

## QUESTIONNAIRE ON LIMITATIONS OF INTERNATIONAL REGISTRATIONS UNDER THE MADRID SYSTEM

The following questionnaire concerns the examination practice of the Offices of the Contracting Parties of the Madrid System regarding limitations made in international applications, subsequent designations and those recorded as changes to international registrations.

The questionnaire has two parts:

- Part I is for Offices of the Contracting Parties of the Madrid System only,
- Part II is for observer organizations only.

Offices and observer organizations are invited to reply to this questionnaire and to provide further information or comments for each of its questions.

Replies to this questionnaire should reach the Secretariat by **March 15, 2018**.

The Secretariat will present to the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its Sixteenth Session, a document summarizing the answers to the questionnaire as well as the information or comments received.

Name of the Contracting Party: .. <b>United States Patent and Trademark Office</b> .....
Name of the observer organization: .....
Name of the contact person: .....
E-mail address: .....

<b>I. FOR OFFICES ONLY</b>
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**A. ROLE OF THE OFFICE OF ORIGIN**
*Limitations Made in International Applications*

**Question 1:** As Office of origin, does the Office examine limitations made in international applications (Form MM2)? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, to determine **only** whether such limitations are covered by the list of goods and services in the basic application or basic registration (hereinafter referred to as “**the basic list**”).
- ☐ Yes, to determine **only** whether such limitations are covered by the list of goods and services in the international application (hereinafter referred to as “**the main list of the international application**”).
- ☐ Yes, to determine whether such limitations are covered by **both** the basic list and the main list of the international application.
- ☐ No, because the Office considers that the applicant is responsible for ensuring that such limitations are covered by the basic list or main list of the international application, or both.
- ☐ No, because the Office considers that the International Bureau should determine whether such limitations are covered by the list of goods and services in the resulting international registration (hereinafter referred to as “**the main list of the international registration**”).
- ☒ No, because the Office considers that the Office of the designated Contracting Party or Parties (where the limitations will have effect) must determine whether such limitations are covered by the main list of the international registration.
- ☒ No, because the Office considers that it does not have the legal basis to do so.
- ☐ N/A, as Office of origin, the Office has not yet received an international application.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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**B. ROLE OF THE OFFICE OF THE CONTRACTING PARTY OF THE HOLDER***Limitations Made in Subsequent Designations or Requested as Recording of a Change to the International Registration*

Holders can make subsequent designations and present requests for recording directly to the International Bureau or through their Office (the Office of the Contracting Party of the holder) which can be the Office of origin or another Office after the recording of a change in ownership.

**Question 2:** As the Office of the Contracting Party of the holder, when the Office receives subsequent designations containing limitations (Form MM4), does the Office examine such limitations? *(It is possible tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, to determine whether such limitations are covered by the main list of the international registration.
- ☐ Yes, to determine whether such limitations are covered by the main list of the international registration, but **only** when the Office is also the Office of origin.
- ☐ No, because the Office considers that the holder is responsible for making sure that such limitations are covered by the main list of the international registration.
- ☐ No, because the Office considers that the International Bureau should determine whether such limitations are covered by the main list of the international registration.
- ☒ No, because the Office considers that the Office of the designated Contracting Party or Parties (where the limitations will have effect) should determine whether such limitations are covered by the main list of the international registration.
- ☒ No, because the Office considers that it does not have the legal basis to do so.
- ☐ N/A, as the Office of the Contracting Party of the holder, the Office has not received subsequent designations.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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**Question 3:** As the Office of the Contracting Party of the holder, when the Office receives a request for the recording of a limitation as a change to the international registration (Form MM6), does the Office examine such limitation? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ Yes, to determine whether such limitation is covered by the main list of the international registration.
- ☐ Yes, to determine whether such limitation is covered by the main list of the international registration, but **only** when the Office is also the Office of origin.
- ☐ No, because the Office considers that the holder is responsible for making sure that such limitation is covered by the main list of the international registration.
- ☐ No, because the Office considers that the International Bureau should determine whether such limitation is covered by the main list of the international registration.
- ☐ No, because the Office considers that the Office of the designated Contracting Party or Parties (where the limitation will have effect) should determine whether such limitation is covered by the main list of the international registration.
- ☐ No, because the Office considers that it does not have the legal basis to do so.
- ☐ N/A, as the Office of the Contracting Party of the holder, the Office has not received requests for the recording of a limitation as a change.
- ☒ Other(s) – please, specify:  
 .....USPTO does not accept MM6 forms for recording of limitations.....  
 .....If an MM6 is filed, USPTO will refuse it or return it to the filer.....  
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Please, provide other relevant information or comment:

