

QUESTIONNAIRE ON LIMITATIONS OF INTERNATIONAL REGISTRATIONS UNDER THE MADRID SYSTEM

The following questionnaire concerns the examination practice of the Offices of the Contracting Parties of the Madrid System regarding limitations made in international applications, subsequent designations and those recorded as changes to international registrations.

The questionnaire has two parts:

- Part I is for Offices of the Contracting Parties of the Madrid System only,
- Part II is for observer organizations only.

Offices and observer organizations are invited to reply to this questionnaire and to provide further information or comments for each of its questions.

Replies to this questionnaire should reach the Secretariat by **March 15, 2018**.

The Secretariat will present to the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its Sixteenth Session, a document summarizing the answers to the questionnaire as well as the information or comments received.

Name of the Contracting Party:
Name of the observer organization:
Name of the contact person:
E-mail address:

I. FOR OFFICES ONLY

A. ROLE OF THE OFFICE OF ORIGIN

Limitations Made in International Applications

Question 1: As Office of origin, does the Office examine limitations made in international applications (Form MM2)? (*It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.*)

- ☐ Yes, to determine **only** whether such limitations are covered by the list of goods and services in the basic application or basic registration (hereinafter referred to as “**the basic list**”).
- ☐ Yes, to determine **only** whether such limitations are covered by the list of goods and services in the international application (hereinafter referred to as “**the main list of the international application**”).
- ☐ Yes, to determine whether such limitations are covered by **both** the basic list and the main list of the international application.
- ☐ No, because the Office considers that the applicant is responsible for ensuring that such limitations are covered by the basic list or main list of the international application, or both.
- ☐ No, because the Office considers that the International Bureau should determine whether such limitations are covered by the list of goods and services in the resulting international registration (hereinafter referred to as “**the main list of the international registration**”).
- ☐ No, because the Office considers that the Office of the designated Contracting Party or Parties (where the limitations will have effect) must determine whether such limitations are covered by the main list of the international registration.
- ☐ No, because the Office considers that it does not have the legal basis to do so.
- ☐ N/A, as Office of origin, the Office has not yet received an international application.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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B. ROLE OF THE OFFICE OF THE CONTRACTING PARTY OF THE HOLDER*Limitations Made in Subsequent Designations or Requested as Recording of a Change to the International Registration*

Holders can make subsequent designations and present requests for recording directly to the International Bureau or through their Office (the Office of the Contracting Party of the holder) which can be the Office of origin or another Office after the recording of a change in ownership.

Question 2: As the Office of the Contracting Party of the holder, when the Office receives subsequent designations containing limitations (Form MM4), does the Office examine such limitations? *(It is possible tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, to determine whether such limitations are covered by the main list of the international registration.
- ☐ Yes, to determine whether such limitations are covered by the main list of the international registration, but **only** when the Office is also the Office of origin.
- ☐ No, because the Office considers that the holder is responsible for making sure that such limitations are covered by the main list of the international registration.
- ☐ No, because the Office considers that the International Bureau should determine whether such limitations are covered by the main list of the international registration.
- ☐ No, because the Office considers that the Office of the designated Contracting Party or Parties (where the limitations will have effect) should determine whether such limitations are covered by the main list of the international registration.
- ☐ No, because the Office considers that it does not have the legal basis to do so.
- ☐ N/A, as the Office of the Contracting Party of the holder, the Office has not received subsequent designations.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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Question 3: As the Office of the Contracting Party of the holder, when the Office receives a request for the recording of a limitation as a change to the international registration (Form MM6), does the Office examine such limitation? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, to determine whether such limitation is covered by the main list of the international registration.
- ☐ Yes, to determine whether such limitation is covered by the main list of the international registration, but **only** when the Office is also the Office of origin.
- ☐ No, because the Office considers that the holder is responsible for making sure that such limitation is covered by the main list of the international registration.
- ☐ No, because the Office considers that the International Bureau should determine whether such limitation is covered by the main list of the international registration.
- ☐ No, because the Office considers that the Office of the designated Contracting Party or Parties (where the limitation will have effect) should determine whether such limitation is covered by the main list of the international registration.
- ☐ No, because the Office considers that it does not have the legal basis to do so.
- ☐ N/A, as the Office of the Contracting Party of the holder, the Office has not received requests for the recording of a limitation as a change.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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C. ROLE OF THE OFFICE OF THE DESIGNATED CONTRACTING PARTY

Limitations in International Registrations, Subsequent Designations or Recorded as a Change

The International Bureau notifies Offices of the designated Contracting Parties of the international registration. The international registration may contain one or more limitations made either in the international application or in a subsequent designation.

