

■ Limitations of Goods and Services

Debbie Roenning

debbie.roenning@wipo.int

Roundtable
October 29, 2013

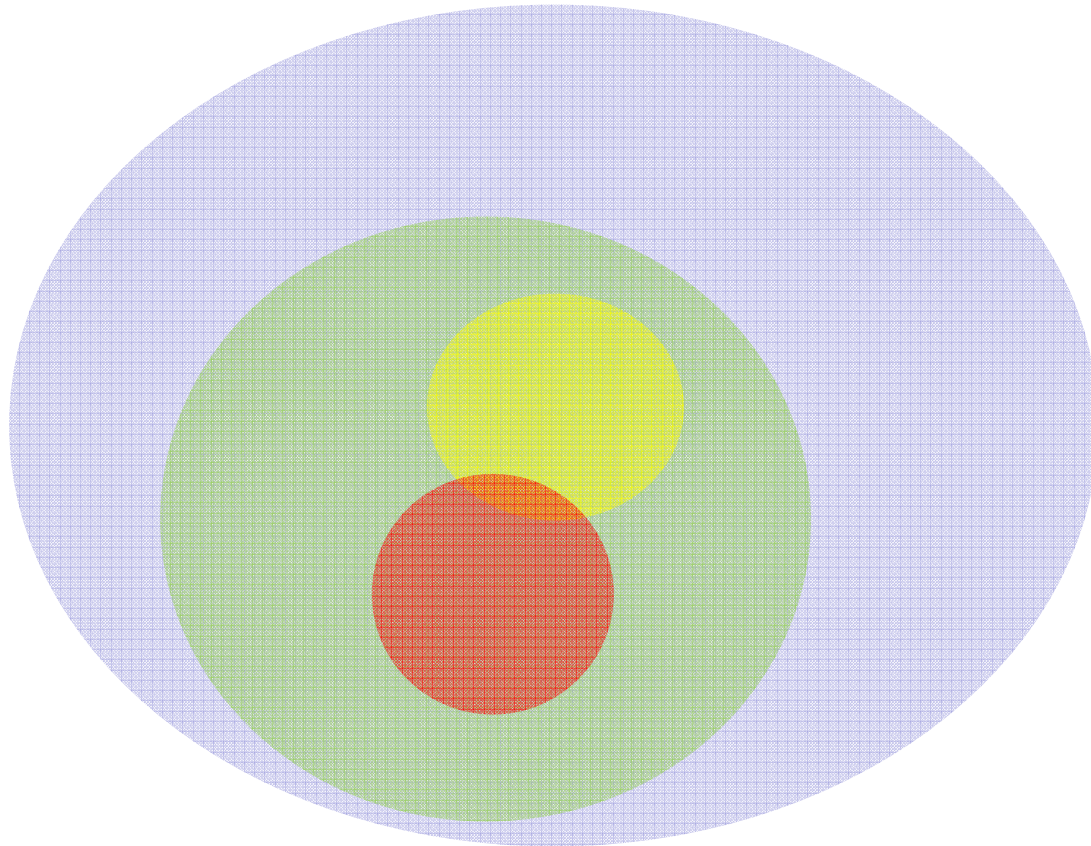
Limitations

- A limitation is a procedure which is designed to restrict the goods and services in respect of all or some of the designated Contracting Parties (DCP) in an international application or in an international registration
- Limitations may be set out in
 - an international application (MM1 to MM3);
 - a subsequent designation (MM4); or in
 - a request for the recording of a limitation presented using official form MM6

Legal Basis for Limitations

- It follows from Article 9 of the Agreement and Article 9*bis* of the Protocol that the International Bureau shall record in the International Register, in respect of all or some of the Contracting Parties, any limitation of the goods and services listed in the international registration
- The Common Regulations have several provisions on limitation;
 - Rule 9(4)(a)(xiii);
 - Rule 24(3)(a)(iv);
 - Rules 25 to 27
- New practice on translation upon request

The Scope: Basic Mark – IR – Limitation (1)



The Scope (2)

Basic Registration

List of goods and services

18 Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery.

25 Clothing; footwear; headgear.

28 Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.



International Registration

List of goods and services

18 Bags (included in this class), briefcases, shopping bags school satchels, pack sacks, namely, sports packs and rucksacks; athletic bags.

25 Stockings, socks, fine-stockings, tights, hosiery; clothing; footwear; headgear.

28 Gymnastic and sporting articles (included in this class).



Limitation: United States of America

List limited to:

25 Clothing, namely, stockings, fine-stockings, pantyhose, socks, tights, hosiery; sportswear, namely suits, shorts, pants, shirts, gloves, jerseys, jackets, coats, sweaters, pullovers, warm-up suits, jump suits, swimwear, rain suits, ski suits, sport sleeves; footwear; headgear, namely, hats, caps, hat scarves; skin suits made of compression material, namely, garments covering torso from shoulders to tights to be worn when participating in triathlons; compression trousers for athletic use; compression socks for athletic use; compression stockings for athletic use.



