

**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 and Time Limit for Notifying Provisional Refusal Based on an Opposition]*
- (a) [...]
- (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) [...]
- (2) [...]

Rule 17
Provisional Refusal

- (1) [...]
- (2) [...]
- (3) [...]
- (4) [...]

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.

(5) *[Declarations Relating to the Possibility of Review]*

(a) [Deleted]

(b) [Deleted]

(c) [Deleted]

(d) [...]

(i) [...]

(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 18*ter*(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 18*ter*(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 18*ter*(2)(ii) or (3).

(6) [Deleted]

[...]

*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:

[Footnote continued on next page]

- (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

[Footnote continued from previous page]

“The references in Rule 18*bis* to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations.”

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.

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 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.

[...]