The International Bureau also notifies the Office of a designated Contracting Party or Parties where a limitation is to have effect as a change to the international registration.

1. Limitations Made in an International Application

Question 4: As the Office of a Contracting Party designated in an international registration, does the Office examine a limitation made in the international application (under Rule 9(4)(a)(xiii)) to determine whether such limitation is covered by the main list of that registration? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, the Office examines the limitation to determine whether such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limited list because the Office considers that only this list (and not the main list) has effects in the Contracting Party.
- ☐ No, the Office only takes into account the limitation because the Office understands that the holder is responsible for ensuring that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the Office of origin has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the International Bureau has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office does not have the legal basis to examine such limitation.
- ☐ N/A, as the Office of a designated Contracting Party, the Office has not been notified of an international registration containing a limitation made in an international application.
- ☐ Other(s) – please, specify:
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Please, provide other relevant information or comment:

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2. Limitations Made in a Subsequent Designation

Question 5: As the Office of a Contracting Party designated in an international registration, does the Office examine a limitation made in a subsequent designation (under Rule 24(3)(a)(iv)) to determine whether such limitation is covered by the main list of that registration? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, the Office examines the limitation to determine whether such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limited list because the Office considers that only this list (and not the main list) has effects in the Contracting Party.
- ☐ No, the Office only takes into account the limitation because the Office understands that the holder is responsible for ensuring that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the Office that presented the subsequent designation or the International Bureau, when presented directly by the holder, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the International Bureau, regardless of who presented the subsequent designation, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office does not have the legal basis to examine such limitation.
- ☐ N/A, as the Office of a designated Contracting Party, the Office has not been notified of an international registration containing a limitation made in a subsequent designation.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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If the answer to either Question 4 or 5 is “Yes”, please reply to Question 6 below:

Question 6: What does the Office do when it determines that a limitation made in an international application (under Rule 9(4)(a)(xiii)) or subsequent designation (under Rule 24(3)(a)(iv)) is not covered by the main list of the international registration?

☐ The Office issues a notification of provisional refusal under Rule 17 of the Common Regulations stating that the limitation has no effect because it is not covered by the main list of the international registration.

☐ Other(s) – please, specify:

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If the answer to either Question 4 or 5 is “No”, please reply to Question 7 below:

Question 7: If the Common Regulations provided for the possibility of refusing the effects of a limitation made in an international application (under Rule 9(4)(a)(xiii)) or subsequent designation (under Rule 24(3)(a)(iv)), either as a provisional refusal or as a declaration similar to that in Rule 27(5), would the Office apply the new provision and issue such notification or declaration?

☐ Yes, the Office would apply the new provision and issue such provisional refusal or declaration that the limitation has no effect.

☐ Yes, however, the national or regional legal framework would need to be changed.

☐ No, because the Office does not consider it should examine such limitations.

☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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3. Limitations Recorded as a Change

Question 8: As the Office of a designated Contracting Party, does the Office examine a limitation recorded as a change (under Rule 27(1)(a))? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, the Office undertakes such examination.
- ☐ No, the Office only takes into account the limitation because the Office understands that the holder is responsible for ensuring that such limitation is covered by the main list of the international registration.
- ☐ No, the Office simply takes note of the limitation because the Office understands that the Office that presented the request or the International Bureau, when the request is presented by the holder, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office simply takes note of the limitation because the Office understands that the International Bureau, regardless of who presented the request, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office simply takes note of the limitation because the Office does not have the legal basis to examine such limitation or refuse the effects of such limitation.
- ☐ N/A, as the Office of a designated Contracting Party, the Office has not been notified of a limitation recorded as a change to an international registration.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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If the answer to Question 8 is “Yes”, please reply to Questions 9 and 10 below:

Question 9: When examining a limitation recorded as a change (under Rule 27(1)(a)), what does the Office take into account? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ the Office takes into account the main list of the international registration only.
- ☐ the Office takes into account the list of goods and services for which the mark has effect or is protected (i.e. the Office also takes into account previous relevant recordings such as limitations, partial change in ownership, notifications of provisional refusals, final decisions, partial invalidation, partial cancellation, etc.).
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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Question 10: What does the Office do when it determines that a limitation recorded as change (under Rule 27(1)(a)) is not covered by the main list of an international registration or, as the case may be, the list of goods and services for which the mark has effect or is protected? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ The Office issues a declaration that such limitation has no effect in the Contracting Party in accordance with Rule 27(5) of the Common Regulations.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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D. ROLE OF THE OFFICE CONCERNING NATIONAL OR REGIONAL APPLICATIONS OR REGISTRATIONS

The following questions refer to the legislation and practice in the designated Contracting Parties concerning national or regional applications or registrations

Question 11: Does the applicable legislation provide for requests in respect of national or regional applications which are equivalent to a limitation to an international registration (for example, partial withdrawal of the national or regional application)?

☐ Yes.

☐ No.

Please, provide other relevant information or comment:

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If the answer to Question 11 is “Yes”, please reply to Question 12 below:

Question 12: Does the Office examine the requests in respect of national or regional applications referred to in question 11?

☐ Yes.

☐ No.

If yes, please describe such examination and provide other relevant information or comment:

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Question 13: Does the applicable legislation provide for recordings in respect of national or regional registrations which are equivalent to a limitation to an international registration (for example partial cancellation of the national or regional registration)?

☐ Yes.

☐ No.

Please, provide other relevant information or comment:

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If the answer to Question 13 is “Yes”, please reply to Question 14 below:

Question 14: Does the Office examine the requests for recordings in respect of national or regional registrations referred to in question 13?

☐ Yes.

☐ No.

If yes, please describe such examination and provide other relevant information or comment:

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II. FOR OBSERVER ORGANIZATIONS ONLY

Question 15: What is (are) the reason(s) for making a limitation in an international application (Form MM2)? (*It is possible to tick more than one box.*)
☐ replaces the tick and means that we selected the option

- ☐ To reflect the applicant's business interest in a particular Contracting Party.
- ☐ To avoid a possible notification of provisional refusal in a particular Contracting Party.
- ☐ To avoid possible litigation in a particular Contracting Party.
- ☐ To exclude the business interests of a third party with whom the applicant has a trademark dispute.
- ☐ To comply with a settlement agreement in which the applicant has a binding obligation under the law of contracts to make the limitation as worded in the contract.
- ☐ To comply with a court order in a particular designated Contracting Party.
- ☐ Other(s) – please specify:

In addition to all of the above options, the following circumstances could be relevant:

1. To avoid an opposition in a particular designated Contracting Party.
2. In some countries such as the US, you must have an intention to use the mark in order to be able to apply for the trademark with goods and/or services where use has not commenced. If the Applicant knows that it has no intention to use the trademark with certain goods/services, then it may want to limit the specification.
3. To avoid paying official fees for additional goods/services where there are per good or sub-class fees (e.g. China).

Please, provide other relevant information or comment:

- The last two specific circumstances noted under "others" could be considered as reflecting "the applicant's business interest in a particular Contracting Party". However, these are common enough that it was worth noting the specific circumstances.

Question 16: What is (are) the reason(s) for making a limitation in a subsequent designation (Form MM4)? (*It is possible to tick more than one box.*)

☐ replaces the tick and means that we selected the option

- ☐ To reflect the holder's business interest in a particular Contracting Party.
- ☐ To avoid a possible notification of provisional refusal in a particular Contracting Party.
- ☐ To avoid possible litigation in a particular Contracting Party.
- ☐ To exclude the business interests of a third party with whom the holder has a trademark dispute.
- ☐ To comply with a settlement agreement in which the holder has a binding obligation, under the law of contracts, to make the limitation as worded in the contract.
- ☐ To comply with a court order in a particular designated Contracting Party.
- ☐ Other – please specify:

- Same comments as reflected under Question 15.

Please, provide other relevant information or comment:

- Same comments as reflected under Question 15.

Question 17: What is (are) the reason(s) for requesting the recording of a limitation as a change to the international registration (Form MM6)? (*It is possible to tick more than one box.*)

☐ replaces the tick and means that we selected the option

- ☐ To reflect the holder's business interest in a particular Contracting Party.
- ☐ To overcome a notification of provisional refusal (*ex-officio* or based on opposition).
- ☐ To exclude the business interests of a third party with whom the holder has a trademark dispute.
- ☐ To comply with a settlement agreement in which the holder has a binding obligation, under the law of contracts, to make the limitation as worded in the contract.
- ☐ To comply with a court order in a particular designated Contracting Party.
- ☐ To avoid cancellation due to non-use.
- ☐ To avoid possible litigation.
- ☐ Other(s) – please specify:

- To avoid cancellation on other basis. For example, in Canada (which is soon to be a Contracting Party to the Madrid System) marks can be cancelled for abandonment, lack of distinctiveness, registrability and entitlement. If only particular sections of the specification of the goods and services in the registration would be affected by the cancellation, a registrant could foreseeably remove that section to avoid cancellation action. This would be rare but could be a possibility.

Please, provide other relevant information or comment:

Question 18: When filing an international application containing one or more limitations (Form MM2), does the applicant expect the Office of origin to deliver advice on such limitation?

☐ Yes.

☐ No.

In order to answer to this question, based on the below comments, if the term “advice” in this case means examination, our answer is NO. However, if the term “advice” means general guidelines, our answer may be YES.

In fact, the limitations may normally pertain to only certain of the designated contracting parties and not the International application as a whole, nor would they affect the basic mark that only the Office of origin is eligible to examine on an exclusive basis. Moreover, it should only be for the respective Offices of the designated contracting parties to examine such limitations.

With respect to classification examination and practices and the need for simplification of the classification examination requirements, as well as for harmonization of minimum standard requirements, we would like to recall the contents of our position paper “MARQUES’ comments on WIPO’s Draft Examination Guidelines concerning the Classification of goods and services in International applications as presented at the Round Table of the Madrid Working Group in June 2016” submitted to WIPO on October 3, 2016 (a copy of which is attached hereto for ease of reference).

Please, provide other relevant information or comment:

- We consider the question as vague. It is not clear what the term “advice” is meant to be – does this mean general advice on or examination of the limitation?
- Assuming the term “advice” is meant to be general advice, the Office of Origin may not issue any general guidelines for other than their own territory (e.g. Canada has a Goods & Services Manual where acceptable descriptions are provided or the EUIPO has a harmonized database TM Class).
- The International Bureau could provide access/links to general guidelines on classification that apply in different jurisdictions, but not provide actual advice or examine on the specific limitation requested other than looking at whether it adds additional classes or expands the scope of existing classes.
- The International Bureau cannot be expected to rule on limitations (even when they are expected to be applicable to all designations) because there is no global harmonization as between the designated countries as to the classification of goods and services.

Therefore, we consider that any limitations should be examined by the Offices of the designated contracting parties where the limitation applies. In any case, the applicant does not expect to incur on further fees for the examination of any limitations.

- To make it clear, the applicant does not expect that the Office of Origin would examine the limitation if the limitation was not evidently relevant to its territory.

Question 19: When making a subsequent designation containing a limitation (Form MM4) through an Office (the Office of the Contracting Party of the holder), does the holder expect this Office to deliver advice on such limitation?

☐ Yes.

☐ No.

In order to answer to this question, based on the below comments, if the term “advice” in this case means examination, our answer is NO. However, if the term “advice” means general guidelines, our answer may be YES.

Please, provide other relevant information or comment:

- We consider the question as vague. It is not clear what the term “advice” is meant to be – does this mean general advice on or examination of the limitation?

- Assuming the term “advice” is meant to be general advice, the Office of the Contracting Party of the Holder may not issue any general guidelines regarding limitations for other than its territory. - (e.g. Canada has a Goods & Services Manual where acceptable descriptions are provided or the EUIPO has a harmonized database TM Class).

- The International Bureau could provide access/links to general guidelines in different jurisdictions, but not provide actual advice or examine on the specific limitation requested other than looking at whether it adds additional classes or expands the scope of existing classes.

