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WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Fifth Session
Geneva, May 5 to 9, 2008

INFORMATION RELATING TO THE FATE OF DESIGNATIONS

Document prepared by the International Bureau

I. BACKGROUND

1. It is first recalled that the Working Group on the Legal Development of the Madrid System (hereinafter referred to as “the Working Group”) was established on an *ad hoc* basis with a view to facilitating, *inter alia*, the review of the safeguard clause envisaged by Article 9*sexies*(2) of the Protocol Relating to the Madrid Agreement (hereinafter referred to as “the Protocol”¹). In the context of this work, the Working Group began considering issues related to the level of services provided by the Offices of Contracting Parties to the Protocol. Discussions were based notably on an informal document entitled “Proposal by Australia to the *Ad Hoc* Working Group on the Legal Development of the Madrid System in relation to further work on the future development of the Madrid System”, presented by the Delegation of Australia during the third session of the Working Group, held from January 29 to February 2, 2007, in Geneva.

¹ Similarly, the Madrid Agreement Concerning the International Registration of Marks will be hereinafter referred to as “the Agreement” and the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement will be hereinafter referred to as “the Common Regulations”.

2. At the conclusion of this session, the Working Group declared its intention that standards be established in the provision of information, which would apply throughout the membership of the Protocol, and agreed to continue to discuss, in depth, at the next session, the proposal put forward by the Delegation of Australia, in the context of the legal development of the Madrid Protocol².
3. At the fourth session of the Working Group, held from May 30 to June 1, 2007, in Geneva, the Delegation of Australia tabled a new proposal³ that emphasized the importance of achieving tangible results, while at the same time recognizing that the improvement of services should be an ongoing process. There was considerable support for this proposal, with many delegations considering favorably the possibility of mandatory issuing of statements of grant of protection, at least in the form of lists of marks.
4. The Chair concluded that the Working Group had agreed to request the Secretariat to prepare a paper addressing the issue of the accessibility of information regarding the fate of international registrations in designated Contracting Parties, and proposing possible amendments to the Common Regulations. He further noted that, with a view to assisting the Secretariat in the preparation of that paper, the Working Group encouraged Contracting Parties and international non-governmental organizations to submit their contributions on this specific issue to the International Bureau by the end of 2007⁴.
5. In September 2007, the Madrid Union Assembly decided to give an *ongoing* mandate to the Working Group in order to consider issues relating to the legal development of the Madrid Protocol. More precisely, the Assembly decided that the Working Group (and thus no longer to be referred to as “*ad hoc*”) should hold two meetings in 2008, and that the first of these – the meeting presently convened – would address the issue of improving the accessibility of information regarding the fate of international registrations in designated Contracting Parties.
6. Contributions for the present session were received from the Governments of Australia, Japan and Switzerland. These are available as documents MM/LD/WG/5/5 and 6, MM/LD/WG/5/3 and MM/LD/WG/5/4, respectively. The International Bureau also received a contribution from MARQUES. All these submissions indicate the desirability of introducing a requirement for Offices to issue statements of grant of protection, and some identify other measures aiming at the longer term.
7. The present document from the International Bureau is intended to facilitate the discussions of the Working Group on the accessibility of information regarding the fate of international registrations in designated Contracting Parties by first recalling the current framework, then considering why it needs to be reviewed and, finally, proposing a possible approach in terms of changing the operation of the system through an amendment of the Common Regulations. After a brief description of alternative considerations relating to the legal framework, the document closes with the presentation of measures relating to the information framework that the International Bureau intends to put into place immediately.

² See paragraph 152 of the Report of that session, document MM/LD/WG/3/5.

³ See document MM/LD/WG/4/5.

⁴ See paragraphs 22 and 23 of the Summary by the Chair, document MM/LD/WG/4/6.

8. Annex I contains a draft amendment of the Common Regulations that illustrates the proposed approach, whilst Annex II contains a number of draft model forms that could be made available by the International Bureau, should the Working Group be supportive of the approach.

II. CURRENT FRAMEWORK

9. The general operation of the Madrid system can be summarized as follows: the International Bureau notifies each Contracting Party in whose territory protection has been requested, whether in the international application, or subsequently. Each designated Contracting Party has the right to refuse protection, within the time limits specified in the Agreement or the Protocol (Article 5(1) of the Agreement and of the Protocol). As stated in the *Guide to the International Registration of Marks*⁵, “*There is no requirement for an Office to issue a statement when it decides that it is not going to refuse protection; it is a fundamental principle of the Madrid system that, if no notification of provisional refusal is sent within the appropriate time limit ..., the mark is automatically protected in the Contracting Party concerned for all the goods and services requested.*”

10. In the Agreement, this fundamental principle of “tacit acceptance” results from the combination of Articles 4 and 5. In the Protocol, it is clearly stated in Article 4(1), which provides that “*If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party.*”

11. In addition to Articles 4 and 5 of the Agreement and of the Protocol, the relevant legal framework is mainly laid out in Rule 17 of the Common Regulations (*Provisional Refusal and Statement of Grant of Protection*), as completed by Rules 16 (*Time Limit for Notifying a Provisional Refusal Based on an Opposition*) and 18 (*Irregular Notifications of Provisional Refusal*), and by Part Five of the Administrative Instructions⁶ (*Notification of Provisional Refusals*).

12. Rule 17, as it currently stands, results from two exhaustive reviews which took place over the years 2000 and 2001⁷. The first led to the coming into effect, on November 1, 2000, of a new paragraph (6), allowing for the issuing of statements of grant of protection. The second sought to clarify the practice regarding final decisions and led to amendments of paragraph (5). On that latter occasion, the abbreviated expression “notification of provisional refusal” was also introduced as item (xix) of Rule 1, in order to make clear that the notification of a provisional – as opposed to final – refusal, under Rule 17, was the exercise of the “right to declare that protection cannot be granted”. All these amendments came into effect on April 1, 2002.

