

Working Group on the Legal Development of the Madrid System for the International Registration of Marks

**Sixteenth Session
Geneva, July 2 to 6, 2018**

FINDINGS OF THE QUESTIONNAIRE ON LIMITATIONS OF INTERNATIONAL REGISTRATIONS UNDER THE MADRID SYSTEM

Document prepared by the International Bureau

1. Since its twelfth session, held in Geneva from October 20 to 24, 2014, the Working Group on the Legal Development of the Madrid System for the International Registrations of Marks (hereinafter referred to as “the Working Group”) has discussed limitations of goods and services in the Madrid System, and, particularly, the roles of the Offices of Contracting Parties and of the International Bureau concerning such limitations¹.
2. At its fifteenth session, held in Geneva from June 19 to 22, 2017, the Working Group requested the International Bureau to conduct a survey among Offices of the Contracting Parties of the Madrid System and observer organizations on the role of those Offices and of the International Bureau on limitations, and to present a document on the findings of that survey at its sixteenth session².
3. Following that request, on November 22, 2017, the International Bureau sent to Offices of Contracting Parties of the Madrid System and observer organizations a draft questionnaire calling for comments by December 22, 2017.
4. The final version of the questionnaire took into account contributions made by several Offices of Contracting Parties of the Madrid System and by representatives from various observer organizations³.

¹ See documents MM/LD/WG/12/2, MM/LD/WG/13/2, MM/LD/WG/14/5 and MM/LD/WG/15/3.

² See document MM/LD/WG/15/5, paragraph 15.

³ Twenty Offices and four observer organizations made comments to the draft questionnaire.

5. On February 15, 2018, the International Bureau sent to the Offices of the Contracting Parties of the Madrid System and to observer organizations Note C.M. 1463, with a *Questionnaire on Limitations of International Registrations Under the Madrid System* and invited the said Offices and organizations to reply to the questionnaire by March 15, 2018.

6. The International Bureau has received 55 returns to the above-mentioned questionnaire, namely from: Algeria (DZ), Australia (AU), Austria (AT), Azerbaijan (AZ), Bahrain (BH), Belarus (BY), Bosnia and Herzegovina (BA), Bulgaria (BG), China (CN), Colombia (CO), Croatia (HR), Czech Republic (CZ), Denmark (DK), Finland (FI), France (FR), Georgia (GE), Germany (DE), Greece (GR), Hungary (HU), Iceland (IS), India (IN), Ireland (IE), Israel (IL), Japan (JP), Kyrgyzstan (KG), Latvia (LV), Lithuania (LT), Madagascar (MG), Mexico (MX), Morocco (MA), New Zealand (NZ), Norway (NO), Philippines (PH), Poland (PL), Portugal (PT), Republic of Moldova (MD), Romania (RO), Russian Federation (RU), Serbia (RS), Sao Tome and Principe (ST), Singapore (SG), Slovakia (SK), Spain (ES), Sweden (SE), Switzerland (CH), Syrian Arab Republic (SY), Thailand (TH), United Kingdom (GB), United States of America (US), Uzbekistan (UZ) and Viet Nam (VN). Furthermore, returns were received from the African Intellectual Property Organization (OA), the Benelux Office for Intellectual Property (BX)⁴, Curaçao (CW)⁵ and the European Union (EM).

7. Finally, the International Bureau has received replies or input from the following seven observer organizations: Asian Patent Attorneys Association (APAA), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA) and MARQUES – Association of European Trade Mark Owners.

8. This document presents the main findings of the questionnaire without any attempt to draw conclusions. The questionnaire and all the replies received, including comments given to specific questions by participating Offices and observer organizations, are available at: http://www.wipo.int/meetings/en/details.jsp?meeting_id=46431.

9. The Working Group is invited to consider this document and to express its views on further work concerning this topic.

[Annex follows]

⁴ The Benelux Office for Intellectual Property (BX) is the common Office of Belgium, Luxembourg and the Netherlands.

⁵ Curaçao (CW) is a territorial entity of the Kingdom of the Netherlands.