- The International Bureau cannot be expected to rule on limitations (even when they are expected to be applicable to all designations) because there is no global harmonization as between the designated countries as to the classification of goods and services.

Therefore, we consider that the limitation should be examined by the Office where the limitation applies, compliant with the domestic law and practice directives of the Contracting Party affected by the limitation. In any case, the applicant does not expect to incur on further fees for the examination of any limitations.

Question 20: When presenting a request for the recording of a limitation (Form MM6) through an Office (the Office of the Contracting Party of the holder), does the holder expect this Office to deliver advice on such limitation?

☐ Yes.

☐ No.

In order to answer to this question, based on the below comments, if the term “advice” in this case means examination, our answer is NO. However if the term “advice” means general guidelines, our answer is YES.

Please, provide other relevant information or comment:

- We consider the question as vague. It is not clear what the term “advice” is meant to be – does this mean general advice on or examination of the limitation?

- Assuming the term “advice” is meant to be general advice, the Office of the Contracting Party of the Holder may not issue any general guidelines regarding limitations for other than its territory. - (e.g. Canada has a Goods & Services Manual where acceptable descriptions are provided or the EUIPO has a harmonized database TM Class).

- The International Bureau could provide access/links to general guidelines in different jurisdictions, but not provide actual advice or examine on the specific limitation requested other than looking at whether it adds additional classes or expands the scope of existing classes.

- The International Bureau cannot be expected to rule on limitations (even when they are expected to be applicable to all designations) because there is no global harmonization as between the designated countries as to the classification of goods and services.

Therefore, we consider that the limitation should be examined by the Office where the limitation applies, compliant with the domestic law and practice directives of the Contracting Party affected by the limitation. In any case, the applicant does not expect to incur on further fees for the examination of any limitations.

Question 21: The Working Group on the Legal Development of the Madrid System for the International Registration of Marks would like to gather the views of the observer organizations on the subject of limitations to international registrations to further advance the Working Group's discussions; please, kindly elaborate on the views of the organization on this particular subject in a separate document and send it to the Secretariat along with the replies to this questionnaire.

We would like to again refer to the above mentioned position paper "MARQUES' comments on WIPO's Draft Examination Guidelines concerning the Classification of goods and services in International applications as presented at the Round Table of the Madrid Working Group in June 2016" submitted to WIPO on October 3, 2016 (a copy of which is attached hereto for ease of reference), which reflects our views on what an ideal system of classification examination practices could be.

Submitted by **MARQUES**, The European Association of Trade Mark Owners

15 March 2018

[End of questionnaire]



MARQUES' Comments on WIPO's Draft Examination Guidelines concerning the Classification of goods and services in International applications as presented at the Round Table of the Madrid Working Group Meeting in June 2016

MARQUES is an official non-governmental organisation that was granted observer status at the World Intellectual Property Organization - WIPO in 1989 by the Governing Bodies at their Twentieth Series of Meetings (cf. paragraph 213 of General Report, document AB/XX/20).

MARQUES is the European Association representing brand owners' interests. **MARQUES'** mission is to be the trusted voice for brand owners.

More information about **MARQUES** and its initiatives is available at www.marques.org.

At the Round Table of the Madrid Working Group Meeting which took place in Geneva on June 16 and 17, 2016, WIPO circulated a draft of its Examination Guidelines pertaining to Classification Practice and **MARQUES** wishes to provide its comments on the said document.

1. General Remarks

MARQUES wishes to commend WIPO for sharing and publishing the International Bureau's draft examination guidelines, the knowledge of which will be beneficial for both users and Offices.

MARQUES is representing the interest of trade mark owners and supports any process improvement which makes it easier or more cost-effective for proprietors to obtain trade mark protection using the International registration system. In particular, **MARQUES** supports a classification practice that allows users to obtain the appropriate protection for their intended goods and / or services spanning the minimum number of classes possible (to reduce fees), and that is as far as possible harmonised so that users seeking registration in a number of countries do not have to make significant changes to the specification of the applications in order to comply with variations in national classification practices.

