

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: APAA Trademark Committee.....
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:

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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]

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.

⇒ The Madrid System for the international registration of marks offers trademark holders the opportunity to apply, update and maintain protection of trademarks efficiently. At their own discretion, holders of international applications can make a limitation of an international application or in a subsequent designation or request the recording of a limitation as a change to the international registration. The purpose of such limitation may either to reflect the applicant's business interest in a particular Contracting Party or to avoid a possible notification of provisional refusal in a particular Contracting Party, etc. Currently, the procedures for requesting for such a limitation at WIPO are quite simple with appropriate forms and overall can meet the holders' needs in updating their international registrations of trademarks.

However, the current process for making a limitation to an international application in response to a Provisional I Refusal based on the citation of a prior mark seems to be quite restrictive. For example, other than by argument or presenting evidence, it is only possible to overcome a citation by limitation, i.e., by excluding conflicting goods or services, and not by qualifying the statement of goods/services in some way. Therefore, it would be preferable for Madrid Applicants to also be able to amend their statements of goods/services by qualification to some extent rather than solely by exclusion.