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AD HOC WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Second Session
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STANDARDIZED FORMS FOR THE USE OF OFFICES OF CONTRACTING PARTIES

Document prepared by the International Bureau

1. On the occasion of the first session, in July 2005, of the *ad hoc* Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), the delegation of Norway raised the merits of possible standardized forms or templates to be used by the Offices of Contracting Parties for various notifications to the International Bureau, notably in the context of provisional refusals, statements of grant of protection and information relating to late oppositions. The Working Group considered this matter and agreed that it required further discussion. The conclusions and recommendations of the Working Group are contained in document MM/LD/WG/1/3, comprising the Report adopted by the Working Group at the conclusion of its first session and submitted to the Assembly of the Madrid Union (document MM/A/36/1) at its 36th session in September 2005.

2. At its 36th session in September 2005, the Assembly of the Madrid Union decided that a further meeting of the Working Group should be convened for the purpose of considering, *inter alia*, the establishment of standardized forms or templates for various notifications, notably in the context of provisional refusals, statements of grant of protection and information relating to late oppositions (see paragraph 15, document MM/A/36/3).

3. The present document contains, for the consideration by the second session of the Working Group, standardized forms for the following five kinds of communications to be addressed to the International Bureau by the Offices of Contracting Parties:

- Notification of provisional refusal (see Standardized Form A);
- Statement of confirmation or withdrawal of a provisional refusal (see Standardized Form B);
- Information relating to possible oppositions (see Standardized Form C);
- Statement of grant of protection (see Standardized Form D);
- Notification relating to the ceasing of effect (see Standardized Form E).

4. It is to be noted that with respect to these, the Common Regulations under the Madrid Agreement and the Protocol provide that the International Bureau shall transmit a copy of the communication received to the holder (with respect to the notification of provisional refusal, it is further provided that a copy thereof shall be transmitted to the Office of origin, if that office has informed the International Bureau that it wishes to receive such copies). Standardization, amongst the Offices of the Contracting Parties, of the canvass used for a given type of communication would thus be of particular interest for holders of international registrations.

5. For each given communication, the proposed standardized form reflects the requirements regarding contents as laid out by the Rule under which such communication is to be issued and is thus generally self-explanatory. In all instances, the International Bureau will continue to provide further guidance to the Office of any Contracting Party as to how and when a specific information should be provided, whether that Office intends to adopt the standardized form or not.

6. In that respect, it should be further noted that forms A and B, which are of relevance to the Offices of all Contracting Parties, are admittedly not universal nor exhaustive. In particular, depending on the applicable law and procedure in the territory of a Contracting Party, as well, of course, as on the corresponding declarations that this Contracting Party has made, certain additional elements may have to be provided for. In such instances, the International Bureau sees it important to work closely with the Office of that Contracting Party to arrive to a layout that is fully adapted to its needs and obligations.

7. The Working Group is invited to consider the proposed standardized forms and to formulate its recommendations to the Assembly of the Madrid Union.

[Annex follows]

ANNEX

*Standardized Form A***MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION
OF MARKS AND PROTOCOL RELATING TO THAT AGREEMENT****PROVISIONAL REFUSAL OF PROTECTION**

Notified to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 17(1) of the Common Regulations under the Madrid Agreement and Protocol

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder of the international registration:
IV.	<input type="checkbox"/> Provisional refusal based on an <i>ex-officio</i> examination <input type="checkbox"/> Provisional refusal based on an opposition ¹ <input type="checkbox"/> Provisional refusal based on both an <i>ex-officio</i> examination and an opposition ¹
V.	<input type="checkbox"/> Provisional refusal for all the goods and/or services <input type="checkbox"/> Provisional refusal for some of the goods and/or services: [followed by an indication of the goods and/or services which are affected or are not affected] ²
VI.	Grounds for refusal [(where applicable, see item VII)]:

¹ The name and address of the opponent should also be provided.

² Where all the goods or services included in a given class are to be mentioned, the indication should read "all goods (or all services) in class X". In all cases, a clear indication should be given as to whether those goods and/or services are affected, or are NOT affected.

VII. Information relating to an earlier mark³

- (i) Filing date and number, and, if any, priority date:
- (ii) Registration date and number (if available):
- (iii) Name and address of the owner:
- (iv) Reproduction of the mark:

- (v) List of all or relevant goods and/or services:

VIII. Corresponding essential provisions of the applicable law [(see text under XII)]:

IX. Information relating to subsequent procedure

- (i) Time limit for requesting review or appeal:
- (ii) Authority to which such request for review or appeal should be made:
- (iii) Indications concerning the appointment of a representative:

X. Date of the notification of provisional refusal:

XI. Signature or official seal of the Office making the notification:

³ Where the grounds on which the provisional refusal is based relate to an earlier mark, as indicated under item VI. The indication required under this item may be given by annexing a printout from the register or database.

