

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

Ninth Session
Geneva, July 4 to 8, 2011

DIVISION OF THE INTERNATIONAL REGISTRATION

Document prepared by the International Bureau

Introduction

1. At the fifth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) which took place in Geneva from May 5 to 9, 2008, the Representative of the *Association romande de propriété intellectuelle* (AROPI), referring to an informal paper made available to delegations, suggested that consideration be given by the Working Group to introducing into the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to, respectively, as “the Agreement”, “the Protocol”, and “the Common Regulations”) provisions for the division of international registrations¹. In his conclusions, the Chair of the Working Group indicated that the Working Group had taken note of the existence of the paper mentioned by the Representative of AROPI and encouraged member States to study that document².
2. At the seventh session of the Working Group, which took place in Geneva from July 7 to 10, 2009, the Delegation of Switzerland, in a paper entitled “Working Group on the Legal Development of the Madrid System for the International Registration of Marks: Contribution by Switzerland”³ (hereinafter referred to as “the contribution by Switzerland”),

¹ See document MM/LD/WG/5/8, paragraph 166.

² *Ibid.*, paragraph 174.

³ See document MM/LD/WG/7/3.

proposed that the suggestion by AROPI be included in the Agenda of that session, and elaborated upon the said suggestion. In his conclusions on the discussion of the contribution by Switzerland which took place at the seventh session of the Working Group⁴, the Chair noted that the Working Group had concluded that further discussions were needed and had been requested by a number of delegations. He further said that the Working Group had expressed its interest in the preparation by the International Bureau of a study which would examine the need for, and the impact and consequences of, the possible introduction of division into the procedures of the Madrid system, and which would also assess national practices on the matter⁵. The Working Group agreed that such a study should be conducted by the International Bureau in order to ascertain the impact and consequences of the possible introduction of a procedure which would permit the division of international registrations. The Working Group further indicated that such a study, the results of which would be presented to the Working Group in due course, should also examine the practices of Contracting Parties of the Madrid system in this regard⁶.

3. With a view to collecting relevant information for the examination of practices of Contracting Parties called for by the decision of the Working Group referred to in the preceding paragraph, the International Bureau addressed, on September 22, 2010, a questionnaire to the Offices of all members of the Madrid Union. A compilation of the replies to the questionnaire received by the International Bureau appears in the Annex to the present document. The findings that could be derived from the response to the questionnaire are analyzed in Part II of this document, following preliminary observations regarding the contribution by Switzerland (Part I). The consequences of a possible introduction of division of international registrations in the Madrid system will be addressed in Part III of the document, whereas Part IV will present possible alternatives to such division of international registrations, for the consideration by the Working Group.

I. PRELIMINARY OBSERVATIONS REGARDING THE CONTRIBUTION BY SWITZERLAND

The Basic Issue

4. In summary, the contribution by Switzerland stems from the observation that, whereas the legislation of most of the members of the Madrid Union provides for the possibility for applicants to divide their applications for trademark registration and, in certain cases, also for the possibility for holders of trademark registrations to divide their registrations, the possibility of dividing an international registration, either before or after it has acquired the effect of a national or regional registration in any given Contracting Party, is not provided for in the Madrid Agreement, the Madrid Protocol or the Common Regulations. As a result, an applicant who chooses the international route for securing protection for his mark cannot avail himself of a somewhat common feature of trademark laws which might have been available to him had he chosen the national or regional route instead of the international route⁷.

⁴ See document MM/LD/WG/7/5, paragraphs 125 to 143.

⁵ *Ibid.*, paragraph 144.

⁶ *Ibid.*, paragraph 145.

⁷ See, however, Part III, below.

5. As set out in the document MM/LD/WG/7/3, “modulable division” would be designed to overcome objections which may affect the international registration in one or more of the designated Contracting Parties (but not necessarily in all the designated Contracting Parties) and which may relate to different goods and services according to the designated Contracting Parties. The international registration would be divided in relation only to the Contracting Party or Parties to which the division is relevant and, in relation to each Contracting Party concerned, the division would relate to the goods or services in dispute in the Contracting Party.
6. Typically, an applicant is interested in dividing his application where an objection by the Office or an opposition filed against the registration of the mark affects only some of the goods and services in respect of which protection is sought. In such a situation, a division allows the undisputed part of the application to proceed to registration, while prosecution of the objection or opposition proceedings continues only with respect to the disputed part of the application.
7. Similarly, the possibility of dividing a registration may be available in jurisdictions where an opposition can be filed only after the mark has been registered (“post-registration” opposition system). Where the opposition affects some only of the goods and services covered by the registration, division of the registration will allow the holder to obtain immediately, in respect of the undisputed goods and services, a title of protection that he may need for the enforcement of his mark or for other business considerations.

Division Under the Trademark Law Treaty (TLT) and the Singapore Treaty on the Law of Trademarks (Singapore Treaty)

8. The situations contemplated in the two preceding paragraphs were indeed the primary considerations which led to the inclusion in the TLT (1994) of provisions regarding the division of applications for trademark registration and of trademark registrations⁸. Article 7 of the TLT makes it mandatory for parties to the Treaty to provide for the division of the *application* up to the (positive or negative) decision by the Office on the registration of the mark, including during any pre-registration opposition proceedings, and during any appeal proceedings against the decision of the Office on the registration of the mark. It further makes it mandatory for Contracting Parties whose legislation does not provide for pre-registration opposition to allow division of the *registration* during any post-registration opposition or administrative invalidation proceedings and during any appeal proceedings against a decision taken by the Office in the said post-registration opposition or administrative invalidation proceedings. Of course, Contracting Parties are free to allow division beyond situations where they are required by the Treaty. It will also be noted that, under paragraph 1(b) of Article 7, Contracting Parties are free to establish requirements for the division, e.g., the contents of the request for division and the payment of fees.
9. The text of Article 7 of the Singapore Treaty (2006) is the same as that of the TLT. At the end of 2010, 51 countries were bound by the TLT, or the Singapore Treaty, or both.

⁸ See document TLT/R/DC/5, paragraphs 7.01 to 7.03.

Partial Change in Ownership Under the Madrid System

10. Naturally, division of an application or of a registration may serve other purposes than those contemplated in paragraphs 6 and 7 above. In particular, division may be a prerequisite for or a consequence of the partial assignment or other transfer of the application or of the registration. Article 9^{ter} of the Madrid Agreement and Article 9 of the Madrid Protocol do provide for the partial assignment or other partial transfer of an international registration (at any time after its recording in the International Register) and, although the term “division” is not used, an international registration, a part or parts of which have been assigned or otherwise transferred, is in fact divided into two or more separate international registrations. Whether by analogy with a division or otherwise, and subject to Rule 27(4) of the Common Regulations under the Agreement and the Protocol⁹, each member of the Madrid Union gives effect to the *de facto* division of an international registration resulting from a partial change in ownership. It is thus understood that division, as a result of or in connection with a partial change in ownership, falls outside the scope of the study called for by the Working Group.
11. It is nevertheless useful to recall here how a partial change in ownership of an international registration – i.e., a change in ownership in respect of some only of the goods and services or some only of the designated Contracting Parties – is recorded by the International Bureau and how the separate international registrations resulting from a partial change in ownership are thereafter maintained.
12. Section 16 (Numbering Following Partial Change in Ownership) of the Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto (hereinafter referred to as “the Administrative Instructions”) provides for the procedure for the recording of partial changes in ownership under Rule 27(1) of the Common Regulations. Under the said section, any assigned or otherwise transferred part of the initial, or “parent”, international registration is cancelled from the parent international registration and recorded as a separate international registration. The latter separate international registration is assigned the number of the parent international registration together with a capital letter, in the alphabetical order of the English or French alphabet, starting from the letter A. Both the parent international registration and the separate international registration resulting from a partial change in ownership may be the subject of a subsequent partial change in ownership and, in both cases, the new international registration thus created will bear the number of the parent international registration together with a capital letter which will be the next available in the alphabetical order of the English or French alphabet.
13. As of the date of recording of the partial change in ownership in the International Register¹⁰, the international registration resulting from a partial change in ownership, while maintaining the international registration date of the parent international registration and any priority attached to the parent international registration, is an international registration in its own right. In particular, it will not be affected by any change affecting

⁹ Under Rule 27(4) of the Common Regulations, the Office of a designated Contracting Party which is notified by the International Bureau of a change in ownership affecting that Contracting Party may, on grounds provided for in its law, declare that the change in ownership has no effect in the said Contracting Party.

¹⁰ Subject to Rule 25(2)(c) of the Common Regulations, the date of receipt by the International Bureau of a request complying with the applicable requirements.

the parent international registration, whose date of recording is later than that of the date of recording of the partial change in ownership. It may itself be the subject of any of the recordings provided for in the Common Regulations, including subsequent designation, total or partial change in ownership, limitation of the list of goods and services, renunciation, cancellation, recording of licenses or of restrictions of the holder's right of disposal; and it will be subject to renewal independently of the parent international registration.

14. The Common Regulations (Rule 27(3)) also provide that, where the same person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change or partial changes in ownership, that person or entity may request that those international registrations be merged. In such case,
- if all or some of the transferred parts of the international registration are merged with the parent international registration, the resulting international registration will bear the number of the parent international registration (without a letter);
 - if all or some of the transferred parts of the international registration are merged amongst themselves and each of the assigned parts covers the same goods and services, the resulting international registration will bear the number of the parent international registration together with the capital letter used earlier in respect of the first of the merged assigned parts;
 - if all or some of the transferred parts of the international registration are merged amongst themselves, but the assigned parts do not cover the same goods and services, the resulting international registration will bear the number of the parent international registration together with the next capital letter (in the alphabetical order) not previously used in conjunction with the number of the international registration concerned.

II. ANALYSIS OF THE REPLIES TO THE QUESTIONNAIRE REGARDING PRACTICES OF MEMBERS OF THE MADRID UNION WITH RESPECT TO THE DIVISION OF TRADEMARK APPLICATIONS, TRADEMARK REGISTRATIONS AND, AS APPLICABLE, DESIGNATIONS UNDER THE MADRID AGREEMENT OR THE MADRID PROTOCOL

15. As mentioned above, the International Bureau addressed, in September 2010, a questionnaire to the Offices of all members of the Madrid Union. Since it is understood that division as a result of or in connection with a partial change in ownership falls beyond the scope of the present study (see Part I above), the questionnaire contemplated only division other than as a result of or in connection with a partial change in ownership.
16. The questionnaire was composed of three parts. The first part addressed the division of national or regional *applications* filed with the Offices of members of the Madrid Union. The second part addressed the division of national or regional *registrations* effected by the said Offices. Moreover, as it appeared that the law or practice of some members of the Madrid Union provided for the division of designations under the Agreement or the Protocol in the course of national proceedings other than the recording of a partial change in ownership of the international registration concerned, a third part of the draft questionnaire addressed this situation.

17. The questionnaire focused on what seems to be most relevant for the purposes of the study, namely, whether, when and in what circumstances, is division available (or not available) to the applicant for or holder of a registration. The availability of the possibility to merge back divisional applications or registrations with the “parent” application or registration was also addressed, as was the quantitative aspect of division.
18. On the other hand, it did not seem necessary to include questions on the effects of division since it is understood that they are essentially the same in all jurisdictions where division is available, namely, the divisional application maintains the filing date of the parent application, together with any applicable priority or seniority date, and any request for a recording in the Register or any recording entered in the Register in respect of the parent application or registration before division is requested equally applies to the divisional application or registration. Neither was it deemed necessary to address in the questionnaire purely formal requirements.
19. There were 54 Offices who responded to the questionnaire (i.e., a return rate of 65 per cent). The replies received by the International Bureau are reproduced in the Annex to the present document, in tabular form. The replies are reproduced as given, except that, consistent with the instructions given for the filling of the questionnaire, where a “NO” reply was given to the leading question of any of the three parts of the questionnaire (questions 1, 12 and 24), any reply to the following questions of the part concerned was disregarded. Comments given by Offices, as well as references to the applicable legislation, are included under the questions to which they relate. The compilation of the replies received is followed by a quantitative summary.
20. The replies to the questionnaire allow the following observations to be made and main conclusions to be drawn.

Division of National or Regional Applications

21. Of the 54 Offices who responded, 40 or 75 per cent of them indicated, in reply to question 1, that their legislation allowed the division of applications for trademark registration other than as a result of or in connection with a partial change in ownership of the application. Besides, eight of the countries whose Office did not respond to the questionnaire are bound by the TLT and are also expected to allow such division¹¹.
22. All the Offices who responded positively to question 1 indicated that their legislation allowed division of the application at any time between the filing date and completion of *ex officio* examination (question 2). Three Offices, however, indicated that division of the application during that period was possible only where the application met with an objection by the Office (question 2.1.1).
23. Questions 2.2 and 2.3 were of relevance to jurisdictions which allow division of the application and which provide for a pre-registration opposition procedure. It appears from the replies to question 2.3 that 60 per cent of the jurisdictions allow the division of the application during opposition proceedings¹². The Office of three of those jurisdictions

¹¹ It is however to be noted that five of the countries whose Office replied negatively to question 1 of the questionnaire are bound by the TLT and, in one case, also by the Singapore Treaty.

¹² One of the Offices concerned indicated that division was allowed upon motion granted by the body responsible for hearing and deciding on oppositions.

indicated in reply to question 2.2 that division is not allowed in the period during which oppositions may be filed, i.e., between the date of publication for opposition or other starting date of the period during which oppositions may be filed and the date of expiry of that period.