⁵ Hereinafter referred to as “the Guide”. See paragraph 33.06 of Part B.II.

⁶ Administrative Instructions for the Application of Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto.

⁷ See document series MM/A/32, MM/LD/WG/1 and MM/LD/WG/2.

13. The information framework is provided by the *WIPO Gazette of International Marks*⁸, published pursuant to Rule 32 of the Common Regulations, the *Madrid Express* database, established pursuant to Rule 33, and ROMARIN. *Madrid Express* features the current status of all international registrations in force, as well as international applications and subsequent designations which have not yet been published in the Gazette, while ROMARIN provides a more detailed history of all international registrations in force. Both databases and the Gazette are accessible in searchable form on the Internet.

14. Finally, on payment of the fee prescribed in the Schedule of Fees, anyone may obtain from the International Bureau a certified copy of the entries in the International Register concerning a given mark. Two types of extract are available:

– a detailed certified extract containing a photocopy of the international registration as originally published in the Gazette, with details of any subsequent changes, refusals, invalidations, corrections and renewals recorded in the International Register at the time the extract is prepared;

– a simple certified extract consisting of certified copies of all entries that have been published in the Gazette concerning the international registration and any notification of refusal received by the International Bureau at the time the extract is prepared.

The Provisional Refusal Procedure

15. Any refusal notified by an Office after the applicable time limit will not be considered as such by the International Bureau (Rule 18(1)). It is important to stress that, as far as the time limits for refusal are concerned, *it is the date on which the Office sends the notification to the International Bureau which is decisive, not the date on which the International Bureau receives that notification.*

16. The normal time limit for the notification of a provisional refusal is one year from the date on which the International Bureau has notified the international registration, or the subsequent designation, to the Office of the designated Contracting Party, unless the legislation of that Contracting Party provides for a shorter period (Article 5(2) of the Agreement and 5(2)(a) of the Protocol). To the knowledge of the International Bureau, there is no Contracting Party where the latter would be the case.

17. However, any Contracting Party to the Protocol may declare that, for international registrations in which it is designated under the Protocol, the time limit of one year is replaced by 18 months (Article 5(2)(b))⁹.

⁸ Hereinafter referred to as “the Gazette”.

⁹ At the time of issuing of the present document, of the 74 Contracting Parties to the Protocol, 33 had made this declaration.

18. In that declaration, the Contracting Party may specify also that a refusal of protection resulting from an opposition may be notified to the International Bureau after the expiry of the period of 18 months (Article 5(2)(c))¹⁰. The Office of a Contracting Party that has made this declaration may, with respect to a given international registration in which that Contracting Party is designated under the Protocol, notify, after the expiry of the 18-month time limit, a refusal of protection resulting from an opposition, but only if

– before the expiry of the 18-month time limit, it has – as required under Rule 16(1) – informed the International Bureau of the possibility that oppositions with respect to the international registration in question may be filed after the expiry of the 18-month period, and

– the notification of refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

19. Pursuant to Rule 16(1)(b), when an Office informs the International Bureau, in connection with a given international registration, of the possibility that oppositions may be filed after the expiry of the 18-month period, it must, where the dates on which the opposition period begins and ends are known, indicate those in the communication. If such dates are, at that time, not yet known, they must be communicated to the International Bureau once they become known and, at the latest, at the same time as any notification of refusal based on an opposition.

20. Pursuant to Rules 16(2) and 32(1)(a)(ii) the International Bureau will record this information in the International Register, transmit it to the holder of the international registration and publish it in the Gazette. The corresponding information will be noted in ROMARIN under the title “Opposition Possible After the 18-Month Time Limit”, with an indication of the Gazette and the Contracting Party in question.

21. Pursuant to Rule 17(4), any provisional refusal is recorded in the International Register, together with an indication of the date on which the notification was sent (or is regarded as having been sent, pursuant to Section 14 of the Administrative Instructions). The International Bureau then transmits a copy of the notification to the holder, as well as to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies.

22. Pursuant to Rule 32(1)(a)(iii), the provisional refusal is published also in the Gazette, with an indication as to whether the refusal is total or partial and, in the latter case, the classes affected (or not affected) by the provisional refusal. However, the publication in the Gazette does not contain any of the other elements that are required under Rules 17(2) and (3) as to the contents of the notification, i.e., the grounds for provisional refusal, an indication as to whether the provisional refusal is based on an opposition, the goods and services affected when the provisional refusal is partial, and the time limit to request a review, or to respond. In ROMARIN the corresponding information is noted under the title “Total Provisional Refusal of Protection” or “Partial Provisional Refusal of Protection”, in each case with an indication of the Gazette and the Contracting Party in question.

¹⁰ At the time of issuing of the present document, of the 33 Contracting Parties that had made the declaration under Article 5(2)(b) of the Protocol, 20 also made this further specification.

Notification of Decisions Following a Provisional Refusal of Protection

23. Pursuant to Rule 17(5)(d), the Office of a Contracting Party may declare that, in accordance with its legislation, any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such a review has been requested by the holder, and any decision taken on the said review may be the subject of a further review or appeal before the Office¹¹.

24. Pursuant to Rule 17(5)(e), the Office of a Contracting Party may declare that, in accordance with its legislation, an *ex officio* provisional refusal that is notified to the International Bureau is not open to review before the Office. Where this declaration applies, any *ex officio* provisional refusal issued by the Office shall be deemed to include the statement provided for in Rule 17(5)(a) (which is normally notified only after all procedures before the Office have been completed) indicating that the protection of the mark is refused for all the goods and services, or indicating the goods and services for which the mark is protected¹².

