

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INFORMATION KIT
FOR OFFICES OF CONTRACTING PARTIES TO THE MADRID SYSTEM,
RELATING TO MODIFIED AND NEW RULES IN FORCE
AS FROM SEPTEMBER 1, 2009, CONCERNING THE FATE OF DESIGNATIONS**

I. PURPOSE OF THIS INFORMATION KIT

1. It is recalled that on September 1, 2009, important changes concerning the procedure relating to, notably, the communication of final decisions (currently confirmation or withdrawal of provisional refusals) will come into effect. The purpose of this document is to briefly guide the Offices of Contracting Parties through these changes, so as to assist them in the practical implementation of these changes.

II. BACKGROUND

2. At its fortieth (23rd extraordinary) session, 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 the modification of two interpretative statements.

3. The new rules and amendments are aimed at improving the accessibility of information regarding the interim and final status of international registrations in designated Contracting Parties and will come into effect on September 1, 2009. For the complete background information, Offices are invited to consult documents MM/A/40/1 and MM/LD/WG/6/4, or, for more concise information, Information Notice No. 27/2008.

4. The new Rules and amendments concerned are the following:
- amendment of Rules 16(1), 17(5) and 17(6);
 - new Rules 18*bis*, 18*ter* and 40(5).

It is to be noted that Rule 17(1) to (4) was not subject to any modification: accordingly, the procedure concerning the notification, *per se*, of an *ex officio* provisional refusal or a provisional refusal based on opposition has not changed.

Revised Model Forms for Offices

5. Offices are advised that, at its sixth session, from November 24 to 28, 2008, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks adopted a number of revised model forms prepared by the International Bureau which take into account the above-mentioned modified and new rules. These forms will be available for the assistance and convenience of the Offices of Contracting Parties on WIPO's website: http://www.wipo.int/madrid/en/contracting_parties/. For background information relating to these revised model forms, Offices are invited to consult document MM/LD/WG/6/4.

III. CHANGES AFFECTING ALL OFFICES – “FINAL DECISIONS” REPLACED

New Rule 18*ter*, paragraph (3) – Confirmation of Total Provisional Refusal

Situation until August 31, 2009

6. Under Rule 17(5)(a)(i) as in force until August 31, 2009, 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.

Situation as from September 1, 2009

7. The requirement in paragraph 6, above, has been transposed to new Rule 18*ter*, paragraph (3). There is no change in the scope of the requirement, but paragraph (3) of new Rule 18*ter* is simply entitled “Confirmation of Total Provisional Refusal” instead of the title under Rule 17(5), “Confirmation or Withdrawal of Provisional Refusal”.

*Model Form 6 refers to notifications under Rule 18*ter*(3).*

New Rule 18ter, paragraph (2) – Statement of Grant of Protection Following a Provisional Refusal

Situation until August 31, 2009

8. Rule 17(5)(a)(ii) and (iii) as in force until August 31, 2009, 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 (ii), or to indicate the goods and services for which the mark is protected (iii).

Situation as from September 1, 2009

9. The requirement in paragraph 8, above, has been transposed to new Rule 18ter, paragraph (2). However, while the scope of the obligation remains unchanged, the said paragraph (2) is entitled “Statement of Grant of Protection Following a Provisional Refusal” rather than “Confirmation or Withdrawal of Provisional Refusal” (as under Rule 17(5)).

Model Form 5 refers to notifications under Rule 18ter(2).

New Rule 18ter, paragraph (4) – Further Decision

Situation until August 31, 2009

10. The provision contained in Rule 17(5)(b), as in force until August 31, 2009, provides that an Office that has sent a statement of confirmation or withdrawal of provisional refusal under Rule 17(5)(a) shall, to the extent to which it is aware of a further decision, send to the International Bureau a further statement indicating the goods and services for which, pursuant to such a decision, the mark is finally protected.

