 7' does not make an imprecise description acceptable.

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<sup>90</sup> Rule 9(4)(a)(xiii) Regulations under the Protocol

### **Use of Class Headings in international applications**

The International Bureau accepts the class headings of the Nice Classification in international applications, but this is not the case in respect of all members of the Madrid System. The Kingdom of Bahrain does not accept class headings as the list of goods or services. To avoid a possible provisional refusal by a designated Office it is advisable to list specific goods or services rather than the indication of the class headings.

#### **Each description of a good or service has been classified according to the Nice Classification**

The list of goods or services included in an international application must be classified according to of the International Classification of Goods and Services, the Nice Classification.<sup>91</sup>

In reviewing the list of goods or services in an international application, the International Bureau will apply the Nice Classification in force at the time of the filing of the international application regardless of the version and edition of the Nice Classification applied to the goods and services in the basic mark.

It is possible that in the period between the filing of the basic mark and the filing of the international application an item of goods or a service may have changed class. Where this is the case, the description should be entered into the international application in the class according to the Nice Classification at the time of receipt of the international application by the Trademarks Office of the Kingdom of Bahrain, provided the International Bureau receives the application within the applicable two-month period. In the event that this creates a new class, and the total number of classes in the international application exceeds three classes, the applicant may need to pay an additional class fee.

#### **Shows the number of the class for each group of goods or services**

The class of the Nice Classification to which goods or services belong must be entered in the first column headed 'Class'. Where there is more than one class of goods or services these should be listed by class number in ascending order.

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<sup>91</sup> Article 3(2) Protocol relating to the Madrid Agreement



## 10. GOODS AND SERVICES<sup>13</sup>

(a) List below the class(es) and goods and services to be covered by the international registration<sup>14</sup>:

Class: Goods and Services<sup>15</sup>:

If the International Bureau receives an application without any indication of the class (or classes) to which the goods or services listed belong, the International Bureau will classify the goods and services in the appropriate classes of the Nice Classification.

### **Groups the goods or services in the appropriate class(es) of the Nice Classification**

The Madrid System allows for international applications to be made in respect of multiple classes of goods or services in a single application. Where goods or services belonging to more than one class are included in an international application, they must be listed and grouped together according to the class of the Nice Classification to which they belong.<sup>92</sup>

### **Several basic marks create a single multi-class international application**

Although the Kingdom of Bahrain does not have a multi-class trademark system, where several basic marks are used as the basis for an international application, this may result in two or more classes of goods or services being listed in the international application. In such a case, the goods or services must be grouped together by their class in the Nice Classification, and the classes presented in the international application in ascending numerical order.

### **Irregularities in the list of goods or services of the international application**

On receiving an international application, the International Bureau will examine the application to ensure that it follows the requirements for the listing of goods and

<sup>92</sup> Rule 9(4)(a)(xiii) Regulations under the Protocol

services. There are two types of irregularity that may relate to the goods or services in an international application, and both will be for the Office of origin to remedy. The first is referred to as an irregularity in the ‘classification’ of the goods or services and/or the grouping of the descriptions (Rule 12 of the Regulations under the Protocol).

The second relates to the acceptability of the descriptions of goods or services (have they been clearly identified by name), Should the International Bureau consider that there is an irregularity, they will send a notification to the Trademarks Office and the applicant (Rule 13 of the Regulations under the Protocol).

### **Irregularity in the classification**

An irregularity in the classification will be raised where the International Bureau considers that goods or services have been placed in the wrong class of the Nice Classification.

An irregularity in the classification may result from the fact that the International Bureau applies the Nice Classification in force at the time of the filing of the international application. If the classification of a good or services has changed between the filing of the basic mark and the filing of the international application and this is not picked up by the Trademarks Office before submitting the international application, an irregularity will result.

Where the irregularity concerns the class in which a description has been listed, the notification from the International Bureau will include a proposal to remedy the irregularity for consideration by the Trademarks Office.<sup>93</sup> At the same time, the International Bureau will send notification of the irregularity to the applicant.<sup>94</sup> If any additional fees will be payable as a result of the proposal from the International Bureau, the notification will mention these.<sup>95</sup>

### **Irregularity resulting from a description considered too vague, incomprehensible or linguistically incorrect**

When applying to register a trademark with the Trademark Office of the Kingdom of Bahrain, the applicant must ensure that the descriptions of goods or services are clear and precise. It must be possible to understand the sort of goods or services that the description relates to, and from this, the rights that will be protected.

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<sup>93</sup> Rule 12(1)(a) Regulations under the Protocol

<sup>94</sup> Rule 12(1)(a) Regulations under the Protocol

<sup>95</sup> Rule 12(1)(b) Regulations under the Protocol

## **Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain**

The test that should be applied by the Trademark Examiner of the Trademarks Office of the Kingdom of Bahrain is whether they consider the average person engaged in the relevant trade will be able to understand the nature of the goods or services without the need for further explanation. Examiners should not accept a description where they do not consider it passes the test. If a description of a good or services cannot be understood, it cannot, with any degree of certainty be said to belong to the class designated on the application form.

In its review of the international application, the International Bureau will apply a similar test. However, it does not follow that the International Bureau will reach the same conclusion on whether a description of goods or services is clear and precise, or too vague, incomprehensible or linguistically flawed.

If the International Bureau considers any description of goods or services indicated in the international application to be incomprehensible or too vague to be classified, or to be linguistically incorrect, an irregularity notification will be sent to the Trademarks Office. At the same time as notifying the Trademarks Office, the International Bureau will send a notification of the irregularity to the applicant. The International Bureau may suggest a substitute term or propose that a description be deleted from the list of goods or services but is not required to do so.<sup>96</sup>

### **Trademarks Office response to the irregularity notification**

#### **Period for response**

The notification will allow the Trademarks Office three months from the date of the notification to respond, either accepting the proposal made by the International Bureau, presenting arguments against the irregularity finding by the International Bureau, or making a counter proposal for consideration by the International Bureau.<sup>97</sup>

#### **Reminder from International Bureau**

If nothing is heard from the Trademarks Office within two months from the date of the notification of the irregularity under Rule 12, the International Bureau will send a reminder of the irregularity and the proposal made by the international Bureau.<sup>98</sup> The sending of this reminder does not change the due date for response set by the sending of the irregularity notification.<sup>99</sup>

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<sup>96</sup> Rule 13(1) Regulations under the Protocol

<sup>97</sup> Rule 12(2) Regulations under the Protocol

<sup>98</sup> Rule 12(3) Regulations under the Protocol

<sup>99</sup> Rule 12(3) Regulations under the Protocol

### **Contact with the applicant regarding irregularity**

At the same time as notifying the Trademarks Office that there is an irregularity affecting the list of goods or services, the International Bureau will send notification of the irregularity to the applicant.<sup>100</sup> If the applicant wishes to comment or make a submission or proposal, they must do so to the Trademarks Office and not directly to the International Bureau. If the applicant sends any communication directly to the International Bureau this will be disregarded.

Where the Trademarks Office considers it to be appropriate or useful, the applicant should be informed how the Trademarks Office intends to respond to the irregularity notification. In particular, the Trademarks Office must contact the applicant and obtain their agreement to any response that will result in any descriptions of goods or services being deleted from the international application as a means of remedying the irregularity.

The applicant may provide their opinion to the Trademarks Office and should they so wish, make a proposal of their own. The Trademarks Office will consider any comments or proposals from the applicant before responding to the International Bureau but will not be obliged to follow any comments or proposals provided by the applicant that the Office considers to be contrary to the laws, regulations, practice or procedures.

### **Responding to an irregularity concerning classification**

An irregularity in the classification of the goods or services in an application will be sent when the International Bureau considers some or all of the goods or services have been allocated to the wrong class of the Nice Classification. The consequence of this will be that the goods or services will be grouped in the wrong class in the international application.

On receiving an irregularity notification concerning the classification of the goods or services, the Trademarks Office has the option of either accepting the proposal by the International Bureau, submitting arguments against the finding of an irregularity, and/or making an alternative proposal to remedy the irregularity.

### **Trademarks Office agrees with International Bureau proposal**

Where the Trademarks Office accepts that there is an irregularity in the classification and agrees with the proposal of the International Bureau to remedy the irregularity, the Trademarks Office should inform the International Bureau. This will avoid the

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<sup>100</sup> Rule 12(1)(a) Regulations under the Protocol

unnecessary work of sending and dealing with a reminder and will allow the international application to proceed at the earliest opportunity.

### **Trademarks Office disagrees with the classification of the International Bureau**

The Trademarks Office may, should it so wish, submit arguments against the finding of an irregularity in the classification and/or grouping by class of the goods or services. Before submitting arguments, the Trademarks Office should give the applicant the opportunity to provide comments. Where the applicant (or their representative) has submitted comments or arguments, these should be included. Should the Trademark Office agree that there is a classification irregularity but not agree with the proposal of the International Bureau, it may make an alternative proposal to remedy the irregularity.

### **Decision of the International Bureau on matters of classification is final**

Where the International Bureau disagrees with the class indicated for any goods or services listed, it will seek to resolve the matter with the Trademarks Office. After considering any submissions or proposals from the Trademarks Office, the International Bureau may withdraw, confirm or modify its classification proposal. The Trademarks Office and the applicant will be informed of the decision of the International Bureau.

If agreement cannot be reached, the decision of the International Bureau will be final.<sup>101</sup>

### **Decision of the International Bureau on the acceptability of descriptions of goods or services**

The decision of the International Bureau will depend upon whether the class to which a description of goods or services found to be 'irregular' has been indicated in the international application.

#### **- Class specified<sup>102</sup>**

If the International Bureau does not receive a proposal from the Trademarks Office agreeing to amend or delete a description of goods or services considered by the International Bureau to be vague, incomprehensible or linguistically flawed within the period allowed, the description will remain in the international registration. This is

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<sup>101</sup> Rule 12(9) Regulations under the Protocol

<sup>102</sup> Rule 13(2(b)) Regulations under the Protocol

provided the class in which the description should be classified is specified in the international application.

Similarly, if the International Bureau receives a proposal from the Trademarks Office, but considers the proposal unacceptable, the description will remain in the international registration if the class in which the description should be classified is specified in the international application.

In both of the above cases, the international registration will contain an indication to the effect that the International Bureau considers the specified description(s) too vague for the purposes of classification, to be incomprehensible or linguistically incorrect.

**- Class not specified<sup>103</sup>**

Where no class has been specified for a description of goods or services that the International Bureau considers vague, incomprehensible or linguistically flawed, the International Bureau will notify an irregularity. The International Bureau will take the decision to delete the description from the international application. As a consequence, the description will not appear in the international registration.

