

Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~November 1, 2022~~November 1, 2023

[...]

Rule 17 Provisional Refusal

[...]

(2) *[Content of the Notification]* A notification of provisional refusal shall contain or indicate

[...]

- (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 of the representative, if any, their addresses, if possible, and a reproduction, ~~of~~ 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,

[...]

- (vii) the time limit, ~~reasonable under the circumstances~~which shall be no less than two months, 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,

(viii) where the time limit referred to in paragraph (2)(vii) begins on a date other than the date on which the International Bureau transmits a copy of the notification to the holder or the date on which the holder receives said copy, preferably with an indication of the date on which the said time limit ~~expires~~begins and ends, and

- (ix) the authority with which such request for review, appeal or response should be filed, ~~with~~and

(x) ~~the~~an 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.

^{*} In adopting this provision, the Assembly of the Madrid Union understood that Contracting Parties whose legislation provides for a time limit of sixty calendar or consecutive days meet the requirement specified in Rule 17(2)(vii).

- (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 and of the representative, if any and, where possible, their addresses; 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.

[...]

(7) *[Information Concerning the Time Limit to Respond to a Provisional Refusal]* Contracting Parties shall notify the International Bureau of the length of the time limit referred to in paragraph (2)(vii) and of the way in which this time limit shall be calculated.

Rule 18

Irregular Notifications of Provisional Refusal

(1) *[General]*

- (a) A notification of provisional refusal communicated by the Office of a designated Contracting Party shall not be regarded as such by the International Bureau

[...]

- (iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of the time limit applicable under Article 5(2)(a) or, subject to Article 9sexies(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol, from the date on which ~~the recording of the international registration or the recording of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending~~ the International Bureau sent the notification of the international registration or of the designation made subsequently.
- (b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.
- (c) If the notification
- (i) is not signed on behalf of the Office which communicated it, or does not otherwise comply with the requirements of Rule 2 or with the requirement applicable under Rule 6(2),
 - (ii) does not contain, where applicable, the details of the mark with which the mark that is the subject of the international registration appears to be in conflict (Rule 17(2)(v) and (3)),
 - (iii) does not comply with the requirements of Rule 17(2)(vi), or
 - (iv) ~~does not comply with the requirements of Rule 17(2)(vii), or~~ [Deleted]
 - (v) [Deleted]

- (vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)),

the International Bureau shall, ~~except where subparagraph (d) applies,~~ nonetheless record the provisional refusal in the International Register. The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

- (d) Where the notification does not comply with the requirements of Rule 17(2)(vii) to (x), the provisional refusal shall not be regarded as such and shall not be recorded in the International Register. The International Bureau shall inform the Office that communicated the provisional refusal of this fact, indicate the reasons therefor and transmit to the holder a copy of the defective notification. ~~If however, if the Office sends~~ a rectified notification ~~is sent~~ within ~~the time limit referred to in subparagraph (c)~~ two months from the date on which the International Bureau informed this Office of the defective notification, ~~the rectified notification~~ shall be regarded, for the purposes of Article 5 of the Protocol, as having been sent ~~to the International Bureau~~ on the date on which the defective notification had been sent to ~~the International Bureau~~ and shall be recorded in the International Register. ~~If the notification is not so rectified, it shall not be regarded as a notification of provisional refusal. In the latter case, the International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.~~
- (e) Any rectified notification shall, where the applicable law so permits, indicate a new time limit, ~~reasonable under the circumstances,~~ in accordance with Rule 17(2)(vii) to (x) 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.~~
- (f) The International Bureau shall transmit a copy of any rectified notification to the holder.

[...]

Rule 32 Gazette

[...]

(2) [Information Concerning Particular Requirements and Certain Declarations of Contracting Parties] The International Bureau shall publish in the Gazette

- (i) any notification made under Rules 7, 17(7), 20bis(6), 27bis(6) 27ter(2)(b) or 40(6) and (7) and any declaration made under Rule 17(5)(d) or (e);

Rule 40
Entry Into Force; Transitional Provisions

[...]

(8) *[Transitional Provision Relating to Rules 17(2)(vii) to (x) and 18(1)(e)]* Contracting Parties may continue to apply Rules 17(2)(vii) and 18(1)(e), as in force on November 1, 2021, until [February 1, 2025] or until a later date, provided the Contracting Party concerned sends a notification to the International Bureau before February 1, 2025, or before the date on which this Contracting Party becomes bound by the Protocol, whichever occurs later. The Contracting Party may withdraw the said notification at any time thereafter.

[End of Annex and of document]