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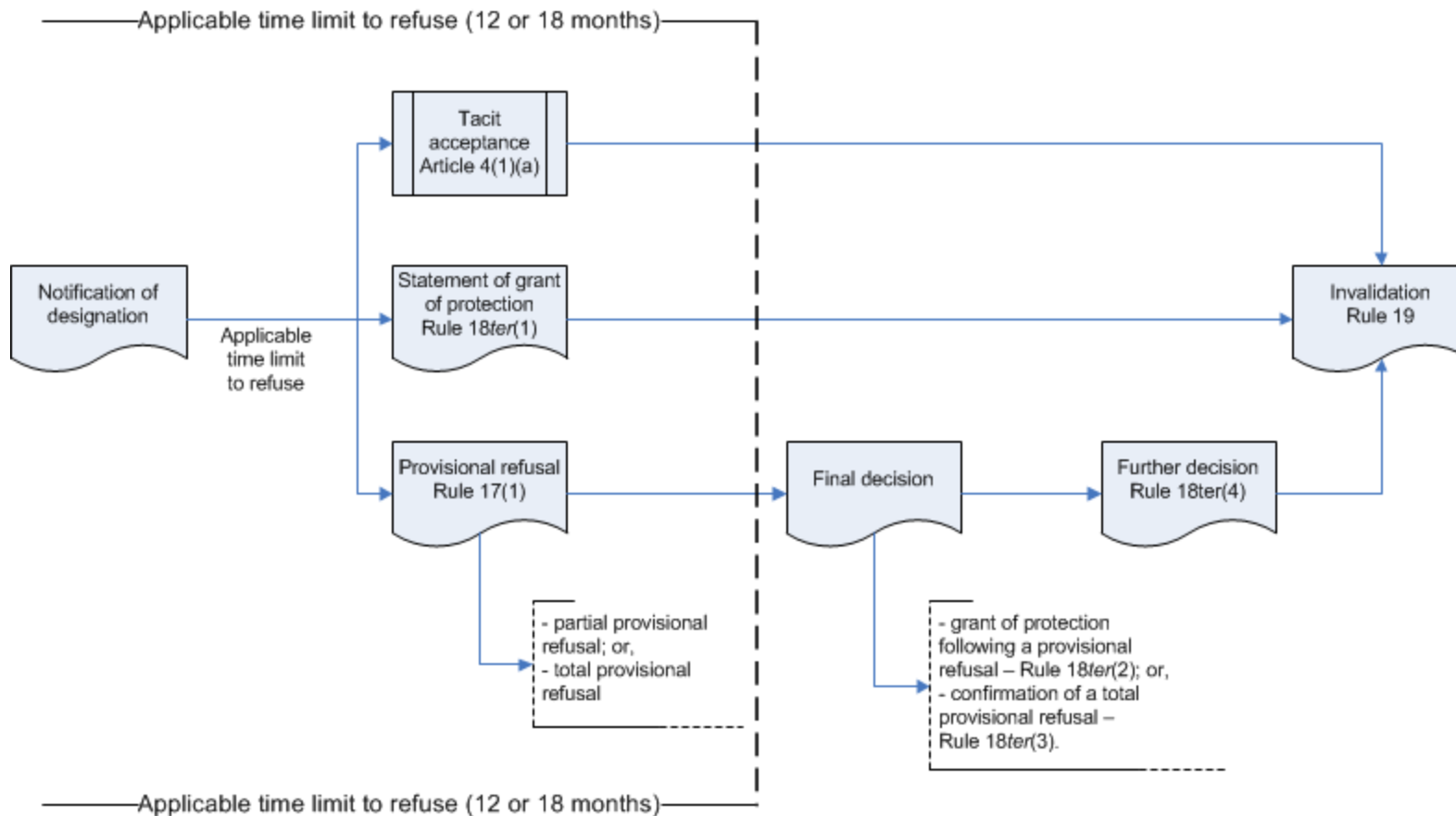