Confirmation or Withdrawal of Provisional Refusal

25. Pursuant to Rule 17(5)(a), where an Office has issued a provisional refusal and all procedures before the Office have been completed, the Office will send to the International Bureau a statement indicating that protection is refused for all the goods and services or that the mark is protected for all the goods and services, or indicating the goods and services for which the mark is protected.

26. As indicated in paragraph 12, above, this provision was substantially reviewed in 2001, with the consequence that “*The statement should be sent as soon as all possibilities of review or appeal before the Office have been exhausted, or the time for requesting review or appeal before the Office has expired. The Office therefore should not wait to see whether an appeal is lodged with a tribunal or other body external to the Office. [...] Although this statement may not necessarily reflect the definitive result regarding the protection of the mark in the Contracting Party concerned, the fact that, in many instances, a decision subsequent to provisional refusal will be recorded and published at an early stage (as soon as the proceedings before the Office have finished) will have advantages for both holders and third parties.*”¹³

27. Pursuant to Rule 17(5)(b), where the Office becomes aware of any further decision that affects the protection of the mark (for example, a decision resulting from an appeal to an authority outside that Office), it will send to the International Bureau a further statement indicating the goods and services for which the mark is now protected, in so far as the Office is aware of this decision.

¹¹ This declaration has been made by the Offices of Georgia, Iceland, Slovakia and Spain.

¹² The Office of China has made this declaration.

¹³ Paragraph 37.05 of Part B.II of the Guide.

28. Pursuant to Rules 17(5)(c) and 32(1)(a)(iii), the International Bureau will record any such statement in the International Register and will transmit a copy to the holder. The statement will be also published in the Gazette. Where such statement specifies goods and services by name, this information, in contrast to the publication of a provisional refusal, will be published in full. The corresponding information will also be noted in ROMARIN under the titles “Statement Indicating that Protection of the Mark is Refused for all the Goods and Services Requested” (Rule 17(5)(a)(i)), “Statement Indicating that the Mark is Protected for all the Goods and Services Requested” (Rule 17(5)(a)(ii)), in each case indicating the date and number of the Gazette in question, and the Contracting Party which notified the decision, or “Other Final Decision” (Rule 17(5)(a)(iii)), again indicating the Gazette and the Contracting Party in question, along with an indication of the goods and services which are protected. Regarding Rule 17(5)(b), the relevant information will also be noted in ROMARIN under the title “Other Final Decision”, indicating the Gazette date and number and the Contracting Party concerned, along with certain particulars of the decision in question.

Statements of Grant of Protection and Other Information

29. Pursuant to Rule 17(6), an Office which has examined an international registration in which it is designated and found no grounds for refusal may, within the applicable refusal period, issue a statement of grant of protection. It is therefore axiomatic that a statement issued under that Rule must relate to all the goods and services for which protection is sought in the Contracting Party concerned.

30. The possibility of issuing statements of grant of protection was introduced in November 2000¹⁴. At the time of issuing the present document, there are 14 Offices of Contracting Parties that issue statements of grant of protection¹⁵. An Office which decides to exercise this possibility may choose between two ways of proceeding, according to what it thinks more appropriate, having regard to the way in which it examines international registrations.

31. For example, in a system of *ex officio* examination without any provision for opposition, or when the opposition period runs concurrently with the examination, the Office might issue a single statement to the effect that all procedures before the Office have been completed and that protection is accordingly granted to the mark that is the subject of the international registration (Rule 17(6)(a)(i)).

¹⁴ In the context of the 2000 review (referred to in paragraph 12, above), the International Bureau indicated that the word “notification” is used in connection with a communication from which stems a legal consequence, whilst the word “statement” is used in connection with an item of information provided for by an Office as to the status of the mark. See document MM/LD/WG/2/6.

¹⁵ The Offices of Armenia, Australia, Benelux, European Community, Georgia, Hungary, Ireland, Japan, Norway, Republic of Korea, Singapore, Syrian Arab Republic, Turkey, United Kingdom.

32. Alternatively, the Office may send a statement to the effect that the *ex officio* examination has been completed favorably but that the protection of the mark is still subject to opposition or observations by third parties; the date by which such oppositions may be filed should be indicated (Rule 17(6)(a)(ii)). This would be the more appropriate course where the opposition period does not start until the *ex officio* examination stage has been completed. If, in this case, the opposition period expires without any opposition or observation having been filed, the Office may then send a further statement to that effect, indicating that the mark is accordingly protected (Rule 17(6)(a)(iii)).

33. Pursuant to Rules 17(6)(b) and 32(1)(a)(iii), any statement of grant of protection will be recorded in the International Register and published in the Gazette and a copy will be transmitted to the holder. The corresponding information will be noted in ROMARIN under the title “Grant of Protection” (Rule 17(6)(a)(i) or (iii)), indicating the Contracting Party concerned and the publication number and date of the Gazette, or “Grant of Protection Subject to Opposition” (Rule 17(6)(a)(ii)), also indicating the Contracting Party concerned and the details of the Gazette in question, along with the date when the opposition period ends.

34. Although it does not prescribe in detail the content of a statement of grant protection, Rule 17(6) has been implemented as requiring that a statement of grant of protection should relate to a single international registration only¹⁶. However, in the context of its electronic communication with Offices, the International Bureau has begun to receive such statements in the form of lists in the xml format, from which it is able – in the case of lists issued by the Benelux Office of Intellectual Property – to create individual documents bearing the Office’s signature, which are then transmitted to each holder concerned.

III. RECONSIDERING “TACIT ACCEPTANCE”

35. As stated in the Guide¹⁷, the principle of “tacit acceptance” referred to in paragraph 10, above, “*has always been considered one of the main advantages for users of the system of international registration, particularly in the days when Offices routinely took longer than 12 months to examine applications filed directly with them.*” It seems, however, that most of the criticism expressed today in relation to the legal framework relates to the consequential effects of this principle.

