



The Madrid system for the International Registration of Marks

Communicating the Office decision

Podgorica
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Legal Division
International Registries of Madrid and Lisbon

Communicating the Office decision

- Provisional Refusal
 - Rules 17 and 18

- Final Disposition on Status of the Mark
 - Rule 18*ter*

- Invalidation
 - Article 5(6) and Rule 19

Provisional refusal of protection

Rules 17 and 18

Provisional refusal

- What is meant by “Provisional Refusal”?

Are there any Limitations on the Right to Refuse?

- Time

- Grounds

Time limits for notifying provisional refusal

■ 12 months

- Mandatory under the Madrid Agreement
- Optional under the Madrid Protocol

■ 18 months

- Optional under Article 5(2)(b) of the Madrid Protocol*

■ '18 months +' in case of opposition

- Optional under Article 5(2)(c) of the Madrid Protocol*

The refusal period runs from the date on which the International Bureau has notified the international registration or the subsequent designation to the Office of the designated Contracting Party in question.

* Article 9*sexies*(1)(b) of the Madrid Protocol

Grounds for Refusal: Non-Valid

- Divergent opinion on the classification of the goods/services (Rule 12)
- Banning of multi-class registration (Article 5(1))
- Obligation of a limited number of goods or services (Article 5(1))

Grounds for refusal (1)

Absolute grounds:

- Descriptive
- Generic
- Deceptive
- Contrary to accepted principles of morality or to public policy
- Prohibitions concerning State Emblems, Official Hallmarks, Emblems of Intergovernmental Organizations

Grounds for refusal (2)

Relative grounds:

- conflict with earlier acquired rights / identity or confusing similarity

Notification of Refusal

prescribed content (Rule 17)

- Office
- International registration number
- All the grounds
- When applicable, details of earlier rights
- Scope
- Time limit and competent Authority for appeal
- Essential provisions of the law
- Signature

Notification of irregular refusal

Rule 18

2 types of irregularities :

- Those which can be remedied
- Those which cannot

Irregular refusal (1)

- Deficiencies:
 - not signed
 - details of conflicting mark(s) not included
 - goods or services affected not mentioned
 - particulars of the opponent and of the goods and services on which opposition is based not mentioned

- Refusal recorded
- Office invited to rectify within 2 months
- Holder receives copy of refusal and invitation

Irregular refusal (2)

- Deficiencies:
 - time limit (for appeal) not mentioned
 - competent authority (for appeal) not mentioned
 - time limits (to file response to opposition) not mentioned
 - requirements to file (appeal or response) not mentioned (address, representation)

- Refusal not recorded
- Office invited to rectify within 2 months:
 - if rectified, recorded with date of defective refusal
 - If not, not considered as such
- Holder receives copy of refusal and invitation

Irregular refusal (3)

- Refusal not considered as such if it:
 - does not indicate any international registration number
 - does not indicate any grounds for refusal
 - is sent after the expiry of the refusal period
- The International Bureau transmits a copy to the holder.
- The International Bureau informs both the holder and the Office.

Responding to Refusals

- Governed entirely by national law
- Vary considerably from country to country
- Strategies/procedures for responding vary correspondingly
- Likely first step
 - Appoint local representative
 - May not be mandatory, but advisable

Notification of Refusal – 2 main stages

- **1.** The initial notification of provisional refusal
 - prescribed content (Rule 17)
 - recording and transmission by the International Bureau

- **2.** The final decision ... all procedures before the Office have been completed

- **?** Further decision affecting protection

Final Disposition on Status of a Mark in a Designated Contracting Party

Rule 18*ter*

Rule 18ter(1)

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

- When, before the expiry of the period applicable (the refusal period)
- 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 concerned.

Rule 18ter(2)

Statement of Grant of Protection Following a Provisional Refusal

- 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.

Rule 18ter(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.

Rule 18ter(4)

Further Decision

- Where, following the sending of a statement in accordance with either paragraph (2) or (3) ... (previous slides)
- 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 concerned.

Additional information available on the Madrid website

- Information notice No. 27/2008
- List of model forms for use by Offices
- Set of questions and answers for assistance of Offices

Invalidation

Article 5(6) and Rule 19

Invalidation – Article 5(6)

- Decision by a Competent Authority, administrative or judicial, of a designated Contracting Party, revoking or cancelling the effects of an international registration with regard to all or some goods and services covered by the designation
- Decision has to be final, no longer subject to appeal
- Office is obliged to notify

Contents of the notification

- authority pronouncing invalidation
- exhaustion of remedies
- international registration number
- name of the holder
- goods and services concerned
- date of pronouncement and of effect

- There is no Model Form available.

Questions ?



Hvala