Situation as from September 1, 2009

11. The provision contained in Rule 17(5)(b), as in force until August 31, 2009, remains unchanged but is relocated in paragraph (4) of new Rule 18ter and will be related either to a statement of grant of protection following a provisional refusal issued under Rule 18ter(2) or to a confirmation of total provisional refusal issued under Rule 18ter(3).

Model Form 7 refers to notifications under Rule 18ter(4).

New Rule 18ter, paragraph 5 – Recording, Information to the Holder and Transmittal of Copies

12. New Rule 18ter paragraph (5) provides for the recording of any statement received under Rule 18ter and the communication of such statements to holders.

IV. CHANGES AFFECTING ALL OFFICES – MANDATORY STATEMENTS OF GRANT OF PROTECTION (as from January 1, 2011)

New Rule 18ter, paragraph (1) – Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated

Situation until August 31, 2009

13. Pursuant to Rule 17(6)(a)(i) as in force until August 31, 2009, an Office which *has not* sent a notification of provisional refusal *may*, before the expiry of the applicable refusal period, send to the International Bureau a statement to the effect that *all* the procedures before the Office have been completed and that the Office has decided to grant protection to the mark.

14. Pursuant to Rule 17(6)(a)(iii) as in force until August 31, 2009, when an Office has sent a statement pursuant to Rule 17(6)(a)(ii) (see paragraph 17, below) it *may* send 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.

Situation as from September 1, 2009

15. Paragraph (1) of new Rule 18ter incorporates the provision under Rule 17(6)(a)(i) as in force until August 31, 2009, and 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. *The sending of this statement by an Office remains optional until December 31, 2010 (see Rule 40(5)). However, it is to be noted that, as from January 1, 2011, the sending of such a statement will be obligatory* (in this regard, see paragraph 25, below).

16. The provision under Rule 17(6)(a)(iii) as in force until August 31, 2009, is also incorporated under new Rule 18ter(1). If, after having sent a statement under Rule 18bis(1)(a) (under Rule 17(6)(a)(ii) until August 31, 2009) (see paragraphs 17 to 19, below), the opposition period has expired without any opposition or observations being filed, an 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.

Model Form 4 refers to notifications under Rule 18ter(1).

V. CHANGES AFFECTING ONLY THE OFFICES THAT CURRENTLY ISSUE
“CONDITIONAL” STATEMENTS OF GRANT OF PROTECTION UNDER
RULE 17(6)(a)(ii)

New Rule 18bis, paragraphs (1) and (2) – Interim Status of a Mark in a Designated
Contracting Party

Situation until August 31, 2009

17. Pursuant to Rule 17(6)(a)(ii) as in force until August 31, 2009, an Office which *has not* sent a notification of provisional refusal may, within the applicable refusal period, 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 may be filed.

Situation as from September 1, 2009

Ex Officio Examination Completed but Opposition or Observations by Third Parties Still Possible (Rule 18bis(1)(a) and (b))

18. Paragraph (1)(a) of new Rule 18bis reiterates the *optional facility* (that already exists under Rule 17(6)(a)(ii) as in force until August 31, 2009) 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, with an indication of the date by which such oppositions may be filed.

19. Paragraph (1)(b) of new Rule 18bis also provides for a similar *optional facility* for an Office that *has* communicated a notification of provisional refusal and subsequently concluded favorably the *ex officio* examination.

Recording, Information to the Holder and Transmittal of Copies (Rule 18bis(2))

20. Paragraph (2) of new Rule 18bis provides for the recording of any information received from an Office under paragraph (1).

Model Form 8 refers to notifications under Rule 18bis(1)(a) and (b).

VI. CHANGES AFFECTING ONLY THE OFFICES OF CONTRACTING PARTIES THAT HAVE MADE A DECLARATION UNDER ARTICLE 5(2)(c) OF THE PROTOCOL

Rule 16(1)(b) – Information Relating to Possible Oppositions and Time Limit for Notifying a Provisional Refusal Based on Opposition

Situation until August 31, 2009

21. Pursuant to Rule 16(1)(b), as in force until August 31, 2009, when an Office informs the International Bureau, in connection with a given international registration, of the possibility that oppositions may be filed after the expiry of the 18-month period, it must, where the dates on which the opposition period begins and ends are known, indicate those dates in the communication. If such dates are, at that time, not yet known, they must be communicated to the International Bureau once they become known and, at the latest, at the same time as any notification of provisional refusal based on an opposition.

Situation as from September 1, 2009

22. Further to the coming into effect of the amendment of Rule 16(1)(b), in the second sentence of paragraph (1)(b) of Rule 16, 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”. Thus, *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 have to be communicated by the Office.

23. 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 on which the opposition period begins.

Model Forms 1 and 2 refer to notifications under Rule 16(1)(a) and(b).

VII. RECOMMENDATION CONCERNING THE TRANSMISSION OF CERTAIN COMMUNICATIONS

24. With reference to communications concerning:

- information relating to possible oppositions and time limit for notifying provisional refusal based on oppositions sent under Rule 16(1)(a) and (1)(b);
- statements of grant of protection where no notification of provisional refusal has been communicated sent under Rule 18*ter*(1);
- information that the *ex officio* examination was completed but opposition or observations by third parties is still possible sent under Rule 18*bis*(1)(a) and (b);

when these communications concern more than one international registration, and despite the availability of the relevant model forms indicated above, the International Bureau strongly encourages Offices to transmit these communications in the form of lists instead of individual communications. Such lists could be transmitted to the International Bureau electronically or on paper and should permit the identification of the international registrations concerned. For those Offices not ready to enter into an e-communication agreement with the International Bureau, a paper list can be used. Alternatively, Offices may send individual communications or statements, preferably using the relevant model forms.

SUMMARY TABLE CONCERNING MODIFIED AND NEW RULES

Until August 31, 2009		As from September 1, 2009	
Rule 16(1)(b)	Time Limit for Notifying Provisional Refusal Based on Opposition	Rule 16(1)(b) Model Form 1 Model Form 2	Information Relating to possible Oppositions and Time Limit for Notifying Provisional Refusal Based on Opposition
17(5)(a)(i)	Confirmation of Total Refusal	Rule 18 ^{ter} (3) Model Form 6	Confirmation of Total Provisional Refusal
17(5)(a)(ii) and (iii)	Confirmation of a Partial Refusal or Withdrawal of Refusal	Rule 18 ^{ter} (2) Model Form 5	Statement of Grant of Protection Following a Provisional Refusal
17(5)(b)	Further Decision	Rule 18 ^{ter} (4) Model Form 7	Further Decision
17(5)(c)	Recording of Statements Received Under Rule 17(5)(a) or (b)	Rule 18 ^{ter} (5)	Recording, Information to the Holder and Transmittal of Copies (of Statements under Rule 18 ^{ter} (1) to (4))
17(6)(a)(i) and (iii)	Statement of Grant of Protection	Rule 18 ^{ter} (1) Model Form 4	Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated
17(6)(a)(ii)	<i>Ex officio</i> Examination Completed but Opposition or Observations by Third Parties Still Possible	Rule 18 ^{bis} (1)(a) and (b) Model Form 8	<i>Ex Officio</i> Examination Completed but Opposition or Observations by Third Parties Still Possible
17(6)(b)	Recording of Statements Received Under Rule 17(6)(a)	Rule 18 ^{bis} (2)	Recording, Information to the Holder and Transmittal of Copies (of Statements under Rule 18 ^{bis} (1))

Model Form 3 is not reflected in this table or in this document as it relates to Rule 17(1) “Notification of Provisional Refusal” which was not subject to any modification.

New Rule 40(5) – Transitional Provision

25. As already indicated above, new Rules *18bis*, *18ter* and 40(5), as well as the amendments referred to above, 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.

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