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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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**SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS
(MADRID UNION)**

ASSEMBLY

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

**COMMON REGULATIONS UNDER THE MADRID AGREEMENT AND PROTOCOL:
STATEMENT OF GRANT OF PROTECTION**

Memorandum prepared by the International Bureau

1. A fundamental principle of the system of international registration of marks under the Madrid Agreement and the Madrid Protocol is that the 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 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 is stated in the second sentence of Article 4(1)(a) of the Protocol, which provides that, if no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2), the protection of the mark in the Contracting Party concerned shall be the same as if the mark had been registered by the Office of that Contracting Party. In the case of the Agreement, this principle follows from a reading of Article 4(1) and Article 5(1) and (2).

2. The result is that, in contrast to the position when an application for registration is filed directly with an Office, it is not necessary to await a positive decision on protection; the holder of an international registration knows that, if no refusal has been sent to the International Bureau within the period applicable under Article 5(2) of the Agreement or

Protocol¹, the mark is protected. For this reason, neither the Agreement or Protocol nor the Common Regulations under the Agreement and Protocol provides for an Office to notify the International Bureau or the holder of the fact that it has found no grounds for objection and that protection is not therefore refused, or is granted.

3. The fact of knowing, at the end of the applicable period (one year or 18 months), that the mark is protected even though the Office concerned has sent no communication to this effect has always been considered one of the main advantages of the Madrid system for users. This was particularly true in the days when many Offices routinely took longer than 12 months to examine applications filed direct 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—often as little as two or three months. This means that, if the Office does not inform the holder of an international registration in the case where it has decided not to refuse protection, the latter is treated less favorably than a direct applicant.

4. As already noted, there is no provision for an Office which finds no ground of objection to inform either the International Bureau or the holder of this fact. Nonetheless, at least the United Kingdom Patent Office sends such information directly to the holder. This means that the holder knows, without having to wait until the end of the period allowed for notifying a refusal, that the mark has met with no official objections. However, since this information is not recorded or published, third parties are not made aware of the situation regarding the protection of the mark.

5. In order to encourage Offices to give early notice to holders that protection is not being refused, and to improve transparency as far as third parties are concerned, it is proposed that specific provision be made in the Common Regulations for one or more statements to this effect to be sent to the International Bureau, which would record these statements in the International Register, copy them to the holder and publish them in the Gazette.

6. The intention is that these statements would fulfil the same purpose as the communication or communications sent by an Office to the applicant in the case of a direct national or regional application. The practice of Offices varies in this regard. Some Offices send a single communication, after the *ex officio* examination has been completed without any objections being raised and (where the applicable law provides for opposition by third parties) after the opposition period has expired without any opposition being filed, informing the applicant that the mark has been or will be registered. Other Offices send a first communication informing the applicant that the *ex officio* examination has been completed without any objections being raised and that the opposition period is about to start, followed by a further communication once the opposition period has expired without any opposition being filed.

¹ Under Article 5(2) of the Agreement and Article 5(2)(a) of the Protocol the applicable period is one year. In the case of a Contracting Party that is designated under the Protocol and has made the declaration referred to in Article 5(2)(b) of the Protocol, the period is 18 months. In the case of such a Contracting Party that has additionally made the declaration referred to in Article 5(2)(c) of the Protocol, a refusal based on an opposition may be sent after the expiry of the period of 18 months, provided that notice of this possibility has been communicated within the said period.

7. It must be stressed that the adoption of this provision would not create any obligation for an Office to send such communications. It should also be emphasized that no legal consequences would result from the fact that no statement of acceptance is sent under the Regulations.
8. The present proposal is inspired in part by the agreed statement that was adopted by the Diplomatic Conference that, in July 1999, adopted the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs. Article 12 of the Geneva Act, like Article 5 of the Madrid Agreement and Madrid Protocol, provides for an Office to communicate, within a prescribed period, a refusal of the effects of an international registration. The relevant part of the agreed statement reads: "It was also understood that an Office may, within the period allowed for communicating a notification of refusal, send a statement to the effect that it has decided to accept the effects of the international registration even where it has not communicated such a notification of refusal." This statement was proposed by the Delegation of Japan and supported by the Delegations of France, the Republic of Korea, the Russian Federation and the United States of America.
9. The provision could take the form of a new paragraph (paragraph (6)) in Rule 17 of the Common Regulations under the Madrid Agreement and Protocol. It would also entail amendment of Rule 32(1)(a)(iii) in order to provide for the publication of statements of grant in the Gazette. Draft provisions appear in the Annex to this document.
10. It is suggested that such provision be adopted with effect from November 1, 2000. This would enable the International Bureau to record, publish and copy to the holder any statement which is received on or after that date.

11. The Assembly is invited to adopt the amendments to the Common Regulations set out in the Annex to this document with effect from November 1, 2000.

[Annex follows]

ANNEX

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

In Rule 17, insert the following new paragraph:

(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.

In Rule 32(1)(a)(iii), make the following amendment:

(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]