36. As further stated in the same paragraph of the Guide, “*Nowadays, however, many Offices are able to examine trademark applications, and to inform the applicant of the result, in a period which is shorter than one year. If the Office does not inform the holder of an international registration where it has carried out the examination and decided not to refuse protection, the latter is treated less favorably than a direct applicant. In order to avoid this, an Office which has carried out an ex officio examination and found no grounds for refusal may send to the International Bureau, within the applicable refusal period, a statement of grant of protection.*”

¹⁶ See circular letter C. M 1157, dated November 10, 2000, addressed to Offices of Contracting Parties.

¹⁷ Paragraph 33.06 of Part B.II.

37. According to statistics compiled by the International Bureau for the year 2007, when Offices need to issue a refusal, such refusal is communicated well within the applicable time limit, and sometimes very early indeed (see tables 1 and 2).

Table 1. Year 2007: Time to process *ex officio* refusals

< 3 months	4–6 months	7-9 months	10-12 months	13-15 months	16-18 months
17.47%	22,83%	21,40%	31,34%	5,40%	1.56%

Table 2. Year 2007: Time to process refusals based on opposition

< 3 months	4–6 months	7-9 months	10-12 months	13-15 months	16-18 months	18+ months
1.85%	35,16%	40,29%	15,55%	3.09%	2.19%	1.87%

38. Yet, as indicated previously, only 14 Offices currently issue statements of grant of protection (11 of which are amongst the 33 Offices that enjoy a longer period of refusal). As regards the designations notified in 2007, of a total of 370,234 designations, around three quarters concerned Contracting Parties whose Offices do not issue statements of grant of protection. That means that, in respect of these, the holder and third parties may not know before the end of the refusal period (plus some lead-time to allow for a notification sent at the very end of the refusal period to be received by the International Bureau) that the mark is protected, unless they are in a position to obtain that information directly from each of the Offices concerned¹⁸.

39. In 2005, of a total of 356,607 designations recorded, around 21.2% were followed by a provisional refusal and around 22.7% were followed by a statement of grant of protection. In other words, 56,1% of all designations in 2005 were not followed by any communication as to the status of the designation.

40. This inconvenience is further aggravated in the specific situation where the possibility of opposition after the 18-month time limit has been communicated, pursuant to subparagraph (a) of Rule 16(1), without the dates of the opposition period being indicated. According to the statistics compiled by the International Bureau, there were 8,547 such cases in 2005, representing 63,18% of all communications received under that Rule. As required by subparagraph (b), in such a case, the dates should be communicated, at the latest, at the same time as any notification of refusal based on an opposition. However, the statistics of 2005 reveal that there would be a further communication of those dates (either independently, or in the context of a notification of refusal based on opposition) in less than 20% of the cases. In other words, in about 80% of such cases, the procedure remains apparently open-ended.

¹⁸ It is to be noted that a very limited number of Offices do, however, issue statements of grant of protection directly to holders.

IV. POSSIBLE APPROACH AS TO THE LEGAL FRAMEWORK

41. An initial way to improve the situation regarding information as to the fate of designations in the territory of Contracting Parties would be to provide that, where an Office does not intend to notify a refusal, information to that effect would be made available as soon as possible, instead of occurring by default at the end of the refusal period. As already considered by the Working Group during its third session, this could be achieved through an amendment of the Common Regulations requiring from Offices that they, alternatively, issue statements of grant of protection, issue information upon request, or provide free online access to information on the status of a given designation¹⁹.

42. Such an approach would mitigate, somewhat, the inconvenience of the principle of “tacit acceptance”. However, it would do little in terms of providing holders and third parties with a single source of information on the status of all designations contained in a single international registration. It would thus seem more logical that any desired information accrued to the International Register – and its associated information database, ROMARIN.

43. To achieve this, an amendment to Rule 17(6), to make it mandatory for Offices to issue statements of grant of protection when they do not intend to send a notification of provisional refusal, might suffice. However, with a view to paving the way to a clearer and gradually expanding information framework under the Madrid system, the Working Group might consider an approach that would consist in breaking Rule 17 into three independent rules, as shown in Annex I of the present document and commented upon below.

Provisional Refusals (Rule 17)

44. As proposed for discussion in Annex I of the present document, the scope of Rule 17 could be narrowed down to relate specifically to the notification of provisional refusal only, though still in a meaning broad enough to cover the particular circumstances envisaged under current subparagraphs (5)(d) and (e). The rest of the Rule would migrate, with some amendments, to new proposed provisions, as shown in the table below:

Current text	Purpose of Rule	Proposed provisions
17(5)(a)(i)	Confirmation of total refusal	18ter(2)
17(5)(a) (ii) and (iii)	Confirmation of a partial refusal or withdrawal	18ter(1)(b)
17(5)(b)	Further Decision	18ter(3)
17(5)(c)	Recording of Final Decision	18ter(4)
17(6)(a)(i) and (iii)	Statement of Grant of Protection	18 (1)(a)
17(6)(a)(ii)	<i>Ex officio</i> examination	18bis(1)

¹⁹ See, to that effect, footnote 15 of document MM/LD/WG/3/2, containing the text of a possible amendment to Rule 17(6) of the Common Regulations.

Interim Status of the Mark in the Territory of a Designated Contracting Party (New Rule 18bis)

45. In the first stage of its possible introduction, such a rule on information as to the interim status of a mark could be limited to the provision, by Offices that so wish, of the statement contemplated by current Rule 17(6)(a)(ii), i.e., a statement to the effect that the Office, having completed its *ex officio* examination, has found no grounds to issue a notification of provisional refusal, but that protection of the mark is still subject to opposition or observations by third parties. It is suggested that the *chapeau* of Rule 17(6), namely “Statements of Grant of Protection”, may be misleading in this context, the purpose of this type of statement being to provide information only as to the interim status of the mark, as better reflected by the draft heading of proposed Rule 18bis.

