



European Communities Trade Mark Association

The fifth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks took place in Geneva from 5 May to 9 May 2008. It was attended by Jan Wrede, Member of the law Committee and Sandrine Peters, Legal Coordinator

Notification of grant of protection.

This session mainly focused on examining how to facilitate access to information on the fate of international registrations in designated Contracting Parties. In this connection, the International Bureau prepared document [MM/LD/WG//5/2](#).

The International Bureau proposed amendments consisting of a reorganization of the Rules currently dealing with provisional refusals, final decisions and statements of grant of protection and a rewording of some of those provisions (namely Rules 16-17-18bis-18ter and 40) so as to provide a clearer and more consistent legal framework, capable of evolving in the future. A major substantive amendment would consist of including a mandatory requirement for Offices to issue statements of grant of protection. The proposed amendments would ensure speedier information with regard to the effect of the international registration in a Contracting Party and would allow that that information be recorded centrally in the International Register for the benefit of all interested parties.

The Working Group agreed to submit the following draft amendments to the Common regulation to the Assembly of the Madrid Union in September 2008, with the proposal to have it effective as of September 1, 2009:

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) 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 constitute 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 filed.

(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]*² 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 concerned³.

(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

² 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.

³ Where Rule 34(3) applies, the grant of protection will be subject to the payment of the second part of the fee. The same remark applies to paragraph (2).

(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 concerned⁴.

(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 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.

Further Documents

Discussion took place on the documents introduced by the Swiss Delegation [MMLD/WG/5/4](#) – by the Delegation of Japan – by the Delegation of Australia [MMLD/WG/5/5](#) and [MMLD/WG/5/6](#).

The chair concluded by encouraging the member States and the IB to consider the possible implementation of the suggestions made by the different delegations.

Proposed Modifications to the ROMARIN Database

The IB gave a demonstration of the new information that would provide the new ROMARIN version.

The aim to the changes is making relevant information more easily accessible to users. One of these measures would consist of making digitalized copies of the notifications of provisional refusals available in ROMARIN before the end of this year. A further measure would consist of adding in ROMARIN, where appropriate, an indication informing that, in respect of a given designation, the refusal period had lapsed with no notification of provisional refusal having been received by the International Bureau. This addition to ROMARIN has already been tested and should be implemented very soon.

⁴ It would be necessary to resubmit to the Assembly the Interpretative Statement that currently appears as footnote 2 (not reproduced here) to the equivalent of this provision, i.e. Rule 17(5)(b).

Replacement – article 4bis

Reference was made to document [MMLD/WG/5/7](#) providing for the responses of the Member State to the questionnaire on the Office practices on Replacement and to the open forum.

Gazette of international Marks

Mr Rubio informed the audience that the IB is planning to replace the paper version of the *Gazette of International Marks* by an electronic version, as from January 2009. The new electronic version of the Gazette would be published on the WIPO website along with the current PDF version.

To be noted that the IB has recently made available, in the PDF format, additional issues of the Gazette, back to 1997. The security that used to prevent partial downloading of images had been removed, so that any person could now extract a single page or a portion from any issue of the Gazette currently available on line in the PDF format.

The next session of the SCT will take place from November 24 to 28, 2008 and would be devoted to discussing the issues raised by the delegations of Norway, in 2006 (document [MM/LD/WG/2/9](#)), and Japan, in 2007 (documents [MM/LD/WG/4/5](#) and [MM/LD/WG/4/5 Corr.](#)).

Reported by Sandrine Peters, ECTA Legal Coordinator.