

WIPO



MM/LD/WG/6/4.

ORIGINAL: English

DATE: October 17, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Sixth Session
Geneva, November 24 to 28, 2008

INFORMATION RELATING TO THE FATE OF DESIGNATIONS:
REVISED MODEL FORMS FOR OFFICES OF CONTRACTING PARTIES

prepared by the International Bureau

I. BACKGROUND

1. It is first recalled that at its last (fifth) session, which was held in Geneva from May 5 to 9, 2008, the Working Group on the Legal Development of the Madrid System (hereinafter referred to as “the Working Group”) considered, *inter alia*, the issue of information relating to the fate of designations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively as “the Agreement” and “the Protocol”¹).
2. The discussions of the Working Group were based on document MM/LD/WG/5/2 and the report of that session is contained in document MM/LD/WG/5/8.
3. At the conclusion of that session, the Working Group agreed to recommend that the Madrid Union Assembly amend the Common Regulations, as reproduced in the draft contained in Annex I of document MM/LD/WG/5/8, including one transitional provision, with September 1, 2009, as the proposed date of entry into force.

¹ Likewise, the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement will be hereinafter referred to as “the Common Regulations”.

4. At its fortieth (23rd Extraordinary) session held in Geneva from September 22 to 30, 2008, the Madrid Union Assembly adopted the amendments referred to above, with September 1, 2009, as the date of entry into force. For ease of reference, the final amended text, as adopted, of the rules of the Common Regulations in question, is reproduced in Annex I hereto.
5. It will be recalled that, in addition to the discussions concerning information regarding the fate of designations, the Working Group also gave consideration to a number of model forms, for use by offices, which had been prepared by the International Bureau, and which were reproduced in Annex II of document MM/LD/WG/5/2. Those model forms were intended to reflect and complement the substance of the proposed amendments in the draft text submitted to the Working Group for its consideration.
6. The purpose of this document is to now submit for the consideration of the Working Group a revised set of model forms in relation to the provision of information concerning the fate of designations, adapted so as to reflect the final text of the proposed amendments, as adopted by the Madrid Union Assembly at its fortieth session. The revised model forms are reproduced in Annex II hereto.
7. A short presentation of the forms is contained in paragraph III of this document.
8. It is to be underlined that these forms are merely *model* forms, made available for the assistance and convenience of the Offices of Contracting Parties, where notifications, communications or statements may or should be sent to the International Bureau.
9. It is to be recalled that in addition to the furnishing by offices of individual notifications, communications or statements, the International Bureau indicated at the last session of the Working Group its willingness to accept also lists that offices may wish to send to it, as an alternative to individual and separate communications (see paragraphs 3, 34, 46 and 58 of document MM/LD/WG/5/2 and paragraphs 40, 41 and 68 of document MM/LD/WG/5/8). In this regard, it is to be noted that the text of paragraph (1) of new Rule 18^{ter} (concerning the sending of statements of grant of protection where no notification of provisional refusal has been communicated) includes a footnote which reads “*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.*”
10. A detailed presentation of the amendments as recommended by the Working Group at its fifth session and as adopted by the Madrid Union Assembly at its fortieth session is contained, respectively, in document MM/LD/WG/5/8, containing the report of that session of the Working Group, and in Assembly document MM/A/40/1.
11. It is therefore not proposed to elaborate further in detail on those amendments in this paper. Instead, what follows is a brief outline of the amendments, as adopted.

II. BRIEF OVERVIEW OF THE AMENDMENTS, AS ADOPTED

Amended Rules 16 and 17, and new Rules 18bis and 18ter of the Common Regulations

12. Paragraph (1)(b) of current Rule 16 has been amended in order that the requirement concerning the communication of the start and end dates of the opposition period will be less open-ended. For this reason, the reference, in current paragraph (1)(b) of that rule, to the communication of the dates “*at the latest at the same time as any notification of a provisional refusal based on an opposition*” has been replaced by “*as soon as they are known*”.

13. The scope of current Rule 17, dealing with provisional refusals, has been narrowed so as to contain only provisions dealing specifically and exclusively with the act of notifying a provisional refusal.

14. New Rule 18bis now deals with the *interim* status of a mark, and, in particular, that aspect of current Rule 17 which enables an office, *optionally*, to send a statement of grant of protection when that office has concluded its *ex officio* examination, including, additionally, cases where a notification of provisional refusal had earlier been communicated. This facility remains optional.

15. New Rule 18ter now consists of three “tiers”, each dealing successively with the final disposition as to the status of a mark. The first tier of new Rule 18ter, paragraph (1), deals with that aspect of current Rule 17 which enables an office, *optionally* (at present), to send a statement of grant of protection where, before the expiry of the applicable refusal period, all procedures before the office have been completed and there is no ground for that office to refuse protection. However, under paragraph (1) of new Rule 18ter, the communication of this information will be *mandatory*. This new paragraph retains in its title the concept of *statement of grant of protection*, as currently in paragraph (6) of Rule 17.