XII. Corresponding essential provisions of the applicable law:

Standardized Form B

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

CONFIRMATION OR WITHDRAWAL OF A PROVISIONAL REFUSAL

Statement sent to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 17(5) of the Common Regulations under the Madrid Agreement and Protocol

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder of the international registration:
IV.	<input type="checkbox"/> The notification is sent in accordance with Rule 17(5)(a) ¹ <input type="checkbox"/> The notification is sent in accordance with Rule 17(5)(b) ²
V.	<input type="checkbox"/> Protection of the mark is refused for all the goods and/or services <input type="checkbox"/> Protection of the mark is granted for all the goods and/or services <input type="checkbox"/> Protection of the mark is granted for the following goods and/or services ³ :
VI.	Date of the statement:
VII.	Signature or official seal of the Office sending the statement:

¹ A statement under Rule 17(5)(a) is sent once ALL PROCEDURES BEFORE THE OFFICE have been completed.

² A statement under Rule 17(5)(b) is a statement concerning a FURTHER DECISION affecting the protection of a mark, SUBSEQUENT to the sending of a statement in accordance with Rule 17(5)(a).

³ ALL the goods and/or services for which protection is granted, INCLUDING those which were not concerned by the provisional refusal, should be indicated here. Where all the goods or services included in a given class are accepted, ONLY THE NUMBER of that class should be indicated.

Standardized Form C

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

INFORMATION RELATING TO POSSIBLE OPPOSITIONS

Communicated to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 16(1) of the Common Regulations under the Madrid Agreement and Protocol

I. Office communicating the information:
II. Number of the international registration:
III. Name of the holder of the international registration:
IV. Date on which the opposition period begins ¹ : Date on which the opposition period ends ¹ :
V. Date of the communication:
VI. Signature or official seal of the Office communicating the information:

¹ These dates should be indicated where they are known at the time of sending the communication. If they are not, the indication "NOT KNOWN ON THE DATE OF THIS COMMUNICATION" should be given, and the dates shall be communicated to the International Bureau at the latest at the same time as any notification of a provisional refusal based on an opposition.

Standardized Form D

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

STATEMENT OF GRANT OF PROTECTION

Sent to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 17(6) of the Common Regulations under the Madrid Agreement and Protocol

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder of the international registration:
IV.	<input type="checkbox"/> All procedures before the Office have been completed; protection is accordingly granted to the mark that is the subject of this international registration (Rule 17(6)(i)) <input type="checkbox"/> The <i>ex officio</i> examination in respect of this international registration has been completed and no grounds for refusal have been found; however the protection of the mark is still subject to opposition or observations by third parties; the opposition period will start on.....and will expire on.....(Rule 17(6)(ii)) <input type="checkbox"/> The opposition period in respect of this international registration has expired without any opposition being filed; protection is accordingly granted to the mark that is the subject of the international registration (Rule 17(6)(iii))
V.	Date of the statement:
VI.	Signature or official seal of the Office sending the statement:

Standardized Form E

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

**CEASING OF EFFECT OF THE BASIC APPLICATION, OF THE REGISTRATION
RESULTING THEREFROM, OR OF THE BASIC REGISTRATION**

Notified to the International Bureau of the World Intellectual Property Organization (WIPO) in
accordance with Rule 22(1)(a) or (c) of the Common Regulations
under the Madrid Agreement and Protocol

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder of the international registration:
IV.	<input type="checkbox"/> The notification is sent in accordance with Rule 22(1)(a) <input type="checkbox"/> The notification is sent in accordance with Rule 22(1)(c)
V.	Facts and decisions affecting the basic application, the registration resulting therefrom, or the basic registration:
VI.	<input type="checkbox"/> These facts and decisions affect all the goods and/or services <input type="checkbox"/> These facts and decisions affect some of the goods and/or services: [followed by an indication of the goods and/or services which are affected or are not affected] ¹

¹ The goods and/or services to be indicated here are as follows:

- those goods and/or services in the **international registration concerned** which are affected by the facts and decisions, or
- if there has already been a partial cancellation, those, out of the remaining goods and/or services, which are affected by the facts and decisions.

Where all the goods or services included in a given class are to be mentioned, the indication should read “all goods (or all services) in class X”. In all cases, a clear indication should be given as to whether those goods and/or services are affected, or are NOT affected.

VII. The cancellation of the international registration is requested to the extent indicated under item VI

VIII. Effective date of those facts and decisions:

IX. Signature or official seal of the Office making the notification:

[End of Annex and of document]