24. Over 80 per cent of the Offices who responded to question 2.4 indicated that their legislation allowed the division of the application in connection with an appeal or during appeal proceedings. It is to be noted, however, that seven Offices replied to question 2.4 in the negative, where four of them were either party to TLT or the Singapore Treaty, or both.
25. In reply to question 2.5, five Offices indicated that their legislation allowed division in connection with the filing of a statement of use – it is observed that the notion of statement of use seems to have been interpreted extensively by some of those Offices, as four of them who do not seem to require affidavits of use, replied in the affirmative to this question.
26. Regarding question 2.6 (Other), a number of Offices gave additional information which is reproduced in the Annex to the present document, which does not seem to call for any particular comment.
27. In question 3, Offices were invited to indicate whether division of the application could concern elements of the mark, other than the list of goods and services. Eight Offices replied in the affirmative. In general, those Offices indicated that, where the Office considered that the application contained more than one mark (or sign), including, as stated by one of those Offices, where the mark consisted of a word mark and its translation in one or more languages, or where the sign shown in the application was not deemed “uniform” by the Office, the applicant was invited to divide its application. One of the Offices who replied in the affirmative commented that, to the extent that a mark as used on some of the goods was not adequately represented by the original reproduction, an applicant might seek to divide such goods into a separate application and amend the reproduction accordingly in that separate application. The mark itself may not be amended if it would be a material change, but the reproduction may be changed to adequately depict the mark in relation to the goods concerned. That Office added that such cases most often occurred in the application for color(s) applied to the surface of the goods, trade dress, or other three-dimensional configuration marks.
28. To the question whether the application could be divided more than once (question 4), all Offices but two replied in the affirmative.
29. Regarding how the division of the goods and services should be spelt out in the request for division (question 5), about 50 per cent of the Offices indicated that the request had to specify both the goods and services to be included in the divisional (child) application and those that were to remain in the parent application; 25 per cent that the request had to specify only the goods and services that were to be included in the divisional application; and 25 per cent that the request had to specify either the goods and services to be included in the divisional application or those that were to remain in the parent application.

30. Under question 6, over 90 per cent of the Offices replied that the goods or services of the divisional application could not overlap with those remaining in the parent application. It is understood of course, as pointed out by one of those Offices, that, depending on the wording of the list of goods and services, there may be overlap in the scope of the two sets of specifications resulting from the division, even though the list of goods and services itself is split.
31. Question 7, like questions 2.2 and 2.3, was of relevance to jurisdictions which provide for a pre-registration opposition procedure. About 37 per cent of the Offices concerned indicated that, where the request for division of the application was made in connection with an opposition, they allowed any of the goods or services against which the opposition was directed to be included in the divisional application. The remaining Offices concerned indicated that they did not so allow.
32. In reply to question 8, all Offices but three indicated that a fee was charged for the division. One of the Offices who replied negatively, however, indicated in a comment that the application fee is charged for the new application resulting from the division. This, and another comment made in connection with question 8.1, suggests that question 8 may have given rise to different interpretations. As a matter of fact, in some jurisdictions, division gives rise to the payment of the application (or filing) fee for each additional application resulting from the division while in other jurisdictions a specific fee applies for the division; the latter may be the equivalent of the application fee and be payable in lieu of the application fee or it may be lower than the application fee, in which case the application fee may or may not be payable in addition to the specific division fee (e.g., where whole classes are divided out in a "pay per class" fee structure). The total of the fees payable for a division therefore may not only be lower than or equal to the application fee but also higher than the application fee.
33. The replies to question 9 show that a minority of jurisdictions provide for the subsequent merger of divisional applications with the parent application. Only seven Offices replied positively to question 9. All but one of those Offices charge a fee for the merger (question 10).
34. Under question 11, Offices were invited to indicate the number of requests for the division of an application for trademark registration (other than as a result of or in connection with a partial change in ownership of the application) that they had received in 2009. The figures given in reply to question 11 have been regrouped in brackets in the quantitative summary at the end of the Annex to the present document, where it can be seen that 33 per cent of the Offices replied that they had received no request, about 15 Offices (38 per cent) between one and 25 requests, two Offices between 26 and 150 requests, two Offices between 151 and 500 requests and two Offices over 1,000 requests (the maximum being about 2,850).
35. The foregoing suggests the following conclusions for the purposes of this study:
 - (a) A majority of members of the Madrid Union allow the division of applications for trademark registration other than as a result of or in connection with a partial change in ownership.
 - (b) Division of the application is generally allowed at any time between filing and completion of *ex officio* examination, except that, in some cases, division during that period is subject to the application meeting with objections by the Office.

- (c) In jurisdictions which provide for a pre-registration opposition procedure, division of the application is generally available during opposition proceedings. In several of those jurisdictions, division is not available in the period during which oppositions may be filed.
- (d) Division of the application is generally available in connection with or during appeal proceedings regarding the decision of the Office on the registration of the mark.
- (e) In several jurisdictions, division of the application may concern not only the list of goods and services but also the sign of which the mark consists.
- (f) In general, the application may be divided more than once.
- (g) The requirements regarding the manner in which the division of the goods and services must be spelt out in the request for division vary from one jurisdiction to the other, according to three possible patterns (see paragraph 29 above).
- (h) In general, goods or services remaining listed in the parent application may not be listed in the divisional (child) application.
- (i) Practices vary regarding the division of goods or services affected by an opposition. Most Offices appear to allow them to be included in the divisional (child) application, while some do not.
- (j) In general, division of the application is subject to the payment of fees.
- (k) Most of the jurisdictions concerned do not provide for the merger of divisional applications. When merger is available, a fee is generally charged.
- (l) Except in a few jurisdictions, little use is made of the possibility to divide the application (other than in connection with a partial change in ownership).

Division of National or Regional Registrations

- 36. Of the 54 Offices who responded to the questionnaire, 27 or 50 per cent indicated in reply to question 12, that their legislation allowed the division of registrations other than as a result of or in connection with a partial change in ownership of the registration. It will be noted that the legislation of a number of those Offices provides for a pre-registration opposition procedure and therefore allows division of the registration beyond the requirements of the TLT or the Singapore Treaty.
- 37. Over 80 per cent of the Offices who responded positively to question 12 indicated that their legislation allowed division of the registration at any time after registration (question 13.1). In the five jurisdictions for which the reply to question 13.1 was in the negative, division of the registration is available either during post-registration proceedings or during cancellation or other invalidation proceedings, or both.

38. Questions 13.2 and 13.3 were of relevance to jurisdictions which allow division of the registration and which provide for a post-registration opposition procedure. It appears from the replies to question 13.3 that all such jurisdictions allow the division of the registration during opposition proceedings. The Office of two of those jurisdictions indicated that division is not allowed in the period during which oppositions may be filed (question 13.2).
39. Of the 25 Offices who responded to question 13.4, 24 indicated that their legislation allowed the division of the registration during cancellation or other invalidation proceedings.
40. Of the 27 Offices who responded to question 13.5, 23 indicated that their legislation allowed the division of the registration in connection with an appeal or during appeal proceedings.
41. In reply to question 13.6 (Other), a number of Offices gave additional information, such as reference to their legislation. This additional information is reproduced in the Annex to the present document; it does not seem to call for any particular comment.
42. In question 14, Offices were invited to indicate whether division of the registration could concern elements of the mark other than the list of goods and services. One Office replied in the affirmative, but did not specify what those elements were.
43. To the question whether the application could be divided more than once (question 15), all Offices but one replied in the affirmative.
44. Regarding how the division of the goods and services should be spelt out in the request for division (question 16), about 50 per cent of the Offices indicated that the request had to specify both the goods and services to be included in the divisional (child) registration and those that were to remain in the parent registration; about 30 per cent of the Offices indicated that the request had to specify only the goods and services that were to be included in the divisional registration; and the remaining 20 per cent of the Offices indicated that the request had to specify either the goods and services to be included in the divisional (child) registration or those that were to remain in the parent registration.
45. Under question 17, 24 out of 27 Offices replied that the goods or services of the divisional application could not overlap with those remaining in the parent application.
46. Question 18, like questions 13.2 and 13.3, was of relevance to jurisdictions which provide for a post-registration opposition procedure. Over 60 per cent of the Offices concerned indicated that, where the request for division of the registration was made in connection with an opposition, they allowed goods or services against which the opposition was directed to be included in the divisional registration.
47. In reply to question 19, however, which did not concern only jurisdictions which provide for a post-registration opposition procedure, of the Offices who replied by "YES" or "NO" to the question whether, where the request for division of the registration was made in connection with cancellation or other invalidation proceedings, they allowed any of the goods or services against which the proceedings were directed to be included in the divisional registration, 30 per cent replied in the negative.
48. In response to question 20, over 90 per cent of the Offices concerned replied that a fee was charged for the division of the registration.

49. In response to question 21, only five Offices indicated that the divisional registration or registrations could be merged back with the parent registration. In all cases, a fee is charged for the merger (question 22).
50. Under question 23, Offices were invited to indicate the number of requests for the division of trademark registration (other than as a result of or in connection with a partial change in ownership of the registration) that they had received in 2009. The figures given in reply to question 23 have been regrouped in brackets in the quantitative summary at the end of the Annex to the present document, where it can be seen that 48 per cent of the Offices concerned had received no such request, about 30 per cent had received one to five requests, four had received six to 25 requests and one had received more than 25 requests (actually, 70).
51. The foregoing suggests the following conclusions for the purposes of this study:
- (a) A significant number of members of the Madrid Union allow the division of trademark registrations other than as a result of or in connection with a partial change in ownership. Consistent with the standard set by the TLT and the Singapore Treaty, this is in particular the case of members whose legislation provides for a post-registration opposition procedure, but it applies also to several members whose legislation provides for a pre-registration opposition procedure.
 - (b) In jurisdictions which provide for the division of the registration, such division is largely available at any time after registration.
 - (c) In jurisdictions which provide for a post-registration opposition procedure, division of the registration is generally available during opposition proceedings. In several of those jurisdictions, division is not available in the period during which oppositions may be filed.
 - (d) Division of the registration is generally available in connection with or during appeal proceedings regarding the decision of the Office on the registration of the mark.
 - (e) In general, division does not concern other elements of the registration than the list of goods and services.
 - (f) In general, the registration may be divided more than once.
 - (g) The requirements regarding the manner in which the division of the goods and services must be spelt out in the request for division vary from one jurisdiction to the other, according to three possible patterns (see paragraph 44 above).
 - (h) In general, goods or services remaining listed in the parent registration may not be listed in the divisional (child) registration.
 - (i) Practices vary regarding the division of goods or services affected by an opposition. Most Offices appear to allow them to be included in the divisional (child) registration while some do not. The same goes where the division of the registration occurs in connection with cancellation or other invalidation proceedings.
 - (j) In general, the division of the registration is subject to the payment of fees.

- (k) Most of the jurisdictions concerned do not provide for the merger of divisional registrations. When merger is available, a fee is charged.
- (l) Little use is made of the possibility to divide the registration (other than in connection with a partial change in ownership).

Division of a Designation Under the Madrid Agreement or the Madrid Protocol

52. To the question “Does the applicable law of your country/organization allow the division of a territorial extension (or “designation”) under Article 3ter of the Madrid Agreement or of the Madrid Protocol other than upon notification by the International Bureau of WIPO of a partial change in ownership of the international registration concerned?” (question 24), the Offices of just eight countries replied in the affirmative. Except for one of those countries, however, it does not seem that the division of a designation under the Agreement or the Protocol is the subject of any express provision in the national legislation of the countries concerned, but it rather seems that the possibility of such division results either from a general provision of the national legislation to the effect that an international registration is treated, before its (tacit or express) acceptance, as a national application for registration and, after its (tacit or express) acceptance, as a national registration, or from an interpretation of the national legislation to that effect.
53. In all of the eight countries referred to above, division may be requested by the holder of the international registration while the international registration has the same effect as an application for registration filed directly with the Office concerned (i.e., up to tacit or express acceptance of the mark, or up to final refusal) (question 25). Consistent with the regime applicable to national registrations, the Offices of three of the countries concerned indicated, in reply to question 26, that division was not available after the international registration has acquired the same effect as a registration effected by the Office (i.e., after tacit or express acceptance of the mark). In all eight jurisdictions, it appears that the regime applicable to the division of the designation is substantially the same, *mutatis mutandis*, as that applicable to the division of a national application for registration or, as the case may be, to a national registration (questions 25.1 and 26.1).
54. The International Bureau further enquired with the Offices of the eight countries referred to above as to whether, in practice, they had received any request for division of a territorial extension (or “designation”) under the Agreement or the Protocol and, if so, requested them to provide it with information on:
- (i) the number of requests for the division of a territorial extension that they had received (other than upon notification by the International Bureau of WIPO of a partial change in ownership of the international registration concerned);
 - (ii) whether the division was notified to the International Bureau and, if so, how;
 - (iii) how any refusal affecting a “divisional territorial extension” was notified to the International Bureau; and
 - (iv) where an international registration the territorial extension of which had been the subject of a division by the Office and any change to the international registration or the renewal thereof was recorded by the International Bureau and notified to the Office, whether such change or renewal was construed as applying to the divisional territorial extension or extensions as well as to the parent territorial extension.

55. As of the date of writing this document four replies to this additional enquiry were received. The Offices of three of the countries concerned (Estonia, Georgia and Kyrgyzstan) informed that they had not received any request for division of a territorial extension as referred to in the preceding paragraph. One Office (the United States Patent and Trademark Office (USPTO)) informed that 94 territorial extensions had been divided following such requests. It further informed that the Office waited until the final outcome of the parent and “child” or “children” applications to notify the International Bureau of the total or partial refusal or acceptance of the territorial extension. Finally, regarding item (iv) of the preceding paragraph, the USPTO further indicated that changes and renewals affecting the international registration were automatically recorded in each of the divisional territorial extensions (parent and child/children); to the extent that a change did not apply in respect of the goods, services or classes of goods and services of a divisional territorial extension, a note to the file was made by the responsible unit.

