



European Communities Trade Mark Association

30 March 2018

RESPONSE FROM ECTA ON THE WIPO QUESTIONNAIRE ON LIMITATIONS OF INTERNATIONAL REGISTRATIONS UNDER THE MADRID SYSTEM

ECTA welcomes the opportunity to participate in Part II of this Questionnaire, namely those questions for the Observer Organisations.

We circulated Part II to those in our membership who are active in ECTA committee work. Please note that those who participated are from a diverse range of countries - Spain, Latvia, Italy, Czech Republic, Hungary, Turkey, Portugal, Cyprus, Estonia, Lithuania, Poland, UK, Finland, Germany and the Netherlands. Our members also have wide diversity in trade mark practice, including those who are litigators and those who practice before IPOs, and included several past Presidents of ECTA.

All of our participants have vast experience of filing limitations to IR marks 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. Settlement agreements were therefore the most common instance when limitations to goods and services of an IR mark would need to be filed. The next most common instance is avoiding a possible provisional refusal. After that, the three next most common instances are to avoid cancellation for non-use, to exclude the business interests of a third party and to avoid possible litigation.

Having considered our members' answers, ECTA is of the view it is not widely expected that any Office of Origin or Office of Contacting Party would deliver advice [as distinct from rejecting a limitation and proposing an alternative wording] regarding a limitation at any of the three stages/procedures of the life of an International Registration which the IB had listed in Part II – the filing of application on MM2, the filing of a subsequent designation on MM4 or a limitation on MM6. Some of our members thought that advice from the Office was to be expected, but they were a very small minority [ratio of 1 to 5]. Of those members in this minority, they were all of the opinion that they would expect the Office to deliver advice at all of these stages/procedures. If therefore the Questionnaire was to determine if users' expectations change according to *when* in the life-cycle of an IR a limitation is made to it, it does not appear, from our sampling of our members, that expectations do change.

ECTA looks forward, when the Secretariat's review of the Part 1 answers is complete and the summary released in preparation to the next Working Group meeting in this June, to any further participation which the Working Group requests from the Observer Organisations.

Should you have any questions or need any clarifications concerning the above, please do not hesitate to revert to us.
