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MADRID AGREEMENT AND PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Adoption of New Rules and Amendments to the Common Regulations Under the Madrid Agreement and Protocol

1. At its fortieth (23rd extraordinary) session, which took place in Geneva from September 22 to September 30, 2008, the Assembly of the Madrid Union adopted a number of new rules and certain amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, along with a number of consequential amendments and modification of two interpretative statements.
2. The new rules and amendments are aimed at improving the accessibility of information regarding the fate of international registrations in designated Contracting Parties and will come into effect on September 1, 2009.

Amendment of Rules 16 and 17

Rule 16

3. The communication by an office to the International Bureau of the dates on which the opposition period begins and ends, as provided for by Rule 16(1)(b), has been amended in order to make that less open-ended. 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 replaced by “as soon as they are known”. The introduction of that amendment is intended to ensure that in all cases – including those cases where there is not in fact any notification of a provisional refusal based on an opposition – the relevant dates will be communicated by the offices.
4. A footnote accompanying amended Rule 16(1)(b) notes that, 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

5. The provisions of current Rule 17 that are concerned with the interim and final status of a mark, and the communication to the International Bureau of same, have migrated to new Rules 18*bis* and 18*ter*. Otherwise, the text of current Rule 17 remains unaltered, apart from the title of the rule and of paragraphs (5)(d) and (e). When it comes into effect, the resulting narrowed scope of Rule 17 will then deal specifically and exclusively with the act of notification of a provisional refusal.

New Rules 18*bis*, 18*ter* and 40(5)

6. New Rules 18*bis* and 18*ter* principally relocate and re-title the provisions of current Rule 17 of the Common Regulations that are concerned not specifically with the act of notification of a provisional refusal, but rather with the status, in a designated Contracting Party, of a mark that is the subject of an international registration, and the communication to the International Bureau, by an office, of that status. New Rule 40(5) contains a transitional provision with regard to statements of grant of protection under new Rule 18*ter*(1).

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

Ex Officio Examination Completed but Opposition or Observations by Third Parties Still Possible

7. Paragraph (1)(a) of the new rule reiterates the optional facility (that already exists under current Rule 17(6)(a)(ii)) for 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, but that the protection of the mark is still subject to opposition or observations by third parties.

8. Paragraph (1)(b) now also provides for a similar facility for an office that *has* communicated a notification of provisional refusal and subsequently concluded favorably the *ex officio* examination. The issuing of such a statement will remain optional, as at present.

9. Finally, paragraph (2) provides for the recording of any information received from an office under paragraph (1). For the purpose of this rule, the International Bureau will also accept from offices lists of international registration numbers, which it will convert into individual communications for transmission to holders.

New Rule 18*ter* – Final Disposition on Status of a Mark

Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated

10. Paragraph (1) of the new rule provides 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, the 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 in the Contracting Party concerned. When the new Rule 18ter(1) comes into effect, the sending of such statement will be obligatory (in this regard, see also paragraph 17, below).

Statement of Grant of Protection Following a Provisional Refusal

11. It will be recalled that current Rule 17(5)(a)(ii) and (iii) (entitled *Confirmation or Withdrawal of Provisional Refusal*) requires 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. The final statement is required to indicate that the mark is protected for all the goods and services, or to indicate the goods and services for which the mark is protected.

12. That requirement has now been transposed to paragraph (2) of the new rule. While the scope of the obligation remains unchanged, the new paragraph speaks of the communication of a *statement of grant of protection* rather than *confirmation or withdrawal* of a provisional refusal (as at present under Rule 17(5)).

Confirmation of Total Provisional Refusal

13. Under current Rule 17(5)(a)(i) an office that has sent to the International Bureau a notification of total provisional refusal, to the extent that such provisional refusal is totally confirmed, is required, once all the procedures before the office have been completed, to send to the International Bureau a final decision that protection of the mark is refused for all the goods and services.

14. That requirement has now been transposed to paragraph (3) of the new rule. As with paragraph (2) of the new rule, there is no change in the scope of the requirement. Instead of the current title, *Confirmation or Withdrawal of Provisional Refusal*, under Rule 17(5), new paragraph (3) is simply entitled *Confirmation of Total Provisional Refusal*.

Further Decision

15. Paragraph (4) of the new rule relocates from current Rule 17(5)(b) the provision – which remains unchanged – concerning a “further” decision affecting the protection of the mark.

Recording, Information to the Holder and Transmittal of Copies

16. Finally, paragraph (5) of the new rule provides for the recording of any statement received under the rule and the communication of such statements to holders.

New Rule 40(5) – Transitional Provision

17. As already noted, new Rules 18bis, 18ter and 40(5), as well as the amendments referred to above and below, will come into force on September 1, 2009. However, in order to facilitate the work of offices that may require time to implement new Rule 18ter(1), Rule 40(5) provides that no office shall be *obliged* to send statements of grant of protection under Rule 18ter(1) before January 1, 2011.

Consequential Amendments to Rules 24, 28, 32 and 36 and Modification of Interpretative Statements

18. The following consequential amendments were adopted:

(a) Rule 24, paragraph (9): the reference in that paragraph to “Rules 16 to 18” is replaced by the reference to “Rules 16 to 18*ter*”;

(b) Rule 28, paragraph (3): the reference in the fifth line of that paragraph to “Rules 16 to 18” is replaced by the reference to “Rules 16 to 18*ter*”;

(c) Rule 32, subparagraph (1)(iii): the reference in the final line of that subparagraph to “Rule 17(5)(c) and (6)(b)” is replaced by the reference to “Rules 18*bis*(2) and 18*ter*(5)”;

(d) Rule 36, subparagraph (viii): the reference in that subparagraph to “Rule 17(5) or (6)” is replaced by the reference to “Rules 18*bis* or 18*ter*”.

19. The following consequential modifications to interpretative statements were adopted:

(a) The interpretative statement referring to current Rule 17(6)(a)(ii) and (iii) is modified so that it refers to Rule 18*bis*;

(b) The interpretative statement referring to current Rule 17(5)(b) is modified so that it refers to Rule 18*ter*.

20. The text of new Rules 18*bis*, 18*ter* and 40(5) of the Common Regulations, the amended text of Rules 16, 17, 24, 28, 32 and 36, and the modified text of the two interpretative statements are reproduced in the Annex hereto.

21. For those who seek a more detailed presentation of the new rules and the amendments, the Madrid Assembly document MM/A/40/1 may be accessed at the following url: http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=103832.

December 18, 2008

ANNEX

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) Subject to Article 9sexies(1)(b), 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 known².

(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

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.

(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.

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 filed³.

(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]*⁴ 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 concerned⁵.

³ 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.”

⁴ 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.

⁵ 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.

(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

(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 concerned⁶.

(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*.

[...]

⁶ 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 18ter 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 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 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 18^{ter}(1) before January 1, 2011.

[...]

[End of Annex]