III. THE CONSEQUENCES OF A POSSIBLE INTRODUCTION OF DIVISION OF INTERNATIONAL REGISTRATIONS

Need for Division of the International Registration

56. As a preliminary observation, it should be noted that, as pointed out in Annex 1 of the contribution by Switzerland, there does not appear to be a need to provide for the division of international *applications*. This is because an international application as such has no effect in designated Contracting Parties until such time as it results in an international *registration*. At that time, the international registration will acquire, in each of the designated Contracting Parties and (normally) retroactively to the date on which the Office of origin received the international application, the effect of an application filed directly with the Office of that Contracting Party. Besides, as long as there are no irregularities in the international application, the mark should be registered by the International Bureau immediately upon receipt from the Office of origin. As a matter of fact, there is no provision in the Agreement, the Protocol or the Common Regulations for the recording of any change to an international application, such as a change in ownership, and there is no suggestion that there should be any such provision.
57. For division of the international registration, it is being understood that such division would have, in a designated Contracting Party,
- the same effect as the division of a national (or regional) application for trademark registration if made before the international registration has acquired registration effect in that Contracting Party, and
 - the same effect as the division of a national (or regional) trademark registration if made after the international registration has acquired registration effect in that Contracting Party.
58. As indicated earlier, division of the application for trademark registration appears to be particularly valuable where the application is met with objection or an opposition (in pre-registration opposition systems) affecting only part of the goods and services listed in the application. In such cases, division of the application allows the undisputed part of the application to proceed to registration without delay, and enables the holder of the resulting registration to obtain a title of protection that he may need for the enforcement of his trademark rights or for other business purposes.

59. The same applies, *mutatis mutandis*, to the division of trademark registrations in opposition proceedings in post-registration opposition systems or in cancellation proceedings. Here again, division of the registration enables the holder of the registration to obtain, for the undisputed part of its registration, an unencumbered title of protection which he may produce to enforcement authorities or business partners.
60. Examples of situations where an early or unencumbered title of protection may be required are given in Annex 2 of the contribution by Switzerland. They include:
- the requirement of evidence of a trademark registration for the obtaining of an authorization for the putting on the market of pharmaceutical or phytosanitary products or of certain foodstuff or food-related goods;
 - the assertion of trademark rights before judicial or administrative enforcement authorities, for the obtaining of injunctive or conservatory measures, seizure or surveillance by customs authorities and similar measures;
 - the granting of licenses or the conclusion of other contracts involving trademark rights;
 - operations of acquisition of equity participations, takeovers and mergers of companies where proper identification and valuation of intellectual property assets, including trademarks, may be of significant importance.
61. It has been underlined in the contribution by Switzerland, as well as in the discussion which took place during the seventh session of the Working Group that, because of the so-called “tacit acceptance” principle of the Madrid system¹³, division might not be as relevant in the international registration system as in national or regional systems, insofar as it could be deduced from a provisional refusal affecting only part of the goods and services listed in the international registration that the protection of the mark was accepted for the goods and services not affected by the provisional refusal. It should, however, be noted that no such deduction can be made before the expiry of the time limit for the notification of provisional refusals, i.e., 12 or 18 months from the date of notification of the international registration or of the subsequent designation, or more for those Contracting Parties having made a declaration under Article 5(2)(c) of the Protocol. Moreover, it was pointed out in the discussions during the seventh session of the Working Group that, whereas the “tacit acceptance” principle was well understood within the circle of trademark practitioners, this was not the case outside that circle and it must be conceded that an extract from the International Register may not be the type of unencumbered title of protection that health administrations, enforcement authorities or business circles would be looking for.
62. As can be seen in Part II, above and in the Annex to the present document, except in a few jurisdictions, division of the application for trademark registration or of the trademark registration (other than in connection with a change in ownership) is made very little use of. The number of divisions, however, is not to be compared, as certain replies to the questionnaire suggest, to the number of applications filed with or registrations made by an Office, but rather to the number of applications or registrations meeting with objections, opposition or cancellation proceedings affecting only part of the list of goods and services and which cannot easily and expeditiously be solved by an amendment of the said list, a limitation or, in *inter partes* proceedings, a settlement between the parties. The use made of division is, however, undeniably small, and one may be tempted to jump to the conclusion that division is of limited utility.

¹³ Article 5 of the Agreement and Article 5 of the Protocol.

Impact of the Possible Introduction of Division of International Registrations

63. For the users of the Madrid system, an introduction of division of the international registration would provide them with a facility for the management of their marks which is not currently available to them within the system.
64. As a procedure for the actual recording and notification of divisional international registrations before the International Bureau, the existing procedure for the recording of partial change in ownership may be followed (see Rules 25(2)(a)(vi) and 27(1) of the Common Regulations and Section 16 of the Administrative Instructions).
65. Nevertheless, division of the international registration as envisaged in the contribution from Switzerland may have a much larger impact on the workload of the International Bureau and have more consequences than the mere recordings of such. Even the procedure for recording of changes as set out in Rules 25 and 27 have already an impact on the International Bureau, with regard to an increasing workload and added complexity to requests. The requests are often involving not only one procedure but several, and increasingly often involving more than one international registration. There is an increasing risk of mistakes being made, both on the side of the person requesting changes to be recorded, as well as for the actual recording in the International Register. The manpower allocated for these tasks, or the necessity of allocating such resources, add to the administrative costs, which today is not nearly covered by the set fee.
66. By analogy with the divisional application at the national level, the request for division of an international registration would need to contain the number of the international registration to be divided, name and address of the applicant/holder, specifications of the goods and services to be included in the divisional international registration and those that are to remain in the parent international registration. This information is further also necessary for recordings in line with the abovementioned Rules 25 and 27.
67. The process of division of the international registration before the International Bureau may be compared to the process of filing an international application.
 - (a) The divisional application may have to undergo parts of the formal examination by the International Bureau, as with any new international application. In particular, the question of classification may increase the workload of the International Bureau, with the possibility of irregularities occurring; for example, if the lists of goods and services overlap, if they are too extensive or too broad in respect of the original list, if indications in the lists are not clear or are too vague, etc. (see Rules 12 and 13). There may be situations where the division will not be a clean separation between classes in the list of goods and services listed in the original international registration, but rather entail two completely new lists of goods and services, indicating examination for both lists. Another option could be to record the division in the International Bureau and leave the possible classification issues for the undertaking of the designated Contracting Parties where the division will be requested to have an effect. The designated Contracting Parties will then have to make sure that the necessary – and correct – information is recorded for the sake of the holder and possible third parties.

- (b) Whether the divisional international registration (child) is seen as new international application or merely as a fact to be recorded in the International Register, the new list(s) of goods and services emanating from the division will have to be translated into the trilingual regime (similarly to the situation of limitations today). This may increase the workload of the International Bureau and have an impact on pendency time as well.
- (c) The possible introduction of division of the international registration may affect the workflow and process management in the International Bureau, not only by the sheer number of transactions, but also in terms of efficiency, i.e., of the array of resources that would need to be made available regardless of the actual figures for requests for division. However, if many requests for division were to be submitted to the International Bureau, the consequences would have an impact on the general workload and use of resources in the International Bureau, the dependency time of actions to be undertaken by the International Bureau, and then, indirectly, also have an impact on the Contracting Parties and the users of the Madrid system.
- (d) Additional work in relation to division would also include IT (new computer programs, a new official form should be established by the International Bureau to be downloadable from the Internet, new official letters should also set out the terms and conditions of remedying possible irregularities, etc.).
- (e) The request for division would also raise the issue of fees. It seems clear that there would need to be a fee to cover the administrative costs for the handling of the request for division of the international registration before the International Bureau.

68. For the Offices of the Contracting Parties whose legislation provides for division, there may also be some consequences.

- (a) There may be an increase in terms of additional volume of work, since the designated Offices may have to undertake the classification as well as conducting examination of the divisional registration to ascertain whether the mark may be granted protection, or refused
- (b) According to the questionnaire, many Contracting Parties require a fee for requests for division, similar to the amount of a national or regional application fee. Would a fee for division of an international registration also be required by designated Contracting Parties, as a designated Office may have to examine the divisional registration with regard to substantive requirements for granting of protection?
- (c) For the members of the Madrid Union whose legislation does provide for the division of an application for trademark registration or of the trademark registration, introduction of division of an international registration should not entail a need to modify their existing legal framework. This, it is believed, is possible if the recording of a division of the international registration by the International Bureau is given no more (and no less) effect than the effect of a request for division of an application for trademark registration or of a trademark registration, as applicable, in the interested Contracting Parties' legal frameworks.

69. Introduction of division of international registrations should not entail new obligations for current or potential members of the Madrid Union whose legislation does not, as of the date of such introduction or, if later, as of the date of their joining the system, provide for the division of applications for trademark registration or of trademark registration. Division would simply have no effect in a designated Contracting Party whose legislation does not provide for division.
70. Yet, the introduction of division, in the abovementioned terms, would however result in an “uneven” harmonization of the Madrid system, as opposed to the recent developments achieved through the consensus principle like the repeal of the safeguard clause and the provisions of statements of grant of protection.

IV. DIVISION OF INTERNATIONAL REGISTRATIONS – OTHER OPTIONS

71. The mandate of the Working Group, as expressed during its seventh session, was to conduct a study in order to ascertain the impact and consequences of the possible introduction of a procedure which would permit the division of international registrations.
72. It may be pertinent in that general context to look also at other possible options that might serve the needs of the users of the Madrid system, apart from the introduction of a formal structure for the division of international registrations, with all the complexity that that would entail. In particular, it may be of interest to consider the possibility of a procedure that would take place, not at the level of the International Bureau, but rather at the level of the Offices of designated Contracting Parties. After all, it is at the level of the designated Contracting Parties that the need to have a division procedure in most cases will arise.
73. In particular, there may be merit in exploring the possibility of the introduction of a structured procedure, at the level of the Offices of Contracting Parties, which would allow for the division of designations, without impacting upon the integrity of the international registration, *per se*, or upon the operations of the International Bureau.
74. In this regard, it is worth recalling that the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as “the Geneva Act”) allows for division of a registration recorded under that Act, and a brief review of that procedure may be of assistance in the discussions of the Working Group.

Division of a Registration Under the Geneva Act¹⁴

75. There is a possibility of dividing an international industrial design registration at the level of the Office of a designated Contracting Party, and not at the level of the International Bureau, under the Geneva Act of the Hague system. Some Contracting Parties of the Geneva Act have in their law a special requirement of, so-called, unity of design. Where this requirement exists, two or more industrial designs included in the same application must conform to the same creative concept. When one of such Contracting Parties is designated in an international registration and the requirement of unity of design is considered by the Office in question as not having been fulfilled, assuming that the Contracting Party concerned has made the necessary declaration under Article 13(1) of the Geneva Act, the registration may be divided before the Office concerned, in order to

¹⁴ Article 13 of the Geneva Act.

overcome the ground for refusal based on lack of unity of design. The Office is entitled then to charge the holder of that registration an additional fee, outside of the fee structure of the Hague system. This additional fee will be specified by each Contracting Party concerned, which will collect it directly from the owner¹⁵.

76. Where an international registration has been divided before the Office of a designated Contracting Party following a notification of refusal based upon lack of unity of design, the Office must notify the International Bureau of that fact, together with the following additional particulars:
- the Office making the notification;
 - the number of the international registration concerned;
 - the numbers of the industrial designs which have been the subject of the division with the Office concerned; and
 - the resulting national or regional application numbers or registration numbers¹⁶.
77. The information furnished by the Office to the International Bureau is not actually recorded in the International Register.
78. Paragraph (2) of Article 13 of the Geneva Act speaks of an Office being enabled to refuse the effects of an international design registration “pending compliance” with the unity of design requirement. Thus, following division, the refusal would be withdrawn and, in essence, the designation of the Contracting Party concerned remains intact at the level of the international registration. This guarantees to the holder the continued enjoyment of the advantages of central management of the international registration in respect of all of the designations contained in the registration, notwithstanding the fact of division at the level of any given Contracting Party.
79. The division will take place in accordance with the national legislation of the Office concerned, and will not follow from the Geneva Act, nor from the Common Regulations under the Geneva Act, and the 1960 Act of the Hague Agreement.

Possible Division of a Designation Under the Madrid System

80. The questionnaire, whose results are analyzed in Part II of this document, revealed that eight Contracting Parties allow for the division of a designation under the Agreement or the Protocol (see paragraph 52, above).
81. Except with respect to one of the said Contracting Parties, however, there is no evidence that the possibility of such division has ever been used, or that a structured procedure is in place for the division of a designation. In the one Contracting Party (the United States of America) where a procedure is in place and where designations are actually divided, division of a designation does indeed offer a practical solution to international holders,

¹⁵ Guide to the International Registration of Industrial Designs Under the Hague Agreement, B.II.03.08-03.10.

¹⁶ Administrative Instructions for the Application of the Hague Agreement, Section 502.

since the United States Patent and Trademark Office (USPTO) issues to the holder of an international registration, whose designation of the United States has been divided, a certificate of registration upon acceptance of protection for the goods and services divided out in the divisional international registration.

82. A procedure of this nature would allow for a form of division that would take place only at the national or regional level, in accordance with national or regional legislation, and independently of the International Bureau. No amendments to the Common Regulations would be necessary for such a procedure to come into place. The designated Contracting Party would continue to be required to inform the International Bureau of its final decision in accordance with Rule 18ter(2).
83. On the other hand, if a holder were to find it necessary to divide several designations at the Office level, the procedure would necessarily imply multiple efforts by the holder, before each Office concerned, and that would probably result in an asymmetrical system, with some Offices accepting division, on terms that may differ from Office to Office, and others not accepting it, thus probably producing an unsatisfactory system for the users.

Statement of Partial Grant of Protection

84. The delegations will be aware of the introduction, as from January 1, 2011, of compulsory statements of grant of protection. Under paragraph (1) of new Rule 18ter, Offices are now obliged to issue statements of grant of protection where, before the expiry of the applicable refusal period, all procedures before an Office have been completed and there is no ground for the Office to refuse protection for the mark in question. This type of statement of grant of protection introduces a new feature into the Madrid system. It is intended to dilute one of the perceived deficiencies in the regime of so-called "tacit acceptance". Many Offices are now in a position to complete their examination processes reasonably speedily and the requirement for an Office to issue a statement of grant of protection in the circumstances above outlined means that the holder of the mark will not be required to await the elapsing of the time until the refusal period has expired. It has, of course, the parallel and substantial value that the holder will be in possession of a document emanating from the Office itself, in confirmation of the protection of the mark.
85. Prior to the introduction of this new provision, there had already existed a more informal regime of statements of grant of protection, under which a number of Offices voluntarily issued such statements, and not merely confined to the circumstances set down in new Rule 18ter(1).
86. It will be recalled that paragraph (2) of new Rule 18ter also introduced a feature that was less innovative, but still of substantial benefit to users of the Madrid system. In simple terms, prior to the introduction of this new provision, an Office that had notified a provisional refusal was, under (old) Rule 17(5) of the Common Regulations (entitled *Confirmation or Withdrawal of Provisional Refusal*) required to send to the International Bureau a statement indicating the eventual status of protection of the mark. This could amount to a total refusal, total protection, or partial protection. However, there did not exist such a formalized structure for the issuing by Offices of positive (total or partial) statements of grant of protection, as such, as now exists under paragraph (2) (and indeed paragraph (1), of Rule 18ter).

