

WIPO



MM/A/32/2

ORIGINAL: English

DATE: October 3, 2000

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

ASSEMBLY

**Thirty-Second (19th Extraordinary) Session
Geneva, September 25 to October 3, 2000**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/35/1): 1, 2, 4, 5, 7, 10, 11, 22, 27 and 28.
2. The report on the said items, with the exception of item 10, is contained in the General Report (A/35/15).
3. The report on item 10 is contained in the present document.
4. Mrs. América Néstar Santos Riveras (Cuba), Chair of the Assembly, presided over the meeting of the Assembly.

ITEM 10 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE MADRID UNION

Common Regulations Under the Madrid Agreement and Protocol: Statement of Grant of Protection

5. Discussions were based on document MM/A/32/1.
6. Introducing the document, the Secretariat emphasized that the sending of a statement of grant of protection would not be obligatory for an Office and that the proposed amendments did not affect the principle that a mark that is the subject of an international registration enjoys the same protection as a mark registered by the Office of a designated Contracting Party if protection has not been refused within the prescribed time limit.
7. In reply to a question by the Delegation of Portugal, the Secretariat explained that subparagraph (i) on the one hand, and subparagraphs (ii) and (iii) on the other, dealt with different cases, depending on the system of examination of a designated Contracting Party; all were therefore needed.
8. The Delegation of Algeria stated that it had no difficulty in accepting the proposal, noting that the practice proposed was already implemented by some countries.
9. The Delegation of Cuba stated that it agreed with the amendments, it being understood that an Office would only send declarations of grant of protection when it was in a position to do so.
10. The Assembly unanimously adopted the amendments to Rule 17 and Rule 32(1)(a)(iii) of the Common Regulations under the Madrid Agreement and Protocol with effect from November 1, 2000, as proposed in paragraph 11 of document MM/A/32/1. The amended provisions are reproduced in the Annex to this report.

[Annex follows]

ANNEX

Amendments to Rule 17 and Rule 32(1)(a)(iii)

The following new paragraph was inserted in Rule 17:

(6) [*Statement of Grant of Protection*] (a) An Office which has not communicated a notification of refusal in accordance with Article 5 of the Agreement or Article 5 of the Protocol 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 by third parties, with an indication of the date by which such oppositions may be filed;

(iii) where a statement in accordance with subparagraph (ii) has been sent, a statement that the opposition period has expired without any opposition being filed and that the Office has therefore decided to grant protection to the mark that is the subject of the international registration.

(b) The International Bureau shall record any statement received under subparagraph (a) in the International Register and shall transmit a copy to the holder.

Rule 32(1)(a)(iii) was amended as follows:

(iii) refusals recorded under Rule 17(4), with an indication as to whether there is a possibility of review or appeal, but without the grounds for refusal, and statements of grant of protection recorded under Rule 17(6)(b);

[End of Annex and of document]