16. The second tier of new Rule 18ter, paragraph (2), deals with what is currently the communication of the final decision by an office which has already notified a provisional refusal, but only to the extent that it has been decided to partially or fully grant protection for the goods and services covered by the mark in question. This new paragraph acquires in its title also the concept of *statement of grant of protection*, rather than the notion of *confirmation or withdrawal of provisional refusal*, as currently in paragraph (5) of Rule 17.

17. Finally, the third tier of new Rule 18ter, paragraph (3) also deals with what is currently the communication of the final decision by an office which has already notified a provisional refusal, but only to the extent that a provisional refusal is totally confirmed. This new paragraph retains the notion of *confirmation of provisional refusal*, as at present in paragraph (5) of current Rule 17.

18. It is recalled that while the amended and new provisions will come into force on September 1, 2009, no office will be obliged to send statements of grant of protection under new Rule 18ter(1) before January 1, 2011.

19. It is recalled also that the amendments to the Common Regulations necessitated a small number of consequential amendments. For the purpose of this document, those additional amendments are not reproduced in Annex I.

III. PRESENTATION OF THE PROPOSED MODEL FORMS

Model Form 1 – Rule 16(1)(a)

Information Relating to Possible Oppositions

20. Model form 1 is concerned with the communication of information relating to possible oppositions, under Rule 16(1)(a). It reflects what is currently standard form C, with the addition of new elements following the amendment of Rule 16 – firstly, if the opposition period is extendible, model form 1 provides for the communication of the start date, and secondly, where no dates are given, the form recalls that the information must be given as soon as the dates are known, rather than “*at the latest, the same time as any notification of a provisional refusal based on an opposition*” (paragraph (b), second sentence, current Rule 16(1)).

Model Form 2 – Rule 16(1)(b)

Date on Which Opposition Period Begins and Ends

21. Model form 2 complements model form 1 and is intended to be used by an office which has already sent to the International Bureau model form 1, at a time when the dates of the opposition period were not known.

Model Form 3 – Rule 17

Notification of Provisional Refusal

22. In substance, model form 3 is merely a replication of what is currently standard form A, dealing with the notification of a provisional refusal, under Rule 17(1). The provisions of Rule 17 which deal with the notification of a provisional refusal remain unchanged.

Model Form 4 – Rule 18^{ter}(1)

Final Disposition on Status of a Mark

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

23. Model form 4 takes from current standard form D the remaining elements of what is covered by current Rule 17(6). While this statement is optional under Rule 17(6), it will be compulsory under new Rule 18^{ter}(1). In simple terms, it is a statement that is required to be sent where, before the expiry of the refusal period, all procedures before an office have been completed and there is not any ground for the office to refuse protection to the mark. This could be considered as the first-level final disposition on the status of a mark.

Model Form 5 – Rule 18ter(2)

Final Disposition on Status of a Mark

Statement of Grant of Protection Following a Provisional Refusal

24. Model form 5 replaces part of what is currently standard form B. The latter, it will be recalled, deals with what is provided for by (current) Rule 17(5) – that is to say, confirmation or withdrawal of provisional refusal, once all the procedures before the office have been completed.

25. New Rule 18ter(2) provides for what might be called the second-level final disposition on the status of a mark. It will be recalled that what is currently provided for under Rule 17(5) has been transposed to new subparagraphs (2) and (3) of Rule 18ter. New Rule 18ter(2) requires that where an office has already communicated a notification of provisional refusal and subsequently all the procedures before the office have been completed, with protection being granted to some or all of the goods and services, then that office shall communicate a statement to that effect.

Model Form 6 – Rule 18ter(3)

Final Disposition on Status of a Mark

Confirmation of Total Provisional Refusal

26. Model form 6 replaces the remaining part of what is currently standard form B. New Rule 18ter(3) provides for what might be called the third-level final disposition on the status of a mark. It is intended to be used by an office that has already notified a provisional refusal when, following the completion of all procedures before the office, refusal of protection is confirmed for all the goods and/or services.

Model Form 7 – Rule 18ter(4)

Further Decision Affecting Protection of a Mark

27. Model form 7 deals with what is provided for by current Rule 17(5)(b) and new Rule 18ter(4) – the communication of information to the International Bureau where there has been a further decision affecting the protection of a mark. There is not presently a standard form available for the use of offices with respect to Rule 17(5)(b).

