



Communicating the status of protection of a mark

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Communicating the status of protection of a mark in a designated Contracting Party

- Interim status
 - Rule 18*bis*
- Grant of protection
 - Rule 18*ter*(1)
- Provisional refusal
 - Rule 17
- Final decisions
 - Rule 18*ter*(2) and (3)
- Further decisions
 - Rule 18*ter* (4)
- Invalidation
 - Rule 19

In 2010 the International Bureau received

- 41,666 statements concerning the interim status of a mark (Rule 18*bis*);
- 84,297 statements of grant of protection (Rule 18*ter*(1));
- 72,009 notifications of provisional refusal (Rule 17);
- 68,775 statements concerning final decisions (Rule 18*ter* (2) y (3))
- 3,629 statements concerning further decisions (Rule 18*ter* (4)); and,
- 448 notifications of invalidation (Rule 19).

Essential content of the communications

- Indication of the kind of communication or reference to the applicable Rule.
- Indication of the Office communicating the information or sending the declaration or notification.
- International registration number and name of the holder.
- Signature or seal of the Office or its equivalent in case of electronic communication.
- Date of the communication.

Interim status – Rule 18*bis*(1)(a)

- Conditions:
 - **without** notification of provisional refusal;
 - *ex officio* examination has been completed;
 - no grounds for refusal; but,
 - protection subject to opposition or observation.
- Content:
 - date by which opposition or observation may be filed, if known.
- Timeliness:
 - optional; but,
 - before the expiry of the applicable refusal time limit.
- Model form:
 - Model form 8 – interim status of a mark.

Interim status – Rule 18*bis*(1)(b)

- Conditions:
 - **after** notification of provisional refusal;
 - *ex officio* examination has been completed;
 - no grounds for refusal; but,
 - protection subject to opposition or observation.
- Content:
 - date by which opposition or observation may be filed, if known.
- Timeliness:
 - optional; but,
 - after sending a notification of provisional refusal.
- Model form:
 - Model form 8 – interim status of a mark.

Grant of protection – Rule 18ter(1)

- Conditions:
 - **without** notification of provisional refusal;
 - **all** procures completed; and,
 - there is no ground to refuse.
- Form:
 - could take the form of a list, electronically or on paper.
- Timeliness:
 - as soon as possible; but,
 - before the expiry of the applicable refusal time limit.
- Model form:
 - Model form 4 – statement of grant of protection.

Provisional refusal following SGP

- The right to declare that protection cannot be granted is provided for in Articles 5(1) of the Agreement and 5(1) of the Protocol.
- The time limit to refuse protection is provided for in Articles 5(2) of the Agreement and 5(2) of the Protocol.
- The statement of grant of protection is a mechanism provided for in Rule 18*ter* (1) of the Common Regulations.
- Could a designated Office send, within the applicable time limit, a notification of provisional refusal following the sending of a statement of grant of protection?

Protection following a provisional refusal – Rule 18ter(2)

- Conditions:
 - **after** notification of provisional refusal;
 - **all** procedures completed; and,
 - provisional refusal is **withdrawn** (total withdrawal); or,
 - protection granted for some goods and services (partial withdrawal or confirmation of partial provisional refusal).
- Content:
 - scope of protection, in a positive manner.
- Timeliness:
 - **after** sending a **total or partial** provisional refusal.
- Model form:
 - Model form 5 – statement of grant of protection following a refusal.

Confirmation of total provisional refusal – Rule 18*ter*(3)

- Conditions:
 - **after** notification of provisional refusal;
 - **all** procedures completed; and,
 - a total provisional refusal is **confirmed**.
- Timeliness:
 - **after** sending a **total** provisional refusal.
- Model form:
 - Model form 6 – confirmation of total provisional refusal.