87. The issuing by an Office of a statement of partial grant of protection following the notification of a provisional refusal could be said to be akin to a division of a designation at the national or regional level. Evidently, however, the weakness of such a contention is that it will issue only after the Office has completed all its procedures.
88. The issuing of a document of this nature – i.e., a statement of partial grant of protection, as a means of dividing off the acceptable part of a Madrid filing and allowing the remaining part to be processed by the Office as normal, was the proposal made by the Delegation of the United Kingdom in an informal document circulated during the first session of the Working Group in 2005. However, the Delegation of the United Kingdom was suggesting the issuing of such a statement immediately following partial refusal, permitting “the acceptable part of the designation to be allowed to proceed to protection (unless opposed), whilst the objectionable element remains under objection.”
89. In the event, the Working Group was not disposed to delve further into the proposal of the Delegation of the United Kingdom at that time. However, the informal paper circulated by the Delegation of the United Kingdom preceded and perhaps could be said to have partly anticipated the eventual later discussions of the Working Group, which led to the revision of the Common Regulations and the introduction of new Rules *18bis* and *18ter*.
90. It is likely that the issuing now, by Offices, of statements of grant of protection (whether under Rule *18bis* or *18ter*) will probably address many of the concerns of the Representative of AROPI, in the context of granting of licenses, mergers and acquisitions, or confiscation of infringing works. However, the fact remains that there will still be the same constraint, in that such a statement will not issue until all the procedures before the Office have been completed (see Annex 2 of the Contribution by Switzerland, document MM/LD/WG/7/3).
91. Further in the context of the making available by Offices of information concerning the partial scope of protection of a mark, it is pertinent to mention also at this point the proposal set out in document MM/LD/WG/9/4 entitled “Proposals for the Simplification of the Madrid System”, regarding a proposal to amend Rule 17(2)(vi) of the Common Regulations (see paragraphs 51 and 52 of that document). If designated Contracting Parties were to be required to notify partial provisional refusals in a positive fashion, that is to say, indicating only the goods and services not affected by the provisional refusal, that may also be seen by users of the Madrid system as an early practical and useful, albeit still provisional, differentiation between the goods and services that have secured protection and those that have not, thus far.

V. RECAPITULATION

92. In order to give context to the discussions of the Working Group, it is recalled that, of the Offices (who provide for division at the national/regional level) that responded to the Questionnaire, 71 per cent replied that they had received between zero and 25 requests for division of an application in 2009 (paragraph 34, above). With regard to requests for division of a registration at the national/regional level, a total of 78 per cent responded that they had received between zero and five requests in the same period (paragraph 50, above).

93. It is noted in the contribution by Switzerland (document MM/LD/WG/7/3) that the Delegation of Switzerland stated that “[a]lthough free of charge, division is not used frequently (about 35 requests for division of an application, out of about 15,000 annual filings; a single case of division of a registration is currently recorded in the register).”
94. At this time, it could be said that the primary focus of the International Bureau, as indeed the Working Group, is to seek simplification of the procedures under the Madrid system, in order to make the system more efficient, flexible and user-friendly. The question is then whether establishing the possibility of division of international registrations, which would perhaps be used only rarely, would be supporting this primary focus, or perhaps merely adding to the complexity of the system as it stands.
95. It is notable that the Contribution by Switzerland (document MM/LD/WG/7/3, see Annex 2) in paragraph 8 stated that “[i]f the aim of the owner is to obtain, shortly after the provisional refusal, an official document confirming the grant of protection for the goods and/or services which are not subject to the provisional refusal, the division of the designation concerned between the goods and /or services provisionally refused and those accepted therefore appears to be too complex a measure, in view of the clarity of the principle stated above [the principle of tacit acceptance].”
96. The potential impact of the introduction of a procedure for the division of international registrations has been outlined above in paragraphs 63 to 70. In summary, there would be, *inter alia*, issues touching upon the possible re-examination of the divisional application, classification issues, translation of the divisional lists, consequential and inevitable impact upon the pendency times and the workflow and process management of the International Bureau, the need for additional IT facilities and, of course, the question of fees. That part of the document above also drew attention to certain implications for Offices and users of the Madrid system. Thus, it is undeniably a fact that the introduction of a procedure to allow for the division of international registrations would complicate an already complex, but working, system.
97. The Working Group may wish to give consideration to the exploration of other possible responses to the question of legal certainty that may be achieved through division, or by other means, in terms of responding to the needs of users in a somewhat less formal regime. Possible solutions in the longer term may include the following:
- (a) As noted by the Delegation of Switzerland in its Contribution (document MM/LD/WG/7/3), “[a]n alternative solution to this specific problem [“tacit acceptance”] could be that the office concerned, or the International Bureau, is bound, on request and possibly in return for payment of a fee, to issue a confirmation of the acceptance of these goods and/or services.”
 - (b) The introduction of the issuing by Offices, initially on a voluntary basis, of a form of statement of partial grant of protection where an international registration has met with a partial refusal. That is to say, the holder of the international registration would not be required to await the completion of all procedures before the issuing of a statement of partial grant of protection under new Rule 18*ter*. It is notable that the current compulsory regime of statements of grant of protection was preceded for many years by a more informal voluntary regime also. Additionally, if the proposal for amending Rule 17(2)(vi), referred to in paragraph 89 above, were to be adopted, the Offices of the Contracting Parties concerned will be issuing a partial provisional refusal in a positive fashion, which in reality will equal a partial statement of grant of protection.

- (c) A division of designations might take place before the Office of the designated Contracting Party having raised an objection to granting full protection, and not involving the International Bureau. There are presently 45 member States of the Madrid Union who are also members of TLT or the Singapore Treaty, and consequently, those Offices, in principle, allow for division of applications and registrations at the national level. These member States represent more than 67 per cent of the total designations¹⁷ through the Madrid system. It has been noted above how the USPTO operates a system of division at the national level, which seems to work satisfactorily for that Office and its users, and which does not have any implications for the International Bureau.

VI. CONCLUSION

98. While there would appear to be undeniable merit in the exploration of the possibility of the introduction of a procedure that would formally allow for division of international registrations, it is suggested that a primary concern of the Working Group should be the implications, for all parties concerned, if such a measure were to be adopted. This would imply giving consideration as to whether there is, at this present time, a real perceived need and demand for such a procedure within the framework of the Madrid system. It would also imply taking into account the current drive to improve the system, in the context of how it serves its users on a day to day basis, in terms of simplicity, transparency, speed and efficiency as well as expectations of those many States that are presently giving consideration to acceding to the system, and the extent to which those States may have misgivings arising from the introduction into the system of a procedure which may have wider-term complex implications.

99. *The Working Group is invited to:*

- (i) review this document; and*
- (ii) give its views on the possible introduction of a procedure allowing for the division of international registrations in the Madrid system, and on the possible alternatives discussed in this document.*

[Annex follows]

¹⁷ 67.23 per cent of the total designations in 2009.

SUMMARY OF THE REPLIES TO THE QUESTIONNAIRE REGARDING PRACTICES OF MEMBERS OF THE MADRID UNION WITH RESPECT TO THE DIVISION OF TRADEMARK APPLICATIONS, TRADEMARK REGISTRATIONS AND, AS APPLICABLE, DESIGNATIONS UNDER THE MADRID AGREEMENT OR THE MADRID PROTOCOL

Responding Contracting Parties	I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS	
	1. Does the applicable law of your country/organization allow the division of applications for trademark registration other than as a result of or in connection with a partial change in ownership of the application?	2. May such division be requested by the applicant:
		2.1. At any time between the filing date and the completion of <i>ex officio</i> examination?
Algeria	NO	...
Armenia	YES*	YES
Australia	YES*	YES
Azerbaijan	YES*	YES
Bahrain	NO	...
Belarus	YES*	YES
Benelux	YES*	YES
Bhutan	NO	...
Bosnia and Herzegovina	NO	...
Bulgaria	YES*	YES
China	NO	...
Croatia	YES*	YES
Cuba	YES*	YES
Czech Republic	YES*	YES
Denmark	YES*	YES
Estonia	YES*	YES
European Union	YES*	YES
Finland	YES*	YES
France	YES*	YES
Georgia	YES*	YES
Germany	YES*	YES
Hungary	YES*	YES
Iceland	NO	...
Ireland	NO	...
Israel	YES*	YES
Italy	YES*	YES
Japan	YES*	YES
Kyrgyzstan	YES*	YES

Responding Contracting Parties	I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS	
	1. Does the applicable law of your country/organization allow the division of applications for trademark registration other than as a result of or in connection with a partial change in ownership of the application?	2. May such division be requested by the applicant:
Latvia	YES*	YES
Liechtenstein	NO	...
Lithuania	YES*	YES
Madagascar	NO	...
Monaco	NO	...
Mongolia	YES	YES
Morocco	NO	...
Mozambique	NO*	...
Norway	YES*	YES
Poland	YES*	YES
Portugal	NO	...
Republic of Moldova	YES*	YES
Russian Federation	YES*	YES
Serbia	YES*	YES
Singapore	YES*	YES
Slovakia	YES*	YES
Slovenia	YES*	YES
Spain	YES*	YES
Sweden	YES*	YES
Switzerland	YES*	YES
Syrian Arab Republic	NO	...
The Former Yugoslav Republic of Macedonia	YES*	YES
Turkey	YES*	YES
Ukraine	YES*	YES
United States of America	YES*	YES
Zambia	YES*	YES

***Additional Comments**

I. QUESTION 1:

- a. ARMENIA: The law of the Republic of Armenia on trademarks. www.aipa.am.

- b. AUSTRALIA: Trade Marks Act 1995: Section 6, Definitions – "divisional application"; Section 45, Divisional Applications; Section 46, Rules relating to divisional applications: <http://www.comlaw.gov.au/ComLaw/Legislation/ActCompilation1.nsf/all/search/97EE03ABC8B36B6CCA2572AA0013E435>.
Part 12 of the IP Australia Trade Marks Examiners Manual: http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm.
- c. AZERBAIJAN: The law of the Republic of Azerbaijan about Trade Marks and Geographical Indications (Article 11).
- d. BELARUS: Article 8(7) of the Law of the Republic of Belarus "On Trademarks and Service Marks": During the examination of the application, the applicant shall have the right, until the decision thereon, to file a divisional application in respect of the same sign for a part of the goods listed in the initial application at the date of filing thereof with the Patent Authority. The divisional application shall preserve the date of filing of the initial application and the date of priority of the trademark concerned by that application.
- e. BENELUX: It is not excluded so it is allowed. Such a request however is treated as a partial change in ownership. This is for administrative / IT related reasons.
- f. BULGARIA: - Article 32(2) and Article 36(4) of the National Law on Trademarks and Geographical Indications; - Article 18(2) and (3) of the Regulations on the Drafting, Filing and Examination of Trademark and Geographical Indication Registration Applications: http://www1.bpo.bg/index.php?option=com_content&task=view&id=75&Itemid=122&lang=en.
- g. CROATIA: Article 33 of the Trademark Act (OG 173/03, 76/07 and 30/09) and Article 15 of the ordinance on Trademarks (06 117/07); English version available at: www.dziv.hr/en.
- h. CUBA: Decree Law No. 203 on Trademarks and Other Distinctive Signs, Articles 36 and 37 and Resolution No. 63/2000 Regulations under Decree Law No. 203 on Trademarks and Other Distinctive Signs, Article 29. Available at: www.ocpi.cu, Existing legislation.
- i. CZECH REPUBLIC: Act. No. 441/2003 Coll., on Trademarks (§27/5-6). Decree No. 97/2004 Coll. Implementing the Act on Trademarks (§5): <http://www.upv.cz/en/legislation/national.html>.
- j. DENMARK: Order on Application and registration, etc. of Trade Marks and Collective marks No. 364 of 21 May 2008, section 15. The Order is not available in English.
- k. ESTONIA: Estonian Trade Mark Act: § 44. Division and restriction of applications: (1) an applicant may divide the application into two or more applications by dividing between these applications the goods and services. The application may be divided until a decision to register or refuse the registration of a trade mark is made or until the end of proceedings concerning an appeal filed with regard to such decisions or proceedings concerning revocation applications with regard to such decisions. A corresponding request shall be submitted together with information concerning payment of the state fee.
- l. EUROPEAN UNION: Article 44 Community Trade Mark Regulation (CTMR). Rule 13 a CTM Implementing Regulation (CTMIR): <http://oami.europa.eu/ows/rw/pages/CTM/legalReferences/regulations.en.do>.
- m. FINLAND: Trademarks Act, Section 17a: Trademarks Decree, Section 9a; Section 2, paragraph 1, item 10; Section 22, paragraph 1, items 12 and 13: www.prh.fi/en/tavaramerkki/lainsaadanto.html.
- n. FRANCE: Articles R 712.27 and R 712.28 of the Intellectual Property Code.
- o. GEORGIA: Georgian Trademark Law; Chapter 1, Article 12(3): www.sakpatenti.org/ge/trademarks/trademarklaw.
- p. GERMANY: § 40 *Markengesetz*, § 35 *Markenverordnung*. An English version is currently not available: www.dpma.de.

