

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: Australia
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:

The goods and services of any limitations need to fall within both the basic list and the main list of the international application; otherwise we will not certify the international application.

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:

Please, provide other relevant information or comment:

As of 1 July 2016, we no longer accept Form MM4 for subsequent designations or Form MM6 for limitations. These forms must be filed directly with WIPO.

Prior to 1 July 2016, when we did receive a Form MM4 request, we still did not examine the limitations.

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:

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:

We only look at the limitation because the main list has not been designated in Australia. The rationale for doing this is that it is up to the Office of origin to determine using their classification procedures whether the limitation falls within the scope of the main list.

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:

Please, provide other relevant information or comment:

See the comments above about limitations in applications.

We do not consider the International Bureau will determine if the limitation falls within the main list especially since changes to the common regulations which came into force on 1 July 2017 expressly state the International Bureau will not determine if the limitation falls within the main list.

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:

[We believe it should be up to the Office of origin to determine if a limitation falls within the scope of the main list of the international registration.](#)

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:

Please, provide other relevant information or comment:

The Office examines a limitation recorded as a change, in order to ensure the scope of the initial claim has not been expanded in Australia. In such instances, we can issue a declaration that the limitation has no effect or only partial effect.

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:

[We consider the list of goods and services for which the mark has effect or is protected and then decide if the amendment can be made in full, only partially or not at all.](#)

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:

[See relevant comments at Question 8.](#)

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:

Under Australian legislation, the applicant can request that their goods and services be limited. Such a request for amendment will only be effected if the amended list falls within the scope of the list that was initially published.

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:

If the request is to delete goods and services we can effect this limitation because it is not expanding the scope. Amendments that alter the indications themselves (or the description of the goods and services) are carefully considered to ensure they would fall within the scope of the initial claim.

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:

We have interpreted this question to refer to limitations in respect of goods and services for national applications or registrations (as stated at Question 11).

On the subject of recordings, applicants can request that their goods and services be amended, but the national application or registration will only publicly display the most current list of goods and services. For example if an application contains Class 9 and 16 and an applicant requests to delete Class 9, once the amendment is processed the application will only publicly display Class 16.

This differs from an international registration, where the list of goods and services originally submitted in the application is always publically viewable in the WIPO Madrid Monitor, with any limitation requests recorded separately.

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:

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:

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Please, provide other relevant information or comment:

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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:

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Please, provide other relevant information or comment:

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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:

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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:

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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:

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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:

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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]