Businesses seeking registration of trade marks overseas will have greater clarity on deadlines for responding to provisional refusals, following an update by the World Intellectual Property Office (WIPO). As of 1 November 2023, local intellectual property offices are required to give the holders of Madrid System international trade mark registrations (IR Holders) a minimum period of 60 days or two months to respond to provisional refusals.

International Trade Mark Registrations

At a high level, the Madrid System provides a mechanism for filing trade mark applications in multiple countries in a more streamlined fashion than individual local applications. From a single international trade mark application filed with WIPO, IR Holders can designate multiple countries in which they wish to pursue registration.

Once an international trade mark application (IR) has been certified by WIPO, the IR is provided to the local intellectual property office of designated countries for examination. The local office
undertakes examination in accordance with local laws and may issue a provisional refusal, raising barriers to acceptance of the trade mark. IR Holders are given an opportunity to respond to these provisional refusals within a designated timeframe, in order to seek acceptance of the trade mark by addressing the barriers raised.

Previously, WIPO had not prescribed that IR Holders and/or representatives ought to be granted a minimum timeframe to consider and respond to provisional refusals. These periods were determined by local offices and ranged from 15 days to 15 months. IR Holders and representatives encountered issues with short deadlines, given the time taken to transmit the refusal from the local office through WIPO to the IR Holder, and the number of administrative and substantive steps required to address a provisional refusal. Local intellectual property offices often require the appointment of a local agent before any substantive responses addressing the provisional refusal can be filed.

WIPO now requires that IR Holders are given at least two months to respond to a provisional refusal. In addition to this minimum two month period, WIPO will calculate and give IR Holders a clear date for responding to provisional refusals. The change should provide greater clarity and efficiency to the international registration process.

Key Takeaways

- A minimum provisional refusal response timeframe has been set.
- IR Holders or new IR applicants can take comfort in knowing they will be granted at least two months to respond to provisional refusals issued by local offices.
- Engaging an intellectual property professional is still the most effective way of ensuring trade marks achieve registration.
- The minimum time period of two months will expire quickly, with a number of steps required to be taken in this relatively short time frame.

Footnotes