- q. HUNGARY: Act XI of 1997 on the Protection of Trademarks and Geographical Indications (hereinafter: TM Act), Article 63 §:
http://mszh.hu/English/jogforras/Trademark_Act_EN.pdf.
- r. ISRAEL: Section 17 of the Trademarks Ordinance.
- s. ITALY: Code of Industrial property rights: Legislative Decree No. 30/ 2005 and subsequent amendments (Legislative Decree No. 140/2006, Legislative Decree No. 131/2010). Regulation of execution: Ministerial Decree No. 33/2010. There are no English/French/Spanish versions of those texts.
- t. JAPAN: Article 10 of the Japanese Trademark Act:
<http://www.japaneselawtranslation.go.jp/law/detail/?ft=1&re=01&dn=1&co=01&ky=%E5%95%86%E6%A8%99%E6%B3%95&page=3>.
- u. KYRGYZSTAN: Implementing Regulations.
- v. LATVIA: Law on Trademarks and Indications of Geographical Origin of Latvia; Article 15 “Division of an Application”:
<http://www.lrpv.lv/index.php?lang=EN&id=26&topic=103>.
- w. LITHUANIA: The division of a national application should be recorded in accordance with Article 7 of the Trade Mark Law Treaty.
- x. MOZAMBIQUE: www.ipi.gov.mz/rubrique.php?id_rubrique=18 and www.wipo.int/wipolex/en/profile.jsp?code=MZ.
- y. NORWAY: For applications: Trademarks Regulations Section 18, Division of applications: An applicant may request that an application filed previously be divided into several independent applications.
Website for the Norwegian Trademarks Act:
http://www.patentstyret.no/en/english/Legal_texts/Trademarks_Act/
Website for the Norwegian Trademarks Regulations:
http://www.patentstyret.no/en/english/Legal_texts/Trademark_Regulations/#2
- z. POLAND: art. 140.2 – Industrial Property Law of 30 June 2000 (the consolidated text of the act): www.uprp.pl/English/Law.
- aa. REPUBLIC OF MOLDOVA: Art. 45, Law No. 38-XVI of February 29, 2008 on the Protection of Trademarks: [http://www.agepi.md/pdf/lege/lege-protectie-marcif/en-38-XVI-29_02_2008\].pdf](http://www.agepi.md/pdf/lege/lege-protectie-marcif/en-38-XVI-29_02_2008].pdf).
- bb. RUSSIAN FEDERATION: Article 1502, Civil Code of The Russian Federation (See XXVII of the present Annex “Additional Information from the Office of the Russian Federation”).
- cc. SERBIA: Article 25 of The Law on Trademarks available in English on web site: www.zis.gov.rs.
- dd. SINGAPORE: Section 5A of Trade Marks Act, Rule 17 of Trade Marks Rules. Form TM8 Request to divide an application for registration. Please refer out links at: <http://www.ipos.gov.sg/topNav/form/Trade+Marks+Forms.htm> and <http://www.ipos.gov.sg/topNav/leg/>.
- ee. SLOVAKIA: Act No. 506/2009 Coll. on Trade Marks, Section 27 (3). “An applicant shall be entitled up to entry of a sign into the Register to divide the application containing in the list more than one kind of goods or services into separate applications. The right of priority and the filing date from the application as filed shall remain unchanged also for divisional applications, if they are related to goods and services from the application as filed”. (http://www.upv.sk/swift_data/source/pdf/legislation/pravo_09506.pdf).
- ff. SLOVENIA: Industrial Property Act (Official Gazette RS, No 51/2006) Article 97: (4) any application listing goods or services belonging to two or more classes of the Nice Classification may, during the registration procedure, including administrative litigation, be divided, upon the request of the applicant, into several applications. Each application shall preserve the date of filing of the initial application and, if priority is claimed, the date of priority.

- gg. SPAIN: Article 24, Law No. 7 of December 2001 on Trademarks. Article 46 of the Implementing Regulations thereunder: www.oepm.es (Legislation).
- hh. SWEDEN: Swedish trademark regulation (No 648 of 1960), Article 7, paragraph 4.
- ii. SWITZERLAND: Article 17(a) of the Swiss Federal Law on the Protection of Trademarks: http://www.admin.ch/ch/fr/232_11/a17a.html and Trademark Division Examination Guidelines, IPI: http://www.ige.ch/fileadmin/user_ipload/Juristische_Infos/f/directives_marques/directives_marques01012010.pdf, Part I, Paragraph 3.3.
- jj. THE FORMER REPUBLIC OF MACEDONIA: Article 185 of the Law on Industrial Property of the Republic of Macedonia, Article 12 of the Regulations on Marks. www.ippo.gov.mk.
- kk. TURKEY: The implementing regulations under the decree-law No. 556 pertaining to the protection of trademarks – Article 15.
- ll. UKRAINE: Law of Ukraine on the Protection of Rights to Marks for Goods and Services. Article 111. Division of an Application: 1. The applicant has the right to divide the application into two or more applications (divisional applications) by dividing the goods and services listed in the application so that each of the divisional applications shall not contain the goods and services that relate to the goods and services listed in the other divisional applications. 2. The division of the application shall be accomplished by filing the applicant's request on making relevant changes in the application and the divisional application (applications), provided that the respective fees are paid for filing the request and the application. 3. The date of filing the divisional application shall be the same as the date of filing the divided application. The priority date of the divisional application shall be the same as the priority date of the divided application if there is a reason for that. http://sdip.gov.ua/en/laws_special_3.
- mm. UNITED STATES OF AMERICA: 37 C.F.R.2.87 (available at: <http://www.uspto.gov/trademarks/law/tmlaw.pdf>). Trademark Manual of Examining Procedure (TMEP) Section 1110 et seq, available at: http://tess2.uspto.gov/tmdb/tmep/1100.htm#_T1110.
- nn. ZAMBIA: Section 39 and Regulations 85 and 102 of the Trade Marks Act Cap. 401 of the Laws of Zambia.

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS							
2. May such division be requested by the applicant:							
Responding Contracting Parties	2.1.1. If your reply to question 2.1 is "yes", is division during the period between the filing date and the completion of <i>ex officio</i> examination possible only if the application meets with an objection by the Office?	2.2. During the opposition period?	2.3. During opposition proceedings?	2.4. In connection with the filing of an appeal or during appeal proceedings?	2.5. In connection with the filing of a statement of use?	2.6. Other (please specify):	
Algeria	
Armenia	NO	YES	YES	YES	N/A	...	
Australia	NO	YES	YES	NO	N/A	...	
Azerbaijan	NO	NO	NO	NO	NO	...	
Bahrain	
Belarus	NO	NO	NO	NO	N/A	...	
Benelux	NO	YES	YES	YES	N/A	...	
Bhutan	

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS						
2. May such division be requested by the applicant:						
Responding Contracting Parties	2.1.1. If your reply to question 2.1 is "yes", is division during the period between the filing date and the completion of <i>ex officio</i> examination possible only if the application meets with an objection by the Office?	2.2. During the opposition period?	2.3. During opposition proceedings?	2.4. In connection with the filing of an appeal or during appeal proceedings?	2.5. In connection with the filing of a statement of use?	2.6. Other (please specify):
Bosnia and Herzegovina
Bulgaria	*
China
Croatia	NO	YES	YES	YES	YES	*
Cuba	NO	YES	YES	YES	YES	...
Czech Republic	NO	YES	YES	YES	N/A	...
Denmark	NO	YES	YES	YES	N/A	...
Estonia	NO	NO	YES	YES	N/A	...
European Union	NO	NO	YES	YES	N/A	...
Finland	NO	N/A	N/A	YES	N/A	...
France	NO	YES	YES	YES	N/A	*
Georgia	NO	YES	YES	YES	N/A	...
Germany	NO	N/A	N/A	YES	N/A	...
Hungary	NO	YES	YES	YES	YES	...
Iceland
Ireland
Israel	NO	YES	YES	YES	N/A	...
Italy	NO	N/A	N/A	YES	YES	...
Japan	NO	N/A*	N/A*	YES	N/A	...
Kyrgyzstan	YES	NO	NO	NO	NO	N/A
Latvia	NO	N/A	N/A	YES	N/A	*
Liechtenstein
Lithuania	NO	N/A	N/A	YES	N/A	...
Madagascar
Monaco
Mongolia	NO	NO	NO	NO	N/A	...
Morocco
Mozambique
Norway	NO	YES	YES*	YES	N/A	...
Poland	NO	N/A	N/A	YES	N/A	...
Portugal
Republic of Moldova	NO	YES	YES*	YES*	N/A	...
Russian Federation	NO	N/A	N/A	YES	N/A	...
Serbia	NO	N/A	N/A	NO	N/A	*
Singapore	NO	YES	YES	YES	N/A	*
Slovakia	NO	YES	YES	YES	N/A	...
Slovenia	NO	YES	YES	YES	N/A	...
Spain	YES	YES	YES	YES	N/A	...
Sweden	NO	N/A	N/A	YES	N/A	...
Switzerland	NO	N/A*	N/A*	YES	N/A	...

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS						
2. May such division be requested by the applicant:						
Responding Contracting Parties	2.1.1. If your reply to question 2.1 is "yes", is division during the period between the filing date and the completion of <i>ex officio</i> examination possible only if the application meets with an objection by the Office?	2.2. During the opposition period?	2.3. During opposition proceedings?	2.4. In connection with the filing of an appeal or during appeal proceedings?	2.5. In connection with the filing of a statement of use?	2.6. Other (please specify):
Syrian Arab Republic
The Former Yugoslav Republic of Macedonia	NO	YES	YES	YES	N/A	...
Turkey	NO	YES	YES	YES	N/A	..
Ukraine
United States of America	NO	NO	YES*	YES	YES	*
Zambia	YES	YES	YES	NO	N/A	...

***Additional Comments**

II. QUESTION 2.2

- a. JAPAN: Since opposition proceedings in Japan are given after the application being registered, division of registrations, not division of applications, is available during the opposition proceedings. See replies in 13.3 and 13.4.
- b. SWITZERLAND: The opposition procedure in Switzerland starts after the registration of the mark.

III. QUESTION 2.3

- a. JAPAN: Since opposition proceedings in Japan are given after the application being registered, division of registrations, not division of applications, is available during the opposition proceedings. See replies in 13.3 and 13.4.
- b. NORWAY: In Norway we have post-registration opposition proceedings.
- c. SWITZERLAND: The opposition procedure in Switzerland starts after the registration of the mark.
- d. REPUBLIC OF MOLDOVA: Art. 45, Law No. 38-XVI of February 29, 2008 on the Protection of Trademarks: (2) a request for division shall not be permitted: (a) if an objection is lodged against an original application and a request for a division separates the goods and/or services to which the objection relates – prior to a final decision being taken on the objection.
- e. UNITED STATES OF AMERICA: Upon motion granted by Trademark Trial and Appeal Board (TTAB).

IV. QUESTION 2.4

- a. REPUBLIC OF MOLDOVA: Art. 45, Law No. 38-XVI of February 29, 2008 on the Protection of Trademarks (2). A request for division shall not be permitted: (a) if an objection is lodged against an original application, and a request for a division separates the goods and/or services to which the objection relates – prior to a final decision being taken on the objection.

V. QUESTION 2.6

- a. BULGARIA: At any time between the date of filing and the end of the formal examination (where the application request is subject to an objection by the Office).
- b. CROATIA: At any time.
- c. FRANCE: Where there is a partial assignment of part of the goods or services.
- d. LATVIA: After the information about the trademark has been made ready for registration and publication, a request for division of an application cannot be withdrawn (Article 15(4), Law on Trademarks and Indications of Geographical Origin of Latvia).
- e. SERBIA: Initial application may, at the request of the applicant, be separated into two or more applications, at any time before the trademark is entered into the Register of Trademarks, by dividing the list of products and/or services. The Law on Trademarks in Republic of Serbia doesn't prescribe opposition proceeding or filing statement of use.
- f. SINGAPORE: At any time before registration.
- g. UNITED STATES OF AMERICA: Any time between the filing of a statement of use and the date the USPTO approves the mark for registration – 37 C.F.R. §2.87(c) (available at: <http://www.uspto.gov/trademarks/law/tmlaw.pdf>) TMEP §1110.03 (http://tess2.uspto.gov/tmdb/tmep/1100.htm#_T111003).

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS						
Responding Contracting Parties	3. May the division concern elements of the mark other than the list of goods and services?	4. May an application be divided more than once?	5. Must the request for division specify:			
			5.1. Either (a) the goods and/or services that are to be part of the divisional application or (b) the goods and/or services that are to remain in the "parent" application?	5.2. Both (a) and (b)?	5.3. Only (a)?	5.4. Only (b)?
Algeria
Armenia	NO	YES	YES	...
Australia	NO	YES	...	YES
Azerbaijan	NO	YES	YES	YES
Bahrain
Belarus	YES	...
Benelux	NO	YES	YES
Bhutan
Bosnia and Herzegovina
Bulgaria	YES*	NO
China
Croatia	NO	YES	...	YES
Cuba	NO	YES	YES	...