Limitation: Japan

List limited to:

18 Bags or the like made of leather and imitation leather

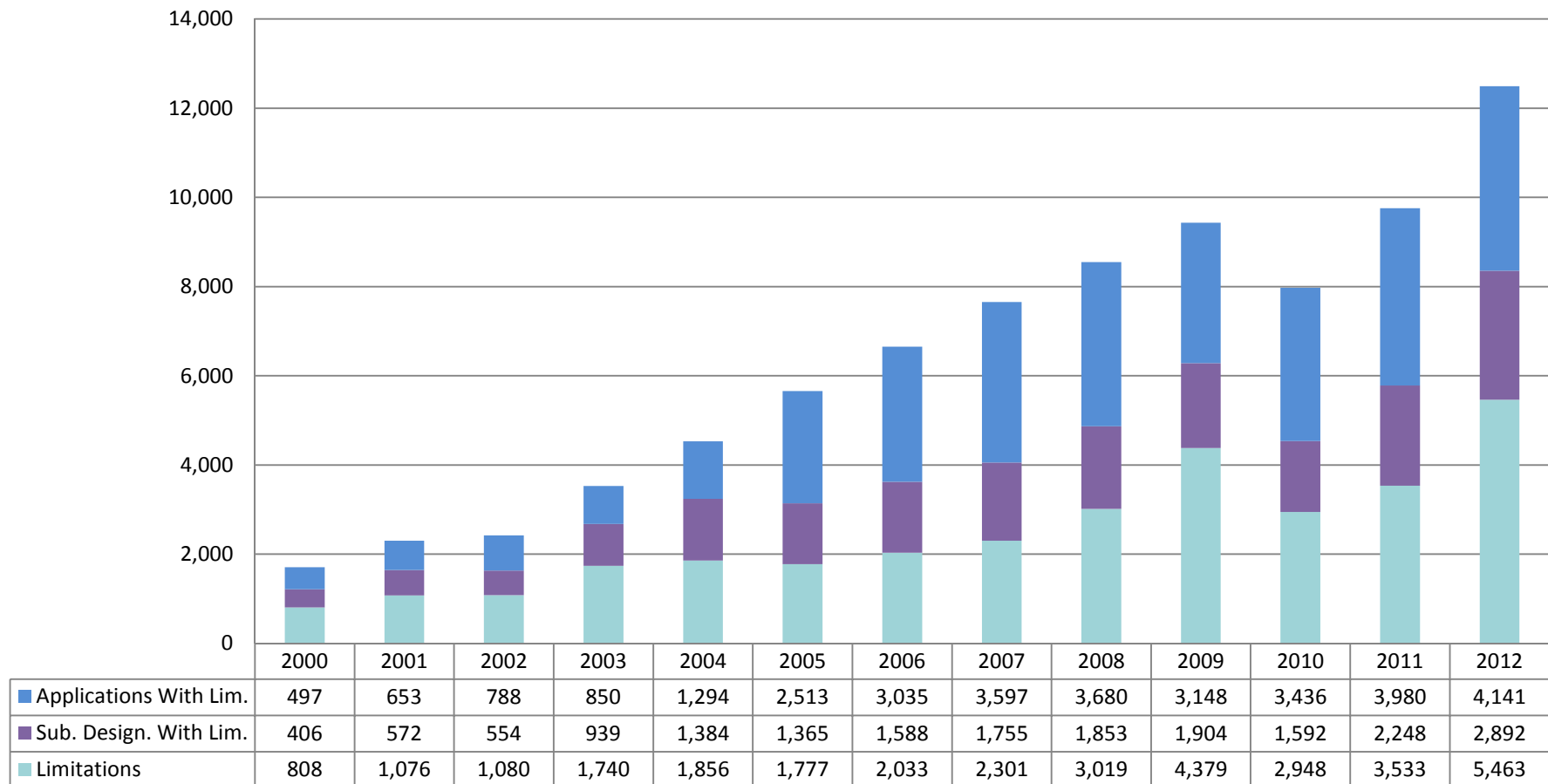
25 Clothing, footwear, headgear; ties and scarves; gloves as clothing and belts as clothing; all the above goods are of Italy origin.

Statistics: Number of Limitations in 2012

- In 2012, 9.87% of the international applications and 20.25% of the subsequent designations included a request for limitation

2012	Number of Requests	Number of Limitations	%
International Application	41,954	4,141	9.87%
Subsequent designation	14,283	2,892	20.25%
Limitation (MM6)	5,463	5,463	100%
Total requests	56,237	7,033	12.51%

Statistics 2000 – 2012





Notification

1 085 878

Registration date: **September 1, 2009**
Date next payment due: **September 1, 2019**

FERRARI S.P.A.
Via Emilia Est, 1163
I-41100 MODENA
(Italy).

Legal nature of the holder (legal entity) and place of organization: Joint stock company, Italy.

Name and address of the representative: Dr. MODIANO & ASSOCIATI S.p.A., Via Meravigli, 16, I-20123 MILANO (Italy).



Classification of figurative elements:
3.3; 24.1; 26.3; 26.4; 29.1.

Colours claimed: Black, red, green, grey, yellow and white. The color black appears in the internal area of the substantially rectangular label extending upwards, in the outlines of the slightly slanting shield, in the strongly stylized rampant horse facing left and in the letters S and F placed inside the slightly slanting shield; the color red appears in the outlines of the substantially rectangular label extending upwards and in the substantially triangular oblique figure evocative of a strongly stylized sail; the color green appears in one of the two slightly slanting segments incident one with the other which surmount the slightly slanting shield; the color grey appears in the outlines of the substantially triangular oblique figure evocative of a strongly stylized sail and in the shading of the figure of a strongly stylized rampant horse facing left; the color yellow appears in the word FERRARI and in the slightly slanting shield placed in the centre of the substantially triangular oblique figure evocative of a strongly stylized sail; the color white appears in the word WORLD, in the outlines of the substantially triangular oblique figure evocative of a strongly

stylized sail, in one of the two slightly slanting segments incident one with the other which surmount the slightly slanting shield and in the shading of the figure of a strongly stylized rampant horse facing left.

