

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.)*

- ☒ **1** To reflect the applicant's business interest in a particular Contracting Party.
- ☒ **2** 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.
- ☒ **3** 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:

.....

.....

.....

.....

Please, provide other relevant information or comment:

All of the reasons stated above are considered applicable. In order to identify which, in practice, are the main reasons for making a limitation, the three main reasons have been rated on a scale of 1 to 3, where 1 corresponds to the most frequent and 3 to the least frequent. Given the time available, however, the survey was limited to members of the Madrid System Subcommittee of INTA. This applies also to Questions 16 and 17.

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.)*

- ☒ **1** To reflect the holder's business interest in a particular Contracting Party.
- ☒ **2** 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.
- ☒ **3** 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:

.....

Please, provide other relevant information or comment:

.See under Question 15.....

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.*)

- ☒ **3** To reflect the holder's business interest in a particular Contracting Party.
- ☒ **1** 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.
- ☒ **2** 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:

.....

Please, provide other relevant information or comment:

.See under Question 15.....

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:

It is assumed that most applicants use the services of specialized attorneys and/or paralegals (in house or in private practice) who are familiar with limitations and the need to keep within the scope of the original specification. It is recognized; however, that people's expectations will be governed by their own experience. For those who file through Offices that provide guidance, they would probably answer "yes" to this question. This comment applies also to Questions 19 and 20.

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:

See under Question 18

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:

See under Question 18

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]

Questionnaire on Limitations of International Registrations Under the Madrid System

Comments on Question 21 by the Madrid System Subcommittee of the International Trademark Association (INTA)

March 2018

Question 21 of the Questionnaire on Limitations of International Registrations Under the Madrid System invites observer organizations to elaborate on the respective roles of the Office of origin, the International Bureau of WIPO and Offices of designated Contracting Parties in the examination of limitations in international registrations, with a view to further advancing discussions in the Working Group on the Legal Development of the Madrid System on this issue.

As a general remark, INTA believes that any solution to this question should be not only consistent with the underlying principles of the Madrid system but also practical in operational terms. Besides, the solution needs not be the same for all types of limitations as reviewed below. Moreover, a distinction should be made between the examination of the limitation with a view to ascertaining that it is in effect a limitation of the scope of the list of goods and services, i.e. that it does not extend that scope, on the one hand, and the control of the classification of the list of goods and services resulting from the limitation on the other hand. This contribution will address first the examination of the limitation as to the scope of the list of goods and services and then as to the classification of the latter.

1. Examination of limitations as to the scope of the list of goods and services

Limitations in International Applications

INTA shares the view expressed by a large number of delegations in the Working Group that the examination, as to its scope, of any limitation in the international application should be part of the process of certification by the Office of origin provided for in Article 3 of the Madrid Protocol and in Rule 9(5)(d) of the Common Regulations.

This is consistent with the basic concept of the Madrid system that the international registration is a territorial extension of the protection obtained in the Contracting Party of origin by virtue of the basic mark. The Office of origin is the only authority in a position to assess with certainty the scope of the goods and services covered by the basic mark, under its law and practice, and to certify that all goods and services listed in the international application, including in any limitation contained therein, fall within that scope.

Since, under item (vi) of Rule 9(5)(d), the Office of origin must ascertain and certify that "*the goods and services indicated in the international application* are covered by the list of goods and services appearing in the basic application or

basic registration" (emphasis added), it seems logical and, in practical terms, expedient, to understand this requirement as applying not only to the "main" list of goods and services but also to any limited list or lists. As required, Rule 9(5)(d)(vi) could be clarified in that sense.

Designated Contracting Parties do rely on the control by the Office of origin that the goods and services appearing in the "main" list of the international application are covered by the goods and services listed in the basic mark; they should likewise be able to rely on the control by the Office of origin that the goods and services resulting from any limitation thereof are also so covered.

Limitations in Subsequent Designations

Subsequent designations may be presented to the International Bureau by the holder either directly or through the Office of the Contracting Party of the holder, which Office may or may not (in case of a change in ownership) be the Office of origin. A systematic examination of the limitation as to its scope by the Office of origin would not therefore be practicable for this type of limitations.

However, now that no international registration remains governed by the Madrid Agreement and that the intervention of the Office of the Contracting Party of the holder has become entirely optional, it would be useful before coming to any conclusion on the examination of limitations in subsequent designations to know what is the proportion of subsequent designations that remain channelled through an office and, if this is a substantial proportion, to investigate the reasons why holders choose to have their subsequent designations presented by the Office of their Contracting Party rather than directly.

Limitations Under Rule 25 of the Common Regulations

Like subsequent designations, limitations under Rule 25 of the Common Regulations may be presented to the International Bureau by the holder either directly or through the Office of the Contracting Party of the holder. The same remarks as are made in the two preceding paragraphs, therefore, also apply to limitations under Rule 25.

However, as pointed out by the International Bureau in WIPO document MM/LD/WG/15/3, Rule 27(5) of the Common Regulations provides Offices with a mechanism to refuse to give effect to a limitation under Rule 25, which, as stated by the International Bureau in paragraph 25 of the said document "was introduced because Offices had informed the International Bureau that the lists of goods and services which resulted from limitations could, in their opinion, be broader than either the main list in the international registration or the scope for which the mark had protection in their corresponding territories". It would be useful to have information on the number of notifications under Rule 27(5) received by the International Bureau and the proportion of such notifications in which the reason given for refusing to give effect to the purported limitation is that it would in fact extend the scope of the list of goods and services.

2. Examination of limitations as to the classification of goods and services

Whatever the solution retained for the examination of limitations as to the scope of the list of goods and services, INTA firmly believes that the International Bureau, as the guardian of the Nice Classification, should effectively control the classification of goods and services in limitations.

The lack of harmonization of classification practices among trademark offices around the world is a constant source of difficulties for users. With the International Bureau of WIPO, the Madrid system offers a central authority with the final word on the classification of goods and services in international registrations. This responsibility of the International Bureau must be maintained and fully recognized in the interest of the smooth operation of the international registration system.