COMPILATION OF THE REPLIES TO THE QUESTIONNAIRE ON LIMITATIONS OF INTERNATIONAL REGISTRATIONS UNDER THE MADRID SYSTEM

Please, note that 55 Offices replied to the questionnaire. The total number of replies to most questions is higher than the number of responding Offices because Offices could choose more than one of the options available.

Replies are available at: http://www.wipo.int/meetings/en/details.jsp?meeting_id=46431.

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)?		Total:
Yes,	to determine whether such limitations are covered by:	
	the basic list.	11
	the main list.	3
	both the basic list and the main list.	40
No,	because the Office considers that:	
	the applicant is responsible for ensuring that such limitations are covered by the basic list or main list, or both.	1
	the International Bureau should determine whether such limitations are covered by the main list.	1
	the Office of the designated Contracting Party should determine whether such limitations are covered by the main list.	2
	it does not have the legal basis to do so.	1

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

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?		Total:
Yes,	to determine whether such limitations are covered by:	
	the main list.	25
	the main list, but only when the Office is also the Office of origin.	14
No,	because the Office considers that:	
	the holder is responsible for making sure that such limitations are covered by the main list.	1
	the International Bureau should determine whether such limitations are covered by the main list.	7
	the Office of the designated Contracting Party or Parties should determine whether such limitations are covered by the main list.	3
	it does not have the legal basis to do so.	4
N/A.		7
Others:	as Office of the holder, the Office has not yet encountered subsequent designations containing limitations.	1
	the Office examines inbound limitations to determine whether they are covered by the main list of the international registration, but does not do so for outbound limitations because it considers that such should be done by the Offices where the limitation is to have effect.	1

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?		Total:
Yes,	to determine whether such limitations are covered by:	
	the main list.	23
	the main list, but only when the Office is also the Office of origin.	14
No,	because the Office considers that:	
	the holder is responsible for making sure that such limitation is covered by the main list.	2
	the International Bureau should determine whether such limitation is covered by the main list.	6
	the Office of the designated Contracting Party or Parties should determine whether such limitation is covered by the main list.	4
	it does not have the legal basis to do so.	4
N/A.		8
Others:	the Office examines limitations to determine whether they are covered by the list of goods and services for which the mark has effect or is protected.	1
	the Office examines inbound limitations to determine whether they are covered by the main list of the international registration, but does not do so for outbound limitations because it considers that such should be done by the Offices where the limitation is to have effect.	1
	as Office of the holder, the Office does not accept requests for the recording of a limitation (Form MM6).	1

C. ROLE OF THE OFFICE OF THE DESIGNATED CONTRACTING PARTY

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

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?		Total:
Yes.		15
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.	17
	understands that the holder is responsible for ensuring that such limitation is covered by the main list.	4
	understands that the Office of origin has already determined that such limitation is covered by the main list.	15
	understands that the International Bureau has already determined that such limitation is covered by the main list.	22
	does not have the legal basis to examine such limitation.	8
Others:	the Office takes into account only the limited list because it understands that the Office of origin or the International Bureau has already determined that the limited list is covered by the main list.	2
	the Office has not had such case.	1

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?		Total:
Yes.		15
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.	17
	understands that the holder is responsible for ensuring that such limitation is covered by the main list.	5
	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.	17
	understands that the International Bureau, regardless of who presented the subsequent designation, has already determined that such limitation is covered by the main list.	20
	does not have the legal basis to examine such limitation.	9
Others:	the Office understands that the International Bureau no longer examines limitations in subsequent designations.	1
	the Office examines limitations in subsequent designations because it examines all communications subsequent to the original designation.	1
	the Office examines limitations to determine whether they are covered by the list of goods and services for which the mark has effect or is protected.	1
	the Office has not had such case.	1

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?		Total:
<i>Question 6 was applicable only to those Offices that replied "yes" to question 4 or 5.</i>		
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.		13
Others:	the Office would send a declaration under Rule 27(5).	2
	the Office does not do anything because it does not examine limitations.	1
	the Office takes note of limitations.	1
	the Office has not had such case but it would send the corresponding notification.	1