Model Form 8 – Rule 18bis(1)(a) and (b)

Completion of Ex Officio Examination – Interim Status of a Mark

28. This form replaces part of what is currently standard form D, entitled *Statement of Grant of Protection*, under current Rule 17(6). It will be recalled that current Rule 17(6) provides, optionally, for an office which has not communicated a notification of provisional refusal to send to the International Bureau, within the applicable refusal period,

– a statement to the effect that all procedures before the office have been completed and that the office has decided to grant protection;

– a statement to the effect that *ex officio* examination has been completed and the office has found no grounds for refusal, but that the protection of the mark is still subject to opposition or observations (with an indication of the date by which these may be filed);

– where the latter has been sent, a further statement to the effect that the opposition period has expired without any opposition or observations being filed and that the office has therefore decided to grant protection to the mark.

29. Current standard form D provides for each of the above three scenarios. It will be recalled, however, that the second of the above scenarios has now been provided for by new Rule 18bis, as reflecting essentially the *interim* status of a mark, and not its final disposition.

30. The sending of model form 8 will continue to be optional, and will provide also for the case where an office, following an *ex officio* examination, has notified a provisional refusal, which has been subsequently withdrawn (new Rule 18bis(1)(b)). In other words, it may be sent, optionally, in all cases where the *ex officio* examination has been concluded favorably for the holder.

31. *The Working Group is invited to consider the above and to indicate its approval of the revised model forms, for use by Offices of Contracting Parties regarding information relating to the fate of designations.*

[Annexes follow]

ANNEX I

**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]* (a) Subject to Article 9*sexies*(1)(b) of the Protocol, 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 known¹.

(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) *[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.

¹ 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
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 18ter(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 18ter(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 18ter(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 filed².

² 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.”

(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*]³ 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 concerned⁴.

(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.

³ 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.

⁴ 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.

(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 concerned⁵.

(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*.

[...]

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 18~~ter~~ 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.

[...]

⁵ 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 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 18*bis*(2) and 18*ter*(5);

[...]

Rule 36
Exemption From Fees

[...]

(viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rules 18*bis* or 18*ter* or any declaration under Rule 20*bis*(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.

[...]

[Annex II follows]

ANNEX II

*Model Form 1***MADRID PROTOCOL****INFORMATION RELATING TO POSSIBLE OPPOSITIONS****Rule 16(1)(a)**

This form is for use by those Offices that have declared an extended refusal period of 18 months and the possibility of notifying a provisional refusal based on an opposition later than 18 months, in certain cases (Article 5(2)(b) and (c) of the Protocol). The form should be sent to the International Bureau where it has become apparent, with regard to a given international registration, that the opposition period will expire too late for the notifying of a provisional refusal based on an opposition within the period of 18 months.

Where, at the time of this communication, the dates on which the opposition period begins and ends are known, those dates shall be indicated (Rule 16(1)(b)). If those dates are not yet known, they shall be communicated to the International Bureau as soon as they are known (by using Model Form 2). If the opposition period is extendable, the Office may communicate only the date on which the opposition period begins.

I.	Office communicating the information:
II.	Number of the international registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	<input type="checkbox"/> Dates on which the opposition period begins and ends known: <ul style="list-style-type: none"> – Date on which the opposition period begins: – Date on which the opposition period ends: <input type="checkbox"/> Opposition period extendable and date on which the opposition period begins known: <ul style="list-style-type: none"> – Date on which the opposition period begins: <input type="checkbox"/> Dates on which the opposition period begins and ends not known.
V.	Signature or official seal of the Office communicating the information:
VI.	Date:

Model Form 2

MADRID PROTOCOL

DATES ON WHICH OPPOSITION PERIOD BEGINS AND ENDS

Rule 16(1)(b)

This form is to be used when an Office has previously sent to the International Bureau information relating to possible oppositions (Model Form 1), at a time when the dates of the opposition period were not known. The Office now communicates those dates to the International Bureau.

I. Office communicating the information:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. <input type="checkbox"/> Dates on which the opposition period begins and ends: – Date on which the opposition period begins: – Date on which the opposition period ends: <input type="checkbox"/> Opposition period extendable and date on which the opposition period begins: – Date on which the opposition period begins:
V. Signature or official seal of the Office communicating the information:
VI. Date:

Model Form 3

MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

This form is to be used in the following situation: the Office considers that protection cannot be granted in the Contracting Party concerned (ex officio provisional refusal) or protection cannot be granted in the Contracting Party concerned because an opposition has been filed, or both. In due course, once all the procedures before the Office have been completed, the Office shall send to the International Bureau a statement regarding the final disposition on the status of the mark, using Model Forms 5 or 6, as the case may be.

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder (or other indication enabling the identity of the international registration to be confirmed):
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:

Model Form 4

MADRID AGREEMENT AND PROTOCOL
FINAL DISPOSITION ON STATUS OF A MARK
– STATEMENT OF GRANT OF PROTECTION –

Rule 18ter(1)

This form is to be used in the following situation: before the expiry of the refusal period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before the Office have been completed and there is no ground for the Office to refuse protection.