The International Bureau will notify the Trademarks Office and the applicant of the action it has taken.

**- Additional fees payable as a result of the irregularity**

As a result of the classification proposal (either made by the International Bureau or a counter proposal from the Trademarks Office) additional fees may have become due for the international application. Where the Trademarks Office had submitted arguments or a counter proposal, the applicant must pay these additional fees within three months of the date that the International Bureau notified the Trademarks Office and the applicant of its decision.

If the Trademarks Office did not submit any arguments or proposals to the International Bureau, any additional fees must be paid within four months from the date of the notification of the irregularity by the International Bureau.

**Limitations**

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<sup>103</sup> Rule 13(2)(b) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

An international application may contain limitations of the list of goods and services.<sup>104</sup> Any limitation may be in respect of one or more of the members designated in the international application and may be different for each member.<sup>105</sup> A limitation may be requested by the applicant for a number of reasons, such as to reduce the fees to be paid.

Members of the Madrid System can and do have differing requirements for goods and services in an international application designating them. The limitation may be required to prevent a provisional refusal by the office of the designated member.

The applicant may also wish to limit the list of goods or services to avoid conflict with a trademark owned by a third party in a member. In some cases, the limitation will have been negotiated in advance of the international application being submitted and the exact wording of the limited list of goods or services is required to comply with an agreement made with that party.

The Trademarks Office must ensure that any limited list of goods or services entered by the applicant for particular designated members only include goods or services covered by the basic mark(s), either specifically by their description or in broader descriptions.<sup>106</sup> See also **Certification of an international application by the Office of Origin** in these guidelines

### Requirement for Limitations to the goods or services

The same requirements apply to a limited list of goods or services as to the main list of goods or services in an international application, namely:

- Any limited list of goods or services in an international application must describe (name) the goods or services in a way that is clear and precise
- It must be possible to understand the sort of goods or services that each description relates to and be able to classify each good or service in a class of the Nice Classification
- The goods or services must be grouped according to their class in the Nice Classification, with each group preceded by the number of the class and listed in ascending numerical order of the class

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<sup>104</sup> Rule 9(4)(xiii) Regulations under the Protocol

<sup>105</sup> Rule 9(4)(xiii) Regulations under the Protocol

<sup>106</sup> Rule 9(5)(d) Regulations under the Protocol



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

The International Bureau will examine any limitations contained in an international application in the same way as the main list and will issue an irregularity where the limited list contains errors of classification, or descriptions that it considers vague, unintelligible, or linguistically inaccurate.

### **The international application contains irregularities relating to the entitlement of the applicant to file an international application**

An international application must be presented to the International Bureau by an Office of Origin.<sup>107</sup> An applicant may use any office as the Office of Origin provided that they meet the eligibility conditions to use that office. The applicant must indicate their eligibility to use the Trademarks Office of the Kingdom of Bahrain as an Office of Origin in Part 3 of the International application.

#### **3. ENTITLEMENT TO FILE<sup>7</sup>**

**(a) Check the appropriate box:**

- (i) ☐ where the Contracting Party of the Office of origin mentioned in item 1 is a State, the applicant is a national of that State; or
- (ii) ☐ where the Contracting Party of the Office of origin mentioned in item 1 is an organization, the name of the State of which the applicant is a national: ; or
- (iii) ☐ the applicant is domiciled in the territory of the Contracting Party of the Office of origin mentioned in item 1; or
- (iv) ☐ the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party of the Office of origin mentioned in item 1.

**(b) Where the address of the applicant, given in item 2(b), is not in the territory of the Contracting Party of the Office of origin mentioned in item 1, indicate in the space provided below:**

- (i) if the box in paragraph (a)(iii) of the present item has been checked, the domicile of the applicant in the territory of the Contracting Party of the Office of origin, or,
- (ii) if the box in paragraph (a)(iv) of the present item has been checked, the address of the applicant's industrial or commercial establishment in the territory of the Contracting Party of the Office of origin.

The International Bureau will undertake a basic check to make sure that the eligibility of the applicants has been indicated in Part 3 of the international application. The International Bureau will also check to ensure that there is consistency in the basis for the eligibility. For example, has an applicant claiming entitlement to use the

<sup>107</sup> Rule 9(1) Regulations under the Protocol



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Trademarks Office of the Kingdom of Bahrain as the Office of Origin on the basis of domicile provided an address within the Kingdom of Bahrain?

Where either the information is missing, clearly incorrect or there is an inconsistency such as mentioned above, the International Bureau will issue an irregularity notification.

Before submitting the international application to the International Bureau, the Trademarks Office should check that Part 3 of the international application has been completed. For an international application submitted by the Trademarks Office of the Kingdom of Bahrain, there must be an indication in the check box:

- 3(a)(i) where the applicant claims entitlement on the basis of being a national of the Kingdom of Bahrain
- 3(a)(iii) where the applicant claims entitlement by being domiciled in the Kingdom of Bahrain
- 3(a)(iv) where entitlement is claimed on the basis of having an industrial or commercial establishment in the Kingdom of Bahrain (whether this is 'real and effective' is a matter for the Trademarks Office of the Kingdom of Bahrain to decide based on its national law)

There must not be an indication in the check box 3(a)(ii) as the Kingdom of Bahrain is not a member of a regional organization that is a contracting party to the Madrid Protocol.

If there is more than one applicant named in the international application, they must all be entitled to use the Trademarks Office of the Kingdom of Bahrain as the Office of Origin. They need not have the same entitlement. For example, one may qualify by being a national of the Kingdom of Bahrain, another on being legally domiciled in the Kingdom of Bahrain.<sup>108</sup>

The Trademarks Office must ensure that all of the applicants for the international application have indicated the basis on which they are entitled to use the Trademarks Office of the Kingdom of Bahrain as an Office of Origin, and that they are, on the information provided, entitled.

There is no requirement for the Trademarks Office to request an applicant to provide verification of the entitlement claimed, and the International Bureau will not request this either from the Trademarks Office or the applicant. The Trademark Office only

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<sup>108</sup> Rule 8(2) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

need satisfy itself that any applicant named in the international application is entitled to use the Trademarks Office of the Kingdom of Bahrain as an Office of Origin.

The Trademarks Office should consider the consistency of the information entered at Part 3 of the international application. For example:

- the address given for any applicant at Part 2(b) of the international application is not within the Kingdom of Bahrain, but the claim to entitlement is indicated as domicile (box 3(a)(iii)) in the Kingdom of Bahrain. If there is no address within the Kingdom of Bahrain entered in the box at Part 3(b), this should be queried with the applicant.
- the address given for any applicant at Part 2(b) of the international application is not within the Kingdom of Bahrain, but the claim to entitlement is on the basis of commercial or industrial activity (box 3(a)(iv)) in the Kingdom of Bahrain. If there is no address within the Kingdom of Bahrain entered in the box at Part 3(b), this should be queried with the applicant.

See **Applicant - entitlement to use an office as the Office of Origin** for a more detailed explanation of the entitlement of applicants to use the Madrid System, and more specifically, the Trademarks Office of the Kingdom of Bahrain as an Office of Origin.

### **International application not signed by the Trademarks Office as the Office of Origin<sup>109</sup>**

As the Office of Origin, the Trademarks Office of the Kingdom of Bahrain must sign the declaration at Part 13 of the international application before transmitting the application to the International Bureau.<sup>110</sup>

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<sup>109</sup> Rule 11(4)(a)(vi) Regulations under the Protocol

<sup>110</sup> Article 3 3(1) Madrid Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

(b) Name of the Office:

(c) Name and signature of the official signing on behalf of the Office:  
*By signing this form, I declare that I am entitled to sign it under the applicable law.*

(d) E-mail address of the contact person in the Office:

By signing the form, the Trademarks Office is confirming that in respect of the details listed in the declaration, the international application corresponds, at the time of the certification, with the information in the basic mark or marks.

If either the name of the Trademark Office of the Kingdom of Bahrain is not entered at 13(a), the name and signature of the person signing the declaration on behalf of the Trademark Office of the Kingdom of Bahrain at 13(b) or an email address at 13(c) is missing, the International Bureau will send the Trademarks Office an irregularity notification. At the same time as notifying the Trademarks Office, the International Bureau will send a notification of the irregularity to the applicant.<sup>111</sup>

Three months from the date of the notification will be allowed for the Trademarks Office to remedy the irregularity. If the irregularity is not remedied within this time, the international application will be considered abandoned.

**International application does not contain the date and number of the basic application or basic registration<sup>112</sup>**

The international application form must include the number allocated to the basic application(s) or basic registration(s) by the Trademarks Office of the Kingdom of Bahrain, and the date on which of receipt.<sup>113</sup> The responsibility for entering this information into the international application belongs to the Trademarks Office of the Kingdom of Bahrain.<sup>114</sup>

<sup>111</sup> Rule 11(4)(b) Regulations under the Protocol

<sup>112</sup> Rule 11(4)(a)(vii) Regulations under the Protocol

<sup>113</sup> Rule 9(5)(b) Regulations under the Protocol

<sup>114</sup> Article 3(1)(i) Madrid Protocol ‘Furthermore, the said Office shall indicate...’.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Where a basic mark is an application, the form must contain the date and number of the basic mark.<sup>115</sup> In the case of a basic mark that has achieved registration, the form must contain the date of registration and registration number and the date of application and number of the application from which the registration resulted<sup>116</sup> If the number of an application does not change when the application is registered, the number at registration must still be entered even if the same.

### 5. BASIC APPLICATION OR BASIC REGISTRATION

Basic application number:	<input type="text"/>	Date of the basic application (dd/mm/yyyy):	<input type="text"/>
Basic registration number:	<input type="text"/>	Date of the basic registration (dd/mm/yyyy):	<input type="text"/>

Other than by indicating a number and date at Part 5 of the international application there is no place in the form to indicate whether basic mark is a basic 'application' and/or a basic 'registration'. This being the case, an irregularity from the International Bureau concerning the number(s) and date(s) entered at Part 5 of the international application will be the result of a missing number and/or date, or inconsistency in the information entered,

If either a 'Basic application number' or 'Date of the basic application' have not been completed this will result in an irregularity, as there must, at the very least, be a basic application.

The international Bureau will not know whether the basic mark is an application or a registration, so as long as both the 'Basic application number' and 'Date of the basic application' have been entered, this should not result in an irregularity notification. However, if the date entered as the 'Date of the basic application' is later than the date of receipt of the international application, an irregularity will be issued.

If there is a 'Basic registration number' entered there must be a 'Date of the basic registration' (or the other way round). Where there is an entry for a basic registration (number and date) there must also be a 'Basic application number' and 'Date of basic application' indicated.<sup>117</sup>

If there is missing information or an inconsistency, the International Bureau will send the Trademarks Office an irregularity notification. At the same time as notifying the

<sup>115</sup> Article 3(1)(i) Madrid Protocol

<sup>116</sup> Article 3(1)(ii) Madrid Protocol

<sup>117</sup> Article 3(1)(ii) Madrid Protocol

Trademarks Office, the International Bureau will send a notification of the irregularity to the applicant.<sup>118</sup>

A period of three months from the date of the notification will be allowed for the Trademarks Office to remedy the irregularity. If the irregularity is not remedied within this time, the international application will be considered abandoned.<sup>119</sup>

### **International application has been filed directly with the International Bureau**

In the case of an international application being filed directly with the International Bureau, the application will not be accepted as being properly filed. The application will be returned to the applicant or the representative that submitted the application without being considered along with any fees paid.<sup>120</sup>

### **Irregularities in an international application**

If the International Bureau considers that the international application is irregular, it will notify the Trademarks Office as the Office of Origin, and at the same time inform the applicant.

Some irregularities are a straightforward matter for the Trademarks Office to remedy. Others might necessitate consultation with the applicant, for example, if the International Bureau considers that there are irregularities relating to the member States or regional organizations designated, or there are questions regarding entitlement of the applicant to file an international application.

### **Irregularities to Be Remedied by the Applicant<sup>121</sup>**

The applicant must remedy any irregularity that is not listed as being the responsibility of the Office of Origin, for example:

- the information given concerning the applicant or representative does not comply with all the requirements, but is sufficient for the International Bureau to identify the applicant and to contact the representative, including missing email address

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<sup>118</sup> Rule 11(4)(a) Regulations under the Protocol

<sup>119</sup> Rule 11(4)(b) Regulations under the Protocol

<sup>120</sup> Rule 11(7) Regulations under the Protocol

<sup>121</sup> Rule 11(2) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- the details concerning any the priority claim are insufficient, for example, the filing date of the earlier application for which priority is claimed has not been given
- the reproduction of the mark is not sufficiently clear
- there is a color claim but the reproduction of the mark in the international application is not in color
- the mark includes characters other than Latin characters, or numerals other than Arabic numerals, and there is no transliteration
- the fees (paid directly) to the International Bureau are insufficient or the funds in the account opened with the International Bureau does not have sufficient funds

Although considered to be irregularities that are the responsibility of the applicant (or their representative) to resolve, some, (such as the reproduction of the mark being in black and white but the international application containing a claim to color) would be within the knowledge of the Trademarks Office. These should be picked up as part of the check of the international application by the Trademarks Office and raised with the applicant before the international application is transmitted to the International Bureau.

Where the international application is submitted with any of the above-mentioned irregularities, the International Bureau will send an irregularity notification to the applicant or their representative, if any. The Trademarks Office as the Office of Origin will also be notified. The irregularity must be remedied by the applicant within three months from the date of the notification of the irregularity sent by the International Bureau.

If the applicant does not remedy the irregularity by the due date, the international application will be considered to have been abandoned.<sup>122</sup> But see **‘Continued processing’** in these guidelines.

The exception is where the only irregularity notified by the International Bureau relates to a claim to priority. If an irregularity in respect of a priority claim is not remedied within the three-month period allowed, the international application will be registered but without the priority claim being recorded. Also where the United States is designated and the MM18 form is not submitted together with the application, if this irregularity is not remedied within the two-month period from the

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<sup>122</sup> Rule 11(2)(b) Regulations under the Protocol

date of receipt of the application by the Office of origin, the designation of the United States is disregarded and the international application processed (if it contains additional designations).

In both cases, the International Bureau will inform the applicant and the Trademarks Office of the action it has taken.<sup>123</sup>

### **Continued processing**

The time limits given for responding irregularity notifications or for the provision of missing or corrected forms are not able to be extended. If an applicant fails to meet the time limit to remedy an irregularity, they have the option to request 'continued processing'.<sup>124</sup>

A request for continued processing can be made by the applicant in respect of missing or insufficient payment of fees, and a missed time limit for the following:

- irregularities in an international application<sup>125</sup>
- irregularities in the information provided in recording a license<sup>126</sup>
- subsequent designation<sup>127</sup>
- request for recording any of the following:<sup>128</sup>
  - a change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties
  - a change in the ownership of the international registration in respect of all or some of the designated Contracting Parties
  - a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties
  - renunciation in respect of some of the designated Contracting Parties for all the goods and services

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<sup>123</sup> Rule 11(2)(b) Regulations under the Protocol

<sup>124</sup> Rule 5bis Regulations under the Protocol

<sup>125</sup> Under Rule 11(2), Rule 11(3) and Rule 12(7) Regulations under the Protocol.

<sup>126</sup> Under Rule 20bis(2) Regulations under the Protocol

<sup>127</sup> Under Rule 24(5)(b) Regulations under the Protocol

<sup>128</sup> Under Rule 25(1)(a) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- a change in the name or address of the holder
- a change in the name or address of a holder that is a legal entity, a change in the legal nature of the holder and the State or the territory within that State under which the entity has been legally organized
- cancellation in respect of all or some of the designated contracting parties for all of the goods and services
- cancellation in respect of all or some of the designated contracting parties for some of the goods and services
- a change in the name or address of the representative
- The recording of the division of an international registration relating to missing or insufficient fees<sup>129</sup>
- The payment of the second part of the individual fee<sup>130</sup>
- request that an international registration continues its effects in a successor State<sup>131</sup>

A request for continued processing must be filed with the International Bureau using Form MM20 within two months following the missed time limit for response. The request must be accompanied by the missing or corrected information, fees etc. notified in the irregularity for which the time limit has been missed. The fee for continued processing must also be paid.

### Signature of international application by the applicant

The form applying for an international application must be signed by the named applicant for the international trademark.<sup>132</sup> Where there are two or more applicants, the signature of one of the applicants is sufficient provided the person signing the application declares that they have the authority sign the document on behalf of all of the applicants.<sup>133</sup> A signature may be handwritten, printed, typed, or stamped<sup>134</sup>.

### Receipt of the international application by the International Bureau

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<sup>129</sup> Rule 27bis(3)(c) Regulations under the Protocol

<sup>130</sup> Under Rule 34(3)(c)(iii) Regulations under the Protocol

<sup>131</sup> Under Rule 39(1)) Regulations under the Protocol

<sup>132</sup> Rule 9(2)(b) Regulations under the Protocol

<sup>133</sup> Section 7(b) Administrative Instructions

<sup>134</sup> Section 7(a) Administrative Instructions



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

The Trademarks Office must forward the international application to the International Bureau within two months of the date on which the Trademarks Office received the international application. It is not possible to request an extension to this two-month time period.

An international application received by the International Bureau more than two months after the date on which it was received by the Office of Origin will be taken as having been applied for on the date on which it was received by the International Bureau. Consequently, the international registration date will become the date of receipt by the International Bureau.

Where an international application is received outside of the two-month period by the International Bureau, because of 'force majeure'<sup>135</sup>, the International Bureau may excuse the late submission. The Office of Origin must be able to submit evidence, to the satisfaction of the International Bureau that the failure was due to force majeure. If accepted the international application will be considered to have been received within the time limit and will keep the date on which it was filed with the Office of Origin.

### 'Other particulars' in the international application

There are other indications related to a mark at Part 9(a), 9(b) and 9(c) that may be included in an international application. In its role as the Office of Origin the Trademarks Office is not required to certify this indication but ensuring the information has been entered can avoid irregularities or provisional refusals.

A transliteration of the mark must be provided at Part 9(a) where the mark consists of or contains characters other than Latin characters, or numerals other than Arabic or Roman numerals

#### 9. MISCELLANEOUS INDICATIONS

- (a) ☐ **Transliteration of the mark** (this information is compulsory where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals):

The applicant may voluntarily include a translation of the mark into any or all of the three languages of the Madrid System. Whether they do so will depend on whether a translation is required by any of the members being designated.

<sup>135</sup> Rule 5(1) Regulations under the Protocol. Force majeure includes, but is not limited to, war, revolution, civil disorder, strike, natural calamity, irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of the interested party.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

(b) **Translation of the mark** (as it may be required for certain designations; **do not** check the box in item (c) if you provide a translation):

(i) into English:

(ii) into French:

(iii) into Spanish:

Where the mark consists of or contains an invented word or words, the applicant may, should they so wish, indicate that the word(s) have no meaning by checking the box at Part 9(c) to avoid provisional refusals being issued by members that require such clarification

(c) ☐ **The words contained in the mark have no meaning** (and therefore cannot be translated; **do not** check this box if you have provided a translation in item (b)).

### Priority claims

The applicant for an international registration may claim priority from an earlier filing.<sup>136</sup> This earlier filing may be the basic application or basic registration application but may also be from another application made either in a country party to the Paris Convention or in a member of the World Trade Organization (WTO). In respect of the Kingdom of Bahrain, a right of priority may be claimed from an earlier application filed with a State that is member of a multilateral international convention to which the Kingdom of Bahrain is a party.

A claim to priority under the Paris Convention can be made within six months from the date of filing of the application from which priority is claimed. In addition, to be a valid claim to priority, the claim must be made at the time of application and must indicate<sup>137</sup>:

- the name of the national or regional Office with which the earlier filing was made
- the date of filing
- the number of the application

<sup>136</sup> Under Article 4 of the Paris Convention

<sup>137</sup> Rule 9(4)(a)(iv) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- where the earlier filing from which priority is being claimed does not include all of the goods or services listed in the international application, the goods and services covered by the earlier filing. Where several earlier filings with different dates are indicated, the goods and services to which each relates should be indicated.

It is not required that a copy of the earlier filing be provided to the International Bureau with the priority claim.

### **Declaration of intention to use**

Where the United States of America is indicated as a member where protection is requested in an international application, it is a legal requirement that the applicant provide a "Declaration of intention to use" the trademark in the United States of America.<sup>138</sup>

The declaration of intention to use is made by submitting a completed form MM18. This must be filed at the same time as the MM2 international application form. The Form MM18 should be completed and attached when submitting the international application to the Trademarks Office of the Kingdom of Bahrain using the Electronic Industrial Property Service ePortal.

The Trademarks Office of the Kingdom of Bahrain will only accept the Form MM18 where it is provided to the Trademarks Office at the same time as the Form MM2. If the form MM18 is not filed with the international application, the applicant will need to send the Form MM18 directly to the International Bureau.