46. As at present, a statement received under paragraph (1) of Rule 18bis would, under paragraph (2), be recorded in the International Register and a copy of the document would be transmitted to the holder or, in the case of a statement included in a list communicated electronically and not accompanied by document images, that statement document would be created by the International Bureau and transmitted to the holder (see paragraph 34, above). Annex II of the present document contains a draft Model Form 1 for Offices to use under the proposed Rule 18bis, or that the International Bureau itself could use when creating documents in the framework of that Rule.

47. Also, as at present, the necessity to indicate the date by which oppositions or observations may be filed should, in itself, impose a certain timeline on Offices to send such statements. It is suggested that, to the extent that the provision is non-mandatory, it would be difficult to go beyond this and to impose a time limit, running from the moment an Office has completed favorably its *ex officio* examination, for the sending of a statement to that effect. Moreover, it would be difficult to conceive a sanction for failure to comply with the time limit that would not penalize the holder of the international registration more than it would affect the Office that sends a belated statement.

48. It remains, under Rule 18bis as devised, that the general time limit for refusals would continue to be applicable. Thus, as at present, should a statement under Rule 18bis not be issued, the status of the mark in that designated Contracting Party would be determined according to the “tacit acceptance” principle, i.e., that no refusal having been sent – or its possibility forewarned – within the applicable period, the mark is automatically protected in the Contracting Party concerned for all the goods and services requested.

49. Having a provision on the communication of information on the interim status of a mark, such as Rule 18bis, outside the intricate framework of current Rule 17(6) on statements of grant of protection, would mean that it could more easily evolve to allow, or require, other types of information. With the development of automation and electronic communications, the availability of such information could take the form of a simple link between the International Bureau’s electronic database and the database of the Office of a designated Contracting Party, requiring perhaps further amendments to Rule 33 or the Administrative Instructions. However, should there be a need to provide for the recording in the International Register of some of this additional information, a new Rule 18bis, as envisaged here, would provide a more appropriate context.

Final Disposition (Rule 18ter)

50. As indicated in the table in paragraph 44, above, such a rule would combine what is currently included partly in paragraph (5) and partly in paragraph (6) of Rule 17.

Operation and Main Effect of Rule 18ter

51. Proposed Rule 18ter would operate as follows:

- the statement that an Office must send under Rule 17(5)(a)(i) where, all the procedures before it being completed, a total provisional refusal is maintained, would now be required under Rule 18ter(2);
- the statement that an Office must send under Rule 17(5)(a)(ii) where a total or a partial provisional refusal is totally withdrawn would now be required under Rule 18ter(1)(b)(i);
- the statement that an Office must send under Rule 17(5)(a)(iii) where a total provisional refusal is partially maintained, or where a partial provisional refusal is fully or partially maintained, would now be required under Rule 18ter(1)(b)(ii);
- finally, the statement that an Office *may* send under Rule 17(6)(a)(i) or (iii)²⁰ where no provisional refusal was first issued, would now be *required* under Rule 18ter(1)(a).

52. More fundamentally then, proposed Rule 18ter(1)(a) would mitigate the inconvenience of the “tacit acceptance” principle by requiring from Offices that they send a statement also in the last of the four situations described above. As a result, whatever the status of the mark in their territories, Offices of designated Contracting Parties could no longer, under Rule 18ter(1) as a whole, remain silent.

53. Additionally, under the proposed Rule 18ter, all situations where protection is afforded to the mark would lead to a positive statement to that effect being issued. Under the current regime, one of these situations is handled under Rule 17(6) (*Statements of Grant of Protection*), but the others are handled under Rule 17(5) as a confirmation or, at best, a withdrawal of refusal, since it is a precondition to the issuing of a grant of protection under Rule 17(6) that a refusal has not been notified. Under proposed Rule 18ter(1), all these situations would now lead to the issuing of a grant of protection.

Timing of the Issuing of Statements by Offices Under Rule 18ter

54. The words “as soon as” in subparagraphs (a) and (b) of Rule 18ter(1), imply that Offices would be required to issue statements as promptly as practically feasible. These provisions do not indicate a precise time limit, from the moment an Office knows that the mark is to be afforded protection, for that Office to send a statement, as any such time limit would be impossible to enforce.

²⁰ Subject, in that case, to a first statement having been sent under item (ii).

55. Subparagraph (a) – which, again, applies in the situation where an Office knows that it will not be sending a notification of provisional refusal – does, however, specify that the issuing must take place as soon as possible *within the applicable refusal period*. Should an Office, for one reason or another, not send the required statement, Rule 18ter(1)(a) would no longer operate and the status of the mark in that designated Contracting Party would be determined according to the “tacit acceptance” principle, i.e., that no refusal having been sent within the applicable period, the mark is automatically protected in the Contracting Party concerned for all the goods and services requested. In other words, no legal consequences would result from the fact that a statement of grant of protection has not been sent by an Office.

56. Should the Working Group, in due course, make a recommendation for an amendment requiring all Offices to issue statements of grant of protection, the notes in support of such an amendment could specify that a communication under Rule 18bis(1) would be without prejudice to the requirement under Rule 18ter(1)(a), where no refusal based on opposition is to follow.

Presentation and Mode of Communication of Statements by Offices Under Rule 18ter

57. The requirement of a compulsory statement in the circumstances envisaged under Rule 18ter(1)(a) should, primarily, be considered in the context of electronic communications. As indicated above in relation to current Rule 17(6), the International Bureau is already in a position to process statements received in the form of lists in the xml format, from which it is able – when no image documents are attached – to create individual documents bearing the Office’s signature for each statement so issued.