Currently, when filing an application for an International registration and designating Contracting Parties to the Madrid system, trade mark proprietors may face three hurdles to obtaining the appropriate goods and services classification for their mark. First, the specification of the goods and / or services is examined by the Office of Origin in relation to the basic mark and the correspondence thereof in the application for International registration. Then the International Bureau examines the classification of goods and / or services of the

application for International registration for compliance with the applicable requirements, and finally the Offices of the designated Contracting Parties may again examine the same goods and/or services applied for. Each of these examinations is carried out according to the applicable rules of the Common Regulations and the standards of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Trade Marks, but following the examination practice that pertains to the individual Office or Bureau.

MARQUES strongly supports the idea that WIPO and all Offices in all Contracting Parties should work towards convergence and preferably harmonisation of examination of classification practice where-ever possible.

By way of example, the IP Offices of the EU member states and the EUIPO (formerly OHIM) agreed on a Common Classification Practice (under Convergence Project CP1 “Harmonisation on Trade Marks Classification Practice of G&S”) and a so-called “harmonised database” was established – according to Nice Classification standards – and is being maintained, which contains over 65,000 terms that are considered clearly classifiable and acceptable in a certain class, without incurring in any objections. All 28 EU member states as well as the EUIPO are bound by this common classification practice, and the corresponding harmonised IP Offices, including the EUIPO, are AT, BG, BX, CY, CZ, DE, DK, EE, ES, EU, FI, FR, GB, GR, HR, HU, IE, IT, LT, LV, MT, PL, PT, RO, SE, SI, and SK. This common classification practice came about because of a strong need felt by all those IP Offices to find a common – cooperative – approach in the interest of users and also to make their workflow on classification examination more efficient and consistent, although of course it involved certain sacrifices and compromises by the parties involved. **MARQUES** has strongly supported and contributed that process and drawing from this experience it believes it is in the interest of brand owners that the international trade mark community strive for harmonisation of classification on an international level, possibly in a similar way.

MARQUES thus proposes that WIPO and all Offices of all Contracting Parties work towards this harmonisation by reviewing whether their current examination practices on classification are aligned and consistent, on the grounds of the applicable rules of the Common Regulations and Nice Classification standards. In any case, the foremost goal should be that WIPO’s examination practice on classification is not stricter than the examination practices of the national Offices (first goal) and, preferably, that the examination practices of the national offices should not be stricter than the examination practice of WIPO (second goal).

This would mean that in a **first step** for international convergence, assessment should be made as to which extent certain examination practices may prove stricter or more lenient than others and whether any stricter classification requirements would find justification in the legal basis of the applicable rules and in the standards specified in the Nice Classification. This way, a common minimum standard could be established. Then, the classification practice at WIPO should not be stricter than the practices before the national Offices where those practices meet said minimum standard. This does not mean that the International Bureau or any Office

has to lower its examination standards, rather a reasonable minimum standard should ideally be agreed upon and applied uniformly by both WIPO and all Offices.

Once this has been achieved, there would be no need for the International Bureau to send irregularity notices for specifications that have been examined by the Office of Origin where that Office's classification practices meet the minimum harmonised standards. Effectively, as the specification of an application for an International Registration is equivalent to an examined basic application or registration, then this specification should be acceptable also to the International Bureau. This would improve the position for users of the Madrid system as they would only have to make sure to comply with the classification practices of the Office of Origin – supposed to apply the same standards as WIPO – and also the objections by the Offices of any designated Contracting Parties should prove lower or even cease, with an anticipated average decrease in the number of hurdles to final registration.

Then, as a **second step** of seeking convergence or even harmonisation, the stricter practices in some Contracting Parties should be reviewed and reconciled. Preferably, a common international level of classification practice should be found. This could be coordinated by WIPO e.g. within the Madrid Working Group or preferably by a specially formed panel of that Group. This would mean in the end that provisional refusals for reason of classification issues should become rare, so that the Office of Origin will remain as the first and final hurdle.

In this context, **MARQUES** encourages WIPO as well as all Offices to accept, i.e. not to reject, the terms contained in the harmonised database (HDB) of the EUIPO and the EU IP Offices as a useful first step towards international classification practice convergence. This does not mean that **MARQUES** suggests that the HDB should be applied on an international level, but only that the terms specified therein should be considered to meet the requirements for proper classification, as the HDB is not clearly diverging from the Nice Classification standards.