### **Declaration of intention to use required but not submitted with the international application**

Should an international application be received by the International Bureau within the two months from its receipt by the Office of Origin, but without a required declaration of intention to use the mark, the International Bureau will notify the applicant and the Office of origin. Similarly, if the declaration does not comply with the requirements, the International Bureau will notify the applicant and the Office of origin.<sup>139</sup>

To maintain the designation of the member that required the declaration of intention to use the mark, the applicant must provide the International Bureau with the

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<sup>138</sup> Declaration by the United States of America under Rule 7(2) Regulations under the Protocol

<sup>139</sup> Rule 9(6)(a) Regulations under the Protocol

completed form MM18 within two months of the date that the international application was submitted to the Trademarks Office of the Kingdom of Bahrain.

### **Declaration of intention to use provided after the international application**

Provided the missing or corrected declaration is received by the International Bureau within the period of two months from the date of receipt of the international application indicated by the Trademarks Office, the declaration will be accepted as having been filed with the international application.<sup>140</sup>

If the missing or corrected declaration is not received by the International Bureau within two months from the date of receipt of the international application indicated by the Trademarks Office, the international application will be deemed not to contain the designation of the United States for which the declaration is required.<sup>141</sup> In such cases, the United States may be subsequently designated.<sup>142</sup>

### **Registration on the International Register**

After completing its examination of the international application and ensuring that all requirements and obligations under the legal texts have been met, the international application will be registered by the International Bureau and assigned an international registration number.

The registration will be published in the International Gazette. A certificate of registration will be sent to the trademark owner(s) who are now referred to as the holder(s).

Although registered on the International Register, the mark is not protected in any of the designated contracting parties. The office authorized to grant protection to a trademark in each of the member state or member organization designated in the international registration will be notified of the designation.

Each of the designated members will examine the mark according to the laws of their domestic system and will notify the International Bureau whether the mark may be protected in their territory.

### **WHERE THE KINGDOM OF BAHRAIN IS DESIGNATED**

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<sup>140</sup> Rule9(6)(b) Regulations under the Protocol

<sup>141</sup> Rule9(6)(c) Regulations under the Protocol

<sup>142</sup> Rule 24 Regulations under the Protocol

## Examination of an international registration designating the Kingdom of Bahrain

When indicated as a member where protection of the international registration is required, the Trademarks Office of the Kingdom of Bahrain may grant protection to the international registration in its territory or may issue a 'provisional refusal' of protection.

The Trademarks Office may issue either a total or partial refusal. In the case of a total refusal, a response will be required from the holder of the international registration in order for there to be any possibility of a grant of protection. For a partial refusal, the Trademarks Office may receive but does not need a response from the holder of the international registration in order to proceed with the reduced grant of protection. See **Total of Partial refusal** in these guidelines

### Basis of the 'ex officio' examination by the Trademark Office

In determining whether or not to grant protection of the designation in the international registration, the Trademarks Office of the Kingdom of Bahrain must apply the same tests, requirements and procedures that are applied for applications filed directly with the Trademark Office of the Kingdom of Bahrain. This is an 'ex officio' examination and for the Kingdom of Bahrain may result in a refusal based on 'absolute' grounds or 'relative' grounds. See **Grounds for refusal** in these guidelines.

Where the Trademarks Office of the Kingdom of Bahrain determines that the international registration cannot be granted protection, it must issue a provisional refusal through the International Bureau and allow the holder of the international registration to contest the refusal by requesting the review or appeal of the refusal set by the GCC Trademark Law and Regulations.

A provisional refusal may only relate to a single International registration.<sup>143</sup> It is not permitted to include more than one international registration in the same notification even where international registration holder is the same.

### International registration accepted 'ex officio' by Trademarks Office

Where the 'ex officio' examination by the Trademarks Office of the Kingdom of Bahrain determines that the international registration satisfies the requirements for protection without any conditions, amendments or requirements, the acceptance will

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<sup>143</sup> Rule 18(1)(b) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

be published in the Bulletin.<sup>144</sup> Unlike an application filed directly with the Trademark Office of the Kingdom of Bahrain, the holder of the international registration will not be required to pay the 'publication fee' as is the case of a direct application made to the Trademark Office of the Kingdom of Bahrain.

### No third-party objection (opposition) to the international registration

Publication in the Bulletin will open a period for third-party objection. Any interested person may, within 60-days from the date of publication in the Bulletin, submit to the Competent Authority a written objection to the granting of protection to the international registration.<sup>145</sup> The 'Competent Authority' is the Trademarks Office of the Kingdom of Bahrain.

### Statement of grant of protection

After having completed the 'ex officio' examination of an international registration designating the Kingdom of Bahrain and found it to satisfy the requirements to be protected, the Trademarks Office must publish its acceptance of the international registration. If no opposition to the international registration being protected in the Kingdom of Bahrain is received in the prescribed 60-day period, the Trademarks Office must send a statement informing the International Bureau.<sup>146</sup>

This statement, referred to as the 'statement of grant of protection' informs the International Bureau that the international registration has been granted protection in the Kingdom of Bahrain. The statements sent will depend on whether a provisional refusal has been sent prior to the grant of protection. See **Notifying a Statement of grant of protection** in these guidelines.

The statement must be sent by the Trademarks Office as soon as possible after the end of the 60-day period allowed for opposition following publication in the Bulletin and before the expiry of the period in which to notify a refusal of protection. In the case of the Kingdom of Bahrain, the refusal period is 18 months from the notification of the designation by the International Bureau to the Kingdom of Bahrain.

A statement of grant of protection is the equivalent of a certificate of registration. On receiving the statement, the International Bureau will record the grant of protection by the Trademarks Office of the Kingdom of Bahrain in the International Register.<sup>147</sup>

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<sup>144</sup> Article 14(1) GCC Trademark Law and Article 10 Regulations under the Protocol

<sup>145</sup> Under Article 14(2) GCC Trademark Law and Article 12 Regulations under the Protocol

<sup>146</sup> Rule 18ter(1) Regulations under the Protocol

<sup>147</sup> Rule 18ter(5) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

The International Bureau will inform the holder of the international registration that protection has been granted in respect of the Kingdom of Bahrain. Where the statement was communicated or can be reproduced in the form of a specific document, the International Bureau will transmit a copy to the holder.<sup>148</sup>

### Notifying Statement of grant of protection

#### No provisional refusal prior to grant of protection

The International Bureau recommends that the Office uses Model Form 4 to notify the International Bureau of a statement of grant of protection. This form is to be used where a provisional refusal has not previously been sent to the International Bureau. The Trademarks Office of the Kingdom of Bahrain does not use the model forms.

The statement of grant of protection must:

- give the name of the Trademarks Office of the Kingdom of Bahrain
- the International registration number to which the statement of grant of protection relates
- name of the holder of the international registration

By sending the statement, the Trademarks Office of the Kingdom of Bahrain is confirming that it has completed all of its required procedures and found there to be no grounds to refuse protection. As there has been no provisional refusal that could have altered the list of goods and services, it is taken that the grant of protection is in respect of all the goods for which the Kingdom of Bahrain was indicated. The Trademarks Office should not list the goods and services.

#### Provisional refusal notified prior to grant of protection

Where a notice of provisional refusal has been sent but the basis for the refusal have been overcome, entirely or in part, the Trademarks Office must send a statement regarding the final decision on the protection of the international registration. The International Bureau recommends that the Trademarks Office use Model Form MF5 for a statement of grant of protection where the office has previously notified the International Bureau of a total or partial provisional refusal.

Other than where the provisional refusal was 'total', covering all of the goods or services, the Trademarks Office may send a statement of grant of protection

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<sup>148</sup> Rule 18ter(5) Regulations under the Protocol

withdrawing the provisional refusal. The resulting grant of protection of the international registration in the Kingdom of Bahrain may be in respect of:

- all goods and services for which protection has been requested in the Kingdom of Bahrain<sup>149</sup> or
- some of the goods or services for which protection of the mark is granted in the Kingdom of Bahrain<sup>150</sup>

Where the statement of the Trademarks Office confirms that protection in the Kingdom of Bahrain is granted for some of the goods or services, the statement must clearly indicate the goods or services for which protection is granted.

Where all of the goods or services in a particular class are granted protection, the statement should state “All goods (or all services) in class (number of the class)”.

#### **Statement of grant of protection not sent – ‘*tacit acceptance*’**

Should the Trademarks Office not send a statement of grant of protection (and no notification of a provisional refusal has been sent either) within the 18-month period, the international registration will be automatically protected in the Kingdom of Bahrain for all the goods or services of the international registration. Where the holder of the international registration indicated a more limited list of goods or services in the designation of the Kingdom of Bahrain, the automatic protection granted will be for the limited list. This is called *tacit acceptance*.

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<sup>149</sup> Rule 18<sup>ter</sup>(2)(i) Regulations under the Protocol

<sup>150</sup> Rule 18<sup>ter</sup>(2)(ii) Regulations under the Protocol



### **Provisional refusal - protection cannot be granted for the Kingdom of Bahrain**

Should the Trademarks Office determine that protection cannot be granted, it must send a notification of provisional refusal.

The refusal of a trademark application filed directly with the Trademarks Office of the Kingdom of Bahrain will be sent to the applicants (or their representative). A refusal of protection for an international registration designating the Kingdom of Bahrain is not sent to the holder of the international registration, but to the International Bureau. The International Bureau is responsible for sending the notification to the holder of the international registration.

The notification sent to the International Bureau will state whether the provisional refusal is 'partial' or 'total' and include the grounds on which the international registration has been found ineligible for protection in the Kingdom of Bahrain. For example, the mark of the international registration has been found to be a generic indication and lacks any distinctive character under Article 3(1) of the GCC Trademark Law, or there is conflict with an earlier trademark under Article 3(11) GCC Trademark Law.

A notification of provisional refusal may also consist of a declaration stating that the Trademarks Office of the Kingdom of Bahrain cannot grant protection to the international registration because of opposition by a third-party.

A provisional refusal may be based on ex officio grounds or on an objection (opposition). There are two different options to be indicated in the Model Form (3A or 3B) depending on whether the provisional refusal is total or partial.

- Model Form 3A is used where there is a Total provisional Refusal of Protection<sup>151</sup>
- Model Form 3B is used where there is a Partial provisional Refusal of Protection

For Notes on filing the MF3A – see here:

[https://www.wipo.int/madrid/en/contracting\\_parties/model\\_forms.html](https://www.wipo.int/madrid/en/contracting_parties/model_forms.html)

### **Total or Partial Refusal**

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<sup>151</sup> Rule 17(1) Regulations under the Protocol

The Trademarks Office may notify either a total refusal of protection for the international registration, or a partial refusal. Whether the refusal is total or partial depends on whether the holder is required to respond to the provisional refusal.

