

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: Japan Patent Attorneys Association	
Name of the contact person:	
E-mail address:	

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.)*

- ☒ 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:

To specify the goods/services of the applicant's interest more concretely or to clarify the scope of goods/services for which the applicant originally seeks in order to prevent the goods/service of the applicant's interest from being excluded due to the interpretation of the goods/services in a designated country.

Please, provide other relevant information or comment:

We have chosen the reasons commonly acknowledged in Japan as above, even though it is practically possible to tick all boxes for the question.

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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.)*

- ☒ 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:

To specify the goods/services of the applicant's interest more concretely or to clarify the scope of goods/services for which the applicant originally seeks in order to prevent the goods/service of the applicant's interest from being excluded due to the interpretation of the goods/services in a designated country.
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Please, provide other relevant information or comment:
From our practical experiences, we have chosen the reasons commonly acknowledged in Japan as above, even though it is practically possible to tick all boxes for the question.

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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.*)

- ☐ 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:

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Please, provide other relevant information or comment:
From our practical experiences, we have chosen the reasons commonly acknowledged in Japan as above, even though it is practically possible to tick all boxes for the question.

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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.

Please, provide other relevant information or comment:

Basically, we believe that the Office of origin should examine limitations (Form MM2), because if it is examined by an examiner in a designated country, there would be disadvantages for the applicant such as an increase in costs and a delay in examination due to unexpected office actions.
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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.

Please, provide other relevant information or comment:

Basically, we believe that the Office of Origin should examine limitations (Form MM4), because if it is examined by an examiner in a designated country, there would be disadvantages for the applicant such as an increase in costs and a delay in examination due to unexpected office actions.
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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.

Please, provide other relevant information or comment:

According to Rule 25(1)(a), MM 6 is supposed to submit directly to the International Bureau, not through the Office of the Contracting party of the holder. Thus, the holder usually does not expect this Office to deliver advice because the holder expects to record the limitation in a designated country as soon as possible.
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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.

[End of questionnaire]

Appendix

In response to the Questionnaire on Limitations of International Registrations under the Madrid System dated February 15, 2018, the JPAA would like to respond to the Question 21 with the following.

We consider that at least, limitations in international applications should be examined by the Office of origin due to the following reasons:

1. Since the users submit MM2 to the Office of origin, the examination of limitations by the Office of origin is understandable and reasonable for users;
2. The Office of origin examines basic requirements under the certification process, and thus, the examination of limitations presented in international applications seems to be an extension of the certification process; and
3. Many Japanese users assume that the scope of the list of goods and services in the main list and the scope of the limitation corresponds to the trademark practices of the Office of origin at the time of filing the international application.