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS						
Responding Contracting Parties	3. May the division concern elements of the mark other than the list of goods and services?	4. May an application be divided more than once?	5. Must the request for division specify:			
			5.1. Either (a) the goods and/or services that are to be part of the divisional application or (b) the goods and/or services that are to remain in the "parent" application?	5.2. Both (a) and (b)?	5.3. Only (a)?	5.4. Only (b)?
Czech Republic	NO	YES	YES
Denmark	NO	YES	..	YES
Estonia	NO	YES	..	YES
European Union	NO	YES	..	YES
Finland	NO	YES	..	YES
France	NO	YES	YES	..
Georgia	YES	YES
Germany	NO	YES	YES	..
Hungary	YES*	YES	YES
Iceland
Ireland
Israel	NO	YES	..	YES
Italy	YES*	YES	..	YES
Japan	NO	YES	..	YES
Kyrgyzstan	YES	YES	YES	..	YES	..
Latvia	YES*	YES	YES
Liechtenstein
Lithuania	NO	YES	..	YES
Madagascar
Monaco
Mongolia	NO	YES
Morocco
Mozambique
Norway	NO	YES	..	YES
Poland	NO	YES	..	YES
Portugal
Republic of Moldova	YES*	YES	YES	..
Russian Federation	NO	YES	YES	..
Serbia	NO	YES	..	YES
Singapore	NO	YES	..	YES
Slovakia	NO	YES	..	YES
Slovenia	NO	YES	..	YES
Spain	NO	YES	..	YES
Sweden	NO	YES	YES
Switzerland	NO	YES	YES
Syrian Arab Republic

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS						
Responding Contracting Parties	3. May the division concern elements of the mark other than the list of goods and services?	4. May an application be divided more than once?	5. Must the request for division specify:			
			5.1. Either (a) the goods and/or services that are to be part of the divisional application or (b) the goods and/or services that are to remain in the "parent" application?	5.2. Both (a) and (b)?	5.3. Only (a)?	5.4. Only (b)?
The Former Yugoslav Republic of Macedonia	NO	YES	YES	...
Turkey	NO	YES	YES
Ukraine	NO	NO	...	YES
United States of America	YES*	YES	YES	
Zambia	NO*	YES	...	YES

***Additional Comments**

VI. QUESTION 3

- a. BULGARIA: An application should only apply to one trademark. Where the application does not meet this requirement, it must be divided.
- b. HUNGARY: The division may concern the sign itself if it is not deemed uniform by the Office (i.e., the applicant seeks protection for more than one sign in one application).
- c. ITALY: If the application contains more than one sign, the Office shall invite the applicant to choose only one trademark, within a given time limit. The remaining trademarks can be applied with separate applications, keeping the original filing date.
- d. LATVIA: For example, if the application obviously contains more than one trademark.
- e. REPUBLIC OF MOLDOVA: Division of verbal signs translated into two or more languages. Reg.59.2 Regulations.
- f. UNITED STATES OF AMERICA: To the extent a mark as used on some of the goods is not adequately represented by the original reproduction, an applicant may seek to divide such goods into a separate application and amend the reproduction accordingly. The mark itself may not be amended if it would be a material change, but the reproduction may be changed to adequately depict the mark in relation to the goods. Such cases most often occur in the application for color(s) applied to the surface of the goods, trade dress, or other three-dimensional configuration marks.
- g. ZAMBIA: The division in applications is limited to separation of application due to Classifications of goods or services based on the Nice classification.

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS						
Responding Contracting Parties	6. May the goods and/or services of the divisional application overlap with those remaining in the "parent" application?	7. Where the request for division of the application is made in connection with an opposition, may any of the goods and/or services against which the opposition is directed be included in the divisional application?	8. Is a fee charged for the division?	8.1. If the reply is yes, is that fee:		
				8.1.1. The same as the application fee?	8.1.2. Lower than the application fee?	
Algeria	
Armenia	NO	YES	YES	...	YES	
Australia	NO	YES	YES	YES	...	
Azerbaijan	NO	...	NO	
Bahrain	
Belarus	NO	N/A	YES	YES	...	
Benelux	NO	YES	YES	...	YES	
Bhutan	
Bosnia and Herzegovina	
Bulgaria	YES	...	YES	YES	...	
China	
Croatia	NO	N/A	YES	...	YES	
Cuba	NO	YES	YES	...	YES	
Czech Republic	NO	YES	YES	YES	...	
Denmark	NO	YES	YES	...	YES	
Estonia	NO	YES	YES	YES	...	
European Union	NO	NO	YES	...	YES	
Finland	NO	N/A	YES	YES	...	
France	NO	NO	YES	YES	...	
Georgia	NO	NO	YES	...	YES	
Germany	NO	N/A	YES	YES	...	
Hungary	NO	YES/NO*	YES	YES	...	
Iceland	
Ireland	
Israel	NO	NO	YES	...	YES	
Italy	NO	N/A	YES	YES	...	
Japan	NO	N/A*	YES	YES	...	
Kyrgyzstan	YES	N/A	YES	...	YES	
Latvia	NO	N/A	YES	YES	...	
Liechtenstein	
Lithuania	NO	N/A	YES	YES	...	
Madagascar	
Monaco	
Mongolia	...	N/A	YES	YES	...	
Morocco	
Mozambique	

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS					
Responding Contracting Parties	6. May the goods and/or services of the divisional application overlap with those remaining in the "parent" application?	7. Where the request for division of the application is made in connection with an opposition, may any of the goods and/or services against which the opposition is directed be included in the divisional application?	8. Is a fee charged for the division?	8.1. If the reply is yes, is that fee:	
				8.1.1. The same as the application fee?	8.1.2. Lower than the application fee?
Norway	NO	YES	YES	YES	...
Poland	NO	N/A	YES	...	YES
Portugal
Republic of Moldova	NO	N/A	YES	YES	...
Russian Federation	NO	N/A	YES	...	YES
Serbia	NO	N/A	YES	YES	...
Singapore	NO*	YES	YES	...	YES
Slovakia	NO	YES	YES	YES	...
Slovenia	NO	NO	NO*
Spain	NO	N/A	YES	...	YES
Sweden	NO	YES	YES	YES	...
Switzerland	NO	N/A*	NO
Syrian Arab Republic
The Former Yugoslav Republic of Macedonia	NO	YES	YES	YES	...
Turkey	NO	NO	YES		...
Ukraine	NO	N/A	YES	YES	...
United States of America	NO	YES	YES	...	YES*
Zambia	YES	YES	YES	YES	...

***Additional Comments**

VII. QUESTION 6

- a. SINGAPORE: NO, but depending on the wordings of the specifications, there may be potential for overlap in the specifications.

VIII. QUESTION 7

- a. HUNGARY: YES (until 2010.12.31). NO (from 2011.01.01).
b. JAPAN: Japan adopts post-registration opposition system.

- c. SWITZERLAND: The opposition procedure in Switzerland starts after the registration of the mark.

IX. QUESTION 8

- a. SLOVENIA: NO, however the application fee is charged for the “new”.

X. QUESTION 8.1.2

- a. UNITED STATES OF AMERICA: However, if an application is divided within a single class, a new application fee for each class of goods/services divided plus a divisional fee is required.

Responding Contracting Parties	I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS		
	9. May the divisional application or applications be subsequently merged back with the “parent” application at the request of the applicant?	10. Is a fee charged for the merger?	11. How many requests for the division of an application for trademark registration (other than as a result of or in connection with a partial change in ownership of the application) did your Office receive in 2009?
Algeria	...	::	...
Armenia	NO	::	1
Australia	YES	N/A	421*
Azerbaijan	NO	::	...
Bahrain	...	::	...
Belarus	NO	::	2009-1/2010-3
Benelux	NO	N/A	0
Bhutan	...	::	...
Bosnia and Herzegovina	...	::	...
Bulgaria	NO	::	NO INFO*
China	...	::	...
Croatia	NO	N/A	0
Cuba	YES	YES	0
Czech Republic	NO	::	16
Denmark	NO	N/A*	0
Estonia	NO	::	4*
European Union	NO	::	70*
Finland	NO	::	0
France	NO	::	5*
Georgia	YES	YES	0
Germany	NO	::	12
Hungary	NO	NO	0
Iceland	...	::	...

I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS			
Responding Contracting Parties	9. May the divisional application or applications be subsequently merged back with the "parent" application at the request of the applicant?	10. Is a fee charged for the merger?	11. How many requests for the division of an application for trademark registration (other than as a result of or in connection with a partial change in ownership of the application) did your Office receive in 2009?
Ireland
Israel	YES	YES	0*
Italy	NO	NO	0*
Japan	NO	...	1049*
Kyrgyzstan	YES	YES	N/A
Latvia	YES*	YES	SOME*
Liechtenstein
Lithuania	NO	...	0
Madagascar
Monaco
Mongolia	NO	...	NO INFO
Morocco
Mozambique
Norway	YES	YES	4 IN 2009
Poland	NO	NO	NO STATS
Portugal
Republic of Moldova	N/A	N/A	0
Russian Federation	NO	...	ABOUT 190
Serbia	N/A	NO	1
Singapore	NO	N/A	32
Slovakia	NO	...	4
Slovenia	NO	...	0
Spain	NO	...	6 (2009)
Sweden	NO	...	2
Switzerland	NO	...	9 (01.01.2010-08.10.2010)
Syrian Arab Republic
The Former Yugoslav Republic of Macedonia	NO	NO	0
Turkey	NO	...	3
Ukraine	NO	NO	1
United States of America	NO	N/A	2,860 (2008-09). 2,834 (2009-10)*
Zambia	NO	N/A	3

Additional Comments*XI. QUESTION 9**

- a. LATVIA: Theoretically.

XII. QUESTION 10

- a. DENMARK: Merger is not allowed in a national application or registration.

XIII. QUESTION 11

- a. AUSTRALIA: In 2009, IP Australia received 421 divisional filings, out of 56,951 filings in total.
- b. BULGARIA: The Office does not keep data on the quantity of requests for division of trademark registration applications.
- c. ESTONIA: Four divisions of the applications (without change in ownership).
- d. EUROPEAN UNION: Around 70 in total (Division of CTM applications or CTM registrations).
- e. FRANCE: Since its implementation by a Decree of February 25, 2004, there have been five requests for applications to be divided.
- f. ISRAEL: None. This section had come into force only on September 1, 2010.
- g. ITALY: No one application for division has been received at the Office, in 2009.
- h. JAPAN: The Japan Patent Office received 1049 requests for the division of an application in 2009.
- i. LATVIA: Exact data are not available, however some have been made.
- j. UNITED STATES OF AMERICA: Fiscal Year 2009 (Oct. 2008 – Sept. 2009) – 2,860. Fiscal Year 2010 (Oct. 2009 – Sept. 2010) – 2,834.

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS							
Responding Contracting Parties	12. Does the applicable law of your country/organization allow the division of trademark registrations other than as a result of or in connection with a partial change in ownership of the registration?	13. May such division be requested by the holder of the registration:					
		13.1. at any time after registration?	13.2. during the opposition period?	13.3. during opposition proceedings?	13.4. during cancellation or other invalidation proceedings?	13.5. in connection with the filing of an appeal or during appeal proceedings?	13.6. Other (Please specify):
Algeria	NO
Armenia	YES*	YES	YES	YES	..	YES	..
Australia	NO
Azerbaijan	NO
Bahrain	NO
Belarus	YES*	YES	YES	YES	YES	YES	..
Benelux	YES*	YES	YES	YES	YES	YES	..
Bhutan	NO
Bosnia and Herzegovina	NO
Bulgaria	NO
China	NO

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS							
Responding Contracting Parties	12. Does the applicable law of your country/organization allow the division of trademark registrations other than as a result of or in connection with a partial change in ownership of the registration?	13. May such division be requested by the holder of the registration:					
		13.1. at any time after registration?	13.2. during the opposition period?	13.3. during opposition proceedings?	13.4. during cancellation or other invalidation proceedings?	13.5. in connection with the filing of an appeal or during appeal proceedings?	13.6. Other (Please specify):
Croatia	YES*	YES	YES	YES	YES	YES	*
Cuba	YES*	YES	YES	YES	YES	YES	..
Czech Republic	NO
Denmark	YES*	YES	YES	YES	YES	YES	..
Estonia	YES*	YES	N/A	YES	YES	YES	..
European Union	YES*	YES	N/A	N/A	YES	YES	..
Finland	YES*	YES	YES	YES	YES	YES	..
France	YES*	NO	N/A	N/A	YES	YES	*
Georgia	NO*
Germany	YES*	NO	NO	YES	YES	YES	...
Hungary	YES*	YES	YES	N/A	YES	YES	...
Iceland	NO
Ireland	NO
Israel	NO
Italy	NO
Japan	YES*	YES	YES	YES	YES	YES	...
Kyrgyzstan	YES*	YES	YES	YES	YES	YES	N/A
Latvia	YES*	NO	NO	YES	YES	YES	...
Liechtenstein	NO
Lithuania	YES*	YES	NO	YES	YES	YES	*
Madagascar	NO
Monaco	NO
Mongolia	NO
Morocco	NO
Mozambique	NO
Norway	YES*	YES	YES	YES	YES	YES	...
Poland	YES*	NO	YES	YES	YES	NO	...
Portugal	NO
Republic of Moldova	YES*	YES	YES	YES	NO	NO	...
Russian Federation	YES*	NO	N/A	N/A	YES	NO	...
Serbia	YES*	YES	N/A	N/A	YES	NO	*
Singapore	NO
Slovakia	NO
Slovenia	NO

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS							
Responding Contracting Parties	12. Does the applicable law of your country/organization allow the division of trademark registrations other than as a result of or in connection with a partial change in ownership of the registration?	13. May such division be requested by the holder of the registration:					
		13.1. at any time after registration?	13.2. during the opposition period?	13.3. during opposition proceedings?	13.4. during cancellation or other invalidation proceedings?	13.5. in connection with the filing of an appeal or during appeal proceedings?	13.6. Other (Please specify):
Spain	YES*	YES	NO	NO	...	YES	..
Sweden	YES*	YES	YES	YES	YES	YES	..
Switzerland	YES*	YES	YES	YES	YES	YES	..
Syrian Arab Republic	YES*	YES	YES	YES	YES	YES	..
The Former Yugoslav Republic of Macedonia	YES*	YES	N/A	N/A	YES	YES	..
Turkey	NO
Ukraine	NO
United States of America	NO
Zambia	YES*	YES	YES	YES	YES	YES	*

***Additional Comments**

XIV. QUESTION 12

- a. ARMENIA: The law of the Republic of Armenia on trademarks. www.aipa.am.
- b. BELARUS: Article 14(4) of the Law of the Republic of Belarus "On trademarks and Service Marks": the registration of the trademark may be divided at the owner's request by distributing the goods for which the trademark is registered.
- c. BENELUX: See the answer concerning applications.
- d. CROATIA: Article 33 of the Trademark Act (06 173/03, 76/07 and 30/09) and Article 15 of the Ordinance on Trademarks (06 117/07); available in English at www.dziv.hr/en.
- e. CUBA: Decree Law No. 203 on Trademarks and Other Distinctive Signs, Articles 36 and 37 and Resolution No. 63/2000 Regulations under Decree Law No. 203 on Trademarks and Other Distinctive Signs, Article 29. Available at: www.ocpi.cu, Existing legislation.
- f. DENMARK: Order on Application and registration, etc. of Trade Marks and Collective Marks No. 364 of 21 May 2008, Section 15. The Order is not available in English.
- g. ESTONIA: Estonian Trade Mark Act: § 20. Division of registration: The holder of a trade mark may divide the registration into two or more registrations and divide the goods and services between these registrations. The division of a registration enters into force on the date of entry of the corresponding amendment in the register.