58. The International Bureau would, of course, continue to handle individual statements received on paper. It would also be ready to process statements received in the form of a paper list, so as to minimize the workload for Offices²¹. This could consist of a photocopy of the International Bureau’s own “notification *bordereau*”, returned with the appropriate international registration numbers ticked, a stamped date and the signature of the Office. If a paper list is used to issue a given statement, the transmission to the holder envisaged under Rule 18ter(4) would simply consist in the notification of the recording by the International Bureau.

59. Annex II of the present document contains draft Model Form 2 that Offices could use with a view to issuing individual paper or image documents under proposed Rule 18ter(1)(a), or that the International Bureau itself could use when creating documents in the framework of that Rule. That form could also be used in the context of Rule 18ter(1)(b), as described in paragraph 51. Annex II also contains draft Model Form 3 to be used in the context of

²¹ As far as the International Bureau is concerned, it is to be noted that of the 356,539 designations recorded in 2005, 56.1% have not been followed by a notification of provisional refusal or statement of grant of protection. Had Rule 18ter(1)(a) already been applied to these designations, the International Bureau would have had to process 199,993 extra statements.

Rule 18ter(2), also as described in paragraph 51, as well as draft Model Form 4, to be used in the context of Rule 18ter(3). Model Forms 2 and 3 would replace current standard forms D and B, respectively. Draft Model Form 4 would also replace current Model Form B, when the latter is used to communicate a further decision.

V. ALTERNATIVE CONSIDERATIONS

60. It is to be noted that, should it become compulsory for Offices – either through the adoption of a new Rule 18ter(1) as discussed above, or otherwise – to issue statements of grant of protection, 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. In such a situation, there could be two possible outcomes: either a notification of refusal would follow – and that notification should, as at present, contain that indication – or a statement of grant of protection would be issued, in which case an indication of dates would no longer serve any purpose²².

61. However, should the Working Group be unwilling to make a recommendation for an amendment requiring all Offices to issue statements of grant of protection, it may nevertheless be willing to address the problem identified in paragraph 40, above, on its own merits. That problem could be mitigated by bringing forward the requirement for Offices to inform the International Bureau of the dates of the opposition period. As shown in Annex I, Rule 16(1)(a) could thus be amended to require that the dates of opposition be communicated independently as soon as they are known. With these dates – more particularly, the starting date – recorded in the International Register, the end of the refusal period under Article 5(2)(c)(ii) could be easily computed by everyone interested.

62. As suggested above in relation to possible new Rules 18bis and 18ter, it would be difficult impose any time limit under Rule 16(1)(b), as any such time limit would be impossible to enforce. It would also, in the opinion of the International Bureau, 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.

63. Annex II of the present document contains a draft Model Form 5 for Offices to use under Rule 16, or that the International Bureau itself could use when creating documents in the framework of that Rule.

64. On a broader level, should the Working Group be unwilling to make a recommendation for an amendment requiring all Offices to issue statements of grant of protection, it may, nevertheless, be willing to recommend the reorganization of Rule 17, so as, in particular, to allow for the issuing of statements of grants of protection even after a notification of provisional refusal. If so, in new Rule 18ter(1) as suggested in Annex I, the word “may” should simply be substituted for the word “shall”.

²² In that context, the notes in support of a proposal for a new Rule 18ter(1) could specify that a communication under Rule 16(1) is without prejudice to the requirement under Rule 18ter(1) in the event that no opposition is filed.

VI. IMMEDIATE MEASURES RELATING TO THE INFORMATION FRAMEWORK

65. The International Bureau will improve the information available in ROMARIN in the following two ways:

1. Information that a refusal period has ended without a notification of refusal having been received by the International Bureau

66. In situations where a refusal period has ended and no notification of refusal has been received in respect of a designation, ROMARIN will indicate that fact. This will be applicable in all situations where the end date of a refusal period can be computed, that is, where no information as to possible oppositions has been received without the relevant dates being also communicated. To take into account the fact that, as far as the time limits for refusal are concerned, it is the date on which the Office sends the notification to the International Bureau which is decisive, such information would not be featured in ROMARIN until one month after the expiry of the applicable time limit. Moreover, any such information would be issued under a caveat preserving the application of Rule 5.

2. Accessibility to notifications of provisional refusals

67. The International Bureau currently digitalizes, for its own internal purposes, all notifications of provisional refusal received in paper form. The International Bureau will soon render these accessible through ROMARIN. In that context, it will also invite those Offices that have indicated a wish to receive a copy of all notifications that concern international registrations for which they constitute the Office of origin to reconsider their needs.

68. The Working Group is invited to consider the above and indicate a way forward for the improvement of the accessibility of information relating to the fate of designations in the territories of designated Contracting Parties.

[Annexes follow]

ANNEX I

Rule 16

~~Time Limit for Notifying~~ Possibility of Provisional Refusal Based on an Opposition

(1) [*Information Relating to Possible Oppositions and Time Limit for Notifying Provisional Refusal Based on an Opposition*] (a) Where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of that Contracting Party shall, where it has become apparent with regard to a given international registration designating that Contracting Party that the opposition period will expire too late for any provisional refusal based on an opposition to be notified to the International Bureau within the 18-month time limit referred to in Article 5(2)(b), inform the International Bureau of the number, and the name of the holder, of that international registration.

(b) 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 [at the latest at the same time as any notification of a provisional refusal based on an opposition] [as soon as they are known].