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Protection is granted to the mark that is the subject of this international registration for all the goods and/or all the services requested.
V. Signature or official seal of the Office sending the statement:
VI. Date:

Model Form 5

MADRID AGREEMENT AND PROTOCOL

FINAL DISPOSITION ON STATUS OF A MARK

**– STATEMENT OF GRANT OF PROTECTION
FOLLOWING A PROVISIONAL REFUSAL –**

Rule 18ter(2)

This form is to be used in the following situation: the Office has already communicated a notification of total or partial provisional refusal and, all procedures before the Office being completed, protection is now granted to some or all of the goods and/or services. (If total refusal is being confirmed, please use Model Form 6).

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	<p><input type="checkbox"/> Protection for all the goods and/or services <i>(This box should be ticked where a notification of provisional refusal has previously been communicated but, eventually, protection is granted to <u>all</u> the goods and/or services.)</i></p> <p>All procedures before the Office have been completed; protection is granted to the mark that is the subject of this international registration for <u>all</u> the goods and/or <u>all</u> the services requested (Rule 18ter(2)(i))</p> <p><input type="checkbox"/> Protection for some only of the goods and/or services <i>(This box should be ticked where a notification of provisional refusal has previously been communicated and protection is now granted to <u>some</u> only of the goods and/or services – giving an indication of the goods and/or services protected. <u>NOTE:</u> 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 other cases, the goods and/or services should be clearly indicated.)</i></p> <p>All procedures before the Office have been completed; protection is granted to the mark that is the subject of this international registration for the following goods and/or services (Rule 18ter(2)(ii)) (please use a continuation sheet if necessary):</p>

V. Signature or official seal of the Office sending the statement:

VI. Date:

Model Form 6

MADRID AGREEMENT AND PROTOCOL

FINAL DISPOSITION ON STATUS OF A MARK

– CONFIRMATION OF TOTAL PROVISIONAL REFUSAL –

Rule 18ter(3)

This form is to be used in the following situation: the Office has sent to the International Bureau a notification of a total provisional refusal and, all procedures before the Office being completed, the Office now confirms refusal of protection of the mark for all goods and/or services.

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Protection of the mark is refused for <u>all</u> the goods and/or services.
V. Signature or official seal of the Office sending the statement:
VI. Date:

Model Form 7

MADRID AGREEMENT AND PROTOCOL

FURTHER DECISION AFFECTING THE PROTECTION OF A MARK

Rule 18ter(4)

This form is to be used where, following the communication of a statement of grant of protection (Rule 18ter(1) and (2)(i) and (ii) – Model Forms 4 and 5) or the sending of confirmation of total provisional refusal for all the goods and/or services (Rule 18ter(3) – Model Form 6), a further decision affects the protection of the mark – for example, a subsequent decision resulting from an appeal to an authority outside the Office, or a case where, following the completion of the regular Office procedures, there has nevertheless been a further decision by the Office, such as restitutio in integrum.

This form should not be used for the communication of invalidations under Rule 19 of the Common Regulations.

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Please indicate here the goods and/or services that are now protected (a continuation sheet may be used, if necessary):
V. Signature or official seal of the Office sending the statement:
VI. Date:

Model Form 8

MADRID AGREEMENT AND PROTOCOL
COMPLETION OF *EX OFFICIO* EXAMINATION
– INTERIM STATUS OF A MARK –

Rule 18bis(1)(a) and (b)

This form is to be used in the following situation: the Office confirms that ex officio examination has been completed, but protection of the mark is still subject to possible opposition or observations by third parties.

NOTE: *This statement may optionally be sent by an Office following ex officio examination, including in situations where the Office had notified a provisional refusal, but ex officio procedure has been completed favorably for the holder.*

If, following the present statement, opposition or observations is/are filed, a Provisional Refusal of Protection (Model Form 3) should be sent in due course.

If no opposition or observations is/are filed, the present statement should be followed by a Statement of Grant of Protection (Model Form 4 or, where the mark had first been the subject of an ex officio provisional refusal, but the ex officio procedure has been completed favorably for the holder, Model Form 5).

I.	Office sending the statement:
II.	Number of the International Registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	A notification of provisional refusal: <input type="checkbox"/> has not been communicated by the Office (Rule 18bis(1)(a)) <input type="checkbox"/> has been communicated by the Office (Rule 18bis(1)(b))
V.	(a) Date on which the opposition period, or the period for the filing of observations, begins: (b) Date on which the opposition period, or the period for the filing of observations, ends:
VI.	Signature or official seal of the Office sending the statement:
VI.	Date: