



# How to Handle a Provisional Refusal of Protection

Madrid Webinar

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**Geneva**  
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**2019**

# Structure of the Webinar

- Presentation : How to handle a provisional refusal
- Interactive questions during the webinar
- Questions & Answer session at the end
- Presentation slides available for download. Recording will be uploaded on the [Madrid Webinar page](#).
- Short survey to provide feedback

# Effects of the International Registration (Article 4)

The International 'Registration' (IR) =

- **A National Application**  
until the expiry of the time limit for issuing a refusal
- **A National Registration**  
once the time limit for issuing a refusal has expired  
(assuming no refusal or refusal withdrawn)

# Various Statements from dCP

- Offices of designated Contracting Parties (dCP) may communicate the status of protection of a mark through various statements in the course of their examination:
  - Possibility of oppositions filed after 18 months – Rule 16
  - Provisional refusal – Rule 17
  - Grant of protection – Rule 18*ter*(1)
  - « Final » decision – Rule 18*ter*(2) and (3)
  - Further decision – Rule 18*ter*(4)
  - Invalidation – Rule 19

# Limitations on the Right to refuse Protection

- Time Limit
- Grounds

# Time Limit

- 12 months

Mandatory under Art. 9sexies(1)(b)

- 18 months

Optional under Article 5(2)(b) of the Protocol

- '18 months +' in the event of a refusal based on opposition

Optional under Article 5(2)(c) of the Protocol

From the Notification Date of the IR or the Subsequent Designation by the International Bureau (IB)

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**NOTIFICATION**


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(continued)

software, computer programming, including development of software to link robot software with applications and manufacturing software.

*Basic application* European Union, 18.06.2018, 017918780

*Basic registration* European Union, 30.11.2018, 017918780

*Data relating to priority under the Paris Convention* European Union, 18.06.2018, 017918780

*Designations under the Madrid Protocol* Australia, China, India, Japan, Mexico, Norway, Republic of Korea, Singapore, Thailand, Turkey, United Kingdom, United States of America, Viet Nam

*Declaration of intention to use the mark* India, Singapore, United Kingdom, United States of America

*Date of notification* 31.01.2019

*Language of the international application* English

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# Declarations made by Contracting Parties of the Madrid System under the Agreement, the Protocol and the Common Regulations

Status on January 31, 2019

(a)	<b>Article 5(2)(b) of the Protocol (extension to 18 months of the refusal period)</b>
	<p>African Intellectual Property Organization (OAPI), Algeria, Antigua and Barbuda, Armenia, Australia, Bahrain, Belarus, Brunei Darussalam, Bulgaria, Cambodia, China, Colombia, Cyprus, Denmark, Estonia, European Union, Finland, Gambia, Georgia, Ghana, Greece, Iceland, India, Indonesia, Iran, Ireland, Israel, Italy, Japan, Kenya, Lao People's Democratic Republic, Liechtenstein, Lithuania, Madagascar, Malawi, Mexico, New Zealand, Norway, Oman, Philippines, Poland, Republic of Korea, Samoa, San Marino, Singapore, Slovakia, Sweden, Switzerland, Syrian Arab Republic, Tajikistan, Thailand, Tunisia, Turkey, Turkmenistan, Ukraine, United Kingdom, United States of America, Uzbekistan, Zimbabwe.</p>



# Time limit - Example

Office of Origin or  
Office of the  
Contracting Party of  
the holder



China

AP



AP

designated  
Contracting  
Party



Switzerland

\* By virtue of Article 9*sexies*(1)(a) of the Madrid  
Protocol

# Time Limit - Example (Cont'd)

Switzerland has opted for a refusal period of 18 months

## Question

Applicable time limit ?

12 months

18 months

**By virtue of Article 9sexies(1)(b) of the Madrid Protocol**

# Non-Valid Grounds for Refusal

- Disagreement over the classification of the goods/services (Rule 12)
- Banning of multi-class registration or obligation of a limited number of goods or services (Art. 5(1))

# Acceptable Grounds for Refusal

[art. 6quinquies(B) Paris Convention, art. 5 A & P]

## ■ Absolute Grounds:

- Mark is descriptive
- Mark lacks distinctive character
- Mark is contrary to morality or public order, is deceptive, etc.

## ■ Relative Grounds:

- Prior rights (citation or opposition)
- Vagueness of G/S

# Notification of Refusal – 1st Stage – The Provisional Refusal

## **prescribed content (Rule 17(2))**

- Office making the notification
- IRN
- All the grounds, together with a reference to the corresponding provisions of the law
- Where applicable, details of prior rights
- Scope
- Time limit and competent Authority for appeal
- Date & Signature

# Notification of Refusal – 1st Stage – The Provisional Refusal

## **prescribed content cont'd (Rule 17(2)(v))**

- Where applicable, details of prior rights:
  - Filing date and number
  - Registration date and number (if available)
  - Name and address of the holder
  - Reproduction of the mark
  - List of G/S

# Irregular Refusals

## Rule 18

- Two Types of Irregularity:
  - those that can be remedied, and
  - those that cannot be remedied

# Irregular Refusals

## Defects :

- Not signed
- No indication of affected goods or services
- Details of conflicting mark(s) not included

**2 Months to rectify**

(However the Provisional Refusal is registered and sent to the holder)



# What is Wrong here?



VII. The mark is refused for the following goods and/or services:

3: Bleaching preparations and other substances for laundry, cleaning, polishing, scouring and abrasive preparations.

9: life (life-saving) and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, magnetic data carriers, recording discs, compact discs, cash registers, calculating machines, software, mobile phone accessories, signaling apparatus and instruments, checking (supervision) apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, DVDs and other digital media, data processing equipment and computers, surveying apparatus and instruments, measuring apparatus and instruments, 科学设备及仪器, nautical apparatus and instruments.

# Goods Listed in non-Madrid Language

VII. The mark is refused for the following goods and/or services:

3: Bleaching preparations and other substances for laundry, cleaning, polishing, scouring and abrasive preparations.

9: life (life-saving) and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, magnetic data carriers, recording discs, compact discs, cash registers, calculating machines, software, mobile phone accessories, signaling apparatus and instruments, checking (supervision) apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, DVDs and other digital media, data processing equipment and computers, surveying apparatus and instruments, measuring apparatus and instruments, nautical apparatus and instruments.

科学设备及仪器,

# What is Wrong here?



1385936	---	DEVICE OF HANDS	0-	TATA CHEMICALS LIMITED	BOMBAY HOUSE, 24, HOMI MODY STREET, MUMBAI-400 001.	Registered	
APPLICATION DATE : 20/09/2005 14:02:00		USER DATE :		Priority Claimed :			
GOODS/SERVICE : CLOTHING AND WEARING APPARELS OF ALL SORTS INCLUDING HOSIERY AND FOOTWEAR INCLUDED IN CLASS 25.							
SHOP - 7/R.							

# No Reproduction of the Cited Mark

1385936	---	DEVICE OF HANDS	0-	TATA CHEMICALS LIMITED	BOMBAY HOUSE, 24, HOMI MODY STREET, MUMBAI-400 001.	Registered	
APPLICATION DATE : 20/09/2005 14:02:00		USER DATE :		Priority Claimed :			
GOODS/SERVICE : CLOTHING AND WEARING APPARELS OF ALL SORTS INCLUDING HOSIERY AND FOOTWEAR INCLUDED IN CLASS 25.							
SHOP - 7/R.							

# Irregular Refusals

## Defects :

- Time limit (for appeal) not mentioned
- Competent authority (for appeal) not mentioned
- Opposition time limits not mentioned

**2 months to rectify**

(Compulsory to avoid a letter of abandonment)

# What is Wrong here?

Reykjavík, 30. June 2015

Our ref.: 4.1 VU0747/2015

Your ref.: 1237100

**Regarding: Notification of an ex officio provisional refusal of protection according to Article 5 and Rule 17(1).**

## 1. Notifying office:

Icelandic Patent Office  
Engjateigur 3, IS-150 Reykjavík, Iceland

Telephone: + (354) 580 9400  
Telefax: + (354) 580 9401

## 2. International registration number: 1237100

**UNIBET**

3. Mark: **By players, for players**

4. Holder of the international registration: Unibet (International) Ltd., Fawwara Bldgs., Msida Road, Gzira GZR 1402 (MT)

5. Time limit to request a review: **30.06.2015** (see item 9).



# Time Limit to Request a Review = the Actual date of the Refusal

Reykjavík, 30. June 2015

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Your ref.: 1237100

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# What is Wrong here ?



IX. Corresponding essential provisions of the applicable law [(see text under XII)]:

Article 8(a)

X. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal: 3 months.

(ii) Authority to which such request for review or appeal should be made:

Israeli Patent Office, Trademarks Department

1 Agudat Sport Hapoel St., Technological Garden, Building No. 5,

Jerusalem, 96951, Israel

Phone: 972-2-5651627, Fax: 972-2-6467026

E-mail: [trademarks@justice.gov.il](mailto:trademarks@justice.gov.il)

(iii) Indications concerning the appointment of a representative:

The representative must be domiciled in Israel.

XI. Date of the notification of provisional refusal: 02/05/2011



# Beginning/End of the Time Limit period ?

IX. Corresponding essential provisions of the applicable law [(see text under XII)]:  
Article 8(a)

X. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal: 3 months.

(ii) Authority to which such request for review or appeal should be made:  
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Jerusalem, 96951, Israel  
Phone: 972-2-5651627, Fax: 972-2-6467026  
E-mail: [trademarks@justice.gov.il](mailto:trademarks@justice.gov.il)

(iii) Indications concerning the appointment of a representative:  
The representative must be domiciled in Israel.

XI. Date of the notification of provisional refusal: 02/05/2011

# What is Wrong here ?



VIII. Corresponding essential provisions of the applicable law (see text under XII):  
Article 6.3.1

IX. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal:

3 months from the date of the notification of provisional refusal. This period may be extended for no more than 6 months provided that the relevant request is submitted and the fee in connection with the request is paid before the date of expiry of this period.

(ii) Indications concerning the appointment of a representative:

[http://www.sdip.gov.ua/en/attorneys\\_register\\_2.html](http://www.sdip.gov.ua/en/attorneys_register_2.html)

X. Date of the notification of provisional refusal: 08.12.2011

# No indication of a Competent Authority

VIII. Corresponding essential provisions of the applicable law (see text under XII):  
Article 6.3.1

IX. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal:

3 months from the date of the notification of provisional refusal. This period may be extended for no more than 6 months provided that the relevant request is submitted and the fee in connection with the request is paid before the date of expiry of this period.

(ii) Indications concerning the appointment of a representative:

[http://www.sdip.gov.ua/en/attorneys\\_register\\_2.html](http://www.sdip.gov.ua/en/attorneys_register_2.html)

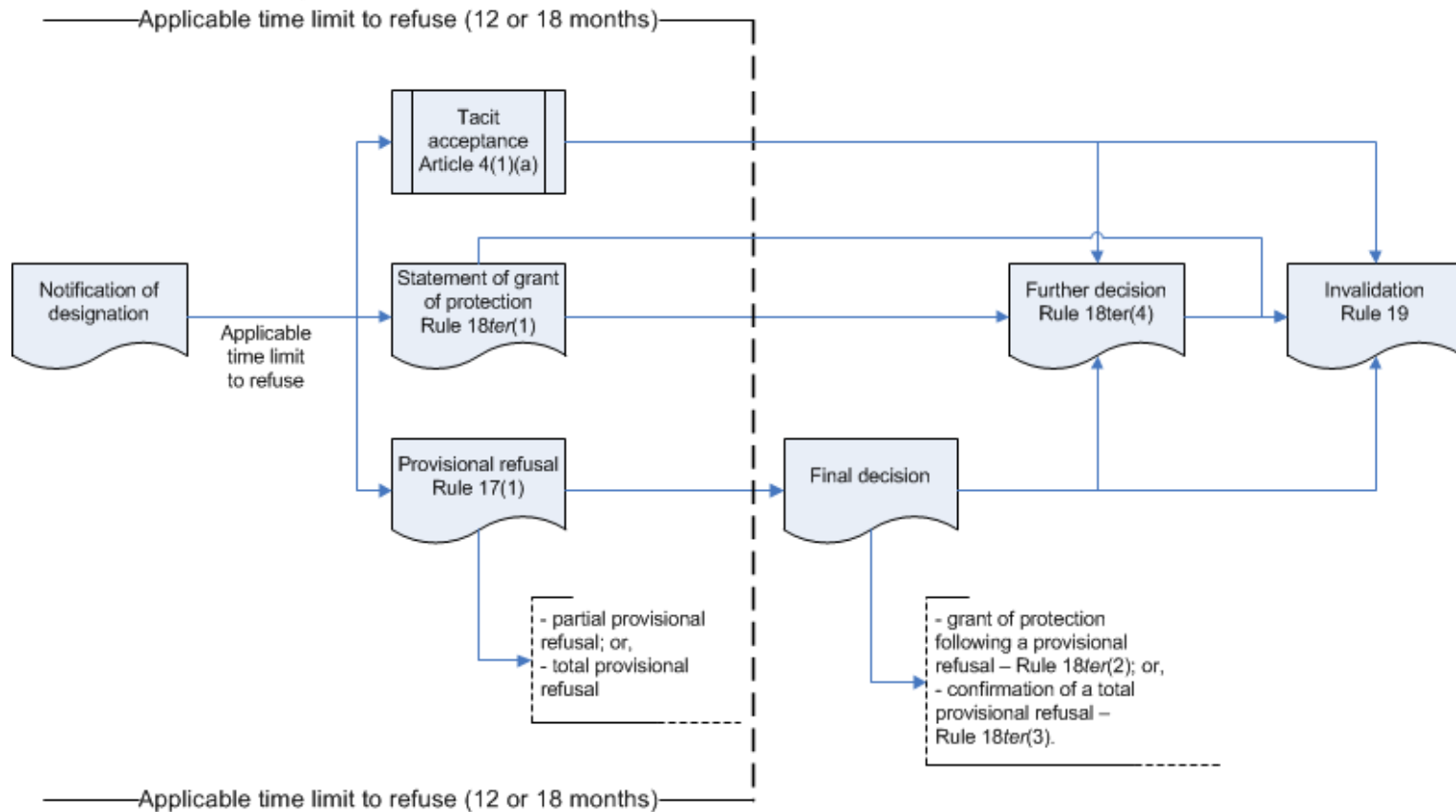
X. Date of the notification of provisional refusal: 08.12.2011

# Irregular Refusals

Not considered a Refusal if:

- IR number is missing
- No grounds are indicated
- Refusal is received after the time limit

However, the IB will send a copy to the holder for information.



# Tips – Responding to Refusals

- Initial deadlines set by national law/practice
- Subsequent procedure and substance governed by national law/practice
- Check [Madrid Member Profiles Database](#)
- Beware of «fake» total Refusals
- Appoint trusted local representatives to advise on:
  - Local procedure
  - Substantive issues

# Questions?



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