- h. EUROPEAN UNION: Article 49 CTMR and Rule 25a CTMIR:
<http://oami.europa.eu/ows/rw/pages/CTM/legalReferences/regulations.en.do>.
- i. FINLAND: Trademarks Act, Section 17a, paragraph 2: Trademarks Decree Section 9a; Section 2, paragraph 1, item 10; Section 3 paragraph 3.
- j. FRANCE: Article R712.27 of the Intellectual Property Code.
- k. GEORGIA: Georgian Trademark Law, Chapter 1, Article 12(3); Chapter VI, Article 39 (1). www.sakpaqteni.org.ge/trademarks/trademarklaw.
- l. GERMANY: § 46 Markengesetz, § 36 Markenverordnung. An English version is currently not available www.dpma.de.
- m. HUNGARY: TM Act Articles 68-70.
http://mszh.hu/English/jogforras/Trademark_Act_EN.pdf.
- n. JAPAN: Article 24 of the Japanese Trademark Act
<http://www.japaneselawtranslation.go.jp/law/detail/?ft=1&re=01&dn=1&co=01&ky=%E5%95%86%E6%A8%99%E6%B3%95&page=3>.
- o. KYRGYZSTAN: Trademark Law
- p. LATVIA: Law on Trademarks and Indications of Geographical Origin of Latvia; Article 20 “Division of a Registration” (see <http://www.lrv.lv/index.php?lang=EN&id=26&topic=103>).
- q. LITHUANIA: The division of a national registration should be recorded in accordance with Article 7 of the Trade Mark Law Treaty.
- r. NORWAY: For registrations: Trademarks Regulations, Section 20, § 20. Division of registrations - A proprietor may request that the Norwegian Industrial Property Office divide a registration into several registrations. Website for the Norwegian Trademarks Act: http://www.patentstyret.no/en/english/Legal_texts/Trademarks_Act/.
Website for the Norwegian Trademarks Regulations:
http://www.patentstyret.no/en/english/Legal_texts/Trademark_Regulations/#2.
- s. POLAND: Art. 7.2 of Singapore Treaty on the Law of Trademarks of 27 March 2006.
http://wipo.int/wipolex/en/wipo_treaties/details.jsp?treaty_id=30.
- t. REPUBLIC OF MOLDOVA: Art. 18, Law No. 38-XVI of February 29, 2008, on the Protection of Trademarks [http://www.agepi.md/pdf/lege/lege-protectie-marci\[en-38-XVI-29_02_2008\].pdf](http://www.agepi.md/pdf/lege/lege-protectie-marci[en-38-XVI-29_02_2008].pdf).
- u. RUSSIAN FEDERATION: Article 1505, Civil Code of The Russian Federation (See XXVII of the present Annex “Additional Information from the Office of the Russian Federation”).
- v. SERBIA: Article 47 of The Law on Trademarks available in English on web site: www.zis.gov.rs.
- w. SPAIN: Article 23 of the 2001 Law on Trademarks and Article 46 of the Implementing Regulations. www.oepm.es (Legislation).
- x. SWEEDEN: Swedish Trademark Regulation (No 648 of 1960), Article 13, paragraph 3.
- y. SWITZERLAND: Article 17(a) of the Swiss Federal law on the Protection of Trademarks: http://www.admin.ch/ch/fr/232_11/a17a.html and Trademark Examination Guidelines, IPI: http://www.ige.ch/fileadmin/user_ipload/Juristische_Infos/f/directives_marques/directives_marques01012010.pdf, Part I, Paragraph 3.3.
- z. SYRIAN ARAB REPUBLIC: www.dcipsy.com, open the Law No. 8, section 7 / Article 47.
- aa. THE FORMER YUGOSLAV REPUBLIC OF MACEDONIA: Article 205 of the Law on Industrial Property of the Republic of Macedonia, Article 22 of the Regulations on Marks. www.ippo.gov.mk.
- bb. ZAMBIA: Section 41 and Regulations 6, 8, 26 and 78 of the Trade Marks Act Cap. 401 of the Laws of Zambia.

XV. QUESTION 13.6

- a. CROATIA: At any time.
- b. FRANCE: Article L712.27 refers to the procedures for appeal against the decision to register a mark.
- c. LITHUANIA: Goods and services, against which the opposition is filed or invalidation proceedings have already been started, should not be included in the divisional application.
- d. SERBIA: Initial registration may be divided at any time, at the request of the holder of trademark, into two or more registrations by separating the list of products and/or services. The Law on Trademarks in Republic of Serbia doesn't prescribe opposition proceeding.
- e. ZAMBIA: The division of a registration may also arise as a result of an assignment, breaking up of a merger, or recordal of a license agreement.

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS							
Responding Contracting Parties	14. May the division concern elements of the mark other than the list of goods and services?	15. May a registration be divided more than once?	16. Must the request for division specify:				17. May the goods and/or services of the divisional registration overlap with those remaining in the "parent" registration?
			16.1. Either (a) the goods and/or services that are to be part of the divisional registration or (b) the goods and/or services that are to remain in the "parent" registration?	16.2. Both (a) and (b)?	16.3. Only (a)?	16.4. Only (b)?	
Algeria
Armenia	NO	NO	YES	...	NO
Australia
Azerbaijan
Bahrain
Belarus	NO	YES	...	YES	NO
Benelux	NO	YES	YES	NO
Bhutan
Bosnia and Herzegovina
Bulgaria
China
Croatia	NO	YES	...	YES	NO
Cuba	NO	YES	YES	...	NO
Czech Republic
Denmark	NO	YES	...	YES	NO
Estonia	NO	YES	...	YES	NO
European Union	NO	YES	...	YES	NO

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS							
Responding Contracting Parties	14. May the division concern elements of the mark other than the list of goods and services?	15. May a registration be divided more than once?	16. Must the request for division specify:				17. May the goods and/or services of the divisional registration overlap with those remaining in the "parent" registration?
			16.1. Either (a) the goods and/or services that are to be part of the divisional registration or (b) the goods and/or services that are to remain in the "parent" registration?	16.2. Both (a) and (b)?	16.3. Only (a)?	16.4. Only (b)?	
Finland	NO	YES	...	YES	NO
France	NO	YES	YES	...	NO
Georgia
Germany	NO	YES	YES	...	NO
Hungary	NO	YES	YES	NO
Iceland
Ireland
Israel
Italy
Japan	NO	YES	YES	...	NO
Kyrgyzstan	YES	YES	YES	...	YES
Latvia	NO	YES	YES	NO
Liechtenstein
Lithuania	NO	YES	...	YES	NO
Madagascar
Monaco
Mongolia
Morocco
Mozambique
Norway	NO	YES	...	YES	NO
Poland	NO	YES	...	YES	NO
Portugal
Republic of Moldova	NO	YES	YES	...	NO
Russian Federation	NO	YES	YES	...	NO
Serbia	NO	YES	...	YES	NO
Singapore
Slovakia
Slovenia
Spain	NO	YES	...	YES	NO
Sweden	NO	YES	YES	NO
Switzerland	NO	YES	YES	NO
Syrian Arab Republic	NO	YES	...	YES	YES

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS							
Responding Contracting Parties	14. May the division concern elements of the mark other than the list of goods and services?	15. May a registration be divided more than once?	16. Must the request for division specify:				17. May the goods and/or services of the divisional registration overlap with those remaining in the "parent" registration?
			16.1. Either (a) the goods and/or services that are to be part of the divisional registration or (b) the goods and/or services that are to remain in the "parent" registration?	16.2. Both (a) and (b)?	16.3. Only (a)?	16.4. Only (b)?	
The Former Yugoslav Republic of Macedonia	NO	YES	YES	...	NO
Turkey
Ukraine
United States of America
Zambia	*	YES		YES	YES

***Additional Comments**

XVI. QUESTION 14

- a. ZAMBIA: The division is limited to goods or services.

XVII. QUESTION 16

- a. SINGAPORE: N/A.

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS				
Responding Contracting Parties	18. Where the request for division of the registration is made in connection with an opposition, may any of the goods and/or services against which the opposition is directed be included in the divisional registration?	19. Where the request for division of the registration is made in connection with cancellation or other invalidation proceedings, may any of the goods and/or services against which the proceedings are directed be included in the divisional registration?	20. Is a fee charged for the division?	21. May the divisional registration or registrations be subsequently merged back with the "parent" registration at the request of the holder?
Algeria
Armenia	YES	N/A	YES	NO
Australia
Azerbaijan
Bahrain
Belarus	YES	YES	YES	NO
Benelux	YES	YES	YES	NO
Bhutan
Bosnia and Herzegovina
Bulgaria
China
Croatia	N/A	N/A	YES	NO
Cuba	YES	YES	YES	YES
Czech Republic
Denmark	YES	YES	YES	NO
Estonia	YES	YES	YES	NO
European Union	N/A	NO	YES	NO
Finland	YES	YES	YES	NO
France	N/A	NO	YES	NO
Georgia
Germany	YES	YES	YES	NO
Hungary	N/A*	YES	YES	NO
Iceland
Ireland
Israel
Italy
Japan	YES	YES	YES	NO
Kyrgyzstan	NO	NO	YES	YES
Latvia	NO	NO	YES	YES*
Liechtenstein
Lithuania	NO	NO	YES	NO
Madagascar
Monaco
Mongolia
Morocco
Mozambique

II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS				
Responding Contracting Parties	18. Where the request for division of the registration is made in connection with an opposition, may any of the goods and/or services against which the opposition is directed be included in the divisional registration?	19. Where the request for division of the registration is made in connection with cancellation or other invalidation proceedings, may any of the goods and/or services against which the proceedings are directed be included in the divisional registration?	20. Is a fee charged for the division?	21. May the divisional registration or registrations be subsequently merged back with the "parent" registration at the request of the holder?
Norway	YES	YES	YES	YES
Poland	YES	YES	NO	NO
Portugal
Republic of Moldova	NO	NO	YES	N/A
Russian Federation	N/A	YES	YES	NO
Serbia	N/A	N/A	YES	N/A
Singapore
Slovakia
Slovenia
Spain	N/A	N/A	YES	NO
Sweden	YES	YES	YES	NO
Switzerland	YES*	YES	NO	NO
Syrian Arab Republic	YES	NO	YES	YES
The Former Yugoslav Republic of Macedonia	YES	YES	YES	NO
Turkey
Ukraine
United States of America
Zambia	YES	YES	YES	NO

***Additional Comments**

XVIII. QUESTION 18

- a. HUNGARY: See our answer under point 7.
- b. SWITZERLAND: The opposition proceedings against both divided trademarks should continue in such a case; no known case to date. There is therefore no established practice in the matter.

XIX. QUESTION 21

- a. LATVIA: Theoretically (for example, applicant can withdraw the request for division).

Responding Contracting Parties	II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS		III. DIVISION OF A DESIGNATION UNDER THE MADRID AGREEMENT OR THE MADRID PROTOCOL
	22. Is a fee charged for the merger?	23. How many requests for the division of a registration (other than as a result of or in connection with a partial change in ownership of the registration) did your Office receive in 2009?	24. Does the applicable law of your country/organization allow the division of a territorial extension (or "designation") under Article 3 ^{ter} of the Madrid Agreement or of the Madrid Protocol other than upon notification by the International Bureau of WIPO of a partial change in ownership of the international registration concerned?
Algeria	NO
Armenia	NO	1	NO
Australia	NO
Azerbaijan	NO
Bahrain	NO
Belarus	NO
Benelux	N/A	0	NO*
Bhutan	NO
Bosnia and Herzegovina	NO
Bulgaria	NO
China	NO
Croatia	N/A	1	NO
Cuba	YES	0	YES*
Czech Republic	YES*
Denmark	N/A*	14	NO
Estonia	...	4*	YES*
European Union	...	70	NO
Finland	...	0	NO
France	...	0	NO
Georgia	YES*
Germany	...	16	NO
Hungary	...	0	NO
Iceland	NO
Ireland	NO
Israel	NO
Italy
Japan	...	3*	NO

Responding Contracting Parties	II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS		III. DIVISION OF A DESIGNATION UNDER THE MADRID AGREEMENT OR THE MADRID PROTOCOL
	22. Is a fee charged for the merger?	23. How many requests for the division of a registration (other than as a result of or in connection with a partial change in ownership of the registration) did your Office receive in 2009?	24. Does the applicable law of your country/organization allow the division of a territorial extension (or "designation") under Article 3 ^{ter} of the Madrid Agreement or of the Madrid Protocol other than upon notification by the International Bureau of WIPO of a partial change in ownership of the international registration concerned?
Kyrgyzstan	YES	N/A	YES*
Latvia	YES	0	NO
Liechtenstein	NO
Lithuania	...	0	NO
Madagascar	NO
Monaco	NO
Mongolia	NO
Morocco	NO
Mozambique	NO
Norway	YES	*	NO
Poland	NO	0	NO
Portugal	NO
Republic of Moldova	N/A	0	YES*
Russian Federation	...	LESS THAN 5	NO
Serbia	NO	1	NO
Singapore	NO
Slovakia
Slovenia	NO
Spain	NO
Sweden	...	1	NO
Switzerland	...	0	NO
Syrian Arab Republic	YES	23	NO
The Former Yugoslav Republic of Macedonia	N/A	0	N/A
Turkey	NO
Ukraine	NO
United States of America	...	0*	YES*
Zambia	N/A	7	YES*

***Additional Comments**

XX. QUESTION 22

- a. DENMARK: Merger is not allowed in a national application or registration.

XXI. QUESTION 23

- a. ESTONIA: Four divisions of the registrations (followed by the change of ownership of the divided part).
- b. JAPAN: The Japan Patent Office received three requests for the division of a registration in 2009.
- c. NORWAY: It was not possible to divide registrations in Norway until the new Trademarks Act which is in force as from 1 July 2010.
- d. UNITED STATES OF AMERICA: Zero – only permitted in cases of partial change of ownership.