2. Specific Remarks on WIPO's Draft Examination Guidelines based on current architecture and functioning of Nice Classification System

More particularly, on the Draft Examination Guidelines provided by WIPO, **MARQUES** is concerned that some practices may not serve the interest of trade mark owners, namely:

Regarding Section 2.2

a) Figurines [statuettes] classified according to the raw material they are made of.

First, the practice that some terms which may fall within different classes are considered "clear" simply by specifying the class, as with "sea water" in class 5, on the one hand, and in class 30, on the other hand (example at the bottom of page 14), would seem to contradict the examples with "figurines" (at the bottom of page 10), which should then also be clear by the specification of the class, e.g. it should be clear that figurines in class 14 are those made of precious metals. This should be corrected in the Draft Examination Guidelines.

Second, notwithstanding the above, the possible classification of a same object in different possible classes depending upon the material it is made of, rather than by reference to its purpose, is a major concern to trade mark owners and should be made use of only under exceptional circumstances. This applies particularly to statuettes, but may likewise apply to other goods.

An applicant who wishes to protect statuettes, whatever the material they are made of, will pay the appropriate fees for protection in six classes or will need to make a choice in order to save costs.

In both cases, the applicant will not be able to obtain a satisfactory protection. In the first case (coverage in 6 classes), the trade mark might become vulnerable to non-use in respect of certain classes. In the second case (coverage only in a limited number of classes), the proprietor may not be able to oppose third parties' conflicting trade marks covering the same goods [statuettes] filed in a different class or may be put to an additional evidential burden to do so. Yet, statuettes, whether made of wood or metal or ceramic serve the same purpose: decoration. As such, by its purpose, they should be regarded as similar to pieces of furniture and would belong to Class 20, for instance.

Brand owners have an interest in that the sole term "statuettes" being accepted, without any mention of the material of which they are made, and whatever the class designated.

b) Multipurpose composite objects.

The example given relates to clock radios that can be classified either in Class 09 or 14.

As indicated above, the choice between the two classes entails consequences for the scope of protection of the trade mark, considering the practice of certain contracting parties where an opposition will be rejected when the two conflicting marks do not cover the same class.

Ideally, brand owners should be able to select the relevant classes at no extra cost, but since this is not possible, a different user-oriented solution should be found. There may be other examples of similar classification practices that create an additional burden for users.

Regarding Section 2.7: Use of trade marks, protected geographical indications and denominations/appellations of origin (GIs or AOs)

Brand owners are particularly concerned about the possibility for parties other than the legitimate right-holders to use trade marks, GIs or AOs in the specification of goods and / or services, as such a practice is likely to contribute to the dilution of protected distinctive signs.

Some Trade Mark Acts in force in a number of Contracting Parties provide that if a trade mark owner does not take any action to prevent its trade mark from being used as a generic term, it is likely to have its trade mark revoked on the ground of dilution or genericism.

If the International Bureau accepts the use of registered trade marks of third parties within specifications of goods and / or services instead of preventing applicants from using trade marks as generic terms, this could endanger the rights of the legitimate trade mark proprietors.

While the reasoning may be different in respect of Geographical Indications and Protected Denominations of Origin and other similar rights, **MARQUES** strongly supports the proprietors of these intellectual property rights and considers that the Draft Examination Guidelines as they currently stand may have a detrimental effect on the protection of such distinctive signs.

In the current International registration system where not all Contracting Parties have harmonised the laws and regulations in relation to the protection of Geographical Indications and similar rights, it appears extremely dangerous to enable International registrations to include such signs in the specification of goods and / or services, without any proper control, such as on the applicant's entitlement to use the GI or AO. It is well known, for instance, that the allowed use of the term "Champagne" substantially differs in France and the USA for instance. An International registration based on a United States basic mark covering sparkling wines described as « Champagne » could be rejected as unregistrable in France, on the ground of deceptiveness, if the standards required to use the protected Denomination of Origin "Champagne" are not met.

In addition, these signs cannot be included in International trade mark applications as part of the mark, so it would not appear logical to authorise the use of the same in the goods and / or services protected.

Respectfully submitted this 3rd October 2016,

On behalf of **MARQUES**, The European Association of Trade Mark Owners



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