Description of the mark: The mark consists of a sign depicting a substantially rectangular label extending upwards with rounded corners, outlined in red and with the internal area in black, containing in the upper part the wording FERRARI WORLD in fancy characters placed on two lines, the word FERRARI being in yellow, with the upper horizontal stroke of the letter F extending above the remaining letters, excluding the final I, the word WORLD being in white and placed under the word FERRARI, on said rectangular label overlapping, under said wording, there is a substantially triangular oblique figure evocative of a strongly stylized sail, in red and outlined in white and grey, with its side slightly concave and the corners protruding from the base and from three sides of the rectangular label, said figure having in its centre a slightly slanting shield in yellow outlined in black, surmounted by two slightly slanting segments in white and green incident one with the other, and containing the figure of a strongly stylized rampant horse facing left, in black with white and grey shading, the lower leg being flanked on the left with a letter S and on the right with a letter F, both in black fancy characters.

List of goods and services - NCL(9):

- 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- 6 Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
- 8 Hand tools and implements (hand-operated); cutlery; side arms; razors.
- 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
- 11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- 12 Vehicles; apparatus for locomotion by land, air or water.
- 14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- 16 Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding

- This international registration contained 4 different limitations for China, Russian Federation, Singapore, the European Union, Japan and the United States of America
- A total of 82 pages of continuation sheet in item 10 (goods and services) of MM3



Notification
(1 085 878 continued)

- material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; roaring fountain pens; roaring ballpoint pens; roaring rolling pens; roaring felt pens; roaring writing pens; roaring roller ball pens; glowing fountain pens; glowing ballpoint pens; glowing rolling pens; glowing felt pens; glowing writing pens; glowing roller ball pens; roaring felt-tip pens; glowing felt-tip pens; roaring pastels (crayons); glowing pastels (crayons); roaring pencils; glowing pencils; roaring photo albums; roaring souvenir cards; glowing paper flags; paper clips of precious metal or coated therewith; visiting card cases of precious metal, leather business card booklets; leather business card holders; leather pen cases; leather pen holders; leather photo albums; leather photo holders; leather address book covers; leather photo album covers Japanese food wrapping sheets of plastics; plastic leaves for wrapping.
- 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- 20 Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
- 21 Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
- 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
- 24 Textiles and textile goods, not included in other classes; bed and table covers.
- 25 Clothing, footwear, headgear.
- 26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
- 28 Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
- 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
- 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
- 34 Tobacco; smokers' articles; matches.
- 35 The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; advertising; business management; business administration; office functions (services on behalf of third parties).
- 36 Insurance; financial affairs; monetary affairs; real estate affairs (services on behalf of third parties).
- 37 Building construction; repair; installation services (services on behalf of third parties).
- 38 Telecommunications (services on behalf of third parties).
- 39 Transport; packaging and storage of goods; travel arrangement (services on behalf of third parties).
- 41 Education; providing of training; entertainment; sporting and cultural activities (services on behalf of third parties).
- 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software (services on behalf of third parties).
- 43 Services for providing food and drink; temporary accommodation (services on behalf of third parties).
- 44 Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services (services on behalf of third parties).
- Basic registration:* Italy, 01.09.2009, 1210886.
Data relating to priority under the Paris Convention: Italy, 15.04.2009, MO2009C000253.
Designations under the Madrid Agreement: Algeria, Egypt.
Designations under the Madrid Protocol: European Union, Japan, Norway, Singapore, Sultanate of Oman, United States of America.
Designations under the Madrid Protocol by virtue of Article 9sexies: China, Islamic Republic of Iran, Morocco, Russian Federation, Switzerland, Syrian Arab Republic.
Declaration of intention to use the mark: Singapore, United States of America.
Limitation of the list of goods and services: China, Russian Federation, Singapore.
List limited to:
3 Bleaching preparations (laundry); bleaching salts; bleaching soda; blueing for laundry; color-brightening chemicals for household purposes (laundry); color-removing preparations; fabric softeners for laundry use; laundry bleach; laundry glaze; laundry preparations; laundry soaking preparations; laundry starch; laundry wax; starch glaze for laundry purposes; dry-cleaning preparations; leather bleaching preparations; quillaia bark for washing; volcanic ash for cleaning; ammonia (volatile alkali) (detergent); canned pressurized air for cleaning and dusting purposes; cleaning chalk; cleaning preparations; preparations for cleaning waste pipes; cloths impregnated with a detergent for cleaning; abrasive cloth; abrasive paper; abrasives; antistatic preparations for household purposes; boot cream; boot polish; polish for furniture and flooring; polishing creams; polishing paper; polishing preparations; polishing rouge; polishing stones; polishing wax; shining preparations (polish); carbides of metal (abrasives); cobblers' wax; corundum (abrasive); creams for leather; degreasers other than for use in manufacturing.

Limitations of the list of goods and services: China, Russian Federation, Singapore

List limited to:

3 Bleaching preparations (laundry); ...



Notification
(1 085 878 continued)

- forecasting, meteorological information, authenticating works of art.
- 43 Bar services; cafés; cafeterias; coffee shops; snack-bars; wine bars; cocktail lounge services; tea rooms; food and drink catering; restaurants; self-service restaurants; carry-out restaurants; fast-food restaurants; rotisseries; canteen services; consultancy services in the field of menu planning for others; consulting services in the field of culinary art; accommodation bureaux, being hotel and boarding houses accommodation services; arranging temporary housing accommodation; providing hotel accommodation; hotel and restaurant reservation services; boarding of animals; boarding house bookings; boarding houses; holiday camp services, being lodging; hotel reservations; hotels; rental of meeting rooms; providing campground facilities; day-nurseries, being children's crèches; retirement homes; tourist homes; motels; bed and breakfast inn services; rental of chairs, tables, table linen, glassware; rental of tents; rental of bar equipment; rental of beach chairs, towels and umbrellas for recreational use; rental of bed and bath linens.
- 44 Artificial insemination services; in vitro fertilization services; blood bank services; medical clinics; medical assistance; hospitals; hospices; dentistry; opticians' services; pharmacy advice; physical therapy; physiotherapy; services of a psychologist; rental of sanitation facilities; telemedicine services; chiropractics; convalescent homes; midwife services; nursing homes; nursing, medical; pharmacists' services to make up prescriptions; hair implantation; plastic surgery; rehabilitation for substance abuse patients; rest homes; sanatoriums; animal breeding; animal grooming; pet grooming; veterinary assistance; aromatherapy services; public baths for hygiene purposes; Turkish baths; beauty salons; hairdressing salons; health care; health spa services; manicuring; massage; sauna services; solarium services; visagists' services; tattooing; aerial and surface spreading of fertilizers and other agricultural chemicals; landscape gardening; landscape design; gardening; lawn care; horticulture; vermin exterminating for agriculture, horticulture and forestry; farming equipment rental; flower arranging; plant nurseries; tree surgery; weed killing; wreath making.

Limitation of the list of goods and services: European Union.

List limited to:

- 35 The bringing together, for the benefit of others, of soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, cleaning preparations, badges of metal for vehicles, pins for wheels, metal tool boxes, metal pins, metal plates and other items of metal hardware, metal building materials, materials of metal for railway tracks, hand tools and implements (hand-operated), cutlery, razors, electronic games and amusement machines and apparatus, adapted and not adapted for use with television receivers and with an external display screen or monitor and their accessories, recorded programs for electronic games, amusement machines and apparatus, spectacles and their parts and accessories, optical apparatus and instruments, protective helmets, protective clothing and

its accessories, protective footwear, protection apparatus and devices for personal use against accidents, multimedia library and contents, downloadable and not downloadable, magnetic data carriers, recording discs, apparatus and instruments for recording, transmission, reproduction of sound and images and their accessories, computers and computer input and output peripheral devices, computer software, photographic and cinematographic apparatus, telephones and their accessories, telecommunication apparatus, scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments, electric and electronic apparatus and instruments for vehicles, electric and electronic apparatus and instruments for personal use, magnets, calculating machines, cases especially made for containing the aforementioned goods, fire-extinguishers, air conditioners for vehicles, lighting installations for vehicles, lights for vehicles, vehicle headlights, anti-dazzle devices for automobiles, anti-glare devices for vehicles, defrosters for vehicles, heating apparatus for defrosting windows of vehicles, heaters for vehicles, vehicle reflectors, lamps and apparatus for lighting in general, fans (parts of air-conditioning installations for vehicles), electric fans for personal use, automobiles and vehicles in general and their parts and accessories, baby carriages and their accessories, parachutes, watches and clocks and their parts and accessories, horological and chronometric instruments, badges, boxes, pins and lanyards of precious metal or coated therewith, jewellery, imitation jewellery, stamps, paper, cardboard and goods made from paper and cardboard, photo albums and leather photo albums, printed publications, printed periodicals, printed reports, booklets, magazines, yearbooks, encyclopaedias, books, pamphlets, brochures, newspapers, general feature magazines and other printed matter, pictures, photographs, posters, calendars, diaries, stationery articles, labels, artists' materials and paint brushes, office requisites, instructional and teaching material, plastic materials for packaging, bags of any material for packaging, lanyards for carrying paper items, key cases, key rings, cases and holders for agendas and weekly planners, for business cards, for booklets, for credit cards, for pens, for pencils, for MP3 players, for CDs, for CD players, for DVDs, for DVD players, for computers and for mobile phones, hang tags, leather clipboards, beauty cases, handbags, rucksacks, trunks, travelling bags, goods made of leather and imitations of leather, umbrellas, parasols, walking sticks, statues and statuettes in any material, furniture, mirrors, picture frames, non-electric fans for personal use, straws for drinking, lanyards for carrying plastic items, flasks, thermos, canteens, carafes, bottles, refrigerating bottles, decanters, mugs, tea mugs, beer mugs, commemorative and ornamental cups and mugs, travel coffee mugs, cups, sippy cups, coffee cups, tea cups, set of shot glasses, set of tea glasses, drinking glasses, shot glasses, beer glasses, tumblers (glasses), cocktail glasses, glowing tumblers (glasses), glowing glasses for drinking, roaring mugs for drinking, coffee services, tea services, non-electric coffee pots, tableware,

**Limitations of the list of
goods and services:
European Union**

List limited to:

**35 The bringing together,
for the benefit for others, of
soaps, ...**



Notification
(1 085 878 continued)

**Limitations of the list of
goods and services: Japan**

List limited to:

**3 Anti-static preparations
for household purposes; ...**

dishes, melamine dishes for infants, cooking dishes, serving dishes, table plates, trays for domestic purposes, serving trays, pots, cake molds, coasters, cocktail stirrers, corkscrews, pepper pots, salt cellars, ice cube molds, jugs, hand-operated pepper mills, fitted picnic baskets, including dishes, spatulas, bowls, glass stoppers, glass caps, containers for caps and stoppers for bottles, pasta colanders, oven mitts, heat-insulated containers and other containers and accessories for household purposes and for kitchen use, dishes for soap, toilet tissue holders, rails, bars and rings for towels, boxes and containers for cotton pads and cotton balls, brushes, toilet brushes, shaving brushes, combs, sponges, utensils and containers for the bathroom, for personal use and for personal care, perfume sprayers, perfume vaporizers, glasses for candles, coin trays, glassware, porcelain, earthenware, not fitted vehicle covers, ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags for packaging, padding and stuffing materials, raw fibrous textile materials, textile beach towels, textile bath towels, dishcloths, dishtowels, towels of textile, bed blankets, bed covers, bed linen, bath linen, table linen, coasters (table linen), place mats, table napkins, tablecloths, flags, glowing flags, roaring flags, textile pennants, textile pennons, banners, textiles and textile goods, bed and table covers, clothing articles, footwear, headgear, parts of clothing articles, of footwear and of headgear, laces, buttons, hooks, eyes, pins, badges not of precious metal for wear, brooches, buckles, clothing accessories, lanyards for wear, scale model cars and scale model vehicles in general, games, playthings, gymnastic and sporting articles, Christmas trees and relative decorations, foodstuffs of all kind for human consumption, beverages in general, smokers' articles, (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; advertising; business management; business administration; office functions (services on behalf of third parties).

Classes 3, 6, 8, 9, 11, 12, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 29, 30, 34, 36, 37, 38, 39, 41, 42, 43 and 44 remain unchanged.

Limitation of the list of goods and services: Japan.

List limited to:

3 Anti-static preparations for household purposes; de-greasing preparations for household purposes; rust removing preparations; stain removing benzine; fabric softeners for laundry use; laundry bleach; adhesives for affixing false hair; adhesives for affixing false eyelashes; laundry starch; seaweed gelatine for laundry use; paint stripping preparations; shoe and boot cream; shoe black (shoe polish); polish for furniture and flooring, automobile polishes, shining preparations (polish), leather dressing, leather preservatives (polishes), and other polishing preparations; soaps and detergents; dentifrices; cosmetics and toiletries; natural perfumery made from plants; natural perfumery prepared from animal extracts; synthetic perfumery; compound perfumery; food flavorings prepared from essential oils; incenses and fragrances; abrasive paper (sand paper); abrasive cloth; abrasive sand; artificial pumice stone; polishing paper; polishing cloth; false nails; false eyelashes.

6 Irons and steel, unwrought or semi-wrought; non-ferrous metals and their alloys; ores of metal; metal materials for building or construction; prefabricated building assembly kits of metal; loading and unloading pallets of metal; turntables for load handling; traversers for load handling; artificial fish reefs of metal (rails); poultry cages of metal; paint spraying booths of metal; metal moulds for forming cement products; pulleys (of metal, not machine elements); springs (of metal, not machine elements) (metal hardware); valves (of metal, not machine elements); metal junctions for pipes; metal flanges (collars); keys (mechanical element); cotter pins; railway points; road signs of metal (not luminous nor mechanical); beacons of metal (non-luminous); liquid storage tanks or reservoirs (of metal); industrial water storage tanks (of metal); liquefied gas storage tanks (of metal); gas storage tanks (of material); internal floating lids of aluminium for use with gas or liquefied gas storage tanks; anchors, other than clock and watch making; mooring bits of metal; mooring bollards of metal; containers of metal for transport and storage; anvils; swage blocks; metal hardware; wire ropes; wire nets and gauzes; industrial packaging containers of metal (not including "metal stoppers, lids and caps"); metal stoppers (for industrial packaging containers); metal lids and caps (for industrial packaging containers); ornamental number plates of metal; commemorative number plates of metal; ornamental plaques and plates, of metal; memorial plaques and plates of metal; commemorative plaques and plates of metal; metal nameplates and door nameplates; chains for dogs; metal stepladders and ladders; letter boxes of metal; hat-hanging hooks of metal; money boxes of metal; water tanks of metal for household purposes; tool boxes of metal (empty); towel dispensers, fixed, of metal; metal joinery fittings; safes (strong boxes); door mats of metal; upright signboards of metal; transportable greenhouses of metal for household use; metal tombs and metal tombstone plaques; ferrules of metal for canes and walking sticks; crampons (climbing irons); carabiners; rock pitons; diving platforms (boards) of metal; spurs; sculptures of metal.

8 Tweezers; braiders (hand-held ones only); hoes (hand-held); digging forks (spading forks); lawn rakes (hand-held ones only); lasts for shoe-making (hand-held ones only); electric or non-electric razors and electric or non-electric hair clippers for personal use; bladed or pointed hand tools (other than "swords"); swords; hand tools (other than "carpenters' inkpots, razor strops, sharpening steels and whetstones"); carpenters' inkpots and their accessories; razor strops (leather strops); sharpening steels; whetstones (sharpening stones); infant sets of spoons and forks; melamine infant sets of spoons and forks; egg slicers (non-electric); non-electric planes for flaking dried bonito blocks; sugar tongs; can openers (non-electric); nutcrackers; spoons (cutlery); cheese slicers (non-electric); pizza cutters (non-electric); forks (cutlery); flat irons (non-electric); needle-threaders; dressmakers' chalk sharpeners; pot stands; fire pans for carrying live charcoal (Juno); fireplace bellows (hand-tools); Japanese charcoal extinguishers; fire tongs;



Notification
(1 085 878 continued)

- calligraphic works; operation of video equipment or audio equipment for production of radio or television programs.
- 42 Franchising, namely services rendered by a franchisor, that is transfer of technical know-how; consultancy relating to the planning and layout design of shops, the interior decor of shops and related signs; architectural consultation, architecture, and other architectural design; construction drafting, engineering, industrial design, mechanical research, calibration (measuring), physics (research), surveying, technical project studies; technical project studies in the field of the construction and the design of cars, F1 racing cars and vehicles in general; technical research, vehicle roadworthiness testing; research and development for others; technical consultancy and research in the design and planning of cars, F1 racing cars and vehicles in general; technical advice relating to performance, operation of computers, automobiles and other machines that require high levels of personal knowledge, skill or experience of the operators to meet the required accuracy in operating them, design of interior decor, dress designing, graphic arts designing, packaging design, packaging design services, styling (industrial design); personalized technical design of cars, and other designing; designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; material testing, textile testing, quality control; certification services; testing, analysis and evaluation of cars of others for the purpose of certification; testing, inspection or research of pharmaceuticals, cosmetics or foodstuff; testing or research on machines, apparatus and instruments; research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; testing, inspection or research on agriculture, livestock breeding or fisheries; computer software consultancy, computer system design, computer systems analysis, consultancy in the field of computer hardware, creating and maintaining web sites for others, hosting computer sites (web sites), installation of computer software, providing search engines for the Internet, computer virus protection services, conversion of data or documents from physical to electronic media, data conversion of computer programs and data (not physical conversion), duplication of computer programs, recovery of computer data, rental of computer software, rental of web servers, updating of computer software, and other computer software design, computer programming or maintenance of computer software; providing computer programs; surveying; geological surveys or research, providing meteorological information; rental of measuring apparatus; rental of drawing instruments; rental of computers; rental of laboratory apparatus and instruments.
- 43 Hotels; motels; bed and breakfast inn services; providing temporary accommodation; accommodation bureaux (brokering reservations for hotels, boarding houses or the like); bar services, cafés, cafeterias, coffee shops, snack-bars, wine bars, cocktail lounge services, tea rooms, restaurants, self-service restaurants, carry-out restaurants,

- fast-food restaurants, rotisseries, food and drink catering; providing food and beverages; boarding for animals; preschooler and infant care at daycare centers; retirement homes; providing conference rooms; providing facilities for exhibitions; rental of futon and quilts; rental of cooking equipment for industrial purposes; rental of industrial dish-drying machines; rental of dishwashing machines for industrial purposes; rental of non-electric cooking heaters; rental of curtains; rental of furniture; rental of wall hangings; rental of floor coverings; rental of towels.
- 44 Beauty salons; hairdressing salons; providing bath houses; garden or flower bed care; garden tree planting; fertilizer spreading; weed killing; vermin exterminating (for agriculture, horticulture or forestry); massage and therapeutic shiatsu massage; chiropractics; moxibustion; treatment for dislocated joints, sprain, bone fractures or the like; acupuncture; medical services; providing medical information; physical examination; dentistry; preparation and dispensing of medications; dietary and nutritional guidance; animal breeding; veterinary services; beautification for animals; nursing care; rental of potted plants; farming equipment rental; rental of medical machines and apparatus; rental of fishing machines and instruments; rental of machines and apparatus for use in beauty salons or barbers' shops; rental of lawnmowers.

Limitation of the list of goods and services: United States of America.

List limited to:

- 3 Bleaching preparations for laundry and household use; bleaching salts; bleaching soda; blueing for laundry; color-brightening chemicals for laundry and household purposes; color-removing preparations; fabric softeners for laundry use; laundry bleach; laundry glaze; laundry preparations; laundry soaking preparations; laundry starch; laundry wax; starch glaze for laundry purposes; dry-cleaning preparations; leather bleaching preparations; quillaia bark for washing; volcanic ash for cleaning; detergent ammonia, being volatile alkali; canned pressurized air for cleaning and dusting purposes; cleaning chalk; cleaning preparations; preparations for cleaning waste pipes; cloths impregnated with detergent for cleaning; abrasive cloth; abrasive paper; abrasives; antistatic preparations for household purposes; boot cream; boot polish; polish for furniture and flooring; polishing creams; polishing paper; polishing preparations; polishing rouge; polishing stones; polishing wax; shining preparations, being polish; abrasive carbides of metal; cobblers' wax; abrasive corundum; creams for leather; degreasers other than for use in manufacturing processes; abrasive diamantine; emery; emery cloth; emery paper; floor wax; floor wax removers, being scouring preparations; non-slipping wax for floors; non-slipping liquids for floors; parquet floor wax; refurbishing preparations; glass cloth; glass paper; grinding preparations; leather preservatives, being polishes; oil of turpentine for degreasing; oils for cleaning purposes; paint stripping preparations; rust removing preparations; safrol; sandcloth; sandpaper; scale removing preparations;

**Limitations of the list of
goods and services: United
States**

List limited to:

**3 Bleaching preparations
for laundry and household
use; ...**



Notification
(1 085 878 continued)

- of sports equipment, except vehicles; rental of stadium facilities; rental of tennis courts; timing of sports events.
- 42 Franchising, namely services rendered by a franchisor, that is transfer of technical know-how; consultancy relating to the planning and layout design of shops, the interior decor of shops and related signs; architectural consultation, architecture, construction drafting, engineering, industrial design, mechanical research, measuring, namely calibration, physics research, surveying, technical project studies; technical project studies in the field of the construction and the design of cars, F1 racing cars and vehicles in general; technical research, vehicle roadworthiness testing; research and development for others; technical consultancy and research in the design and planning of cars, F1 racing cars and vehicles in general; design of interior decor, dress designing, graphic arts designing, packaging design, packaging design services, industrial design, namely styling; personalized technical design of cars; material testing, textile testing, quality control; certification services; testing, analysis and evaluation of cars of others for the purpose of certification; computer programming, computer software consultancy, computer software design, computer system design, computer systems analysis, consultancy in the field of computer hardware, creating and maintaining web sites for others, hosting computer web sites, installation of computer software, maintenance of computer software; providing search engines for the Internet; computer rental, computer virus protection services, conversion of data or documents from physical to electronic media, data conversion of computer programs and data, not physical conversion, duplication of computer programs, recovery of computer data, rental of computer software, rental of web servers, updating of computer software; oil-well testing, oil-field surveys, land surveying, geological prospecting, geological research, cosmetic research, chemical research, chemical analysis, bacteriological research, biological research, weather forecasting, meteorological information, authenticating works of art.
- 43 Bar services; cafés; cafeterias; coffee shops; snack-bars; wine bars; cocktail lounge services; tea rooms; food and drink catering; restaurants; self-service restaurants; carry-out restaurants; fast-food restaurants; rotisseries; canteen services; consultancy services in the field of menu planning for others; consulting services in the field of culinary arts; accommodation bureaux, being hotel and boarding houses accommodation services; arranging temporary housing accommodations; providing hotel accommodation; hotel and restaurant reservation services; boarding of animals; boarding house bookings; boarding houses; holiday camp services, being lodging; hotel reservations; hotels; rental of meeting rooms; providing campground facilities; day-nurseries, being children's crèches; retirement homes; tourist homes; motels; bed and breakfast inn services; rental of chairs, tables, table linen, glassware; rental of tents; rental of bar equipment; rental of beach chairs, towels and umbrellas for recreational use; rental of bed and bath linen.
- 44 Artificial insemination services; in vitro fertilization services; blood bank services; medical clinics; medical assistance; hospitals; hospices; dentistry; opticians' services; pharmacy advice; physical therapy; physiotherapy; services of a psychologist; rental of sanitation facilities; telemedicine services; chiropractics; convalescent homes; midwife services; nursing homes; nursing, medical; pharmacists' services to make up prescriptions; hair implantation; plastic surgery; rehabilitation for substance abuse patients; rest homes; sanatoriums; animal breeding; animal grooming; pet grooming; veterinary assistance; aromatherapy services; public baths for hygiene purposes; Turkish baths; beauty salons; hairdressing salons; health care; health spa services; manicuring; massage; sauna services; solarium services; visagists' services; tattooing; aerial and surface spreading of fertilizers and other agricultural chemicals; landscape gardening; landscape design; gardening; lawn care; horticulture; vermin exterminating for agriculture, horticulture and forestry; farming equipment rental; flower arranging; plant nurseries; tree surgery; weed killing; wreath making.
- 43 Bar services; cafés; cafeterias; coffee shops; snack-bars; wine bars; cocktail lounge services; tea rooms; food and drink catering; restaurants; self-service restaurants; carry-

Date of notification: 18.08.2011

Language of the international application: English

42 pages total



Notification

EXN/2007/17

572 660

Subsequent designations under the Madrid Protocol: Australia, Japan, Republic of Korea, United Kingdom, United States of America.

Limitation of the list of goods and services: Australia.

The designation concerns only class 16.

Limitation of the list of goods and services: United Kingdom.

The subsequent designation concerns only classes 16 and 25 and goods in class 18 as follows: goods of leather or imitation leather, namely wallets, change purses, key rings, handbags, briefcases, suitcases, umbrella, covers for agendas, agendas, holders for credit cards, document wallets, cases, boxes, portfolios.

Limitation of the list of goods and services: Japan.

The subsequent designation concerns only class 16 and goods in class 18 as follows: leather or imitation leather products, namely wallets, change purses, key rings, handbags, briefcases, suitcases, umbrellas, covers for agendas, agendas, holders for credit cards, document wallets, cases, boxes, portfolios.

Limitation of the list of goods and services: Republic of Korea.

The subsequent designation concerns only class 16 and goods in class 25 as follows: clothing, hats, jackets, pullovers, shirts, trousers, skirts, shawls, sashes for wear, scarves, handkerchiefs, ties, gloves.

Limitation of the list of goods and services: United States of America.

The subsequent designation concerns only class 16 and goods in classes 18 and 25 as follows: cl 18: leather or imitation leather products, namely wallets, change purses, key rings, handbags, briefcases, suitcases, umbrellas, covers for agendas, agendas, holders for credit cards, document wallets, cases,

boxes, portfolios. cl. 25: Clothing, hats, jackets, pullovers, shirts, trousers, skirts, shawls, sashes for wear, scarves, handkerchiefs, ties, gloves.

Declaration of intention to use the mark: United Kingdom, United States of America.

Date of subsequent designation: 23.10.2006

Date of notification: 10.05.2007

International registration concerned

572 660

Registration date: **June 6, 1991**

Date next payment due: **June 6, 2011**

CHOPARD INTERNATIONAL SA

Route de Promenthoux

CH-1197 Prangins

(Switzerland).

Legal nature of the holder (legal entity) and place of organization: Société anonyme, Suisse.

Name and address of the representative: INFOSUISSE, rue du Grenier 18, CH-2302 La Chaux-de-Fonds (Switzerland).

The Chopard logo, featuring the brand name 'Chopard' in a highly stylized, cursive script font.

Classification of figurative elements:

27.5.

List of goods and services:

- 9 Eyeglasses, sunglasses, eyeglass frames, eyeglass settings, eyeglasses lenses, eyeglass cases.
- 16 Ballpoint pens, pencil holders and fountain pens, desk pads, diary covers.
- 18 Leather or imitation leather products, namely wallets, purses, key rings, handbags, napkins, cases, cases not adapted to the products they are intended to contain.
- 25 Clothing, footwear and headgear, neckties, neckscarves and scarves.
- 34 Lighters for smokers and lighter holders.

Basic registration: Switzerland, 26.03.1991, 383 385.

Data relating to priority under the Paris Convention: Switzerland, 26.03.1991, 383 385 for some of the goods.

Language of the international application: French

Limitations



NOTIFICATION

LIN/2012/02

1 010 609 (Comos Industry Solutions). Siemens Aktiengesellschaft, 80333 München (Germany).

