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SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS
(MADRID UNION)

ASSEMBLY

**Fortieth (23rd Extraordinary) Session
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AMENDMENT OF THE COMMON REGULATIONS

prepared by the International Bureau

I. INTRODUCTION

1. It is recalled that the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (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 Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”¹). In the context of this work, the Working Group began also considering issues related to the level of services provided by the offices of Contracting Parties to the Protocol.

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 its fourth session, held in Geneva from May 30 to June 1, 2007, the Working Group requested the Secretariat to prepare a paper addressing, in particular, the issue of the accessibility of information regarding the fate of international registrations in designated Contracting Parties, with a view to proposing possible amendments to the Common Regulations.
3. 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 convene two meetings in 2008, and that the first of these would address the issue of improving the accessibility of information regarding the fate of international registrations in designated Contracting Parties.
4. The first of such meetings (the fifth session of the Working Group) was held in Geneva from May 5 to 9, 2008. Contributions received for that session from the Governments of Australia, Japan and Switzerland (documents MM/LD/WG/5/5 and 6, MM/LD/WG/5/3 and MM/LD/WG/5/4, respectively) indicated, in particular, the desirability of introducing into the Madrid system a requirement for offices to issue statements of grant of protection. The discussions of the Working Group were based on document MM/LD/WG/5/2. The report of that session is contained in document MM/LD/WG/5/8.
5. At the conclusion of that session, the Working Group agreed to recommend that the Madrid Union Assembly amend the Common Regulations, as provided in the draft contained in Annex I of document MM/LD/WG/5/8, including one transitional provision, with September 1, 2009, as the proposed date of entry into force.
6. The purpose of the present document is to submit the amendments referred to above for adoption by the Assembly. For easier reference, the proposed amendments are first reproduced in Annex I in ‘track changes’ mode, i.e., with the text that is proposed to be deleted, struck through, and the text that is proposed to be added, appearing underlined. For additional clarity, the final text of the Common Regulations, as it would result following the adoption of the proposed amendments, is reproduced in Annex II to the present document.
7. Chapter II below provides notes in support of the proposed amendments.

II. NOTES ON PROPOSED AMENDMENTS TO RULES 16 AND 17 AND PROPOSED NEW RULES 18BIS, 18TER AND 40(5)

8. In addition to Articles 4 and 5 of the Agreement and of the Protocol, the legal framework concerning the fate of international registrations in designated Contracting Parties 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 Provisional Refusal Based on an Opposition*) and 18 (*Irregular Notifications of Provisional Refusal*), and by Part Five of the Administrative Instructions² (*Notification of Provisional Refusals*).

9. The amendments that are now proposed, along with new Rules 18bis and 18ter, are the result primarily of a review of current Rule 17 of the Common Regulations. If adopted, the proposed amendment of Rule 17 will result in that rule providing only and specifically for the act of notification of a provisional refusal, the content of such notification, additional requirements in the case of a notification based on an opposition, and finally, the recording and transmittal by the International Bureau of copies of such notification. Additionally, it is proposed that current paragraphs 17(5)(d) and (e) (concerning the making of certain declarations relating to the possibility of review) will continue, unchanged.

10. On the other hand, it is proposed to transpose, from current Rule 17 to two new rules, namely Rules 18bis and 18ter, those provisions that are not concerned specifically with the act of notification of a provisional refusal, but are concerned rather with the status, in a designated Contracting Party, of a mark that is the subject of an international registration, and the communication, by an Office, of that status.

11. It is envisaged that such reorganization of Rule 17, along with the proposed amendment of Rule 16, will result in a more transparent and coherent framework of provisions in the Common Regulations to deal with the refusal procedure under the Madrid system and enable holders to more precisely and easily establish the status of their marks.

Amended Rule 16

12. Rule 16 of the Common Regulations deals with the notification of provisional refusal based on opposition in certain cases outside the extended period of 18 months provided for by Article 5(2)(c) of the Protocol. As it currently stands, paragraph (1)(b) of Rule 16 provides for the communication by an Office to the International Bureau of the dates on which the opposition period begins and ends, where those dates are known, and otherwise, at the latest, at the same time as any notification of a provisional refusal based on opposition.

² Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto.

13. It frequently occurs that at the time of a communication by an Office under paragraph (1)(b) of Rule 16, the dates on which the opposition period begins and ends are not, in fact, known. It has been established, however, that in such cases, the initial communication is frequently not then eventually followed by the communication of the start and end dates of the opposition period, in particular where there is not, in fact, eventually any notification of provisional refusal based on opposition.

14. In a document prepared by the International Bureau in the context of an earlier session of the Madrid Working Group in June 2001 (document MM/WG/2/4), the International Bureau had suggested that the “information about the start and end dates of the opposition period is required solely in order for the International Bureau to be able to check that the requirements of Article 5(2)(c)(ii) have been met. In practice therefore, where an Office has been unable to include this information in the communication under subparagraph (a), it may send it only in the case where an opposition has actually been filed”. However, in light of the further discussions of the Working Group during its recent sessions, it is clear that the omission to communicate this additional information may result in difficulty for holders and third parties seeking to establish the precise status of a mark, regardless of whether or not the initial communication is followed by an actual notification of refusal based on opposition.

15. It is therefore proposed to amend paragraph (1)(b) in order that the requirement concerning the communication of the dates referred to above would become less open-ended. Thus, in the second sentence of current paragraph (1)(b), the reference to the communication of the dates “*at the latest at the same time as any notification of a provisional refusal based on an opposition*” is proposed to be replaced by “*as soon as they are known*”.

16. The introduction of this proposed amendment is intended to ensure that, in all cases, the relevant dates will be communicated by offices, including, in particular, in cases where the communication is not, in fact, eventually followed by a refusal based on opposition.

17. Additionally, it was the recommendation of the Working Group that amended paragraph (1)(b), if adopted, be accompanied by a footnote to the effect that in adopting this provision, the Assembly of the Madrid Union understood that if the opposition period were extendable, the Office might communicate only the date the opposition period begins. To the extent that Article 5(2)(c)(ii) establishes an eventual time limit, which is calculated from the date on which the opposition period begins, the International Bureau would, therefore, in any event, be in a position to record and publish the expiry of that time limit, even in cases where the commencement date only had been indicated.

Amended Rule 17

18. If adopted, the amendment of Rule 17 will result in the migration (to new Rules 18*bis* and 18*ter*), from that rule, of those provisions that are concerned not specifically with the act of notification of a provisional refusal, but rather with the interim and final status of a mark, and the communication of that status. Otherwise, the text of Rule 17 (apart from the title of the rule and the title of paragraphs (5)(d) and (e)) will remain unaltered³.

19. The provisions of current Rule 17 which it is proposed to migrate to new Rules 18*bis* and 18*ter* are paragraphs (5)(a), (b) and (c) (*Confirmation or Withdrawal of Provisional Refusal*) and paragraph (6) (*Statement of Grant of Protection*). The resulting narrowed scope of Rule 17 will then deal exclusively with the act of notification of a provisional refusal and provide solely for the following:

paragraph (1) – *Notification of Provisional Refusal*

paragraph (2) – *Content of the Notification*

paragraph (3) – *Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition*

paragraph (4) – *Recording and Transmittal of Copies of Notifications*

paragraph (5) (new title) – *Declarations Relating to the Possibility of Review*.

New Rule 18*bis* – Interim Status of a Mark

– (paragraph (6)(a)(ii) of current Rule 17)

20. Proposed new Rule 18*bis* is entitled *Interim Status of a Mark in a Designated Contracting Party*.

21. It is recalled that paragraph (6)(a)(ii) of current Rule 17 is a provision which enables the office of a designated Contracting Party that has not communicated a notification of provisional refusal within the relevant refusal period to issue 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.

22. In effect, proposed new Rule 18*bis* retains this facility envisaged under paragraph 6(a)(ii) of current Rule 17, but relocates it. The provision is now to be found in proposed new Rule 18*bis*(1)(a).

