

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 INTELLECTUAL PROPERTY ASSOCIATION	
Name of the contact person:	
E-mail address:	

II. FOR OBSERVER ORGANIZATIONS ONLY
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Question 15: What is (are) the reason(s) for making a limitation in an international application (Form MM2)? <i>(It is possible to tick more than one box.)</i>
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- ☐ 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)? <i>(It is possible to tick more than one box.)</i>
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- ☐ 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:

To reduce the renewal cost for unnecessary class(es).....

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:

Accompanied by the Office of origin's examination of the international application .

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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:

To reduce the risk of rejection at the designated country(-ies) (and the cost/time for responding it).....

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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:

To reduce the risk of rejection at the designated country(-ies) (and the cost/time for responding it).....

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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]

JIPA Answer to Q.21

We JIPA hope that the Office of origin should examine that whether a limitation to an international application falls within the scope of the main list of that application and that the Office of the designated Contracting Parties should not undertake an examination of such limitation. The reasons are as follows:

1. We would be very concerned about an increase of cost amount for the reply to the Office Action and a delay of examination if an examination of limitation is undertaken by the Office of the designated Contracting Parties; and
2. If the Office of the designated Contracting Parties judges that the limited goods/services are not included in the specification of goods/services in the basic application or basic registration, we cannot enjoy the advantage of a single application through the Madrid System and we will hesitate to make good use of it.