Joint stock-company, Germany.

Designations concerned: Japan.

Limitation of the list of goods and services:

List limited to:

42 Creation, development and design of computer programs and software, in particular for production, materials management, quality management, maintenance, project management and archiving; creation, development and design of computer programs and software, in particular for Web-based staff members, customers and partner portals, online shops and integration solutions; implementation, renting, up-dating and maintenance of computer programs and software; consultancy on the creation, design, development, use and application of computer programs and software; research in the fields of computer programs and software; Internet services, i.e. the conversion of data and computer programs (excluding physical changes); conversion of data from physical to electronic media; compression of data for electronic storage; encryption of data; software and EDP preparation, i.e. the preparation, up-dating, adaptation of programs for data processing, also by means of terminal-based services at the location where the services are rendered; services of an EDP programmer; storage of electronically stored data for third parties; takeover of electronically stored data for back-up purposes, for the purpose of virus checks and for checking purposes; online services, i.e. the renting and maintenance of storage locations to be used as Websites for third parties (hosting); renting of data processing systems and telecommunication devices; technical network planning; creation of interactive, electronic, user-oriented software; technical consultancy services and rendering expert opinions; technical consultancy in the field of the electronic media; design of the information and communication engineering structures of appliances, machines and devices; database and Internet investigation and searching for science and research; storage of data in computer databases.

Other classes remain unchanged.

Date of recordal in the International Register: 01.04.2011



Limitation in International Application (1)

- Rule 9(5)(d) “The international application shall contain a declaration by the Office of origin certifying... (vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic list or basic registration, as the case may be”
- Is the limitation part of the certification procedure?
- What should be the role of the Office of origin (OO)?
- Or is the responsibility with the applicant; he may have his reasons for why he wishes a particular limitation for specific designated Contracting Parties (DCPs)?

Limitation in International Application (2)

- What should be the role of the International Bureau?
- How extensive should the examination be by the International Bureau?
 - Rules 9(4)(a)(xiii), 12 and 13
- The role of the Office of a designated Contracting Party?
 - Determining the scope of protection
 - Rules 16 to 18 apply

Limitation in Subsequent Designation

- Rule 24(3)(a)(iv): where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services need to be indicated in the form MM4
- “Simultaneous limitations”: different limitations for different designated Contracting Parties may be presented in the same MM4 form

MM4: Who should do what?

- MM4 may be sent directly to the IB, meaning it is not mandatory to send it through the intermediary of the OO
- Who should be responsible for a “proper” limitation in MM4?
 - The holder - he may have his reasons for a particular wording
 - The OO may not even see the MM4
 - Examination by the IB?
 - Office of the designated Contracting Party who will need to determine scope of protection
- Where is value added in this process?

The Role of the IB (MM4)

- Legal basis is in Rule 24
- No reference to Rules 12 and 13
- Regarding examination, the IB is considering
 - Only checking to establish whether the class numbers in fact correspond to the numbers listed in the main list
 - Issue irregularity-notices where the class numbers are missing or do not correspond, or where the formal requirements are not met
 - Not examining as to whether the indications in the list represent a restriction or an extension, or examine the linguistic correctness or the classification of the indications

The Role of the Office of DCP (MM4)

- The Office of the designated Contracting Party (DCP) will examine the international registration in accordance with its national or regional legislation and may use available mechanisms
- The DCP will determine the scope of protection of the international registration in its territory
- The DCP may refuse protection of the mark if the limitation is exceeding the scope of protection as listed in the main list
 - Rules 16 to 18 apply

Request for Recording of Limitation (MM6)

- Rules 25 to 27
- Rule 25(1)(a)(ii): “... a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties”
- The limitation must be presented on the MM6 form
- MM6 form may be presented to the IB directly by the holder or by the Office of the CP of the holder
- One single form may be used to request the recording of one limitation for several IRs, **provided that** the holder is the same and the same limitation applies to all designated CPs or to the same designated CPs for each of the IRs concerned

MM6: Who should do what?

- Who should be responsible for a “proper” limitation in MM6?
 - The holder – he may have received a proposal for a text from a DCP who has issued a refusal
 - The OO may not even see the MM6
 - Examination by the IB? Legal basis is in Rules 25 to 27
 - Office of the DCP who will need to determine scope of protection
- Where is value added in this process?

Role of the IB (MM6)

- Regarding examination, the IB is considering to
 - Only checking the formal requirements (Rules 25 and 26)
 - Only checking to establish whether the class numbers in fact correspond to the numbers listed in the main list
 - Issue irregularity-notices where the class numbers are missing or do not correspond, or where the formal requirements are not met
 - Not examining as to whether the indications in the list represent a restriction or an extension, or examine the linguistic correctness or the classification of the indications

Role of the Office of DCP (MM6)

- The Office of the designated Contracting Party (DCP) will examine the IR in accordance with its national or regional legislation
- The DCP will determine the scope of protection of the international registration in its territory
- The DCP may declare that the limitation has no effect
 - Rule 27(5): time limit of 18 months
 - The IB will record such declaration and notify the holder/Office

Factors to Consider (1)

- Where could the responsibility best be placed – where will there be value added to the process?
 - The applicant/holder?
 - Should the OO certify the limitation in the international application?
 - Should the IB examine all the limitations and issue irregularities?
 - Should the responsibility be better left with the designated CPs as these have mechanism available (refusals and declarations that a limitation has no effect)?

Factors to Consider (2)

- One consistent practice for limitation?
- Should limitation be treated the same in the IB regardless of whether it is presented in the international application (MM1 to MM3), the subsequent designation (MM4) or as a request for recording in an international registration (MM6)?
- In line with current legal basis or amend the legal basis?