Further decisions – Rule 18ter(4)

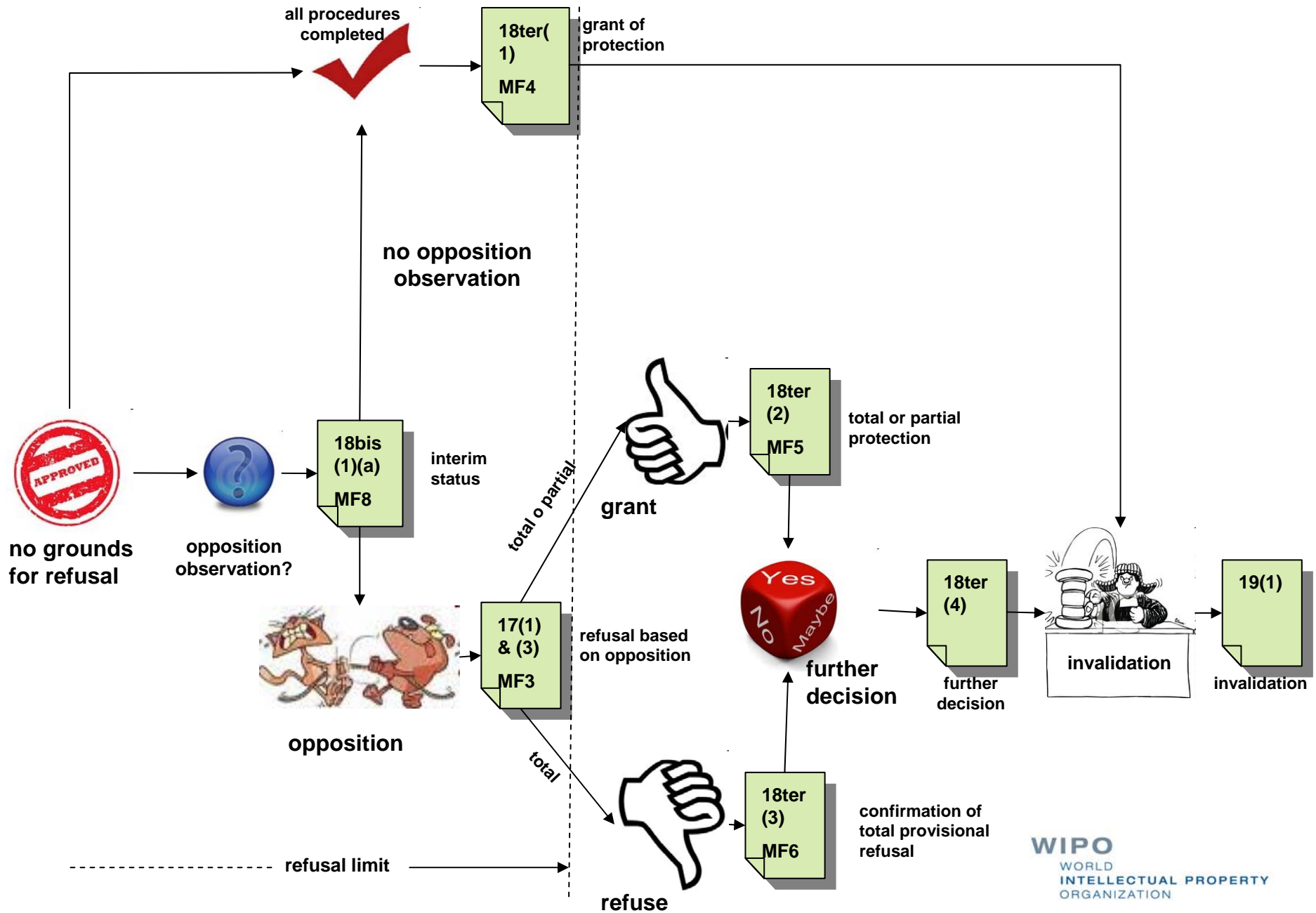
- Conditions:
 - **after** declarations under Rules 18ter(2) o 18ter(3);
 - further decision affects the scope of protection; and,
 - the Office is aware of that decision.
- Content:
 - scope of protection.
- Timeliness:
 - after sending a declaration concerning a final decision.
- Model form:
 - Model form 7 – further decision affecting the protection of the mark.

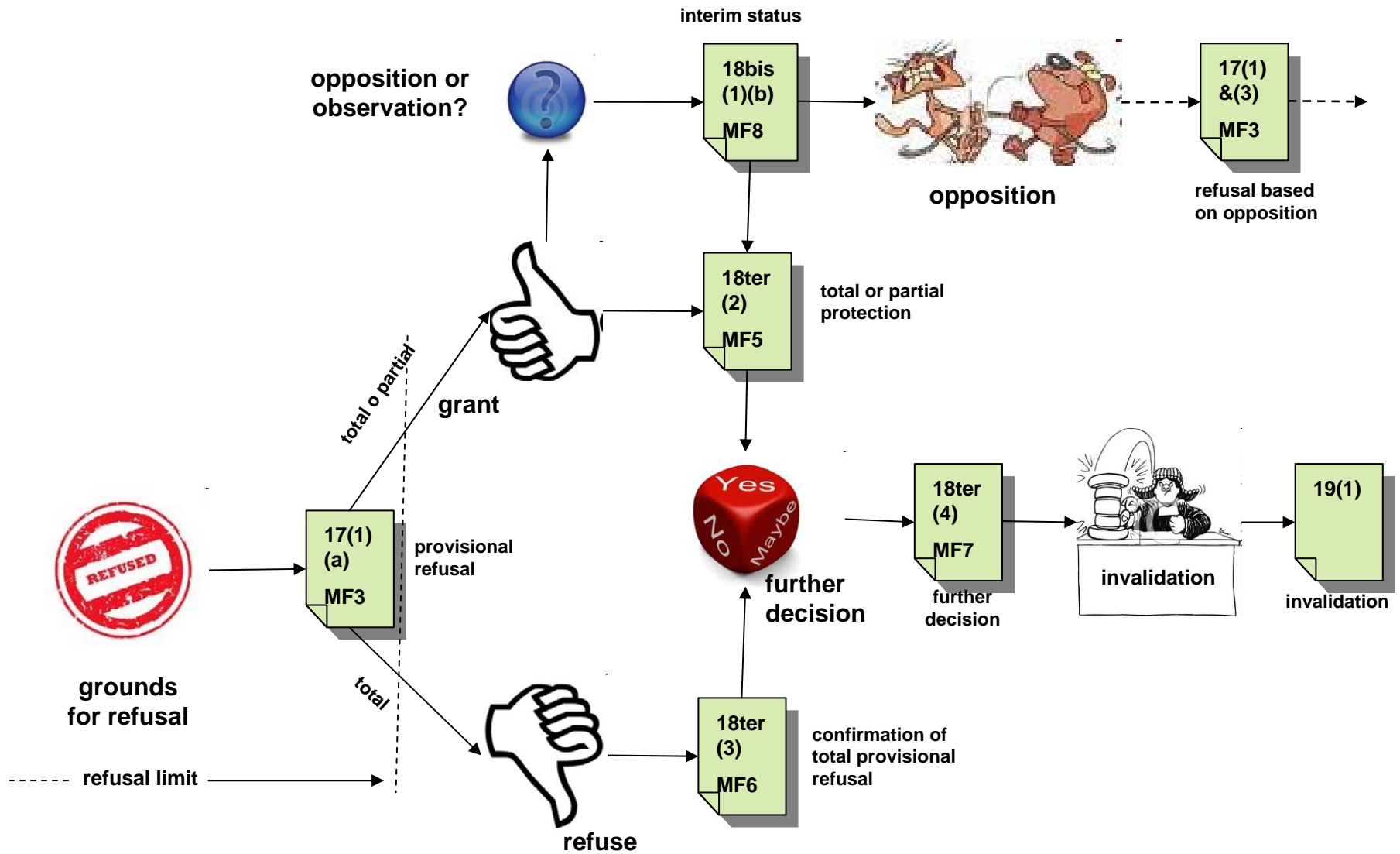
Further decisions following SGP

- Rule 18ter(4) indicates that the statement concerning a further decision following the sending of statements under paragraphs (2) and (3).
- An interpretative statement of Rule 18ter(4) indicates that the reference to a further decision also includes the case of a decision taken by an Office, “*notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed*”.
- Could an Office send a statement under Rule 18ter(4) following the sending of a statement under Rule 18ter(1)?

Invalidation – Rule 19

- The decision:
 - has observed due process, Articles 5(6) of the Agreement and 5(6) of the Protocol;
 - the effects of an international registration are invalidated; and,
 - is not subject to appeal.
- Content:
 - the authority;
 - IRN and name of the holder;
 - scope of the invalidation;
 - the fact that the decision is not subject to appeal;
 - the date the decision was pronounced and, if known, the effective date.





Thank you