Where a total refusal is issued by the Trademarks Office, no further action can be taken by the Trademarks Office until the holder of the international registration submits a response to the refusal. If the holder of the international registration does not submit a response, the request for protection within the Kingdom of Bahrain will be considered abandoned. A total refusal may be issued even though only part of the list of goods or services is objectionable.

A partial refusal is issued where the Trademarks Office determines that there are grounds for refusal but does not require a response from the holder of the international registration to proceed. In the absence of a response to the partial refusal by the holder of the international registration, the Trademarks Office can still grant protection to the part of the international registration, for example, in respect of some of the goods or services.

### **Contents of the provisional refusal**

The notification of a provisional refusal sent by the Trademarks Office must include the following details:

- that the notification of provisional refusal is being made by the Trademarks Office of the Kingdom of Bahrain<sup>152</sup>
- the number of the international registration<sup>153</sup>

The International Bureau would prefer other indications such as any verbal elements of the mark or the basic application or basic registration number to be included. Such information assists in the identification of the correct international registration and reduces the risk of error, although this is at the option of the Trademarks Office.

In addition, a provisional refusal sent by the Trademark Office of the Kingdom of Bahrain must include:

the grounds on which the provisional refusal is based, with reference to the corresponding GCC Trademark Law and Regulations<sup>154</sup>

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<sup>152</sup> Rule 17(2)(i) Regulations under the Protocol

<sup>153</sup> Rule 17(2)(ii) Regulations under the Protocol

<sup>154</sup> Rule 17(2)(iv) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- where the provisional refusal is based on 'relative' grounds (conflict with an earlier application or registration) the following details of the earlier mark|:
  - its filing date and number
  - priority date (if any)
  - registration date and number (if available)
  - name and address of the owner
  - representation of the earlier mark (or where to access the representation)
  - the list of the relevant goods and services in the earlier application or registration<sup>155</sup> ('Relevant' is to be taken as meaning all of the goods or services in the earlier application or registration)
  - whether the provisional refusal affects all or some of the goods or services of the international registration<sup>156</sup>

The Trademarks Office of the Kingdom of Bahrain must state whether it considers all, or only certain goods or services listed in the request for protection to be subject to the provisional refusal.

Where the provisional refusal affects only some of the goods or services of the international registration, the provisional refusal should indicate either:

- the goods and services which are subject to the provisional refusal, or,
- any goods or services that are not subject to the provisional refusal
- a 'reasonable' time limit [two months]<sup>157</sup> for the holder of the international registration to file a request for review of, or appeal against the provisional refusal,<sup>158</sup> (stating the start and the date on which the time limit expires)

This includes both provisional refusals 'ex officio' or based on an opposition. The provisional refusal should indicate that any request for review, appeal or response should be filed with the Trademark Office of the Kingdom of Bahrain, and the

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<sup>155</sup> Rule 17(2)(v) Regulations under the Protocol

<sup>156</sup> Rule 17(2)(vi) Regulations under the Protocol

<sup>157</sup> Recommended by the Madrid Union Assembly

<sup>158</sup> Rule 17(2)(vii) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

requirements for filing, for example, via the Electronic Industrial Property Services ePortal.

- In the case of a provisional refusal based on a decision of the Trademarks Office (ex-officio), the holder of an international registration has a period of 60-days from the date of notification of the provisional refusal in which to file an appeal to the Grievance Committee.
- Where the provisional refusal results from an objection (opposition) filed by an 'interested person', the holder of the international registration will have 60-days in which to file a written response to the objection (opposition).

In the event that the international registration holder does not submit an appeal to the Grievance Committee (ex-officio refusal) or a written response to an objection (opposition) by a third-party, the provisional refusal will be confirmed. Depending on whether the provisional refusal is partial or total, this will result in the international application being refused protection in whole or in part.

Where the holder of the international registration would not be eligible to make an application for registration of a trademark in the Kingdom of Bahrain, the provisional refusal should state that any request for review, the appeal or the response must be filed through a representative authorized by the Trademarks Office of the Kingdom of Bahrain.

- A provisional refusal of protection based on an opposition (whether solely or with other 'ex-officio' grounds) must, in addition to the above, contain<sup>159</sup>:
  - an indication that the provisional refusal is based on an opposition
  - the name and address of the opponent
  - where the opposition is based on an earlier filed application or registration, a list of the goods and services on which the opposition is based.

The provisional refusal may include the complete list of goods and services covered by the earlier application or registration provided that, where the opposition is not based on all of the goods or services, must still provide a list on which the opposition is based.

### **Provisional refusal must contain all grounds**

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<sup>159</sup> Rule 17(3) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Should the Trademarks Office determine that a provisional refusal of protection must be raised against an international registration designating the Kingdom of Bahrain, whether 'ex officio' or as a result of an opposition, it must include all of the grounds for refusal in the provisional refusal.

It is possible to add new grounds or send a further provisional refusal during the 18-month period allowed, but it is not permitted to do so after the expiry of this time limit.

The only exception on adding new grounds is where the provisional refusal is based on opposition and the member concerned has made a declaration allowing for possible notification of refusals based on an opposition after the 18-month time limit.<sup>160</sup> The Kingdom of Bahrain has not made such a declaration.

### **Total provisional refusal confirmed**

A 'Total final refusal' of a designation may occur in two circumstances:

- there has been no response from the holder of the international registration to the provisional total refusal, or,
- there has been an exchange of correspondence and possibly a grievance hearing, but the total refusal has been maintained by the Trademarks Office

Where the Trademarks Office has notified the International Bureau of a total provisional refusal, the Office must notify the International Bureau of its final decision as soon as all procedures before the Office have been completed. In this respect, 'completed' means that the holder of the international registration has no further avenues of appeal against the refusal under the procedures under the full control of the Trademarks Office. This still leaves open the possibility of the international registration holder submitting an appeal to a body outside of the Trademarks Office, such as the Grievance Committee or the Civil Court.

The Trademarks Office will send the International Bureau a statement confirming the total refusal of the protection of the mark in the Kingdom of Bahrain for all goods or services. In confirming the total refusal, the International Bureau recommends the use Model Form 6.

Where the Trademark Office confirms the total provisional refusal, the holder may re-designate the Kingdom of Bahrain<sup>161</sup> where the grounds preventing such protection no longer exist.

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<sup>160</sup> Under Article 5(2)(c) Madrid Protocol

<sup>161</sup> Article 3ter(2) Madrid Protocol

### **Objection to grant of protection by third party**

Where an opposition to the granting of protection to the international trademark is received by the Trademarks Office of the Kingdom of Bahrain, a notification of provisional refusal will be sent to the International Bureau. The notification will give details of the international registration, and inform the International Bureau that protection is provisionally refused because of the filing of an opposition by a third party. See **Contents of a provisional refusal**.

The steps that follow will be the same as if the international registration had been filed directly with the Trademarks Office of the Kingdom of Bahrain. See the **Opposition Guidelines**

### **Grounds for Refusal**

As a member of the Madrid Protocol, the Trademark Office of the Kingdom of Bahrain has the right to refuse to protect an international mark designating its territory.<sup>162</sup> A refusal to protect an international registration may only be based on the grounds which would apply in the case of an application for registration filed directly with the Trademarks Office of the Kingdom of Bahrain.<sup>163</sup> There are exceptions to this:

- **Non-compliance with national ‘formalities’**

The international registration may not be refused protection because it is considered not to comply with the filing requirements, generally referred to as the ‘formalities’ because the formal requirements have already been checked by the International Bureau.

- **Multi-class designations**

The Madrid System allows for the registration of multiple classes of goods and services through a single application. This is not the case in the Kingdom of Bahrain which operates a one application – one class trademark registration regime. The Trademark Office of the Kingdom of Bahrain cannot refuse protection, even in part to an international registration solely because the GCC Trademark Law and its Regulations only permit an application for registration in respect of a single class of goods or services.<sup>164</sup>

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<sup>162</sup> Article 5(1) Madrid Protocol

<sup>163</sup> Article 6(1) Paris Convention ‘(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.’

<sup>164</sup> Article 5(1) Madrid Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Where a designation includes more than one class of goods or services, the designation will be recorded in the Trademarks Register with each class allocated a separate number as if it had been submitted as a single application, as follows:

TM في انتظار استكمال مستندات	[US] إنسومنيا كوكيز، إل إل سي Insomnia Cookies, LLC	NCL(11-0) 30	إنسومنيا كوكيز INSOMNIA COOKIES	11/07/2023	INSOMNIA COOKIES	BH/T/0001/139672	<input type="checkbox"/>
TM في انتظار استكمال مستندات	[US] إنسومنيا كوكيز، إل إل سي Insomnia Cookies, LLC	NCL(11-0) 35	إنسومنيا كوكيز INSOMNIA COOKIES	11/07/2023	INSOMNIA COOKIES	BH/T/0001/139673	<input type="checkbox"/>
TM في انتظار استكمال مستندات	[US] إنسومنيا كوكيز، إل إل سي Insomnia Cookies, LLC	NCL(11-0) 39	إنسومنيا كوكيز INSOMNIA COOKIES	11/07/2023	INSOMNIA COOKIES	BH/T/0001/139674	<input type="checkbox"/>
TM في انتظار استكمال مستندات	[US] إنسومنيا كوكيز، إل إل سي Insomnia Cookies, LLC	NCL(11-0) 43	إنسومنيا كوكيز INSOMNIA COOKIES	11/07/2023	INSOMNIA COOKIES	BH/T/0001/139675	<input type="checkbox"/>

### - Wide list of goods of services

Similarly, the Trademark Office of the Kingdom of Bahrain cannot refuse protection, even in part to an international registration solely because the list of goods or services is considered to cover too many goods or services.<sup>165</sup> (This is different consideration to where descriptions of goods and services are considered by the Trademarks Office to be too broad or vague)

### - Classification of goods or services

Prior to the international application being registered, the International Bureau will have considered the list of goods or services and found the classification to be correct. The International Bureau have the final word on the lists of goods or services on matters of classification, meaning that there is no scope to refuse a designation on the basis of the classification not complying with the practice in the Kingdom of Bahrain.<sup>166</sup>

The Trademarks Office may object to terms in the list of goods or services that it considers too broad or too vague. See the section on **Provisional refusals – term too broad or is vague**

### Time limit for issuing a refusal of protection

Where a refusal is to be issued, this must be received by the International Bureau within a given time limit. The standard time limit for issuing a refusal is one year from the date that a member is notified that protection is requested in their territory.<sup>167</sup> Should it so wish, a member may declare that the period for issuing a refusal of protection in respect of its territory will be 18 months from the date of the notification

<sup>165</sup> Article 5(1) Madrid Protocol

<sup>166</sup> Rule 12(9) Regulations under the Protocol

<sup>167</sup> Article 5(2)(a) Madrid Protocol

that protection is requested.<sup>168</sup> **The Kingdom of Bahrain has made the relevant declaration, extending the time limit to 18- months.**<sup>169</sup>

A refusal letter may be reissued, for example, to correct an irregularity, provided that the case is still within the 18- month time limit.

### **Provisional refusal – description of goods or services too broad or vague**

An Office may find a description in the list of goods or services to be too broad or too vague. This is different to the situation where the Trademarks Office considers an international registration, either in a particular class, or as a whole, to include too many goods or services. It refers to a situation where a particular description is very wide, for example the entry of the description 'Machines' in Class 7 or 'Brokerage' in Class 39.

Should the Trademarks Office of the Kingdom of Bahrain consider a particular description of goods or services to be too wide in its scope or unclear in its meaning, this should be notified to the International Bureau as a provisional refusal.

The Trademarks Office may (but is not obliged) to propose an alternative description of goods or services to replace any descriptions found to be too broad or too vague. This will not be possible where the term is so wide or unclear that it would be difficult to propose a narrower or more precise term without more information on the intentions of the trademark owner in respect of the use of the mark.

Where the provisional refusal includes a proposal by the Trademarks Office, the International Bureau will notify the holder both of the provisional refusal and the proposal of the Trademarks Office that would remove the objection. If the proposal is acceptable to the holder of the international registration, they must inform the Trademarks Office and not the International Bureau.

The Trademarks Office of the Kingdom of Bahrain will inform the International Bureau of any amendment agreed with the international registration holder in its final decision. The amendment of the international registration will be indicated in the Trademarks Register of the Kingdom of Bahrain.

### **Irregularities in a provisional refusal**

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<sup>168</sup> Article 5(2)(b) Madrid Protocol

<sup>169</sup> Madrid (Marks) Notification No. 178 and Madrid (Marks) Notification No. 179



## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Upon receipt of a provisional refusal, the International Bureau will examine it for formalities only, prior to recording the provisional refusal in the International Register, notifying the holder and publishing this on Madrid Monitor. Where the International Bureau finds any irregularities, it will notify the Office concerned.

A provisional refusal notified to the International Bureau will be disregarded if:

- the refusal is notified to the International Bureau after the due date<sup>170</sup> (18 months from notification of the request for protection in the Kingdom of Bahrain)
- the notification of provisional refusal is missing the international registration number <sup>171</sup>(unless other indications in the notification enable the international registration to which the provisional refusal relates to be identified)
- the notification of provisional refusal is missing the grounds that cause the refusal<sup>172</sup>

Even though there is an irregularity in the notification of the provisional refusal, the International Bureau will transmit a copy of the notification to the holder of the international registration and the Trademarks Office. The notification will inform both the international registration holder and the Trademarks Office that the International Bureau does not regard the notification as a provisional refusal, and the reasons why.<sup>173</sup>

If still within the time limit for notification of a provisional refusal, the Trademarks Office must send a new provisional refusal.

If the time limit has expired, the Trademarks Office will lose the right to refuse the international registration protection in the Kingdom of Bahrain. The International Bureau will proceed as if there has been no refusal and the international registration will be deemed as protected in the Kingdom of Bahrain under the principle of tacit acceptance.<sup>174</sup>

Additionally, a provisional notification of refusal issued by the Trademarks Office will be considered irregular' by the International Bureau, but will not be disregarded where:

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<sup>170</sup> Rule 18(1)(a)(i) Regulations under the Protocol

<sup>171</sup> Rule 18(1)(a)(ii) Regulations under the Protocol

<sup>172</sup> Rule 18(1)(a)(iii) Regulations under the Protocol

<sup>173</sup> Rule 18(1)(b) Regulations under the Protocol

<sup>174</sup> Article 4 Madrid Protocol and Rule 18(1)(a) and Rule (2) Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- the notification is not signed on behalf of the Trademarks Office of the Kingdom of Bahrain<sup>175</sup>
- the provisional refusal does not comply with the requirements of the Administrative Instructions<sup>176</sup>
- the provisional refusal is not in English<sup>177</sup> (the language chosen to be used by the Trademarks Office of the Kingdom of Bahrain)
- the provisional refusal does not include the required details of the mark with which the international registration appears to be in conflict<sup>178</sup>

The International Bureau will record the provisional refusal in the International Register and invite the Trademarks Office of the Kingdom of Bahrain to send a rectified notification within two months<sup>179</sup>. The International Bureau will send the holder of the international registration a copy of the irregular notification and the invitation sent to the Trademarks Office. But see the exception in the following paragraph.

The exception will be where the provisional refusal does not provide a 'reasonable time limit' for the holder of the international registration to respond, file a request for review, or to appeal against the provisional refusal.<sup>180</sup> In this case the refusal is not recorded in the International Register. The International Bureau will invite the Trademarks Office to submit a rectified notification within 2-months.<sup>181</sup> The rectified notification must indicate a new 'reasonable time limit' for the holder of the international registration to respond, file a request for review, or to appeal against the provisional refusal.

The provisional refusal will be regarded as having notified to the International Bureau on the date on that the defective notification had been sent to it. The International Bureau will send a copy of any rectified notification to the holder of the international registration.

If an irregular notification of provisional refusal is not rectified or is not rectified within the 18-month period allowed, the International Bureau will disregard the provisional refusal. The holder of the international registration and the Trademarks Office will be

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<sup>175</sup> Rule 18(1)(c)(i) Regulations under the Protocol as required by Rule 2 Regulations under the Protocol

<sup>176</sup> Rule 18(c)(i) Regulations under the Protocol as required by Rule 2 Regulations under the Protocol

<sup>177</sup> Rule 18(c)(i) Regulations under the Protocol as required by Rule 6(2) Regulations under the Protocol

<sup>178</sup> Rule 18(c)(ii) Regulations under the Protocol as required by Rule 17(2)(v) Regulations under the Protocol

<sup>179</sup> Rule 18(1)(c) Regulations under the Protocol

<sup>180</sup> As required by Rule 17(2)(vii) Regulations under the Protocol

<sup>181</sup> Rule 18(1)(d) referring to Rule 18(1)(c) Regulations under the Protocol

informed that the notification of provisional refusal is to be disregarded and give the reason why. The international registration will, by default, be deemed to be protected in the Kingdom of Bahrain.<sup>182</sup>

### **Appeal against a refusal of protection, or conditions, amendments or restrictions**

A holder of an international registration that receives a provisional refusal of protection in the Kingdom of Bahrain must be given the same rights and remedies to appeal against the refusal as an applicant that has filed directly with the Trademarks Office of the Kingdom of Bahrain.<sup>183</sup> The International Bureau has no role or authority to intervene.

In the Kingdom of Bahrain, an appeal against a refusal to register, or to make registration subject to an amendment condition or limitation is appealed, in the first instance, to a Grievance Committee. Accordingly, any holder of an international registration that wishes to appeal against a provisional refusal of protection in the Kingdom of Bahrain must do so by application to the Grievance Committee.<sup>184</sup>

Any appeal against a provisional refusal must be filed within 60 days of the provisional refusal being notified to the International Bureau.<sup>185</sup> There is no provision to extend this period.

See the **Grievance Guidelines** for information and guidance on filing an appeal for the Grievance Committee.

Should the holder of the international registration fail to appeal the provisional refusal within the 60-day period, the Kingdom of Bahrain will send the International Bureau a statement.<sup>186</sup> This will either confirm a total refusal, or that the international registration is to proceed to publication where the refusal was partial.

Depending on whether the Trademark Office of the Kingdom of Bahrain had notified a 'total' or 'partial' refusal, the statement will notify the International Bureau of a confirmation of total refusal of protection, or a grant of protection for the part of the international registration that was not subject to the refusal (after publication of opposition where no opposition was lodged).

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<sup>182</sup> Under the principle of tacit acceptance. Article 4 Protocol relating to the Madrid Agreement and Rule 18(1)(a) and Rule 18(2) Regulations under the Protocol

<sup>183</sup> Article 5(3) Madrid Protocol – '(3) ... The said holder shall have the same remedies as if the mark had been deposited by him direct with the Office which has notified its refusal.'

<sup>184</sup> Article 13.1 of the GCC Trademark Law and Article 7 of the Regulations under the Protocol.

<sup>185</sup> Article 13.1 of the GCC Trademark Law.

<sup>186</sup> Rule 18ter(3) Regulations under the Protocol

### **Invalidation of an international registration**

The protection of an international registration may be invalidated in whole or in part. An international registration may not be declared invalid without the holder of the international registration being given sufficient opportunity to defend the rights afforded by the international registration.

Under the provisions of the GCC Trademark Law, invalidation of may be by means of a decision by the competent court who may order the cancellation of a trademark which has been 'unlawfully registered'.<sup>187</sup> Should the competent court in the Kingdom of Bahrain declare an international registration invalid (in whole or in part) and the holder of the international registration has no further options for appeal, the Trademark Office must notify the International Bureau using Model Form 10 of the following<sup>188</sup>:

- the authority (name of the competent court) which pronounced the invalidation
- that the decision is final and no longer subject to appeal
- the number of the international registration
- the name of the holder of the international registration
- the goods or services for which the international registration has been declared invalid, either by indicating the goods or services which are no longer covered in the international registration or those which are still covered
- the date of the decision declaring the international registration to be invalid and the effective date of the decision

The International Bureau will record the invalidation in the International Register and notify the holder. If requested by the Trademarks Office, the International Bureau will send it a notification when the invalidation has been recorded in the international register. The International Bureau will publish the invalidation in the Gazette.<sup>189</sup>

### **Communications sent through the International Bureau**

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<sup>187</sup> Article 22 GCC Trademark Law and Article 23 Regulations under the Protocol

<sup>188</sup> Rule 19(2) Regulations under the Protocol

<sup>189</sup> Rule 32(1)(a)(x) Regulations under the Protocol

The holder may receive a communication from an Office of a designated member (through the International Bureau) that falls outside of its obligations in the Regulations. This concerns situations where the law of a member does not allow the Office to transmit the communication directly to a holder who has no address for service or local representative in the Kingdom of Bahrain. The Trademarks Office of the Kingdom of Bahrain will send communications to holders located outside of the Kingdom via the WIPO portal.

### **Subsequent designation of the Kingdom of Bahrain**

The holder of an international registration may at some later date decide that the protection obtained in an international registration needs to be extended. This may happen, for example, when there is a new member, or the business interests of the holder of the international registration widen to include other Madrid members, or the goods or services indicated in the international registration have changed.

At the time of making the subsequent designation, the holder of the international registration must fulfil the same entitlement that have to be met in order to become the holder of an international registration.<sup>190</sup>

A subsequent designation may be for all of the goods or services listed in the international register, or for some of the goods and services recorded for the international registration. Where the Kingdom of Bahrain is subsequently designated, the procedures will be the same as if it had been designated in the original international application.