Communications sent by designated Offices

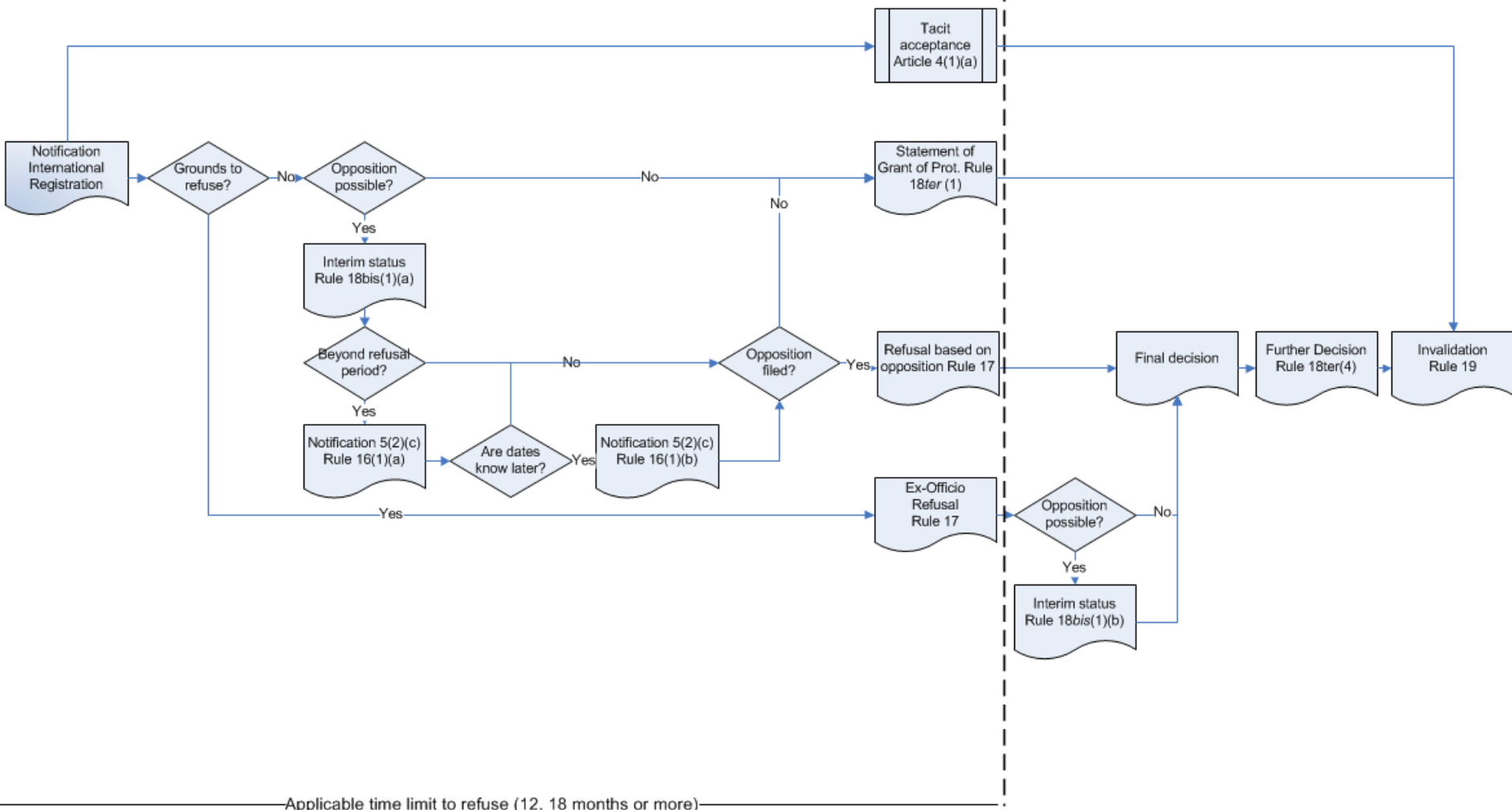
Madrid Working Group Roundtable

Juan Alejandro Rodriguez
Senior Legal Officer

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2014



Applicable time limit to refuse (12, 18 months or more)



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Communications sent by Designated Offices and recorded in 2013

■ Grants of protection	200,831
■ Provisional refusals	84,757
■ Interim status	83,322
■ Extension of time limit	18,299
■ Final decisions	132,308
■ Further decisions	2,271
■ Invalidations	1,101
■ Total	522,889

Rule 16(1)(b)

As from September 1, 2009

Where, at the time of the communication of the information referred to in subparagraph (a), the dates on which the opposition period begins and ends are known, those dates shall be indicated in the communication. If such dates are not yet known at that time, they shall be communicated to the International Bureau **as soon as they are known** ~~at the latest at the same time as any notification of a provisional refusal based on an opposition.~~

[...]

(2) *[Recording and Transmittal of the Information]* The International Bureau shall record in the International Register the information received under paragraph (1) and shall transmit that information to the holder.

Document MM/LD/WG/5/2

“...be amended to require that the dates of opposition be communicated independently as soon as they are known [so that] the end of the refusal period be easily computed by everyone interested.”

“...this would mitigate the problem identified in paragraph 40, above, in relation to Rule 16(1)(b), i.e., the open-ended situation that results from information as to possible oppositions not being followed by an independent indication of dates.”

“...not be advisable to provide that failing a subsequent communication of the dates, a notification of refusal based on opposition should be treated as irregular, or not considered as such.”

Rule 18*bis*(1)(a)

An Office which has not communicated a notification of provisional refusal may [...] send [...] a statement to the effect that the ex officio examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed.

[...]

(2) [Recording, Information to the Holder and Transmittal of Copies]
The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

Document MM/A/32/1 (2000)

Rule 17(6)(a)(ii)

The intention is that these statements would fulfil the same purpose as [...] communications sent by an Office to the applicant [...] The practice of Offices varies in this regard. [...] Other Offices send a first communication informing the applicant that the ex officio examination has been completed without any objections being raised and that the opposition period is about to start, followed by a further communication once the opposition period has expired without any opposition being filed.

It must be stressed that the adoption of this provision would not create any obligation for an Office to send such communications. It should also be emphasized that no legal consequences would result from the fact that no statement of acceptance is sent under the Regulations.

Rule 18ter(4)

(4) [Further Decision] Where, following the sending of a statement in accordance with either paragraph (2) or (3), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned

Document MM/LD/WG/2/4 (2001)

Rule 17(5)

“...an Office should notify the International Bureau of the outcome of proceedings subsequent to a provisional refusal...”

“... an Office would send the decision that terminates the procedure before the Office [and] would also state what is the scope of the protection of the mark”

“Where there is a further decision (for example, on appeal) which reverses, in whole or in part, the decision already notified, that further decision should also be notified ...”

“...this will mean that, in some instances, there will be two (or even more) decisions subsequent to refusal...”

Thank you

Juan Alejandro Rodriguez
Senior Legal Officer
Legal Division – Madrid Registry

juan.rodriguez@wipo.int