(c) Where subparagraph (a) applies and the Office referred to in the said subparagraph has, before the expiry of the 18-month time limit referred to in the same subparagraph, informed the International Bureau of the fact that the time limit for filing oppositions will expire within the 30 days preceding the expiry of the 18-month time limit and of the possibility that oppositions may be filed during those 30 days, a provisional refusal based on an opposition filed during the said 30 days may be notified to the International Bureau within one month from the date of filing of the 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.

Rule 17

Provisional Refusal ~~and Statement of Grant of Protection~~

(1) [*Notification of Provisional Refusal*] (a) A notification of provisional refusal may comprise a declaration stating the grounds on which the Office making the notification considers that protection cannot be granted in the Contracting Party concerned (“*ex officio* provisional refusal”) or a declaration that protection cannot be granted in the Contracting Party concerned because an opposition has been filed (“provisional refusal based on an opposition”) or both.

(b) A notification of provisional refusal shall relate to one international registration, shall be dated and shall be signed by the Office making it.

(2) [*Content of the Notification*] A notification of provisional refusal shall contain or indicate

(i) the Office making the notification,

(ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,

(iii) [Deleted]

(iv) all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law,

(v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a reproduction, of the former mark, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

(vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal,

(vii) the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires, and the authority with which such request for review, appeal or response should be filed, with the indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

(3) [*Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition*] Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name and address of the opponent; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

(4) [*Recording; Transmittal of Copies of Notifications*] The International Bureau shall record the provisional refusal in the International Register together with the data contained in the notification, with an indication of the date on which the notification was sent or is regarded under Rule 18(1)(d) as having been sent to the International Bureau and shall transmit a copy thereof to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies, and, at the same time, to the holder.

(5) ~~{Confirmation or Withdrawal of Provisional Refusal}~~ [*Declarations Relating to the Possibility of Review*] (a) ~~[Deleted]—An Office which has sent to the International Bureau a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau a statement indicating either~~

~~(i) that protection of the mark is refused in the Contracting Party concerned for all goods and services,~~

~~(ii) that the mark is protected in the Contracting Party concerned for all goods and services requested, or~~

~~(iii) the goods and services for which the mark is protected in the Contracting Party concerned.~~

(b) ~~[Deleted] Where, following the sending of a statement in accordance with subparagraph (a), 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.²~~

(c) ~~[Deleted] The International Bureau shall record any statement received under subparagraph (a) or (b) in the International Register and shall transmit a copy thereof to the holder.~~

(d) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party,

(i) any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and

(ii) the decision taken on the said review may be the subject of a further review or appeal before the Office.

Where this declaration applies and the Office is not in a position to communicate the said decision directly to the holder of the international registration concerned, the Office shall, notwithstanding the fact that all procedures before the said Office relating to the protection of the mark may not have been completed, send the statement referred to in ~~subparagraph (a)~~ [Rule 18ter\(1\) or \(2\)](#) to the International Bureau immediately following the said decision. Any further decision affecting the protection of the mark shall be sent to the International Bureau in accordance with ~~subparagraph (b)~~ [Rule 18ter\(3\)](#).

(e) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party, any *ex officio* provisional refusal that has been notified to the International Bureau is not open to review before the said Office. Where this declaration applies, any *ex officio* notification of a provisional refusal by the said Office shall be deemed to ~~include~~ [constitute](#) a statement in accordance with ~~subparagraph (a)(i) or (iii)~~ [Rule 18ter\(1\)\(b\)\(ii\) or \(2\)](#).

~~(6) — [Statement of Grant of Protection]~~

~~(a) — An Office which has not communicated a notification of provisional refusal may, within the period applicable under Article 5(2) of the Agreement or Article 5(2)(a) or (b) of the Protocol, send to the International Bureau any of the following:~~

~~(i) — a statement to the effect that all procedures before the Office have been completed and that the Office has decided to grant protection to the mark that is the subject of the international registration;~~

~~(ii) — 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 may be filed;~~

~~(iii) — where a statement in accordance with item (ii) has been sent, a further statement to the effect that the opposition period has expired without any opposition or observations being filed and that the Office has therefore decided to grant protection to the mark that is the subject of the international registration.³~~

~~(b) — The International Bureau shall record any statement received under subparagraph (a) in the International Register and shall transmit a copy to the holder.~~

Rule 18bis

Interim Status of a Mark in the Territory of a Designated Contracting Party

(1) [Ex Officio Examination: No Refusal but Opposition or Observations by Third Parties Still Possible] An Office which has not communicated a notification of provisional refusal may, within the period applicable under Article 5(2) of the Agreement or Article 5(2)(a) or (b) of the Protocol, send to the International Bureau 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, Notification to the Holder and Transmittal of Copies] The International Bureau shall record any statement or information received under this Rule in the International Register, notify the holder accordingly and, where the statement was communicated, or may be reproduced in the form of a specific document, transmit a copy of that document to the holder.

Rule 18ter

Final Disposition on Status of a Mark in the Territory of a Designated Contracting Party

(1) [Statement of Grant of Protection] (a) An Office which does not intend to communicate a notification of provisional refusal shall, as soon as possible within the period applicable under Article 5(2) of the Agreement or Article 5(2)(a) or (b) of the Protocol, send to the International Bureau a statement to the effect that all procedures before the Office have been completed and that the Office has decided to grant protection to the mark that is the subject of the international registration

(b) [Statement of Grant of Protection following a provisional refusal] Except where it sends a statement under paragraph (2), an Office which has communicated a notification of provisional refusal shall, as soon as all procedures before the said Office relating to the protection of the mark have been completed, send the International Bureau either

(i) a statement of grant of protection of the mark, in the Contracting Party concerned, for all goods and services requested, or

(ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.

(2) [Confirmation of Total Provisional Refusal] An Office which has sent to the International Bureau a notification of a total provisional refusal may, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International a statement confirming that protection of the mark is refused in the Contracting Party concerned for all goods and services,

(3) [Further Decision] Where, following the sending of a statement in accordance with either paragraph (1) or (2), 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 concerned¹.

