

## **Working Group on the Legal Development of the Madrid System for the International Registration of Marks**

**Twentieth Session**  
**Geneva, November 7 to 11, 2022**

### **PROVISIONAL REFUSAL**

*Document prepared by the International Bureau*

### **INTRODUCTION**

1. At its nineteenth session, held in Geneva from November 15 to 17, 2021, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) discussed the practical challenges that holders face when receiving notifications of provisional refusal, insofar as time limits and their calculations are concerned.
2. Following the aforementioned discussion, the Working Group requested the International Bureau to prepare a document, for discussion at its next session, proposing amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Regulations” and “the Protocol”) providing for:
  - (i) a minimum time limit for the holder of an international registration to respond to a notification of a provisional refusal;
  - (ii) an obligation to clearly indicate in that notification the start and expiry date of the said time limit; and,
  - (iii) the delayed implementation of the proposed amendments giving Contracting Parties time to make the necessary legislative and administration changes.

3. This document proposes amendments to the Regulations reflecting the above-mentioned request from the Working Group, as well as other editorial amendments.

## BACKGROUND

4. The Working Group has discussed provisional refusals in three previous sessions.<sup>1</sup> More specifically, it discussed the challenges trademark holders face when they receive notifications of provisional refusal to keep track of the different time limits to respond to them and of the way to calculate these time limits.

5. In acknowledging these challenges, the Working Group discussed the possibility of prescribing either a fixed or a minimum time limit in the Regulations, as well as harmonizing the way to calculate them.

6. During the nineteenth session of the Working Group, a number of delegations expressed that they were in favor of having a minimum time limit of two months, rather than a fixed time limit. A minimum time limit of two months would be in line with the applicable legislation in most Contracting Parties, as revealed by the findings of a survey conducted by the International Bureau and presented to the Madrid Working Group Roundtable in 2014.<sup>2</sup> Eighty-five per cent of the Offices that participated in that survey indicated that their legislation allows for two months or more to respond to provisional refusals. A minimum time limit would allow Offices to provide for a time limit of more than two months in accordance with their applicable legislation.

7. A minimum time limit of two months, calculated from the date on which the International Bureau transmits the notification to the holder, would provide further certainty for all users of the Madrid System. This would not only provide holders with a clear end date, but also allow them sufficient time to consider the grounds of the provisional refusal, obtain translations, if necessary, and appoint a representative in the designated Contracting Parties concerned. However, several delegations indicated that such approach would be too challenging to implement, and that their preferred approach would be to oblige the Offices to indicate the start and expiry date of the applicable time limit in the notification.

8. Rule 17(2)(vii) of the Regulations states that the time limit to respond to a provisional refusal should be “reasonable under the circumstances”. While the Rule says that it would be preferable for Offices to indicate clearly in the notification of provisional refusal the end-date of the time limit, this indication is not required. Nonetheless, a number of delegations indicated that Offices would not be in a position to indicate those dates where the legislation provides for the time limit to begin when the International Bureau transmits the notification to the holder or when the holder receives the notification.

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<sup>1</sup> See documents MM/LD/WG/17/5 “Notification of Provisional Refusal – Time Limit to Reply and Ways in Which to Calculate that Time Limit”, MM/LD/WG/18/6 “Provisional Refusal”, and MM/LD/W/19/3 “Provisional Refusal”.

<sup>2</sup> See document “Information on Provisional Refusals”.

## **PROPOSED AMENDMENTS TO RULES 17, 18 AND 40 OF THE REGULATIONS**

9. In view of the above considerations, the International Bureau proposes an amendment to Rule 17(2)(vii) of the Regulations, to introduce a minimum time limit of two months. The proposed amendment would also introduce the requirement to indicate in the notification the start and expiry date of the said time limit, where it starts on a date other than the date on which the International Bureau transmits the notification to the holder or on which the holder receives the notification.

10. For the sake of clarity, the International Bureau proposes to break down the elements in Rule 17(2)(vii) by introducing three new subparagraphs. The International Bureau also proposes consequential amendments to Rule 18(1)(d) and (e) concerning irregularities with provisional refusals.

11. In previous sessions of the Working Group, some delegations explained that they would need time to amend their legislation as well as their Information and Communication Technology (ICT) systems to implement amendments concerning time limits. To allow Offices time to make the necessary amendments, the International Bureau proposes to introduce a transitional provision in Rule 40, providing a later date for the entry into force of the proposed amendments, for example, February 1, 2025.

## **OTHER PROPOSED AMENDMENTS TO RULES 17 AND 18 OF THE REGULATIONS**

12. The Offices of some designated Contracting Parties have expressed that, for practical reasons, they are unable to indicate in the notifications of *ex officio* provisional refusal the address of the holder because they might not have it for older domestic registrations. Other Offices have expressed that they are unable to do so due to strict privacy laws. Accordingly, the International Bureau proposes to amend Rule 17(2)(v) of the Regulations to account for these particular situations.

13. Where a notification of provisional refusal is based on earlier rights or on an opposition, it might be advantageous for the holder to receive information concerning the representative of the holder of the earlier rights or of the opponent, if any. The International Bureau proposes amending Rule 17(2)(v) and (3) for this purpose.

14. Rule 18(1)(a)(iii) of the Regulations states that, for the purposes of Article 5(2) of the Protocol, the date of the recording of the international registration or subsequent designation, as the case may be, is understood to be the same as the date on which the International Bureau sends the corresponding notification to the Offices concerned. This assumption was required when the Madrid System was a two-treaty system. It is no longer required because Article 5(2) of the Protocol states that the relevant refusal period starts on the date on which the International Bureau sends the notification. Consequently, the International Bureau proposes to amend Rule 18(1)(a)(iii) of the Regulations by deleting the said assumption.

15. For the sake of clarity, it is proposed to:

- (i) delete the reference to Rule 17(2)(vii) from Rule 18(1)(c)(iv) of the Regulations;
- (ii) amend Rule 18(1)(d) so it deals exclusively with defective notifications due to insufficient information for the holder to exercise the right to respond to a provisional refusal; and
- (iii) introduce a small consequential amendment to Rule 18(1)(c)(iii).

## PROPOSED DATE OF ENTRY INTO FORCE

16. It is suggested that the proposed amendments to Rules 17, 18 and 40 of the Regulations enter into force on November 1, 2023.

17. *The Working Group is invited to:*

*(i) consider the proposals made in this document; and,*

*(ii) recommend to the Madrid Union Assembly the adoption of the proposed amendments to the Regulations, as presented in the Annex to this document or in amended form, for entry into force on November 1, 2023.*

[Annex follows]

## Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~November 1, 2022~~November 1, 2023

[...]

### Rule 17 Provisional Refusal

[...]

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

[...]

- (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 of the representative, if any, their addresses, if possible, 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,

[...]

- (vii) the time limit, ~~reasonable under the circumstances~~which shall be no less than two months, 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,

(viii) where the time limit referred to in paragraph (2)(vii) begins on a date other than the date on which the International Bureau transmits a copy of the notification to the holder or the date on which the holder receives said copy, preferably with an indication of the date on which the said time limit expires~~begins and ends,~~  
~~and~~

(ix) the authority with which such request for review, appeal or response should be filed, ~~with~~and

(x) the~~an~~ 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 and of the representative, if any; 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.

[...]

## **Rule 18** **Irregular Notifications of Provisional Refusal**

### (1) *[General]*

- (a) A notification of provisional refusal communicated by the Office of a designated Contracting Party shall not be regarded as such by the International Bureau

[...]

- (iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of the time limit applicable under Article 5(2)(a) or, subject to Article 9*sexies*(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol, from the date on which ~~the recording of the international registration or the recording of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending~~the International Bureau sent the notification of the international registration or of the designation made subsequently.

- (b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

- (c) If the notification

- (i) is not signed on behalf of the Office which communicated it, or does not otherwise comply with the requirements of Rule 2 or with the requirement applicable under Rule 6(2),
- (ii) does not contain, where applicable, the details of the mark with which the mark that is the subject of the international registration appears to be in conflict (Rule 17(2)(v) and (3)),
- (iii) does not comply with the requirements of Rule 17(2)(vi), or
- (iv) ~~does not comply with the requirements of Rule 17(2)(vii), or~~ [Deleted]
- (v) [Deleted]

- (vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)),

the International Bureau shall, ~~except where subparagraph (d) applies,~~ nonetheless record the provisional refusal in the International Register. The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

- (d) Where the notification does not comply with the requirements of Rule 17(2)(vii) to (x), the provisional refusal shall not be regarded as such and shall not be recorded in the International Register. The International Bureau shall inform the Office that communicated the provisional refusal of this fact, indicate the reasons therefor and transmit to the holder a copy of the defective notification. If hHowever, if the Office sends a rectified notification is sent within the time limit referred to in subparagraph (e) two months from the date on which the International Bureau informed this Office of the defective notification, ~~it~~the rectified notification shall be regarded, for the purposes of Article 5 of the Protocol, as having been sent ~~to the International Bureau~~ on the date on which the defective notification had been sent to ~~it~~the International Bureau. ~~If the notification is not so rectified, it shall not be regarded as a notification of provisional refusal. In the latter case, the International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.~~
- (e) Any rectified notification shall, where the applicable law so permits, indicate a new time limit, ~~reasonable under the circumstances,~~ in accordance with Rule 17(2)(vii) to (x) 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.~~
- (f) The International Bureau shall transmit a copy of any rectified notification to the holder.

[...]

#### **Rule 40 Entry Into Force; Transitional Provisions**

[...]

(8) [Transitional Provision Relating to Rules 17(2)(vii) to (x) and 18(1)(e)] Offices may continue to apply Rules 17(2)(vii) and 18(1)(e), as in force on November 1, 2021, until [February 1, 2025].

[End of Annex and of document]