



WORLD INTELLECTUAL PROPERTY ORGANIZATION

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Additional Information Available in the ROMARIN Database

STATUS OF PROTECTION OF A MARK

1. Users of the Madrid system will be aware of the terms of Article 4 of the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating to that Agreement, concerning the effects of an international registration. Article 4 provides, *inter alia*, that if a provisional refusal has not been notified to the International Bureau in accordance with the relevant provisions of the treaties, or if a duly notified provisional refusal has subsequently been withdrawn, the protection of a mark in a designated Contracting Party shall be the same, from the date of international registration, as if the mark had been registered by the Office of the Contracting Party in question.
2. Users will also be aware that a number of Offices now notify to the International Bureau statements of grant of protection in accordance with the provisions of Rule 17(6) of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement. Such a statement is not mandatory, at present.
3. The advantage of such a statement is that in a case where the examination of a mark has been completed and the opposition period has expired without a mark becoming the subject of a notification of provisional refusal, the holder of the international registration will obtain definitive confirmation that the mark is then protected in the designated Contracting Party concerned. The holder will thus not be obliged to await the expiry of the refusal period in order to ascertain, by default, that the mark is protected in a given Contracting Party.
4. However, in the absence of the issuing by an Office of a statement of grant of protection, holders of international registrations, which have not, up to a given point in time, been the subject of a notification of provisional refusal, were heretofore required themselves to compute the refusal period, in order to ascertain the status of protection of a mark. This was done by reference to the information which was provided on the ROMARIN database, and by deduction, enabled holders to conclude, where appropriate, that in accordance with the provisions of the treaties, the mark was protected.
5. The International Bureau has taken the view that, with respect to the status of protection of a mark, holders of marks and users of the Madrid system would benefit if the scope of the information provided on the ROMARIN database could be enlarged and improved. To that end, modifications have been introduced into the ROMARIN database.

6. The principal aim of the modifications is, wherever possible, to provide holders of marks and users of the Madrid system with concrete information in relation to the status of protection of a mark. In simple terms, the result of the modifications is that, in all cases where the International Bureau has not recorded in the international register a provisional refusal with respect to a given mark (or, of course, a statement of grant of protection) and the refusal period has expired, a data entry in the form of an indication to that effect is published on the ROMARIN database. This, in effect, relieves holders and third parties who are seeking information with regard to the status of a mark from having to compute the relevant period and, as heretofore, by deduction, establishing a mark's status.

7. The indication reads as follows:

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved).

8. The indication will feature in the ROMARIN database where no statement of grant of protection has been recorded and the two conditions have been met:

- (i) the refusal period has expired, and
- (ii) the International Bureau has not recorded a notification of provisional refusal.

9. As a general rule, the indication will feature in the ROMARIN database, at the earliest, 30 days following the expiry of the relevant refusal period. For further guidance, the table attached to the present notice describes all possible situations where these two conditions would be met, so that, in relation to the designation in question, the indication will feature in ROMARIN.

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Situations in which the indication will feature in the ROMARIN database	Timing of the publication of the indication
<p>Case 1 – No notification of provisional refusal.</p> <p>The refusal period has expired and the International Bureau has not recorded any notification of provisional refusal, because the Office has not communicated any such notification to the International Bureau within the applicable refusal period.</p>	<p>30 days after the expiry of the refusal period</p>
<p>Case 2 – Irregular and not correctable notification of provisional refusal.</p> <p>The refusal period has expired and the International Bureau has not recorded any notification of provisional refusal, because the Office has communicated to the International Bureau a notification of provisional refusal which is not regarded as such by the International Bureau.</p>	<p>30 days after the expiry of the refusal period</p>
<p>Case 3 – Irregular, correctable, but not corrected notification of provisional refusal.</p> <p>The refusal period has expired and the International Bureau has not recorded any notification of provisional refusal because the Office has communicated an irregular notification of provisional refusal which is recorded only if rectified and which, in fact, has not been rectified within the time prescribed.</p>	<p>30 to 90 days after the expiry of the refusal period</p>
<p>Possibility of provisional refusal after 18-month time limit, based on an opposition.</p> <p>Case 4(a) – Where (i) a provisional refusal based on an opposition may be notified after the 18-month time limit and (ii) the Office has communicated to the International Bureau the dates on which the opposition period begins and ends, the refusal period has expired and the International Bureau has not recorded any notification of provisional refusal because:</p> <ul style="list-style-type: none"> – Case 1 applies => – Case 2 applies => – Case 3 applies => <p>Case 4(b) – Where (i) a provisional refusal based on an opposition may be notified after the 18-month time limit and (ii) the Office has communicated to the International Bureau only the date on which the opposition period begins, the refusal period has expired and the International Bureau has not recorded any notification of provisional refusal because:</p> <ul style="list-style-type: none"> – Case 1 applies => – Case 2 applies => – Case 3 applies => 	<p>1 month + 30 days after expiry of the opposition period</p> <p>1 month + 30 days after expiry of the opposition period</p> <p>1 month + 30 to 90 days after expiry of the opposition period</p> <p>7 months + 30 days from the beginning of the opposition period</p> <p>7 months + 30 days from the beginning of the opposition period</p> <p>7 months + 30 to 90 days from the beginning of the opposition period</p>