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

[Annex II follows]

¹ It would be necessary to resubmit to the Assembly the Interpretative Statement that currently appears as footnote 2 (not reproduced here) to the equivalent of this provision, i.e. Rule 17(5)(b).

ANNEX II

Model Form 1

**MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION
OF MARKS AND PROTOCOL RELATING TO THAT AGREEMENT**

**COMPLETION OF *EX OFFICIO* EXAMINATION
– INTERIM STATUS OF THE MARK –**

Rule 18bis

Statement sent to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 18bis(1) of the Common Regulations under the Madrid Agreement and Protocol.

The Office confirms 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 possible opposition or observations by third parties.

NOTE: This statement may *optionally* be sent by an Office that has not communicated a provisional refusal. In due course, depending upon whether the mark proceeds to protection without opposition being filed, or is the subject of a notification of provisional refusal based on opposition, or the subject of observations, the Office should send to the International Bureau the appropriate additional documentation – please see Model Forms A, 2 and 3.

I. Office sending the statement:
II. Number of the International Registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. (a) Date on which the opposition period, or the period for the filing of observations, begins: (b) Date on which the opposition period, or the period for the filing of observations, ends:
V. Signature or official seal of the Office communicating this information:
VI. Date:

Model Form 2

**MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION
OF MARKS AND PROTOCOL RELATING TO THAT AGREEMENT**

**FINAL DISPOSITION ON STATUS OF MARK
– STATEMENT OF GRANT OF PROTECTION –**

(once all the procedures *before the Office* have been completed)

Rule 18ter

Statement sent to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 18ter1(a) or (b) of the Common Regulations under the Madrid Agreement and Protocol.

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	<input type="checkbox"/> Protection for all the goods and/or services: <i>(In the event that a notification of provisional refusal has not been communicated previously, and the goods and/or services are now protected, this box only should be ticked. If a provisional refusal <u>has</u> already been communicated but, eventually, protection is granted to <u>all</u> the goods and/or services, this box should also be ticked).</i> All procedures before the Office have been completed; protection is accordingly granted to the mark that is the subject of this international registration for <u>all</u> the goods and/or <u>all</u> the services requested (Rule 18ter(1)(a) or (b)).
	<input type="checkbox"/> Protection for some only of the goods and/or services: <i>(This box should be ticked where a notification of provisional refusal has earlier been communicated and protection is now granted to some only of the goods and/or services – giving an indication of the goods and/or services protected. NOTE Where all the goods or services included in a given class are to be mentioned, the indication should read “all goods (or, all services) in class X”. In all other cases, the goods and/or services should be clearly indicated).</i> All procedures before the Office have been completed; protection is accordingly granted to the mark that is the subject of this international registration for the following goods and/or services (Rule 18ter(1)(b)):

V. Signature or official seal of the Office sending the statement:

VI. Date:

Model Form 3

**MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION
OF MARKS AND PROTOCOL RELATING TO THAT AGREEMENT**

**FINAL DISPOSITION ON STATUS OF MARK
– CONFIRMATION OF TOTAL PROVISIONAL REFUSAL –**

(once all the procedures *before the Office* have been completed)

Rule 18ter

Statement sent to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 18ter(2) of the Common Regulations under the Madrid Agreement and Protocol

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Protection of the mark is refused for <u>all</u> the goods and/or services.
V. Signature or official seal of the Office sending the statement:
VI. Date:

Model Form 4

**MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION
OF MARKS AND PROTOCOL RELATING TO THAT AGREEMENT**

FURTHER DECISION AFFECTING THE PROTECTION OF A MARK

Rule 18ter

Statement sent to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 18ter(3) of the Common Regulations under the Madrid Agreement and Protocol.

NOTE: This form is to be used where, following the communication of a statement of grant of protection (Rule 18ter(1)(a) or (b) – Model Form 2) or the sending of confirmation of total provisional refusal for all the goods and/or services (Rule 18ter(2) – Model Form 3), a *further* decision affects the protection of the mark – for example, a subsequent decision resulting from an appeal to an authority *outside* the Office, or a case where, following the completion of the regular Office procedures, there has nevertheless been a further decision by the Office, such as *restitutio in integrum*.

This form should not be used for the communication of invalidations under Rule 19 of the Common Regulations.

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Protection is granted to the mark that is the subject of this international registration for the following goods and/or services (Rule 18ter(3)):
V. Signature or official seal of the Office sending the statement:
VI. Date:

Model Form 5

**MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION
OF MARKS AND PROTOCOL RELATING TO THAT AGREEMENT**

INFORMATION RELATING TO POSSIBLE OPPOSITIONS

Rule 16

Communicated to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 16(1) of the Common Regulations under the Madrid Agreement and Protocol.

This form is for use by those Offices that have declared an extended refusal period of 18 months *and* the possibility of notifying a provisional refusal based upon opposition later than 18 months, in certain cases (Article 5(2)(b) and (c) of the Protocol). The form should be used where it has become apparent, with regard to a given international registration, that the opposition period will expire too late for the notifying of a provisional refusal based on opposition within the period of 18 months.

NOTE: If this information is communicated to the International Bureau and no opposition ensues, the Office shall, nevertheless, eventually communicate to the International Bureau the statement of grant of protection provided for by Rule 18ter(1)(a) and Model Form 2.

I. Office communicating the information:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. (a) Date on which the opposition period begins: (b) Date on which the opposition period ends: NOTE: These dates should be indicated where they are known at the time of sending the communication. If they are not yet known, the indication <i>Not known at the date of this communication</i> should be given. In such case, the dates should be communicated as soon as they are known.
V. Signature or official seal of the Office communicating the information:
VI. Date: