



WIPO | MADRID

The International
Trademark System

Roles and obligations of an IP Office in the Madrid System

WIPO Regional Training Workshop on IPAS for Trademark Examiners

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Madrid Registry

**Gaborone,
July 13, 2017**

Agenda

- Introduction
- Role as the Office of origin of an international application
 - Certification of international applications
 - Irregularities in international applications
 - Ceasing of effect
- Role as the Office of a designated Contracting Party
 - Effects of an international registration
 - Communications within the refusal period
 - Communications following a provisional refusal
 - Further decision and invalidation
 - Centralized management

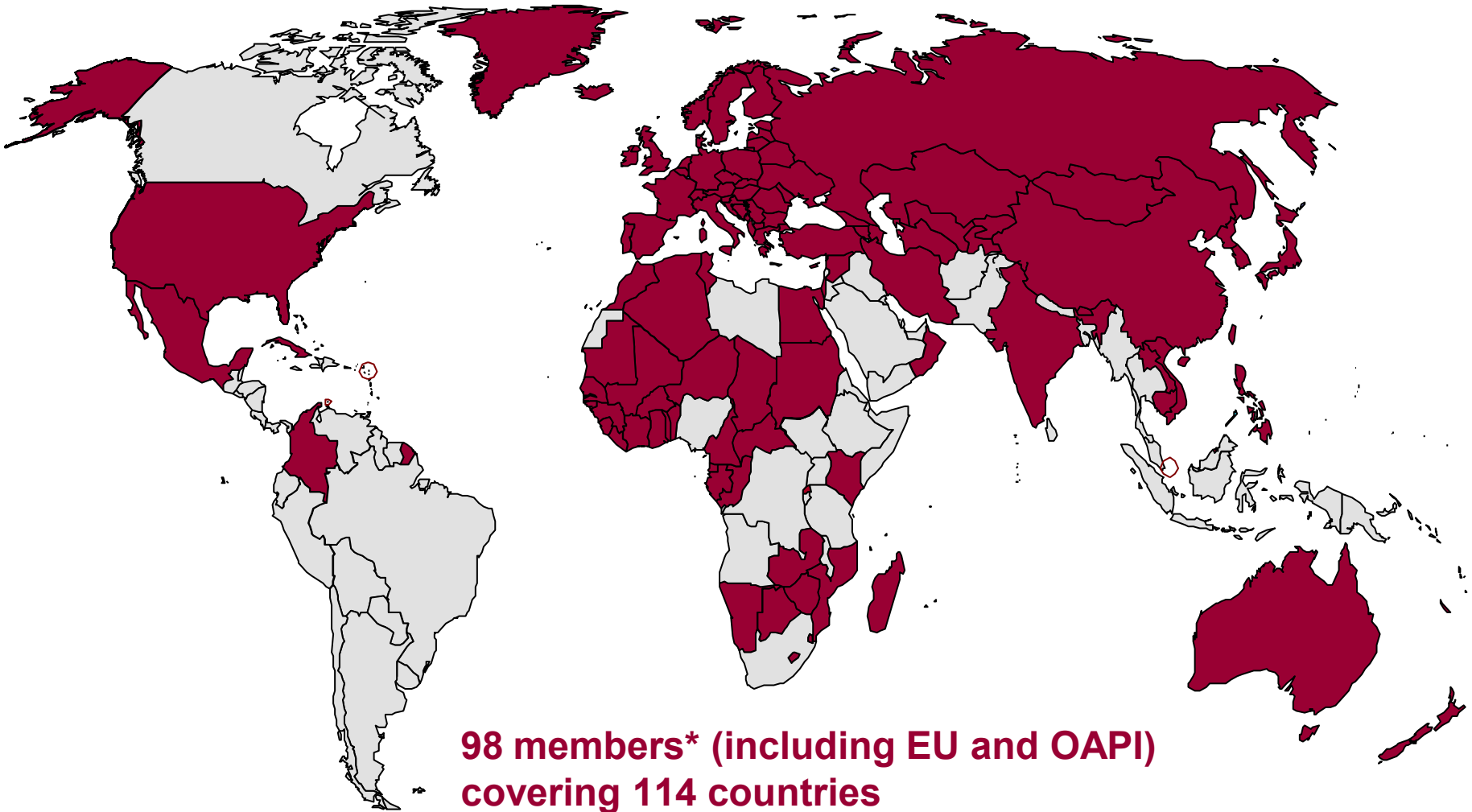
Introduction

The Madrid system

A global registration system facilitating the protection of marks through a simple, expeditious and cost-effective procedure for the central:

- filing of requests for protection; and,
- management of acquired rights

Members of the Madrid System



**98 members* (including EU and OAPI)
covering 114 countries**

WIPO | MADRID
The International
Trademark System

*All are party to the Protocol, the governing treaty, while 55 are also party to the Agreement

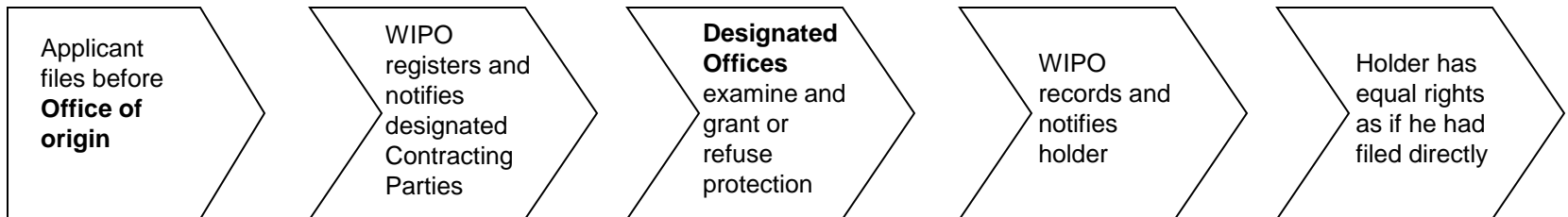
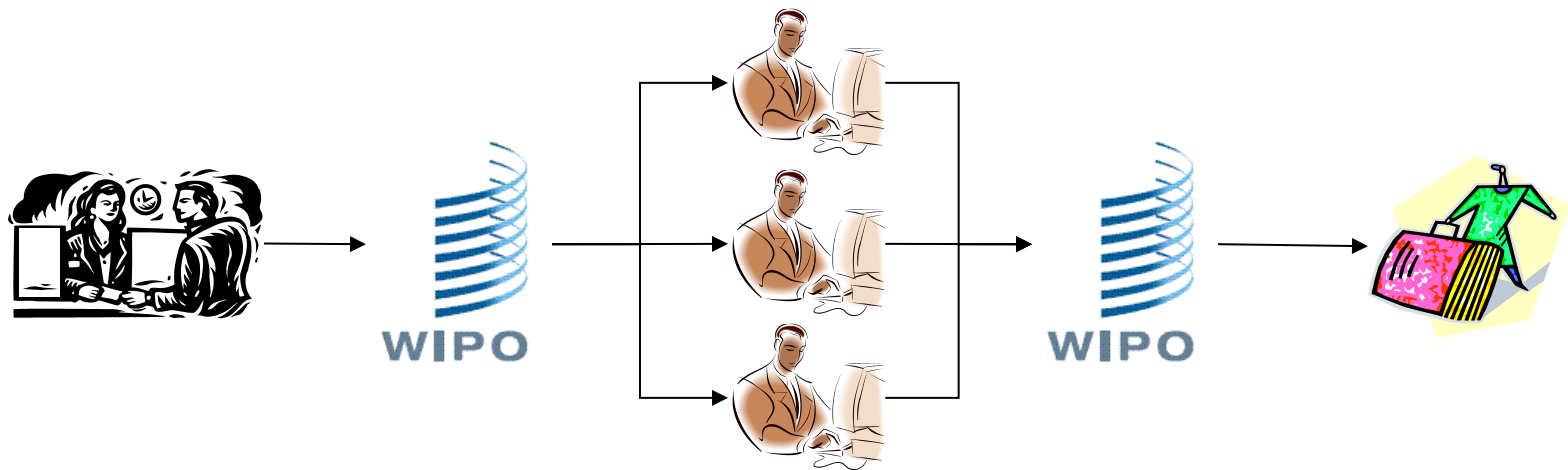
Legal framework

- Paris Convention (1883)
as in force on September 28, 1979
- **Madrid Agreement (1891)**
latest revised in 1979
- Madrid Protocol (1989)
as in force from September 1, 2008
- Common Regulations
as in force from April 1, 2016
- Administrative Instructions
as in force from January 1, 2008
- **Laws, regulations and practices of each Contracting Party**

Main features

- Application or registration of a mark (basic mark) in a CP
- Connection between the holder and that CP: establishment, domicile, or nationality
- International application filed through Office of that CP (Office of origin) in E/F/S
- International application must designate at least one CP, other than the CP of origin
- Bundle of fees in Swiss francs (basic + standard or individual fees)
- Time limit for the Office of designated CP to refuse protection (12 – 18 months +)
- Further CP may be designated following the registration (subsequent designation)
- International registration depends on fate of basic mark for five years (dependency – central attack – transformation)
- 10-year period of protection, renewable for similar periods
- Centralized management of IR direct with the International Bureau

Madrid international procedure



Roles and responsibilities of an Office in the Madrid System

As Office of origin

- Inform and support users
- Receive, examine, certify and transmit to WIPO the international application
- Remedy certain irregularities in the international application
- Monitor basic mark and notify ceasing of effect
- Transmit to WIPO requests from holders

As Office of a designated Contracting Party

- Substantive examination of international registrations
- Send WIPO grant of protection or notify provisional refusal
- When refused, send WIPO final decision
- Send WIPO further decisions or notify invalidation
- Examine licenses, limitations and change in ownership and notify WIPO they have no effect

Role as the Office of origin of an international application

Certification of international applications

Certification and Signature by the OO

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 12/05/2014 (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) appears also in the basic application or the basic registration, as the case may be,
 that the mark in item 7(a) is the same as 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, the same claim is included in item 8 or that, if color is claimed in item 8 without having been 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: THE SWEDISH PATENT AND REGISTRATION OFFICE

Kerstin Dullaghan

Name and signature of the official signing on behalf of the Office: 16/05/2014

K Dullaghan

Office of origin must certify that

- the name of the applicant is the same in the basic mark
- the reproduction corresponds to the basic mark
- claims that the mark is a color, 3-D, sound, collective, certification or guarantee mark appear in the basic mark
- colors claimed are also claimed or appear in the basic mark
- G&S are covered by the basic mark

Is there correspondence?

International application

MONACO



Basic Mark

MONACO



Are G&s covered by basic mark?

- Basic application or registration:

classes 7, 9 and 25

International application:

classes 7 and 25



- Basic application or registration:

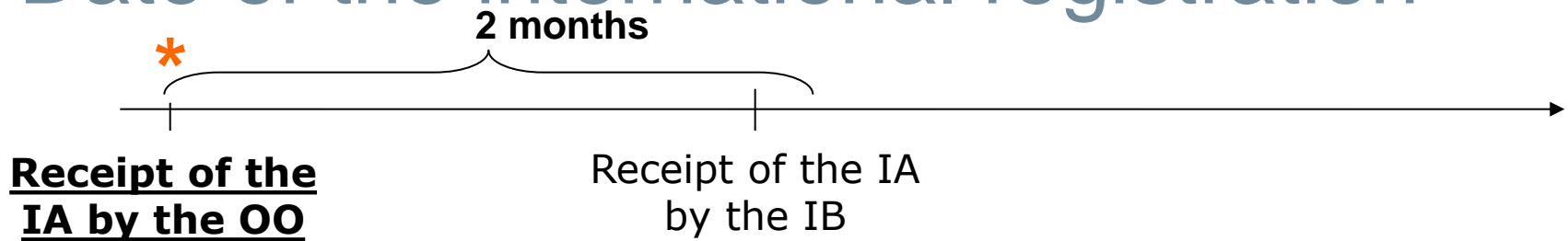
class 7: cutting machines; metalworking machines

International application:

class 7: machines



Date of the international registration



Irregularities in international applications

Irregular international application

■ Formalities

no certification, using wrong form, no indication of entitlement, missing form MM18, no payment, etc. (Rule 11)

■ Classification of goods and services

no indication of class or terms wrongly classified (Rule 12)

■ Indications of goods and services

linguistically incorrect, incomprehensible or too vague for the purposes of classification (Rule 13)

Consequences

- **Formalities (Rule 11)**
where not remedied, application is declared abandoned
- **Classification of goods and services (Rule 12)**
recorded with the classification considered to be correct by the International Bureau; applicant has a new deadline to pay any additional fees
- **Indications of goods and services (Rule 13)**
without a satisfactory proposal from Office of origin, original term is inscribed with a note from the International Bureau

Remedying an irregular application

Office of origin:

- using wrong form
- defective application (missing applicant, mark, goods and services or designations)
- missing or defective entitlement
- missing number or date of basic mark
- irregular certification
- goods and services (Rules 12 y 13)

Applicant:

- address not sufficient for postal communication
- unclear reproduction of the mark
- missing transliteration
- description of the mark not in a working language
- insufficient fees
- missing form MM18

Time-limit to remedy irregularities

- A late priority claim will be disregarded
- Where form MM18 is not received by WIPO within two months from date on which international application was received by the Office of origin, designation of the US is disregarded
- Other irregularities must be remedied within three months from their notification

Ceasing of effect

Independence

Article 6(2)

Upon the expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

Before the expiry of the dependency period

The basic application is

withdrawn

the subject of a final decision of rejection

The basic or resulting registration

lapses

is renounced

is the subject of a final decision of revocation, cancellation or invalidation

Basic application

After the expiry of the dependency period, the basic application is

the subject of a final decision of rejection resulting from

an appeal against a decision refusing the effects of the basic application which began before the expiry of such period

an opposition to the basic application which began before the expiry of such period

the subject of a final decision ordering its withdrawal resulting from an action requesting such withdrawal which began before the expiry of such period

withdrawn while being still the subject of a proceeding in the above-mentioned appeal, opposition or action

Basic or resulting registration

After the expiry of the dependency period, the registration (basic or resulting) is

the subject of a final decision of revocation, cancellation or invalidation resulting from an action requesting such revocation, cancellation or invalidation which begun before the expiry of such period

renounced while being still the subject of a proceeding in the above-mentioned action.

Article 6(4)

The Office
of origin
must

notify the International Bureau the facts and
decisions relevant under paragraph (3)

request the International Bureau to cancel, to the
extent applicable, the international registration

The
International
Bureau
must

notify interested parties and publish

cancel the international registration to the extent
requested by the Office of origin

MF9 – Ceasing of effect

MADRID PROTOCOL

Model Form 9: Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration, and request for cancellation of the international registration (Rule 22(1)(a) or (c) and (2)(b) of the Common Regulations)

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Facts and decisions affecting the basic application, the registration resulting therefrom, or the basic registration and their effective date: <i>Please briefly state these facts and decisions:</i> Voluntary information: <input type="checkbox"/> Not resulting from an action brought by a third party <input type="checkbox"/> Resulting from an action brought by a third party, for example, an opposition or a request for cancellation ("central attack").
V.	Effective date of these facts and decisions:

VI.	Goods and services affected by the facts and decisions: <i>Please choose only one of the following options and, where applicable, list the goods and/or services:</i> Total cancellation: <input type="checkbox"/> The facts and decisions affect all the goods and/or services of the international registration Partial cancellation: <input type="checkbox"/> The facts and decisions affect only the goods and/or services of the international registration listed below <input type="checkbox"/> The facts and decisions do not affect the goods and/or services of the international registration listed below List of goods and /or services:
VII.	Request for the cancellation of the international registration: In accordance with Article 6(4) of the Madrid Protocol, the undersigned Office hereby requests the cancellation of the international registration to the extent indicated under item VI.
VIII.	Signature or official seal of the Office making the notification:
IX.	Date of notification to the International Bureau:

Role as the Office of a designated Contracting Party

Effects of an international registration

Effects of an international registration



CERTIFICATE OF REGISTRATION

The International Bureau of the World Intellectual Property Organization (WIPO) certifies that the indications appearing in the present certificate conform to the recording made in the International Register of Marks maintained under the Madrid Agreement and Protocol.

Reproduction of the mark



Registration number 879 539
 Registration date December 27, 2005
 Date next payment due December 27, 2015
 Name and address of holder Organisation Mondiale de la Propriété Intellectuelle
 34 chemin des Colombettes, CH-1211 Genève 20 (Switzerland)
 Legal nature of the holder (legal entity) and place of organization Organisation Intergouvernementale
 Classification of figurative elements 16.3; 27.5
 List of goods and services NCL(8)
 16 Manuals, printed matter and pamphlets; instructional and teaching material (except apparatus)
 35 Clerical services for data banks (including statistical data), in connection with the provision of information in the field of patents of invention, including collection, updating, editing, formatting, development and analysis of such data.
 Basic registration Switzerland, 19.07.2005, 538720
 Data relating to priority under the Paris Convention Switzerland, 19.07.2005, 538720
 Designations under the Madrid Protocol Australia, European Community, Japan, Republic of Korea, Singapore, United States of America
 Declaration of intention to use the mark Singapore, United States of America
 Date of notification 20.04.2006
 Language of the international application English

Asta Valdimarsdóttir
 Ásta Valdimarsdóttir
 Head of the Operations Service
 Madrid Registry
 Brands and Designs Sector

Geneva, April 20, 2006

From the date of the international registration or of the subsequent designation, it has the effects of:

- an application filed with the Office of the designated CPs; and,
- a registration effected by the Office of the designated CPs where protection is not refused within the applicable time limit or refusal is withdrawn

NOTIFICATION

ENN/2015/11

Reproduction of the mark in
color under Rule 9.4(a)(vii)



Registration number	1 239 997
Registration date	January 16, 2015
Date next payment due	February 8, 2016
Name and address of holder	NINA'S INTERNATIONAL 29 rue Danielle Casanova, F-75001 PARIS (France)
Legal nature of the holder (legal entity) and place of organization	SARL (société à responsabilité limitée), FRANCE
Name and address of the representative	GASQUET Denis, Cabinet GASQUET, Les Pléiades n°24C, PARK NORD ANNECY, F-74370 METZ-TESSY (France)
Classification of figurative elements	2.3; 5.13; 24.11; 25.1; 27.5; 29.1
Colors claimed	Pink, red and gold.
List of goods and services NCL(10-2015)	3 Soaps; perfumes; essential oils; cosmetics; hair lotions; dentifrices; make-up removing products; lipsticks; beauty masks; face and body creams; all the aforesaid goods are of French origin.
Basic application	France, 17.12.2014, 14 4 142 745
Data relating to priority under the Paris Convention	France, 17.12.2014, 14 4 142 745
Designations under the Madrid Protocol	European Community, Japan, Republic of Korea, Singapore, United States of America
Designations under the Madrid Protocol by virtue of Article 9sexies	China, Mongolia, Russian Federation, Viet Nam

**18 months
from this date**

Date of notification 26.03.2015

NOTIFICATION

EXN/2016/42

Reproduction of the mark **PROGRESSO**

Registration number **135 832**

Subsequent designations under
the Madrid Protocol United States of America

Declaration of intention to use
the mark United States of America

Date of subsequent designation **August 23, 2016**

Date of notification 27.10.2016

18 months
from this date

International registration
concerned **135 832**

Registration date **April 14, 1948**

Date of the renewal **April 14, 2008**

Date next payment due **April 14, 2018**

Declaration of intention to use
the mark United States of America

Name and address of holder KOH-I-NOOR HARDTMUTH a.s.
F.A. Gerstnera 21/3, CZ-371 30 České Budějovice (Czech
Republic)

Name and address
of the representative KOREJZOVÁ & SPOL., v.o.s. JUDr. Petra Korejzová, Korunní
810/104 E, CZ-101 00 Praha 10 (Czech Republic)

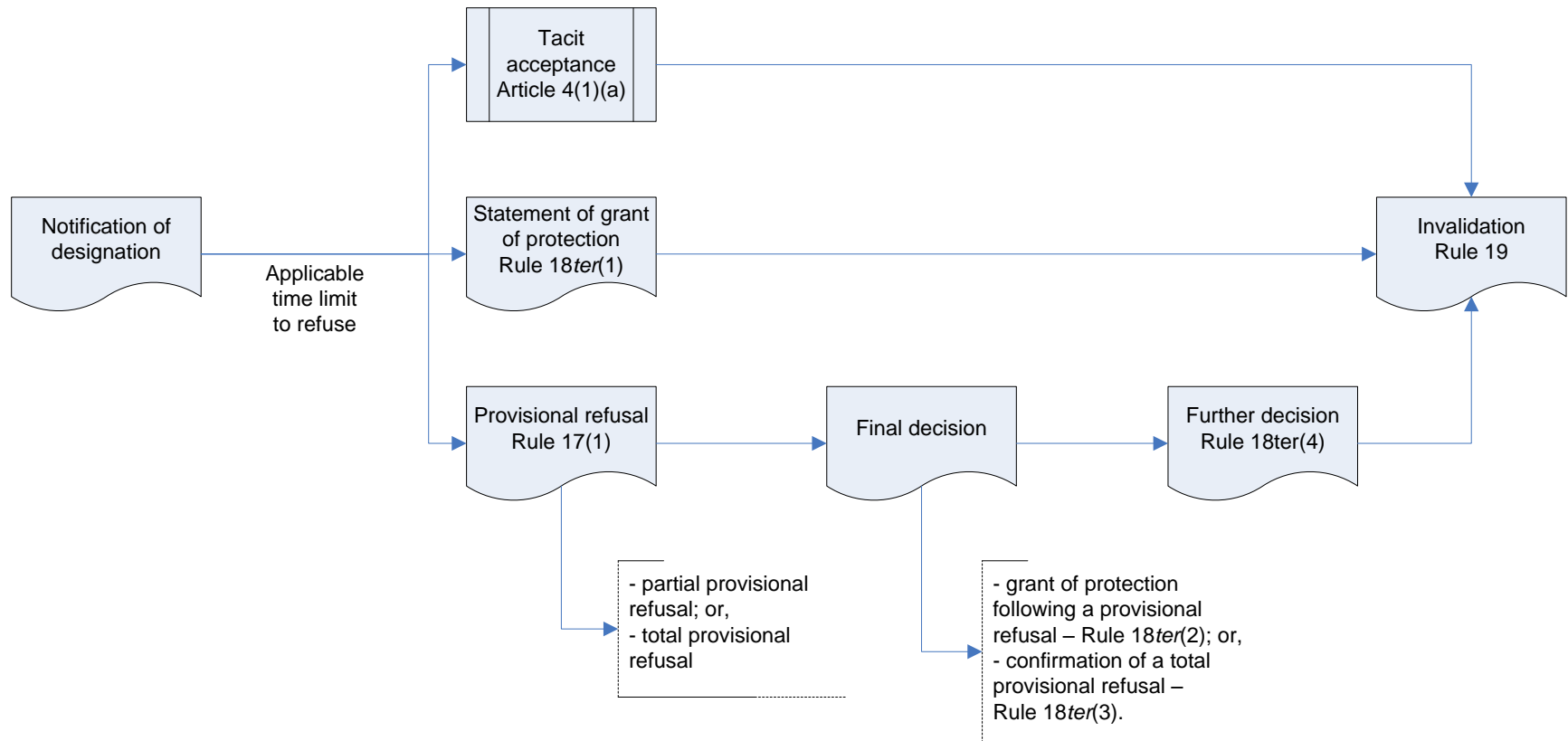
List of goods and services 16 Ordinary pencils, colored pencils, copying pencils and wood-
free chalks.

Basic registration Czechoslovakia, 24.07.1960, 113 395

Basic application Czechoslovakia, 24.07.1940, 2850

Language of
the international application French

Decisions by Offices of designated CPs



Communications before the expiry of the refusal period

Communications before the expiry of the refusal period

- Statement of grant of protection (Rule 18*ter*(1))
- Notification of provisional refusal (Rule 17(1))

Statement of grant of Protection

MF4 – Statement of Grant of Protection under Rule 18ter(1)

- Within refusal period
- No grounds to refuse
- **All** procures completed

MADRID PROTOCOL

Model Form 4: Final Disposition on Status of a Mark – Statement of Total Grant of Protection (Rule 18ter(1) of the Common Regulations)


I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder:
IV.	Protection is granted to the mark that is the subject of this international registration for all the goods and/or all the services for which protection has been requested.
V.	Signature or official seal of the Office sending the statement:
VI.	Date of notification to the International Bureau:



www.iponz.govt.nz
INTERNATIONAL: +64 4 962 2607
NATIONAL: 0508 4-IPONZ
(0508 447 669)

MADRID PROTOCOL AND AGREEMENT
FINAL DISPOSITION ON STATUS OF A MARK
– STATEMENT OF GRANT OF PROTECTION –

Rule 18ter(1)

I.	Office sending the statement: Intellectual Property Office of New Zealand
II.	Number of the international registration: 1023333 Number of the New Zealand trade mark: 1046301
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed): Wella GmbH
IV.	Mark Reproduction : 3D-SCULPT
V.	Protection is granted to the mark that is the subject of this international registration for all the goods and/or all the services requested.
VI.	Signature or official seal of the Office sending the statement: Intellectual Property Office of New Zealand  NEW ZEALAND INTELLECTUAL PROPERTY OFFICE



CERTIFICATE OF REGISTRATION
TRADE MARK

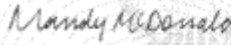
TRADE MARK REGISTRATION NUMBER: **1046301**
INTERNATIONAL REGISTRATION NUMBER: **1023333**

In accordance with the Trade Marks Act 2002 this trade mark was entered on the register of trade marks on **1 November 2016** with a deemed registration date of **29 March 2016**. The details of registration are:

3D-SCULPT

Owner(s): **Wella GmbH, Sulzbacher Straße 40, 65824 Schwalbach am Taunus, Germany**

In respect of the goods and services that follow.


Mandy McDonald
Commissioner of Trade Marks
Issued on 1 November 2016



MINISTRY OF BUSINESS,
INDUSTRY & EMPLOYMENT
TRADE MARKS ACT 2002

New Zealand Government

Provisional refusal

MF3A – Total provisional refusal

MADRID PROTOCOL

Model Form 3A: Total Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)

I. Office making the notification:
II. Number of the international registration:
III. Name of the holder:
IV. Information concerning the type of provisional refusal: <i>Please indicate the type of refusal by checking only one of the following options:</i> <input type="checkbox"/> Total provisional refusal based on an <i>ex officio</i> examination <input type="checkbox"/> Total provisional refusal based on an opposition <input type="checkbox"/> Total provisional refusal based on both an <i>ex officio</i> examination and an opposition <i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i> (i) Name of the opponent: (ii) Address of the opponent:
V. Information concerning the scope of the provisional refusal: Total provisional refusal affects all the goods and/or services.
VI. Grounds for refusal [(where applicable, see item VII)]:

VII. Information relating to an earlier mark: (i) Filing date and number, and, if any, priority date: (ii) Registration date and number (if available): (iii) Name and address of the owner: (iv) Reproduction of the mark: (v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):
VIII. Corresponding essential provisions of the applicable law:
IX. Information relating to the possibility to request a review or file an appeal: (i) Time limit for requesting review or appeal: (ii) Authority to which such request for review or appeal should be made: (iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party: (iv) Other requirements, if any:
X. Signature or official seal of the Office making the notification:
XI. Date of the notification to the International Bureau:

MF3B – Partial Provisional refusal

MADRID PROTOCOL

Model Form 3B: Partial Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)

I. Office making the notification:
II. Number of the international registration:
III. Name of the holder:
<p>IV. Information concerning the type of provisional refusal:</p> <p><i>Please indicate the type of refusal by checking only one of the following options:</i></p> <p><input type="checkbox"/> Partial provisional refusal based on an <i>ex officio</i> examination</p> <p><input type="checkbox"/> Partial provisional refusal based on an opposition</p> <p><input type="checkbox"/> Partial provisional refusal based on both an <i>ex officio</i> examination and an opposition</p> <p><i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i></p> <p>(i) Name of the opponent:</p> <p>(ii) Address of the opponent:</p>
<p>V. Information concerning the scope of the provisional refusal:</p> <p><i>Please indicate the scope of the refusal, by choosing one of the two listed options below and, where applicable, list the relevant goods and/or services:</i></p> <p><input type="checkbox"/> Partial provisional refusal affects only the following goods and/or services:</p> <p><input type="checkbox"/> Partial provisional refusal does NOT affect the following goods and/or services:</p> <p>List of goods and/or services:</p>

VI. Grounds for refusal [(where applicable, see item VII)]:
<p>VII. Information relating to an earlier mark:</p> <p>(i) Filing date and number, and, if any, priority date:</p> <p>(ii) Registration date and number (if available):</p> <p>(iii) Name and address of the owner:</p> <p>(iv) Reproduction of the mark:</p> <p>(v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):</p>
VIII. Corresponding essential provisions of the applicable law:
<p>IX. Information relating to the possibility to request a review or file an appeal:</p> <p>(i) Time limit for requesting review or appeal:</p> <p>(ii) Authority to which such request for review or appeal should be made:</p> <p>(iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:</p> <p>(iv) Other requirements, if any:</p>
X. Signature or official seal of the Office making the notification:
XI. Date of the notification to the International Bureau:

Provisional refusal : example

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Trademark

Following substantive examination

- Article 1483(1) of the applicable law provides for lack of distinctiveness as absolute ground for refusal
- The Office considers that MARCA DE FÁBRICA (TRADE MARK) lacks distinctiveness; other traders are likely to identify their trade marks on their goods by using the words MARCA DE FÁBRICA and should be able to use MARCA DE FÁBRICA in connection with their goods
- **All** goods and services are affected
- The holder may disclaim the indication directly with the Office and obtain protection for the mark
- A local attorney or agent is required to file the disclaimer
- The holder may file the disclaimer within six (6) months from the date on which WIPO sends the notification to the holder
- Failure to file a disclaimer would result in abandonment

I. Office making the notification: [TYPE NAME OF THE OFFICE HERE]
II. Number of the international registration: 1 200 443
III. Name of the holder: Bacardi & Company Limited
IV. Information concerning the type of provisional refusal: <i>Please indicate the type of refusal by checking only one of the following options:</i> <input checked="" type="checkbox"/> Total provisional refusal based on an <i>ex officio</i> examination <input type="checkbox"/> Total provisional refusal based on an opposition <input type="checkbox"/> Total provisional refusal based on both an <i>ex officio</i> examination and an opposition <i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i> (i) Name of the opponent: (ii) Address of the opponent:
V. Information concerning the scope of the provisional refusal: Total provisional refusal affects all the goods and/or services.
VI. Grounds for refusal [(where applicable, see item VII): MARCA DE FÁBRICA (TRADE MARK) lacks distinctiveness; other traders are likely to identify their trade marks on their goods by using the words MARCA DE FÁBRICA and should be able to use MARCA DE FÁBRICA in connection with their goods. The holder may disclaim the indication directly with the Office and obtain protection for the mark. Failure to file the disclaimer will result in abandonment.

VII. Information relating to an earlier mark: (i) Filing date and number, and, if any, priority date: (ii) Registration date and number (if available): (iii) Name and address of the owner: (iv) Reproduction of the mark: (v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):
VIII. Corresponding essential provisions of the applicable law: Article 1481(1) of the Trade Mark Act
IX. Information relating to the possibility to request a review or file an appeal: (i) Time limit for requesting review or appeal: The holder may file the disclaimer within six (6) months from the date on which WIPO sent this notification to the holder (ii) Authority to which such request for review or appeal should be made: [TYPE NAME OF THE OFFICE HERE] (iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party: A local attorney or agent is required to file the disclaimer. (iv) Other requirements, if any:
X. Signature or official seal of the Office making the notification: [SIGN OR SEAL THE NOTIFICATION HERE]
XI. Date of the notification to the International Bureau: [TYPE THE DATE OF THE NOTIFICATION HERE]

Issues with provisional refusal

Types of issues

- Irregular refusal recorded – Rule 18(1)(c)
- Irregular refusal not recorded – Rule 18(1)(d)
- Refusal not considered as such – Rule 18(2)(a)

Refusal recorded with irregularities

Rule 18(1)(c)

Grounds

- not signed by the Office
- does not comply with the administrative instructions
- not in a working language
- without the details of the previous or opposing mark
- without the particulars of the opponent
- does not indicate scope

Consequence

- **refusal is recorded**
- refusal transmitted to the holder
- Office invited to send a rectified notification within 2 months

**NOTICE CONCERNING A NOTIFICATION
OF PROVISIONAL REFUSAL**

29 April 2015

Re.: International Registration No. 1181262
for the mark McGraw Hill Education Practice
in the name of McGraw-Hill Global Education Holdings, LLC

Date of notification of the international registration
or subsequent designation:
4 September 2014

Date of sending the notification of provisional
refusal: 20 April 2015

Our ref. : RF-I/887417701/EF
Office ref. : A0038568 85915810 00
Examiner: Eric FONTAINE +.41.22.338.75.02
E-mail: intreg.mail@wipo.int

We acknowledge receipt of the notification of provisional refusal
issued by the Indian Office relating to the above-mentioned
international registration.

The examination of the notification of provisional refusal has
revealed that:

in respect of the mark with which the mark that is the subject of
the international application appears to be in conflict, a
reproduction of the mark is missing (Rule 17(2)(v)).

This applies to the cited mark 1418243 "Practice tracker" for
which you have provided a totally different reproduction "Silpure" !
Please clarify.

In accordance with Rule 18(1)(c), your Office is requested to
send to the International Bureau a rectified notification of
provisional refusal within a two month time limit from the date of
the present notice, expiring on 29 June 2015.

Where the law applicable to your Office so permits, the rectified
notification should indicate a new 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/or for responding to the opposition, preferably
with an indication of the date on which the said time limit expires
(Rule 18(1)(e)).

International Bureau of the
World Intellectual Property Organization
(WIPO)

Irregular refusal not recorded

Rule 18(1)(d)

Grounds

- does not indicate a time limit to file for review, appeal or to respond; or,
- does not indicate the authority with which to file the review, appeal or response

Consequences

- **refusal is not recorded;**
- Office invited to send a rectified notification
- copy sent to the holder
- rectified notification recorded if received within 2 months

NOTICE CONCERNING A NOTIFICATION
OF PROVISIONAL REFUSAL

21 August 2015

Re.: International Registration No. 1229188
for the mark DOVER ARTIFICIAL LIFT
in the name of DELAWARE CAPITAL FORMATION, INC.

Date of notification of the international registration
or subsequent designation:
25 December 2014

Date of sending the notification of provisional
refusal: 13 July 2015

Our ref. : RF-I/907110201/DC
Office ref. : A0041741 86209307 00
Examiner: David LIERN CENDRERO
E-mail: intreg.mail@wipo.int

We acknowledge receipt of the notification of provisional refusal
issued by the Indian Office relating to the above-mentioned
international registration.

The examination of the notification of provisional refusal has
revealed that:

The notification does not indicate the time limit reasonable
under the circumstances for filing a request for review of, or appeal
against, the ex officio provisional refusal, and/or for filing a
response to the opposition, as required by Rule 17.2) (vii)).

The notification does not indicate the authority with which the
request for review or appeal and/or the response to the opposition
should be filed, as required by Rule 17(2) (vii)).

In accordance with Rule 18(1) (c), your Office is requested to
send to the International Bureau a rectified notification of
provisional refusal within a two month time limit from the date of
the present notice (expiring on 21 October 2015).

Failing this, the notification of provisional refusal will not be
regarded as such, in accordance with Rule 18(1) (d).

Where the law applicable to your Office so permits, the rectified
notification should indicate a new 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/or for responding to the opposition, preferably
with an indication of the date on which the said time limit expires
(Rule 18(1) (e)).

International Bureau of the
World Intellectual Property Organization
(WIPO)

Refusal not regarded as such

Rule 18(2)(a)

Grounds

- sent too late
- missing the number of the IR or other indications for its identification;
- missing the grounds for the refusal

Consequences

- **refusal is not recorded**
- notification returned to Office
- nevertheless, a copy is sent to the holder

NOTICE CONCERNING A NOTIFICATION
OF PROVISIONAL REFUSAL

29 April 2015

Re.: International Registration No. 1175907
for the mark G650
in the name of GULFSTREAM AEROSPACE CORPORATION

Date of notification of the international registration
or subsequent designation:
3 October 2013

Date of sending the notification of provisional
refusal: 20 April 2015

Our ref. : RF-I/887416601/EF
Office ref. : A0037707 76541117 34
Examiner: Eric FONTAINE +.41.22.338.75.02
E-mail: intreg.mail@wipo.int

We acknowledge receipt of the notification of provisional refusal
issued by the Indian Office relating to the above-mentioned
international registration.

The notification of provisional refusal **is not regarded as such**
by the International Bureau because:

It has been sent to the International Bureau too late, that is,
after the expiry of the 18-month time limit from the date of
notification of the international registration or subsequent
designation, which expired on 3 April 2015 (Rule 18(2)(a)).

A copy of the said notification of provisional refusal, along
with a copy of the present notice will nevertheless be sent to the
holder of the international registration for information purposes.

International Bureau of the
World Intellectual Property Organization
(WIPO)

WIPO | MADRID
The International
Trademark System

Communications following a provisional refusal

Communications following a provisional refusal – Rule 18*ter*(2) or (3)

Final Decisions

- Protection following a provisional refusal
Rule 18*ter*(2)
- Confirmation of a total provisional refusal
Rule 18*ter*(3)

MF5 – Total or partial grant of protection after a provisional refusal

MADRID PROTOCOL

Model Form 5: Final Disposition on Status of a Mark – Statement of Total or Partial Grant of Protection Following a Provisional Refusal (Rule 18ter(2) of the Common Regulations)

I. Office sending the statement:	VI. Where a further review or appeal against this decision before an authority outside the Office is still possible, the Office should provide the following information, where available: <ul style="list-style-type: none"> (i) Time limit for requesting review or appeal: (ii) Authority to which such request for review or appeal should be made: (iii) Whether the request for review or appeal has to be filed in a specific language or through the intermediary of a representative whose address is within the territory of the Contracting Party:
II. Number of the international registration:	
III. Name of the holder:	VII. Signature or official seal of the Office sending the statement:
IV. The Office has completed all its procedures and this is the decision by the Office: <ul style="list-style-type: none"> <input type="checkbox"/> Total protection is granted for <u>all</u> the goods and/or services (Rule 18ter(2)(i)) <input type="checkbox"/> Partial protection is granted to the following goods and/or services (Rule 18ter(2)(ii)): 	
V. Disclaimer or Reservation: <p><i>Please specify the element(s) of the mark for which protection cannot be granted:</i></p> <p><i>Please also specify, by checking only one of the options below, whether the disclaimer or reservation applies to:</i></p> <ul style="list-style-type: none"> <input type="checkbox"/> All of the goods and/or services <input type="checkbox"/> Only the following goods and/or services: 	VIII. Date of notification to the International Bureau:

MF6 – Confirmation of total refusal under Rule 18ter(3)

MADRID PROTOCOL

Model Form 6: Final Disposition on Status of a Mark – Confirmation of Total Provisional Refusal (Rule 18ter(3) of the Common Regulations)

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder:
IV.	The Office has completed all its procedures and this is the decision by the Office: Protection of the mark is refused for <u>all</u> the goods and/or services.
V.	Where a further review or appeal against this decision before an authority outside the Office is still possible, the Office should provide the following information, where available: <ul style="list-style-type: none"> (i) Time limit for requesting review or appeal: (ii) Authority to which such request for review or appeal should be made: (iii) Whether the request for review or appeal has to be filed in a specific language or through the intermediary of a representative whose address is within the territory of the Contracting Party:
VI.	Signature or official seal of the Office sending the statement:
VII.	Date of notification to the International Bureau:

Holder disclaims MARCA DE FÁBRICA



MADRID PROTOCOL

Model Form 5: Final Disposition on Status of a Mark – Statement of Total or Partial Grant of Protection Following a Provisional Refusal (Rule 18ter(2) of the Common Regulations)

<p>I. Office sending the statement:</p> <p>[TYPE NAME OF THE OFFICE HERE]</p>	<p>VI. Where a further review or appeal against this decision before an authority outside the Office is still possible, the Office should provide the following information, where available:</p> <p>(i) Time limit for requesting review or appeal:</p> <p>(ii) Authority to which such request for review or appeal should be made:</p> <p>(iii) Whether the request for review or appeal has to be filed in a specific language or through the intermediary of a representative whose address is within the territory of the Contracting Party:</p>
<p>II. Number of the international registration:</p> <p>1 200 443</p>	<p>VII. Signature or official seal of the Office sending the statement:</p> <p>[SIGN OR SEAL THE NOTIFICATION HERE]</p>
<p>III. Name of the holder:</p> <p>Bacardi & Company Limited</p>	<p>VIII. Date of notification to the International Bureau:</p> <p>[TYPE THE DATE OF NOTIFICATION HERE]</p>
<p>IV. The Office has completed all its procedures and this is the decision by the Office:</p> <p><input checked="" type="checkbox"/> Total protection is granted for <u>all</u> the goods and/or services (Rule 18ter(2)(i))</p> <p><input type="checkbox"/> Partial protection is granted to the following goods and/or services (Rule 18ter(2)(ii)):</p>	
<p>V. Disclaimer or Reservation:</p> <p><i>Please specify the element(s) of the mark for which protection cannot be granted:</i></p> <p>MARCA DE FÁBRICA</p> <p><i>Please also specify, by checking only one of the options below, whether the disclaimer or reservation applies to:</i></p> <p><input checked="" type="checkbox"/> All of the goods and/or services</p> <p><input type="checkbox"/> Only the following goods and/or services:</p>	

Further decision and invalidation

Further decision under Rule 18*ter*(4)

Further decision now

Can be sent only after a final decision under Rule 18*ter*(2) or (3)

As from November 1, 2017

Can be sent after tacit acceptance, grant of protection under Rule 18*ter*(1) or final decision under Rule 18*ter*(2) or (3)

Difference between further decision and invalidation

Further decision

- Can increase or reduce the scope of protection
- Subject to review or appeal
- Can be modified by another further decision
- MF7 – Further decision

Invalidation

- All or part of the registration no longer has effect
- No longer subject to appeal
- Registration cannot regain effect; except under a later subsequent designation
- MF10 – Invalidation

Centralized management

Renewal and recordings

- Renewal of the international registration
- Appoint a representative before the International Bureau
- Subsequent designation of new Contracting Parties
- Change ownership of the international registration
- Change in the name of the holder
- Cancellation of the international registration
- Renunciation of a designated Contracting Party
- Limitation in a designated Contracting Party
- Recording, change or cancellation of licenses

Declarations of no effect

- Change in ownership
 - MF11 – Declaration that a change in ownership has no effect
 - MF12 – Final decision stating that a change in ownership has no effect
- Limitation
 - MF13 – Declaration that a limitation has no effect
 - MF14 – Final decision stating that a limitation has no effect
- License

Thank you
for your attention

juan.rodriguez@wipo.int