XXII. QUESTION 24

- a. BENELUX: Only through the Office of origin.
- b. CUBA: Decree Law No. 203 on Trademarks and other Distinctive Signs. Articles 36 and 37 and Resolution No. 63/2000, Regulations under Decree Law No. 203 on Trademarks and Other Distinctive Signs, Article 29. Available at: www.ocpi.cu, Existing legislation.
- c. CZECH REPUBLIC: However, we have never received such a request. Act. No. 441/2003 Coll., on Trademarks (§27/5-7). Decree No. 97/2004 Coll. Implementing the Act on Trademarks (§5). <http://www.upv.cz/en/legislation/national.html>.
- d. ESTONIA: Estonian Trade Mark Act: § 69. Effect of international registration: (1) Legal protection arising from an international registration valid in Estonia is equal to legal protection arising from a national registration and the rights and obligations arising from an internationally registered trade mark are equal to those arising from a nationally registered trade mark.
- e. GEORGIA: Georgian Trademark Law; Chapter 1, Article 12(3); Chapter VI; Article 39 (1). www.sakpaqteni.org.ge/trademarks/trademark-law.
- f. KYRGYZSTAN: Implementing regulations.
- g. REPUBLIC OF MOLDOVA: Art. 18, 45, 74 Law No. 38-XVI of February 29, 2008, on the Protection of Trademarks: [http://www.agepi.md/pdf/lege/lege-protectie-marci\[en-38-XVI-29_02_2008\].pdf](http://www.agepi.md/pdf/lege/lege-protectie-marci[en-38-XVI-29_02_2008].pdf).
- h. UNITED STATES OF AMERICA: 37 C.F.R.2.87 for requests prior to grant of protection (available at <http://www.uspto.gov/trademarks/law/tmlaw.pdf>) TMEP §1110.11 (available at: http://tess2.uspto.gov/tmdb/tmep/1100.htm#_T111011).
- i. ZAMBIA: Sections 73(1), 39, 41 and Regulations 6, 8, 26, 78, 85 and 102 of the Trade Marks Act Cap. 401 of the laws of Zambia as it relates to the Paris Convention.

III. DIVISION OF A DESIGNATION UNDER THE MADRID AGREEMENT OR THE MADRID PROTOCOL				
Responding Contracting Parties	25. May such division be requested by the holder of the international registration while the international registration has the same effect as an application for registration filed directly with your Office (i.e., up to tacit or express acceptance of the mark, or up to final refusal)?	25.1. If your answer to question 25 is "yes", is the regime applicable to the division of the designation substantially the same, <i>mutatis mutandis</i> , as that applicable to the division of an application for registration filed directly with your Office?	26. May such division be requested by the holder of the international registration after the international registration has acquired the same effect as a registration effected by your Office (i.e., after tacit or express acceptance of the mark)?	26.1. If your answer to question 26 is "yes", is the regime applicable to the division of the designation substantially the same, <i>mutatis mutandis</i> , as that applicable to the division of a registration effected by your Office?
Algeria
Armenia
Australia
Azerbaijan
Bahrain
Belarus
Benelux
Bhutan
Bosnia and Herzegovina
Bulgaria
China
Croatia
Cuba	YES	YES	YES	YES
Czech Republic	YES	YES	NO	...
Denmark
Estonia	YES	NO*	YES	NO*
European Union
Finland
France
Georgia	YES	YES	NO	...
Germany
Hungary
Iceland
Ireland
Israel
Italy
Japan
Kyrgyzstan	YES	YES	YES	YES
Latvia

III. DIVISION OF A DESIGNATION UNDER THE MADRID AGREEMENT OR THE MADRID PROTOCOL				
Responding Contracting Parties	25. May such division be requested by the holder of the international registration while the international registration has the same effect as an application for registration filed directly with your Office (i.e., up to tacit or express acceptance of the mark, or up to final refusal)?	25.1. If your answer to question 25 is "yes", is the regime applicable to the division of the designation substantially the same, <i>mutatis mutandis</i> , as that applicable to the division of an application for registration filed directly with your Office?	26. May such division be requested by the holder of the international registration after the international registration has acquired the same effect as a registration effected by your Office (i.e., after tacit or express acceptance of the mark)?	26.1. If your answer to question 26 is "yes", is the regime applicable to the division of the designation substantially the same, <i>mutatis mutandis</i> , as that applicable to the division of a registration effected by your Office?
Liechtenstein
Lithuania
Madagascar
Monaco
Mongolia
Morocco
Mozambique
Norway
Poland
Portugal
Republic of Moldova	YES	YES	YES	YES
Russian Federation
Serbia
Singapore
Slovakia
Slovenia
Spain
Sweden
Switzerland
Syrian Arab Republic
The Former Yugoslav Republic of Macedonia
Turkey
Ukraine
United States of America	YES	YES	NO*	...
Zambia	YES	YES	YES	YES

***Additional Comments**

XXIII. QUESTION 25.1

- a. ESTONIA: If the division is in connection with a partial change in ownership, it has do be done through WIPO.

XXIV. QUESTION 26

- a. UNITED STATES OF AMERICA: NO, TMEP §1615.02.
http://tess2.uspto.gov/tmdb/tmep/1600.htm#_T161502.

XXV. QUESTION 26.1

- a. ESTONIA: If the division is in connection with a partial change in ownership, it has do be done through WIPO.

XXVI. ADDITIONAL INFORMATION FROM THE OFFICE OF TURKEY

The Implementing Regulation under the Decree-Law No 556 Pertaining to the Protection of Trademarks.

Request for Division

Article 15

An application for trademark registration may be divided into two or more applications by the request of applicant or his representative, until the trademark is registered by the Institute. The division of registered trademarks shall not be permitted.

Below-mentioned documents shall be required by the Institute for the division of the trademark application:

- a) Petition for division request,
- b) The original receipt documenting the payment of the fee charged for division request,
- c) If the request is filed by an agent, a power of attorney.

As a result of division of an application, goods and/or services listed in the initial application may be distributed among divisional applications. Each divisional application is given a separate application number. Each divisional application shall continue to proceed separate from other divisional applications. The divisional applications shall preserve the filing date of the initial application and the benefit of the right of priority, if any. The merger of the divisional applications shall not be possible. The division of an application proceeded after the publication of the initial application shall be published separately.

The request for division shall not be accepted in any of the following cases:

- a) where the request for division of the application is made in connection with an opposition, if all the goods and/or services against which the opposition is directed be included in the divisional application,
- b) where the request for division of the application is made in connection with the filing of an appeal or during appeal proceedings, if all the goods and/or services against which the appeal is directed be included in the divisional application,
- c) in case of finding of other grounds which necessitates the refusal of the division request.

For the division requests that are not accepted no fee is reimbursed and it is recorded to the revenue.

XXVII. ADDITIONAL INFORMATION FROM THE OFFICE OF THE RUSSIAN FEDERATION

“Article 1502. Withdrawal of a Trademark Application and Division of Another Application From It.

“[...]

“2. During the period of examination of the trademark application, the applicant shall have the right until the adoption of a decision under it to file to the Federal agency of executive authority for intellectual property a divisional application for the very same indication. Such an application must contain a list of goods from those indicated in the initial application on the date of its filing with the Given Federal agency and not of the same kind as other goods of the list contained in the initial application, in connection with which the initial application shall remain in force.

“[...].”

“Article 1505. Entry of Changes into the State Register of Trademarks and into the Trademark Certificate.

“[...]

“2. In case of a contest of the grant of legal protection to a trademark (Article 1512), on request of the right holder a separate registration of this trademark for one of the goods or some of the goods from those indicated in the initial registration that is not of the same kind as the goods the list of which remains in the original registration may be divided from the state registration of a trademark in effect with respect to various goods. Such a request may be filed by the right holder before the adoption of a decision on the results of consideration of a dispute on registration of the trademark.

“[...].”

QUESTIONS		REPLIES	YES	%	NO	%	N/A	%	OTHERS
I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS									
3.	May the division concern elements of the mark other than the list of goods and services?	39	8	20.5%	31	79.5%		0.0%	7 comments
4.	May an application be divided more than once?	39	37	94.9%	2	5.1%		0.0%	
5. Must the request for division specify:	5.1. Either (a) the goods and/or services that are to be part of the divisional application or (b) the goods and/or services that are to remain in the "parent" application?	39	10		25.6%				
	5.2. Both (a) and (b)?		20		51.3%				
	5.3. Only (a)?		9		23.1%				
	5.4. Only (b)?		0		0.0%				
6.	May the goods and/or services of the divisional application overlap with those remaining in the "parent" application?	39	3	7.7%	36	92.3%		0.0%	1 comment
7.	Where the request for division of the application is made in connection with an opposition, may any of the goods and/or services against which the opposition is directed be included in the divisional application?	38	14	37.8%	7	16.2%	17	45.9%	3 comments; the response from Hungary is included in the "NO"
8.	Is a fee charged for the division?	40	37	92.5%	3	7.5%		0.0%	1 comment
8.1. If the reply is yes, is that fee:	8.1.1. The same as the application fee?	36	22		61.1%				
	8.1.2. Lower than the application fee?		14		38.9%				1 comment

QUESTIONS	REPLIES	YES	%	NO	%	N/A	%	OTHERS
I. DIVISION OF NATIONAL/REGIONAL APPLICATIONS								
9. May the divisional application or applications be subsequently merged back with the "parent" application at the request of the applicant?	40	7	17.5%	31	77.5%	2	5.0%	1 comment
10. Is a fee charged for the merger?	20	6	30.0%	6	30.0%	8	40.0%	1 comment
11. How many requests for the division of an application for trademark registration (other than as a result of or in connection with a partial change in ownership of the application) did your Office receive in 2009?	39	No info		4			10.3%	10 comments
		some		1			2.6%	
		0		13			33.3%	
		1 to 25		15			38.5%	
		26 to 150		2			5.1%	
		151 to 500		2			5.1%	
Over 1000		2			5.1%			

QUESTIONS	REPLIES	YES	%	NO	%	N/A	%	OTHERS
II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS								
12. Does the applicable law of your country/organization allow the division of trademark registrations other than as a result of or in connection with a partial change in ownership of the registration?	54	27	50.0%	27	50.0%		0.0%	28 comments
13. May such division be requested by the holder of the registration:								
13.1. at any time after registration?	27	22	81.5%	5	18.5%		0.0%	
13.2. during the opposition period ?	27	17	63.0%	4	14.8%	6	22.2%	
13.3. during opposition proceedings?	27	20	74.1%	1	3.7%	6	22.2%	
13.4. during cancellation or other invalidation proceedings?	25	24	96.0%	1	4.0%	0	0.0%	
13.5. in connection with the filing of an appeal or during appeal proceedings?	27	23	85.2%	4	14.8%		0.0%	
13.6. Other (Please specify):	7					1	14.3%	5 comments
14. May the division concern elements of the mark other than the list of goods and services?	26	1	3.8%	25	96.2%		0.0%	1 comment
15. May a registration be divided more than once?	27	26	96.3%	1	3.7%		0.0%	
16. Must the request for division specify:								
16.1. either (a) the goods and/or services that are to be part of the divisional registration or (b) the goods and/or services that are to remain in the "parent" registration?	27		5		18.5%			
16.2. both (a) and (b)?			13		48.1%			
16.3. only (a)?			9		33.3%			
16.4. only (b)?			0		0.0%			

QUESTIONS	REPLIES	YES	%	NO	%	N/A	%	OTHERS
II. DIVISION OF NATIONAL/REGIONAL REGISTRATIONS								
17. May the goods and/or services of the divisional registration overlap with those remaining in the "parent" registration?	27	3	11.1%	24	88.9%		0.0%	
18. Where the request for division of the registration is made in connection with an opposition, may any of the goods and/or services against which the opposition is directed be included in the divisional registration?	27	16	59.3%	4	14.8%	7	25.9%	2 comments
19. Where the request for division of the registration is made in connection with cancellation or other invalidation proceedings, may any of the goods and/or services against which the proceedings are directed be included in the divisional registration?	27	16	59.3%	7	25.9%	4	14.8%	
20. Is a fee charged for the division?	27	25	92.6%	2	7.4%		0.0%	
21. May the divisional registration or registrations be subsequently merged back with the "parent" registration at the request of the holder?	27	5	18.5%	20	74.1%	2	7.4%	1 comment
22. Is a fee charged for the merger?	14	5	35.7%	3	21.4%	6	42.9%	1 comment
23. How many requests for the division of a registration (other than as a result of or in connection with a partial change in ownership of the registration) did your Office receive in 2009	25	N/A		1			4%	4 comments
		0		12			48%	
		1 to 5		7			28%	
		6 to 25		4			16%	
		Over 25		1			4%	

QUESTIONS		REPLIES	YES	%	NO	%	N/A	%	OTHERS
III. DIVISION OF A DESIGNATION UNDER THE MADRID AGREEMENT OR THE MADRID PROTOCOL									
24.	Does the applicable law of your country/organization allow the division of a territorial extension (or "designation") under Article 3ter of the Madrid Agreement or of the Madrid Protocol other than upon notification by the International Bureau of WIPO of a partial change in ownership of the international registration concerned?	52	8	14.3%	43	87.3%	1	2.0%	9 comments
25.	May such division be requested by the holder of the international registration while the international registration has the same effect as an application for registration filed directly with your Office (i.e., up to tacit or express acceptance of the mark, or up to final refusal)?	8	8	100.0%		0.0%		0.0%	
	25.1. If your answer to question 25 is "yes", is the regime applicable to the division of the designation substantially the same, <i>mutatis mutandis</i> , as that applicable to the division of an application for registration filed directly with your Office?	8	7	87.5%	1	12.5%		0.0%	1 comment
26.	May such division be requested by the holder of the international registration after the international registration has acquired the same effect as a registration effected by your Office (i.e., after tacit or express acceptance of the mark)?	8	5	62.5%	3	37.5%		0.0%	1 comment
	26.1. If your answer to question 26 is "yes", is the regime applicable to the division of the designation substantially the same, <i>mutatis mutandis</i> , as that applicable to the division of a registration effected by your Office?	5	4	80.0%	1	20.0%		0.0%	1 comment