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?		Total:
<i>Question 7 was applicable only to those Offices that replied "no" to question 4 or 5.</i>		
Yes,	the Office would apply the new provision and issue such provisional refusal or declaration that the limitation has no effect.	8
	however, the national or regional legal framework would need to be changed.	1
No.		31
Others:	the Office could examine limitations but considers it would be more efficient if the International Bureau examined them.	1
	its legal framework does not allow the Office to examine these limitations.	1

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))?		Total:
Yes.		27
No,	the Office simply takes note of the limitation because the Office understands that:	
	the holder is responsible for ensuring that such limitation is covered by the main list.	5
	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.	11
	the International Bureau, regardless of who presented the request, has already determined that such limitation is covered by the main list.	15
	it does not have the legal basis to examine such limitation or refuse the effects of such limitation.	8
Others:	the Office examines limitations referred to specification but does not examine changes in ownership.	1
	the Office takes into account only the limited list as this is the only list that has effects.	1

Question 9: When examining a limitation recorded as a change (under Rule 27(1)(a)), what does the Office take into account?		Total:
<i>Question 9 was applicable to those Offices that replied "yes" to question 8.</i>		
The Office takes into account:	the main list of the international registration only.	4
	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, notifications of provisional refusals, etc.).	25
Others:	the Office takes into account all prior amendments and understands that further amendments can only restrict or narrow the scope.	1

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.		Total:
<i>Question 10 was applicable to those Offices that replied "yes" to question 8.</i>		
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.		28
Others:	the Office refuses the application.	1
	the Office has not had such a case but it would send the corresponding declaration.	1

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)?		Total:
Yes.		47
No.		8

Question 12: Does the Office examine the requests in respect of national or regional applications referred to in question 11?		Total:
<i>Question 12 was applicable to the Offices that replied "yes" to question 11.</i>		
Yes.		47
No.		1

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)?	Total:
Yes.	46
No.	9

Question 14: Does the Office examine the requests for recordings in respect of national or regional registrations referred to in question 13?	Total:
<i>Question 14 was applicable to the Offices that replied "yes" to question 13.</i>	
Yes.	41
No.	5

II. FOR OBSERVER ORGANIZATIONS ONLY

Please, note that six observer organizations replied to the questionnaire and one organization sent a statement. The number of replies in each question is higher than the number of responding organizations because organizations could choose more than one of the options available.

Replies given by observer organizations under "Other(s)" as well as comments to each question are available at: http://www.wipo.int/meetings/en/details.jsp?meeting_id=46431

Question 15: What are the reasons for making a limitation in an international application (Form MM2)?		Total:
	To reflect the applicant's business interest in a particular Contracting Party.	5
	To avoid a possible notification of provisional refusal in a particular Contracting Party.	6
	To avoid possible litigation in a particular Contracting Party.	5
	To exclude the business interests of a third party with whom the applicant has a trademark dispute.	5
	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.	5
	To comply with a court order in a particular designated Contracting Party.	5
	Other(s).	2

Question 16: What are the reasons for making a limitation in a subsequent designation (Form MM4)?		Total:
	To reflect the holder's business interest in a particular Contracting Party.	5
	To avoid a possible notification of provisional refusal in a particular Contracting Party.	6
	To avoid possible litigation in a particular Contracting Party.	5
	To exclude the business interests of a third party with whom the holder has a trademark dispute.	6
	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.	6
	To comply with a court order in a particular designated Contracting Party.	5

Question 17: What are the reasons for requesting the recording of a limitation as a change to the international registration (Form MM6)?	Total:
To reflect the holder's business interest in a particular Contracting Party.	4
To overcome a notification of provisional refusal.	6
To exclude the business interests of a third party with whom the holder has a trademark dispute.	5
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.	6
To comply with a court order in a designated Contracting Party.	5
To avoid cancellation due to non-use.	4
To avoid possible litigation.	5
Other(s).	1

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?	Total:
Yes.	2
No.	3
Other(s).	1

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?	Total:
Yes.	2
No.	3

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?	Total:
Yes.	1
No.	4

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.	Total:
Five observer organizations elaborated on their views, which are available at http://www.wipo.int/meetings/en/details.jsp?meeting_id=46431 .	5

[End of Annex and document]