### **Ceasing of effect and cancellation**

#### **Ceasing of Effect during dependency period**

An international application is connected to the basic mark(s) for a period of five years from the date of the international registration<sup>191</sup>. This link between the international application and the basic mark(s) is referred to as 'dependency'. After this period of five-years has passed, the international registration will become independent of the basic mark(s).

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<sup>190</sup> Rule 24(1) Regulations under the Protocol

<sup>191</sup> Article 6(3) Madrid Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

The exception is where an action concerning the basic mark(s) is started during the five-year period of dependency, but a final decision has not been made by the end of the five-year dependency period.<sup>192</sup>

For example, an appeal against an ex officio refusal of the basic application, an opposition by a third party to the registration of the basic application, or proceeding for the revocation, cancellation or invalidation of a basic registration. The final decision concerning the basic application, or basic registration will have the same effect as though the outcome had been notified during the five-year dependency period.

Where the Trademarks Office of the Kingdom of Bahrain has acted as the Office of Origin for an international trademark application, it has a responsibility to monitor the basic marks. If a basic mark is cancelled, refused, successfully opposed, withdrawn, or for any other reason the rights cease (in whole or in part) during the dependency period, the Trademarks Office must inform the International Bureau of a 'ceasing of effect'.<sup>193</sup>

The notification of a 'ceasing of effect' should not be sent by the Trademarks Office until there is a decision, and the period allowed for making an appeal has either passed and there is no further route of appeal open. The rationale behind this is to avoid the possibility of the ceasing of effect being reversed.

The Trademarks Office may become aware of an action (such as in the courts) that has the potential to result in a ceasing of effect of the basic mark, and which will not reach a final decision before the end of the five-year dependency period. In such cases, the Trademarks Office should notify the International Bureau at the earliest opportunity, that an action that could result in a ceasing of effect in respect of the basic mark has not yet reached a final decision.

There is no official form to notify a 'ceasing of effect'. The International Bureau prefers the ceasing of effect to be notified using either Model Form 9A, 9B or 9C as appropriate. However, the Trademarks Office of the Kingdom of Bahrain does not use the model forms.

The notification from the Trademarks Office must indicate:

- the number of the international registration
- the name of the holder

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<sup>192</sup> Article 6(3) Madrid Protocol and Rule 22(1)(b) Regulations under the Protocol

<sup>193</sup> Article 6(4) Madrid Protocol and Rule 22(1)(a) Regulations under the Protocol

- the facts and decisions affecting the basic mark:
  - where the international registration is based on a basic application which has not resulted in a registration, the facts and decisions affecting the basic application
  - where the international registration is based on a basic application which has resulted in a registration, the facts and decisions affecting that registration, and the effective date of those facts and decisions
- where the facts and decisions affect the international registration in respect of some of the goods or services, the goods and services which are affected, or the goods or services that are not affected

In the case of proceedings concerning the basic mark commenced during the five-year dependency period, but not concluded by the end of the period, the Trademarks Office must notify the International Bureau of the outcome as soon as possible.

### **Request to transfer international registration to national registration of Trademark and Service Marks**

An international registration may be cancelled at the request of an Office of Origin<sup>194</sup> in respect of some or all of the goods or services listed in the international registration. This will result from a ceasing of effect involving a basic mark.

Under a process referred to as ‘transformation’ the holder of the international registration has the option of filing an application for the registration of the same mark with the member States or regional organizations listed in the international registration. In effect, the holder of the international registration has the possibility of transforming the cancelled international registration by filing separate ‘national’ or ‘regional’ applications with the members where continued protection for the mark is required. Transformation is not an option where the holder of the international registration made the decision to cancel the international registration.

The holder may request transformation with respect to all or only some of the members included in the international registration. The bar will be where a member had previously issued a total refusal, invalidation or renunciation. The goods and services listed in the application to a State or organization must have been covered by the list in the cancelled international registration for any State or organization where transformation is to take effect.

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<sup>194</sup> Under Article 6(4) Madrid Protocol

Although the holder of the international registration loses the benefits of the Madrid System, under transformation the national or regional application will be treated as if it had been filed with the office of the member concerned on the date of the international registration.<sup>195</sup> That is, unless the member State or regional organization was a later addition (subsequent designation) to the international registration, in which case, the date will be the date that the territorial extension was recorded.<sup>196</sup>

A request for transformation of a international trademark registration to a national trademark in the Kingdom of Bahrain is done by submitting a letter addressed to the Trademarks Office of the Kingdom of Bahrain. The letter must be in Arabic, and where indicated, also in English, providing the following details:

- The type of action required and its date
- The trademark number and class in which it is registered
- Name and address of the trademark holder
- Name and signature of the party making the request

If the international registration had an earlier date based on a claim to priority, the date of priority will be kept for any national or regional application resulting from a transformation, provided:<sup>197</sup>

- the national or regional application is filed within three months from the date on which the international registration was cancelled in the International Register<sup>198</sup>
- the goods and services listed in the national or regional application are covered by the list of goods and services in the international registration in respect of the member concerned<sup>199</sup>
- the application complies with all the requirements of the applicable national or regional law, including the requirements concerning fees<sup>200</sup>

Transformation means that the holder of the international registration becomes an applicant for a national registration in the same way as if they had filed directly with the Trademarks Office of the Kingdom of Bahrain. As such, the requirements of the

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<sup>195</sup> According to Article 3(4) Madrid Protocol

<sup>196</sup> According to Article 3ter(2) Madrid Protocol

<sup>197</sup> Article 9quinquies Madrid Protocol

<sup>198</sup> Article 9quinquies(i) Madrid Protocol

<sup>199</sup> Article 9quinquies (ii) Madrid Protocol

<sup>200</sup> Article 9quinquies (iii) Madrid Protocol



GCC Trademark Law and Regulations become applicable, including those that apply to eligibility of an individual or entity to register a trademark in the Kingdom of Bahrain, and the requirements for certain applicants to use a representative authorized by the Trademarks Office of the Kingdom of Bahrain.

A holder of an international registration that wishes to take advantage of the transformation provisions must file a national application within three months. This three-month period runs from the date the International Bureau recorded the cancellation of the international registration in the International Register.<sup>201</sup>

The Trademarks Office of the Kingdom of Bahrain requires that such an application resulting from the transformation complies with all of the ‘formalities’ that apply to a direct filing with the Trademarks Office.

### **Request to transfer international registration to national registration of Collective Mark, Public Beneficiaries and Professional Institute Mark**

This option is used to request the transformation of an international trademark registration into other forms of national trademark (Collective mark, Public Beneficiaries and Professional Institute Mark) in the Kingdom of Bahrain.

Collective marks are trademarks owned by an association of business operators. The collective mark is available to be used by members of the association, as long as they comply with the rules and requirements of the association for the use of the mark.

Certification and guarantee marks are trademarks that have a guarantee or certification function. These marks may be used on products or services that meet the criteria set by the owner of the trademark who is responsible for ensuring that any products or services for which the mark is used comply with the requirements for the use of the mark.

International applications may be filed as a collective marks, certification marks or guarantee marks. The international application form does not distinguish between the types of mark for which the international registration is being made. The fact that the international registration is in respect of a collective, certification or guarantee mark will be indicated in the international registration form as a statement ‘collective/certification/guarantee mark’

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<sup>201</sup> Article 9quinquies (i) Madrid Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Designations for collective, certification and guarantee marks are examined in the same way as other types of trademarks. There are, however, additional requirements that such marks must comply with in the Kingdom of Bahrain:

### Collective marks:

- The applicant must be a representative of the collective legal entity and the application submitted under their specific authority.<sup>202</sup> The applicant may use a duly authorized agent such as a law firm.
- The applicant must declare that the application is for registration of a collective mark<sup>203</sup> and submit with the application:
  - A statement indicating the category of persons entitled to use the collective mark and their relation to the applicant<sup>204</sup>
  - A copy of the regulations/Rules of Procedure governing the use of the collective mark for goods and services.<sup>205</sup> Any amendments must be clearly indicated and documented<sup>206</sup>

Should these regulations be changed, the owner of a registered collective mark must notify and obtain the approval of to the modification for the changes to be valid.<sup>207</sup>

  - A copy of the conditions regulating the use of the collective mark for goods and services<sup>208</sup>
  - Declaration stating that the applicant is conducting, or will conduct, a strict control on the use of the collective mark by the members<sup>209</sup>
  - Eligibility requirements for membership in the collective entity<sup>210</sup>
- All documents must be authenticated and duly certified and translated into Arabic.<sup>211</sup>

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<sup>202</sup> Article 34.1 of the GCC Trademark Law.

<sup>203</sup> Article 34.2 of the GCC Trademark Law and Article 35.1 of the Regulations.

<sup>204</sup> Article 35.2(a) of the Regulations.

<sup>205</sup> Article 34.2 of the GCC Trademark Law and Article 35.2 of the Regulations.

<sup>206</sup> Article 35.2 of the Regulations.

<sup>207</sup> Article 34.2 of the GCC Trademark Law.

<sup>208</sup> Article 35.2(b) of the Regulations.

<sup>209</sup> Article 35.2(c) of the Regulations.

<sup>210</sup> Article 35.2(d) of the Regulations.

<sup>211</sup> Article 35.3 of the Regulations.

### **Certification mark (Control and Inspection mark)**

A certification mark (referred to in the Kingdom of Bahrain as a 'control or examination/inspection' mark) is not used by the owner of the mark. The request for protection must declare that it relates to a certification mark, and include:

- o An exact copy of the regulations/Rules of Procedure governing the use of the mark for goods and services. Any amendments must be clearly indicated and documented.

Should these regulations be changed, the owner of a registered collective mark must notify and obtain the approval of to the modification for the changes to be valid.

- o A declaration stating that the control or examination mark:
  - o will be used by third parties
  - o that the applicant will not engage in the marketing or production of any goods or services using the mark
  - o the applicant will not conduct any differentiation policies that would preclude the use of the mark by third parties meeting the specifications set by the owner.
- o A declaration stating that the control or examination mark:
  - o certifies the quality, grade and advantages of goods and services, and
  - o does not indicate the origin of the goods or services.
- o Documents indicating the specifications and standards applied by the applicant:
  - o to monitor the use of the mark, and
  - o proving that the applicant is conducting an accredited quality assessment program.
- o A certificate of the advantages of the goods and services approved, or to be approved, by the control or examination mark.

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

All documents must be authenticated and duly certified and translated into Arabic.

The mark of Public Welfare Bodies or Professional Institutions

These are signs such as adopted by a public utility body or used by a professional institution. The sign is registered for non-commercial purposes, being used such as to distinguish its correspondence or as a sign of membership.

In the case of registration of marks for non-commercial purposes, this shall be indicated in the application for registration. A copy of the Rules of Procedure of the applicant public utility body or professional institution shall be annexed to the application. This document must be authenticated and duly certified and translated into Arabic.

### Replacement of National or Regional registration with international registration<sup>212</sup>

Replacement is a procedure that allows holders designating territories where they already have an older prior right, to benefit from that earlier date of protection.

#### **Replacement is automatic**

Replacement is a procedure that allows holders designating territories where they already have an older prior right, to benefit from that earlier date of protection.

A trademark owner may have obtained an international registration designating a particular State or intergovernmental organization whilst already owning a registration that they filed directly with the office of that State or organization. In effect, the holder has two sets of overlapping protection; one national or regional, the other international through the designation of the State or region in the international registration.

Where there is a national or regional trademark registration and an international registration designating the State or regional organization is subsequently made by the same individual or legal entity, the international registration will be deemed to replace the national or regional registration provided:

- the protection resulting from the international registration extends to the State or regional organization

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<sup>212</sup> Rule 21 Regulations under the Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

- all or some of the goods and services listed in the national or regional registration are also listed (or covered) in the international registration in respect of the State or regional organization (total or partial replacement)
- the date of the international registration in the State or with the intergovernmental organization post-dates the date of the national or regional registration.

Replacement is automatic, without any action being required by a Trademarks Office or the holder of the international registration.

### Request for replacement by the holder of the international registration

The holder of an international registration may request the national or regional office to note the international registration in its Register.<sup>213</sup> When noted the international registration is deemed to have 'replaced' the national or regional registration. There is no visible replacement in the national or regional trademark register. Providing the trademark owner continues to renew the national or regional registration<sup>214</sup> it will remain as a record on the trademarks register of the State or intergovernmental organizations where the international registration is deemed to have replaced them.

The international registration and the national or regional registration will coexist on the national or regional trademarks register. The Trademarks Office may not require the holder of the international registration to renounce or request the cancellation of a national or regional registration deemed to have been replaced by the international registration. Replacement is a useful feature for the trademark holder to consolidate their portfolios of rights under one number, the international registration. While the trademark holder may consider letting the national or regional registration later to lapse, but whether to let this lapse or to renew this is a decision to be made solely by the holder.

A single international registration may replace more than one national or regional registration. This will happen where, as is the case in the Kingdom of Bahrain, a national registration can include only one category (or class) of goods or services. An international registration can cover as many as 45 classes of goods and services, meaning that the international registration may overlap with multiple single-class registrations.

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<sup>213</sup> Article 4bis(2) Madrid Protocol

<sup>214</sup> Rule 21(3)(b) Regulations under the Protocol: The owner of the national or regional trademark must be allowed to renew the registration in accordance with the national or regional law

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

The holder of an international registration that wishes to request the Office to take note of the 'replacement' of a 'national' registration in the Kingdom of Bahrain, must make the request directly to the Trademarks Office in the Kingdom of Bahrain.<sup>215</sup> The request is made via the Electronic Industrial Property Services ePortal.

Before proceeding with the request to note the replacement, the Trademarks Office must examine the request to ensure.<sup>216</sup>

- that the international registration and the registration in the Kingdom of Bahrain are in the name of the same individual or legal entity
- that the protection resulting from the international registration extends to the Kingdom of Bahrain (either from the original registration or a subsequent designation)
- that the goods or services listed in the national registration are also listed in the international registration in respect of the Kingdom of Bahrain, or at least that there are some overlapping goods and services

The list of goods or services in the national registration in the Kingdom of Bahrain do not need to be identical to the goods or services listed in the international registration. The goods and services concerned with replacement, listed in the national or regional registration must be covered by those listed in the international registration. Replacement may concern only some of the goods and services listed in the national or regional registration.<sup>217</sup>

- the date of designation of the Kingdom of Bahrain (whether in the international registration or a subsequent designation) took effect after the date of the national registration in the Kingdom of Bahrain

Provided these requirements are satisfied, the Trademarks Office of the Kingdom of Bahrain must make a note in the Trademarks Register to the effect that the national registration has been replaced by the international registration.<sup>218</sup> The international registration will be deemed to replace the national registration, without prejudice to any rights acquired by virtue of the national registration.

After checking the request to take note of replacement and making the required notation in the Trademarks Register of the Kingdom of Bahrain, the Trademarks

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<sup>215</sup> Rule 21(1) Regulations under the Protocol

<sup>216</sup> Article 4*bis*(1) Madrid Protocol and Rule 21(3)(c) Regulations under the Protocol

<sup>217</sup> Rule 21(3)(d) Regulations under the Protocol

<sup>218</sup> Article 4*bis*(2) Madrid Protocol

## Guidelines on the examination and processing of application under Madrid Protocol in the Kingdom of Bahrain

Office must send the International Bureau a notification including in the following information<sup>219</sup>:

- the number of the international registration that replaces the national registration in the Kingdom of Bahrain
- where the replacement concerns only some of the goods or services listed in the international registration, the goods or services concerned

In respect of the national mark that is being replaced:

- the filing date and number
- the registration date and number, and,
- the priority date (if any) of the national registration or registrations which have been replaced by the international registration.
- The notification may also include information relating to any other rights acquired by virtue of that national or regional registration or registrations.

### How to take note in IPAS

Upon receipt of a request to take note and examination to ensure that the conditions are met, the examiner can utilize IPAS to record the changes taking place on the file. The examiner can amend information in the IPAS notes fields available in the main screen with details of the grounds of this change. It can be noted that the specific international registration has replaced the specific national registration numbers.

When the Office is ready to take note, they can use model form 17 found on WIPO's website and send the filled-out form to the International Bureau.

### Recording that the Office has taken note of the replacement by the International Bureau

Provided the notification from the Trademarks Office contains all of the required information, the International Bureau will record the notification of replacement in the International Register and inform the holder of the international registration.

The replacement will be recorded by the International Bureau as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

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<sup>219</sup> Rule 21 Regulations under the Protocol

### **Division of an International Registration<sup>220</sup>**

The Madrid System allows for the holder of an international registration to request the division of an international registration before the designated member concerned. The request must be made to the International Bureau using the Form MM22. However, where the law of a member does not provide for division of an application or registration, they may opt out of the requirement to present requests for division to the International Bureau.

Other than as a result of a partial transfer<sup>221</sup> (partial assignment), the GCC Trademark Law and Regulations has no mechanism by which an application or registration can be divided. The Kingdom of Bahrain has made a declaration to the Director General of WIPO<sup>222</sup> stating that the Trademark Office of the Kingdom of Bahrain will not present requests for division of an international registration.

### **Merger of international registrations<sup>223</sup>**

The holder of an international registration may request the merger of international registrations. It is only possible to merge international registrations that were previously separated from the same international registration as a result of a partial change in ownership or the division of an international registration. It is not possible to merge international registrations that were filed as separate international applications.

As is the case with requests for division of an international registration, where the law of the member State or intergovernmental organization does not provide for the merger of registrations resulting from division, they may opt out from the provision allowing for mergers of international registrations resulting from division.

The GCC Trademark Law and Regulations allow for a partial transfer<sup>224</sup> (partial assignment) of a trademark but has no mechanism by which an application or registration can be divided or merged. The Kingdom of Bahrain has made a declaration to the Director General of WIPO<sup>225</sup> stating that the Trademark Office of the Kingdom of Bahrain will not present requests for the merger of international registrations resulting from division.

### **Corrections to the International Register**

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<sup>220</sup> Rule 27bis(1)(a) Regulations under the Protocol

<sup>221</sup> Article 27 GCC Trademark Law and Article 24 of the Regulations

<sup>222</sup> Rule 27bis(6) Regulations under the Protocol

<sup>223</sup> Rule 27bis(2)(a) Regulations under the Protocol

<sup>224</sup> Article 27 GCC Trademark Law and Article 24 of the Regulations

<sup>225</sup> Rule 27ter(2)(b) Regulations under the Protocol



If the International Bureau considers that there is an error in the information recorded on the register, the International Bureau acting ex officio, will correct that information.<sup>226</sup> A holder of the international registration or the office of a member State or regional organization may also request the correction of an error made by the International Bureau or by an Office.<sup>227</sup>

The International Bureau will not correct errors made by the holder of the international registration or their representative (if any). Depending on the nature of the error, the holder of the international registration may be able to be resolved by another process, such as a subsequent designation, recording a change in the holder's details, etc.

### **Requests for correction**

If the error in the international register has been made or caused by the International Bureau, the request for a correction can be made at any time.

Where the error has been made by an office of a member the holder of the international registration or the office may request a correction. Any such request must be made within nine months of the erroneous entry into the International Register published by the International Bureau in the Gazette.

The holder may make the correction using the online form.

### **Notification of the correction**

Where the International Bureau corrects an error, ex officio or following a request, a notification will be sent by the International Bureau to the holder of the international registration. At the same time, the International Bureau will send a notice to the Offices of the members designated in the international registration that are affected by the correction.

The International Bureau will also inform the Office that made the request for correction if that Office is not of an office of a member State or regional organization affected by the correction.

The Offices designated in the international registration where the correction has effect will have the right to send a notification of provisional refusal to the International Bureau. The notification must declare that protection cannot or can no

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<sup>226</sup> Rule 28(1) Regulations under the Protocol

longer be granted to the international registration as corrected. A period of 18-months is allowed for sending the notification, this period starting on the date of the notification of the correction being sent.

If the correction notified limits the scope of the designation relating to the Kingdom of Bahrain, there should be no requirement for the Trademarks Office to re-examine the designation. However, if a correction widens the scope of the designation, such as by adding goods or services, removal of a limitation, or changes the mark from that originally received, the designation will need to be re-examined in respect of the corrected information.

### **Request for Recording**

The following changes to an international registration may be presented to the International Bureau [by the holder of the international registration or the Office of Origin of the member State or regional organization of the holder....]. The Trademarks Office of the Kingdom of Bahrain will receive and transmit the official form to the International Bureau on behalf of the holder.

The request for recording the change must be presented to the International Bureau on the relevant official form where the request relates to any of the following:

- change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties
- limitation of the list of goods and services in respect of all or some of the designated Contracting Parties
- renunciation in respect of some of the designated Contracting Parties for all the goods and services
- change in the name or address of the holder or, where the holder is a legal entity, an introduction of or a change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized
- cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services
- change in the name or address of a representative.

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A request presented by the holder must be signed by the holder. Where the request is presented by the Trademarks Office, it must be signed by the Trademarks Office and if required, also by the holder.