



WORLD INTELLECTUAL PROPERTY ORGANIZATION

34, chemin des Colombettes, P.O. Box 18, CH-1211 Geneva 20 (Switzerland)
☎ (41-22) 338 91 11 – Facsimile (International Trademark Registry): (41-22) 740 14 29
e-mail: intreg.mail@wipo.int – Internet: <http://www.wipo.int>

MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND PROTOCOL RELATING THERETO

Provisional Refusal and Confirmation or Withdrawal of Provisional Refusal

1. The Assembly of the Madrid Union adopted a number of amendments to the Common Regulations under the Madrid Agreement and Protocol during its thirty-third session (September 24 to October 3, 2001). In particular, Rule 17 (which concerns refusal of protection) has been extensively revised, as has Rule 32(1)(a)(iii) (which concerns the publication of information relating to refusals).

2. The revised Rule 17(1) makes it clear that the initial notification of refusal is provisional and that it may be based on grounds raised *ex officio* or on an opposition or both. Such a provisional refusal must be sent within the time limit applicable under Article 5(2) of the Agreement or Protocol. The publication in the *WIPO Gazette of International Marks* of provisional refusals will indicate whether the refusal is total or partial but without an indication of the goods and services concerned and without the grounds for refusal; instead it will be indicated simply which classes are affected by the refusal.

3. In accordance with the revised Rule 17(5) an Office which has sent to the International Bureau a notification of provisional refusal must, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau a statement indicating either

(i) that protection of the mark is refused in the Contracting Party concerned for all goods and services,

(ii) that the mark is protected in the Contracting Party concerned for all goods and services requested, or

(iii) the goods and services for which the mark is protected in the Contracting Party concerned.

The International Bureau will publish the confirmation or the withdrawal with an indication of goods and services protected, as the case may be.

4. The Office of the Contracting Party concerned must send a further statement to the International Bureau where a further decision affecting the protection of the mark is taken (for example, by an external appeal board or a court of law), to the extent that it is aware of that decision. The International Bureau will publish any such further decisions.

5. Offices no longer need to send the communication of information relating to the fact that an appeal against the refusal has been filed or has not been filed or has been withdrawn. Experience has shown that this provision was implemented unevenly or was interpreted differently by different Offices, and the relevant provision was therefore deleted.

April 3, 2002