



## WORLD INTELLECTUAL PROPERTY ORGANIZATION

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### **PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

#### **Amendments to the Common Regulations Under the Madrid Agreement and Protocol: Statement of Grant of Protection**

1. On September 26, 2000, the Assembly of the Madrid Union adopted amendments to Rules 17 and 32 of the Common Regulations under the Madrid Agreement and Protocol, with effect from November 1, 2000. The text of the amendments appears below.
2. The amendment to Rule 17 consists in inserting a new paragraph (6), which provides for an Office which finds no ground of objection to the international registration to send a statement of grant of protection to the International Bureau before the expiry of the applicable refusal period. New paragraph (6) further provides for the International Bureau to record any such statement in the International Register and to transmit a copy thereof to the holder of the international registration. In addition, Rule 32(1)(a)(iii) has been amended to provide for the publication of statements of grant of protection in the Gazette.
3. The reason for these amendments is as follows: under the Madrid Agreement and Protocol, a mark that is the subject of an international registration is automatically protected in each of the designated Contracting Parties unless, within a time limit which is specified in Article 5(2) of the respective treaties, the Office of a designated Contracting Party expressly notifies the International Bureau that protection of the mark cannot be granted. This principle has always been considered as one of the main attractions of the Madrid system since, at the expiry of the applicable refusal period (12 or 18 months), the holder of an international registration is in a position to know how the protection of the mark stands in each designated Contracting Party, even if no communication has been received from the Office concerned. This was particularly advantageous in the days when many Offices routinely took longer than 12 months to examine applications filed directly with them. In recent years, however, many Offices have reduced their backlogs and are able to issue examination reports in a period shorter than one year. This means that, well before the expiry of the applicable refusal period, an Office may already be in a position to know that it will not issue a refusal of protection.
4. The amendment to Rule 17 is aimed at encouraging Offices to give early notice to holders of international registrations that protection is not being refused. Moreover, the publication of this information will improve transparency as far as third parties are concerned.

5. An Office which avails itself of this possibility is free to choose whether to send a single notice of acceptance once all procedures before that Office have been completed without any objections being raised (subparagraph (i) of Rule 17(6)(a)), or two notices, the first at the end of the *ex officio* examination, informing the holder that the mark is still subject to the possibility of opposition by third parties, and the second at the expiry of the opposition period (subparagraphs (ii) and (iii)).

6. It must be stressed that the adoption of Rule 17(6) does not create any obligation for an Office to send a statement of grant of protection where it finds no objection to the international registration; it simply offers the possibility for an Office to do so. Furthermore, no legal consequences result from the fact that no statement of grant of protection has been sent by an Office.

October 6, 2000

### **Text of the amendments**

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 to read 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);