³ However, regarding solely the French version of Rule 17(1)(a) and the title of Rule 17(3), proposed amendments of a purely editorial nature are also set out in Annexes I and II of the French version of the present document.

23. The Working Group took the view that it may be of interest to users and third parties to have this information regarding the status of their marks also in cases where an Office *may* have notified a provisional refusal and subsequently concluded favorably the *ex officio* examination. To that effect, the scope of proposed new Rule 18*bis* has been enlarged and a new text has been added to provide for this additional facility in new Rule 18*bis*(1)(b).

24. Paragraph 6 of current Rule 17 is entitled *Statement of Grant of Protection*. It is believed that by migrating paragraph (6)(a)(ii) to proposed new Rule 18*bis* and by revising the title of that new rule to read *Interim Status of a Mark in a Designated Contracting Party*, the Common Regulations, if so amended, will more accurately reflect the intention and effect of the statement in question.

25. As it stands at present, the facility for an office to issue a statement under paragraph (6)(a)(ii) of Rule 17 is an optional facility. As proposed under new Rule 18*bis*(1)(a) and (b), the optional nature of this facility remains unchanged.

26. New Rule 18*bis*(2) provides for the recording of any information received from an office under paragraph (1) of that Rule. The new rule provides, additionally, that the International Bureau shall inform the holder accordingly and, “where a statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder”. As is the practice at present, for the purpose of this rule, the International Bureau will accept lists of international registration numbers, which it will convert into individual communications for transmission to holders.

Overview of New Rule 18*ter* – Final Disposition on Status of a Mark in a Designated Contracting Party

– (paragraph (5)(a)(i), (ii) and (iii), paragraph (5)(b) and (c), and paragraph (6)(a)(i) and (iii) of current Rule 17)

27. Proposed new Rule 18*ter* is entitled *Final Disposition on Status of a Mark in a Designated Contracting Party*.

28. It is recalled that paragraph (6)(a)(i) of current Rule 17 enables the office of a designated Contracting Party that has not communicated a notification of provisional refusal within the relevant refusal period to issue 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 an international registration.

29. Additionally, paragraph (6)(a)(iii) of current Rule 17 enables the office of a designated Contracting Party that has not communicated a notification of provisional refusal within the relevant refusal period and which has already issued a statement as to the interim status of a mark (under paragraph (6)(a)(ii)) to issue a further statement to the effect that the opposition period has expired without any opposition or observations having been filed, and that the office has therefore decided to grant protection to the mark that is the subject of an international registration.

30. Unlike the statement issued by an office under paragraph (6)(a)(ii) (now the subject of proposed new Rule 18*bis* – *Interim Status of a Mark*), the statements referred to above deal, in effect, with the final status of a mark. In addition, at present, the sending of either of the statements in question is merely optional.

31. Furthermore, it is recalled that paragraph (5)(a) of current Rule 17 is the provision in the Common Regulations which provides for the obligatory communication by an office of the final determination as to the status of a mark, following the notification of provisional refusal. Paragraph (5) is currently entitled *Confirmation or Withdrawal of Provisional Refusal*.

32. It was the recommendation of the Working Group that the Common Regulations be amended so as to incorporate in a single new Rule 18*ter*, dealing with the final status of a mark, all of what is currently provided by paragraph (5)(a), (along also with subparagraphs (b) and (c) of paragraph (5)), and paragraphs (6)(a)(i) and (iii) of current Rule 17.

Rule 18*ter*(1)

33. Paragraph (1) of proposed new Rule 18*ter* is entitled *Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated*. This paragraph transposes what is currently the facility that is provided for by paragraph (6)(a)(i) and (iii) of current Rule 17.

34. If adopted, it will provide that when, before the expiry of the applicable refusal period, all procedures before an office have been completed and there is no ground for that office to refuse protection, that office shall, as soon as possible and before the expiry of the applicable refusal period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of international registration in the Contracting Party concerned.

35. It is to be noted that, whereas under paragraph (6) of current Rule 17, the sending of such a statement is optional, paragraph (1) of new Rule 18*ter* makes the sending of such statement obligatory.

36. This, effectively, is a mitigation of the inconvenience associated with the so-called *tacit acceptance* principle. As stated in the *Guide to the International Registration of Marks Under the Madrid Agreement and the Madrid Protocol*, 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”. However, it is important to underline that, notwithstanding new Rule 18*ter*(1), the principle of tacit acceptance remains.

37. Finally, it was the recommendation of the Working Group that, if adopted, this provision would be accompanied by a footnote to the effect that in adopting this provision, the Assembly of the Madrid Union understood that a statement of grant of protection could concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of those international registrations, and a further footnote (with respect to both paragraphs (1) and (2) of new Rule 18ter) to the effect that where Rule 34(3) applied, the grant of protection would be subject to the payment of the second part of the fee.

Rule 18ter(2)

38. The title of paragraph (2) of proposed new Rule 18ter is *Statement of Grant of Protection Following a Provisional Refusal*. This new paragraph migrates from subparagraphs (5)(a)(ii) and (iii) of current Rule 17 (entitled *Confirmation or Withdrawal of Provisional Refusal*) the requirement for an office to send to the International Bureau a final statement in respect of a provisional refusal already notified by that office, once all the procedures before the office have been completed – indicating that the mark is protected for all the goods and services, or indicating the goods and services for which the mark is protected.

39. In essence, paragraph 2 of new Rule 18ter is not intended to change in any way the scope of this obligation that is already imposed on offices. However, instead of the concept of *confirmation* or *withdrawal* of a provisional refusal, the new title of paragraph (2) of Rule 18ter shifts the focus of the obligation, insofar as it refers not to *confirmation* or *withdrawal* of a provisional refusal, but instead to a *statement of grant of protection*. For this reason, paragraph (2) omits reference to the first subparagraph of current Article 5(2), which is final confirmation that an office has *refused* protection for *all* the goods and services. This, instead, is the subject of paragraph (3) of new Rule 18ter.

Rule 18ter(3)

40. As noted above, paragraph (3) of new Rule 18ter transposes the requirement in paragraph (5)(a)(i) of current Rule 17 for an office to notify a final decision that protection of the mark is refused in the Contracting Party concerned for all the goods and services. For this reason, it is proposed to entitle this paragraph *Confirmation of Total Provisional Refusal*.

41. As with paragraph (2) of new Rule 18ter, new paragraph (3) does not alter in any way the scope of the obligation which is currently imposed upon offices under paragraph (5) of Rule 17. It merely relocates and re-titles the provision.

Rule 18ter (4) and (5)

42. Paragraphs (4) and (5) of new Rule 18ter simply relocate from paragraph (5) of current Rule 17 the provision concerning a “further” decision and the provision relating to the recording of the information received from offices. Other than conferring a title upon those provisions (which are not specifically titled in current Rule 17) in new Rule 18ter, the provisions remain unchanged.

43. However, with regard to what will become paragraph (4) of new Rule 18ter, if adopted, the Working Group noted that it would be necessary to resubmit for the endorsement of the Madrid Union Assembly the interpretative statement that currently appears as footnote 2 to the equivalent of this provision in current Rule 17 – i.e., Rule 17(5)(b).

Summary – Amended Rules 16 and 17, and new Rules 18bis and 18ter

44. In summary, therefore, it is proposed as follows:

– that paragraph (1)(b) of current Rule 16 be amended in order that the requirement concerning the communication of the start and end dates of the opposition period would become less open-ended. For this reason, the reference, in current paragraph (1)(b) of that rule, to the communication of the dates “*at the latest at the same time as any notification of a provisional refusal based on an opposition*” is proposed to be replaced by “*as soon as they are known*”;

– that the scope of current Rule 17, dealing with provisional refusals, be narrowed so as to contain only provisions dealing specifically and exclusively with the act of notifying a provisional refusal;

– that new Rule 18bis would deal with the *interim* status of a mark, and, in particular, that aspect of current Rule 17 which enables an office, *optionally*, to send a statement of grant of protection when that office has concluded its *ex officio* examination (paragraph (6)(a)(ii)), including, additionally, cases where a notification of provisional refusal had earlier been communicated; it is proposed that this facility remain optional;

– that new Rule 18ter would consist of three “tiers”, each dealing successively with the final disposition as to the status of a mark. The first tier of new Rule 18ter, paragraph (1), would deal with that aspect of current Rule 17 which enables an office, *optionally* (at present), to send a statement of grant of protection where, before the expiry of the applicable refusal period, all procedures before the office have been completed and there is no ground for that office to refuse protection (paragraph (6)(a)(i)). However, under paragraph (1) of new Rule 18ter, the communication of this information would become *mandatory*. This new paragraph would retain in its title the concept of *statement of grant of protection*, as currently in paragraph (6) of Rule 17;

– that the second tier of new Rule 18ter, paragraph (2), would deal with what is currently the communication of the final decision by an office which has already notified a provisional refusal (Rule 17(5)), but only to the extent that it has been decided to partially or fully grant protection for the goods and services covered by the mark in question (Rule 17(5)(a)(ii) and (iii)). This new paragraph would acquire in its title also the concept of *statement of grant of protection*, rather than the notion of *confirmation or withdrawal of provisional refusal*, as currently in paragraph (5) of Rule 17;

– that, finally, the third tier of new Rule 18ter, paragraph (3) would also deal with what is currently the communication of the final decision by an office which has already notified a provisional refusal (Rule 17(5)), but only to the extent that a provisional refusal is totally confirmed (Rule 17(5)(a)(i)). This new paragraph would retain the notion of *confirmation of provisional refusal*, as at present in paragraph (5) of current Rule 17.

New Paragraph (5) of Rule 40 – Transitional Provisions

45. It was the recommendation of the Working Group that, while the amended and new provisions would come into force on September 1, 2009, no office should be obliged to send statements of grant of protection under new Rule 18ter(1) before January 1, 2011.

46. It will be recalled that under paragraph (1) of new Rule 18ter, where, before the expiry of the applicable refusal period, all procedures have been completed and there is no ground for an office to refuse protection, such office will be required to send a statement to the effect that protection is granted to the mark in question. Prior to the adoption of new Rule 18ter, if adopted, it was merely *possible* for an office to send such a statement – but not obligatory. The deferment of the operation of this specific provision in new Rule 18ter is seen by the Working Group as facilitating, as far as possible, the work of those offices that may require time to implement the provision.

III. AMENDMENTS CONSEQUENTIAL TO THE AMENDMENTS TO RULE 17 AND PROPOSED NEW RULES 18BIS, 18TER, IF ADOPTED

47. If adopted, the amendments to Rule 17 and new Rules 18bis and 18ter will entail also the adoption of consequential amendments to the following rules:

(a) Rule 24, paragraph (9) – the reference in that paragraph to “*Rules 16 to 18*” shall be amended to read “*Rules 16 to 18ter*”.

(b) Rule 28, paragraph (3) – the reference in the fifth line of that paragraph to “*Rules 16 to 18*” shall be amended to read “*Rules 16 to 18ter*”.

(c) Rule 32, subparagraph (1)(iii) – the reference in the final line of that subparagraph to “*Rule 17(5)(c) and (6)(b)*” shall be amended to read “*Rules 18bis(2) and 18ter(5)*”.

(d) Rule 36, subparagraph (viii) – the reference in that subparagraph to “Rule 17(5) or (6)” shall be amended to read “Rules 18bis or 18ter”.

48. The Assembly of the Madrid Union is invited to take the following decisions concerning the Common Regulations, with a date of entry into force of September 1, 2009:

(a) adopt new Rules 18bis, 18ter and 40(5), accompanied by the footnote to new Rule 18ter, as set out in Annex I hereto;

(b) modify its interpretative statement presently referring to current Rule 17(6)(a)(ii) and (iii) so that it refers to new Rule 18bis;

(c) modify its interpretative statement presently referring to current Rule 17(5)(b) so that it refers to new Rule 18ter;

(d) adopt the amendments to Rules 16, 17, 24, 28, 32 and 36, accompanied by the footnote to paragraph (1)(b) of amended Rule 16, as set out in Annex I hereto.

[Annexes follows]

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on September 1, ~~2008~~ 2009)

LIST OF RULES

[...]

**Chapter 4
Facts in Contracting Parties
Affecting International Registrations**

Rule 16

*~~Time Limit for Notifying~~ Possibility of Notification of a Provisional Refusal Based on an
Opposition Under Article 5(2)(c) of the Protocol*

(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 known¹.

(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.

¹ In adopting this provision, the Assembly of the Madrid Union understood that if the opposition period is extendable, the Office may communicate only the date the opposition period begins.

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

² — ~~Interpretative statement endorsed by the Assembly of the Madrid Union:~~

~~“The reference in Rule 17(5)(b) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”~~

(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\(2\) or \(3\)](#) 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\(4\)](#).

(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 a statement in accordance with ~~subparagraph (a)(i) or (iii)~~ [Rule 18ter\(2\)\(ii\) or \(3\)](#).

~~(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.~~

[...]

³ ——— Interpretative statement endorsed by the Assembly of the Madrid Union:

“The references in Rule 17(6)(a)(ii) and (iii) to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations.”

Rule 18bis
Interim Status of a Mark in a Designated Contracting Party

(1) [Ex Officio Examination Completed but Opposition or Observations by Third Parties Still Possible] (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 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 filed⁴.

(b) An Office which has communicated a notification of provisional refusal may send to the International Bureau a statement to the effect that the *ex officio* examination has been completed but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed.

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

Rule 18ter
Final Disposition on Status of a Mark in a Designated Contracting Party

(1) [Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated]⁵ When, before the expiry of the period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned⁶.

(2) [Statement of Grant of Protection Following a Provisional Refusal] Except where it sends a statement under paragraph (3), an Office which has communicated 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 either

⁴ Interpretative statement endorsed by the Assembly of the Madrid Union:

“The references in Rule 18bis to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations.”

⁵ In adopting this provision, the Assembly of the Madrid Union understood that a statement of grant of protection could concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of these international registrations.

⁶ In adopting paragraphs (1) and (2) of this rule, the Assembly of the Madrid Union understood that where Rule 34(3) applies, the grant of protection will be subject to the payment of the second part of the fee.

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or

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

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

(4) [Further Decision] Where, following the sending of a statement in accordance with either paragraph (2) or (3), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned⁷.

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

[...]

Rule 24

Designation Subsequent to the International Registration

[...]

(9) *[Refusal]* Rules 16 to 18^{ter} shall apply *mutatis mutandis*.

[...]

⁷ Interpretative statement endorsed by the Assembly of the Madrid Union:

“The reference in Rule 18^{ter}(4) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”

Rule 28
Corrections in the International Register

[...]

(3) *[Refusal Following a Correction]* Any Office referred to in paragraph (2) shall have the right to declare in a notification of provisional refusal addressed to the International Bureau that it considers that protection cannot, or can no longer, be granted to the international registration as corrected. Article 5 of the Agreement or Article 5 of the Protocol and Rules 16 to 18^{ter} shall apply *mutatis mutandis*, it being understood that the period allowed for sending the said notification shall be counted from the date of sending the notification of the correction to the Office concerned.

[...]

Rule 32
Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

- (i) international registrations effected under Rule 14;
- (ii) information communicated under Rule 16(1);
- (iii) provisional refusals recorded under Rule 17(4), with an indication as to whether the refusal relates to all the goods and services or only some of them but without an indication of the goods and services concerned and without the grounds for refusal, and statements and information recorded under ~~Rule 17(5)(c) and (6)(b)~~ Rules 18bis(2) and 18ter(5);

[...]

Rule 36
Exemption From Fees

[...]

(viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under ~~Rule 17(5) or (6)~~ Rules 18bis or 18ter or any declaration under Rule 20bis(5) or Rule 27(4) or (5),

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(5) *[Transitional Provision Relating to Statements of Grant of Protection]* No Office shall be obliged to send statements of grant of protection under Rule 18ter(1) before January 1, 2011.

[...]

[Annex II follows]

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on September 1, 2009)

LIST OF RULES

[...]

**Chapter 4
Facts in Contracting Parties
Affecting International Registrations**

Rule 16

*Possibility of Notification of a Provisional Refusal Based on an Opposition
Under Article 5(2)(c) of the Protocol*

(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 as soon as they are known¹.

(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.

¹ In adopting this provision, the Assembly of the Madrid Union understood that if the opposition period is extendable, the Office may communicate only the date the opposition period begins.

Rule 17
Provisional Refusal

(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) *[Declarations Relating to the Possibility of Review]* (a) [Deleted]

(b) [Deleted]

(c) [Deleted]

(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 Rule 18*ter*(2) or (3) 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 Rule 18*ter*(4).

(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 a statement in accordance with Rule 18*ter*(2)(ii) or (3).

[...]

Rule 18bis
Interim Status of a Mark in a Designated Contracting Party

(1) *[Ex Officio Examination Completed but Opposition or Observations by Third Parties Still Possible]* (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 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 filed².

(b) An Office which has communicated a notification of provisional refusal may send to the International Bureau a statement to the effect that the *ex officio* examination has been completed but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed.

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

Rule 18ter
Final Disposition on Status of a Mark in a Designated Contracting Party

(1) *[Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated]*³ When, before the expiry of the period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned⁴.

(2) *[Statement of Grant of Protection Following a Provisional Refusal]* Except where it sends a statement under paragraph (3), an Office which has communicated 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 either

² Interpretative statement endorsed by the Assembly of the Madrid Union:

“The references in Rule 18bis to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations.”

³ In adopting this provision, the Assembly of the Madrid Union understood that a statement of grant of protection could concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of these international registrations.

⁴ In adopting paragraphs (1) and (2) of this rule, the Assembly of the Madrid Union understood that where Rule 34(3) applies, the grant of protection will be subject to the payment of the second part of the fee.

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or

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

(3) *[Confirmation of Total Provisional Refusal]* An Office which has sent to the International Bureau a notification of a total provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed and the Office has decided to confirm refusal of the protection of the mark in the Contracting Party concerned for all goods and services, send to the International Bureau a statement to that effect.

(4) *[Further Decision]* Where, following the sending of a statement in accordance with either paragraph (2) or (3), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned⁵.

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

[...]

Rule 24
Designation Subsequent to the International Registration

[...]

(9) *[Refusal]* Rules 16 to 18^{ter} shall apply *mutatis mutandis*.

[...]

⁵ Interpretative statement endorsed by the Assembly of the Madrid Union:

“The reference in Rule 18^{ter}(4) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”

Rule 28
Corrections in the International Register

[...]

(3) *[Refusal Following a Correction]* Any Office referred to in paragraph (2) shall have the right to declare in a notification of provisional refusal addressed to the International Bureau that it considers that protection cannot, or can no longer, be granted to the international registration as corrected. Article 5 of the Agreement or Article 5 of the Protocol and Rules 16 to 18*ter* shall apply *mutatis mutandis*, it being understood that the period allowed for sending the said notification shall be counted from the date of sending the notification of the correction to the Office concerned.

[...]

Rule 32
Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

- (i) international registrations effected under Rule 14;
- (ii) information communicated under Rule 16(1);
- (iii) provisional refusals recorded under Rule 17(4), with an indication as to whether the refusal relates to all the goods and services or only some of them but without an indication of the goods and services concerned and without the grounds for refusal, and statements and information recorded under Rules 18*bis*(2) and 18*ter*(5);

[...]

Rule 36
Exemption From Fees

[...]

(viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rules 18*bis* or 18*ter* or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(5) *[Transitional Provision Relating to Statements of Grant of Protection]* No Office shall be obliged to send statements of grant of protection under Rule 18^{ter}(1) before January 1, 2011.

[...]

[End of Annex II and of document]