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## C. ROLE OF THE OFFICE OF THE DESIGNATED CONTRACTING PARTY

### *Limitations in International Registrations, Subsequent Designations or Recorded as a Change*

The International Bureau notifies Offices of the designated Contracting Parties of the international registration. The international registration may contain one or more limitations made either in the international application or in a subsequent designation.

The International Bureau also notifies the Office of a designated Contracting Party or Parties where a limitation is to have effect as a change to the international registration.

#### 1. Limitations Made in an International Application

**Question 4:** As the Office of a Contracting Party designated in an international registration, does the Office examine a limitation made in the international application (under Rule 9(4)(a)(xiii)) to determine whether such limitation is covered by the main list of that registration? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☒ Yes, the Office examines the limitation to determine whether such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limited list because the Office considers that only this list (and not the main list) has effects in the Contracting Party.
- ☐ No, the Office only takes into account the limitation because the Office understands that the holder is responsible for ensuring that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the Office of origin has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the International Bureau has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office does not have the legal basis to examine such limitation.
- ☐ N/A, as the Office of a designated Contracting Party, the Office has not been notified of an international registration containing a limitation made in an international application.
- ☐ Other(s) – please, specify:  
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Please, provide other relevant information or comment:

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## 2. Limitations Made in a Subsequent Designation

**Question 5:** As the Office of a Contracting Party designated in an international registration, does the Office examine a limitation made in a subsequent designation (under Rule 24(3)(a)(iv)) to determine whether such limitation is covered by the main list of that registration? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☒ Yes, the Office examines the limitation to determine whether such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limited list because the Office considers that only this list (and not the main list) has effects in the Contracting Party.
- ☐ No, the Office only takes into account the limitation because the Office understands that the holder is responsible for ensuring that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the Office that presented the subsequent designation or the International Bureau, when presented directly by the holder, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office understands that the International Bureau, regardless of who presented the subsequent designation, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office only takes into account the limitation because the Office does not have the legal basis to examine such limitation.
- ☐ N/A, as the Office of a designated Contracting Party, the Office has not been notified of an international registration containing a limitation made in a subsequent designation.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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***If the answer to either Question 4 or 5 is “Yes”, please reply to Question 6 below:***

**Question 6:** What does the Office do when it determines that a limitation made in an international application (under Rule 9(4)(a)(xiii)) or subsequent designation (under Rule 24(3)(a)(iv)) is not covered by the main list of the international registration?

☒ The Office issues a notification of provisional refusal under Rule 17 of the Common Regulations stating that the limitation has no effect because it is not covered by the main list of the international registration.

☐ Other(s) – please, specify:

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***If the answer to either Question 4 or 5 is “No”, please reply to Question 7 below:***

**Question 7:** If the Common Regulations provided for the possibility of refusing the effects of a limitation made in an international application (under Rule 9(4)(a)(xiii)) or subsequent designation (under Rule 24(3)(a)(iv)), either as a provisional refusal or as a declaration similar to that in Rule 27(5), would the Office apply the new provision and issue such notification or declaration?

☐ Yes, the Office would apply the new provision and issue such provisional refusal or declaration that the limitation has no effect.

☐ Yes, however, the national or regional legal framework would need to be changed.

☐ No, because the Office does not consider it should examine such limitations.

☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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3. Limitations Recorded as a Change

**Question 8:** As the Office of a designated Contracting Party, does the Office examine a limitation recorded as a change (under Rule 27(1)(a))? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☒ Yes, the Office undertakes such examination.
- ☐ No, the Office only takes into account the limitation because the Office understands that the holder is responsible for ensuring that such limitation is covered by the main list of the international registration.
- ☐ No, the Office simply takes note of the limitation because the Office understands that the Office that presented the request or the International Bureau, when the request is presented by the holder, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office simply takes note of the limitation because the Office understands that the International Bureau, regardless of who presented the request, has already determined that such limitation is covered by the main list of the international registration.
- ☐ No, the Office simply takes note of the limitation because the Office does not have the legal basis to examine such limitation or refuse the effects of such limitation.
- ☐ N/A, as the Office of a designated Contracting Party, the Office has not been notified of a limitation recorded as a change to an international registration.
- ☐ Other(s) – please, specify:  
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Please, provide other relevant information or comment:

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**If the answer to Question 8 is “Yes”, please reply to Questions 9 and 10 below:**

**Question 9:** When examining a limitation recorded as a change (under Rule 27(1)(a)), what does the Office take into account? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☐ the Office takes into account the main list of the international registration only.
- ☐ the Office takes into account the list of goods and services for which the mark has effect or is protected (i.e. the Office also takes into account previous relevant recordings such as limitations, partial change in ownership, notifications of provisional refusals, final decisions, partial invalidation, partial cancellation, etc.).
- ☒ Other(s) – please, specify:  
~~....USPTO takes into consideration all prior amendments to the list of.....~~  
~~....goods and services and the current list of goods and services of.....~~  
~~....record at the time the limitation is received. Further amendments to the~~  
~~....list of goods and services may only be to restrict or narrow the scope of~~  
 goods and services but not to extend or broaden the scope.  
 Please, provide other relevant information or comment:

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**Question 10:** What does the Office do when it determines that a limitation recorded as change (under Rule 27(1)(a)) is not covered by the main list of an international registration or, as the case may be, the list of goods and services for which the mark has effect or is protected? *(It is possible to tick more than one box; however, in such case, kindly explain in the comments section below.)*

- ☒ The Office issues a declaration that such limitation has no effect in the Contracting Party in accordance with Rule 27(5) of the Common Regulations.
- ☐ Other(s) – please, specify:

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Please, provide other relevant information or comment:

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## D. ROLE OF THE OFFICE CONCERNING NATIONAL OR REGIONAL APPLICATIONS OR REGISTRATIONS

*The following questions refer to the legislation and practice in the designated Contracting Parties concerning national or regional applications or registrations*

**Question 11:** Does the applicable legislation provide for requests in respect of national or regional applications which are equivalent to a limitation to an international registration (for example, partial withdrawal of the national or regional application)?

☒ Yes.

☐ No.

Please, provide other relevant information or comment:

~~..US national practice allows for amendment of the list of goods and services throughout prosecution of the application and even after registration.....~~  
~~..However, the amendment may only be to restrict or narrow the scope of the goods and services but not to extend or broaden the scope.....~~

***If the answer to Question 11 is "Yes", please reply to Question 12 below:***

**Question 12:** Does the Office examine the requests in respect of national or regional applications referred to in question 11?

☒ Yes.

☐ No.

If yes, please describe such examination and provide other relevant information or comment:

~~..US national practice allows for amendment of the list of goods and services throughout prosecution of the application and even after registration.....~~  
~~..However, the amendment may only be to restrict or narrow the scope of the goods and services but not to extend or broaden the scope.....~~

**Question 13:** Does the applicable legislation provide for recordings in respect of national or regional registrations which are equivalent to a limitation to an international registration (for example partial cancellation of the national or regional registration)?

☒ Yes.

☐ No.

Please, provide other relevant information or comment:

~~..US national practice allows for amendment of the list of goods and services throughout prosecution of the application and even after registration.....~~  
~~..However, the amendment may only be to restrict or narrow the scope of the goods and services but not to extend or broaden the scope.....~~

***If the answer to Question 13 is “Yes”, please reply to Question 14 below:***

**Question 14:** Does the Office examine the requests for recordings in respect of national or regional registrations referred to in question 13?

☒ Yes.

☐ No.

If yes, please describe such examination and provide other relevant information or comment:

~~..US national practice allows for amendment of the list of goods and services throughout prosecution of the application and even after registration:.....~~  
~~..However, the amendment may only be to restrict or narrow the scope of the goods and services but not to extend or broaden the scope:.....~~

<b>II. FOR OBSERVER ORGANIZATIONS ONLY</b>
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<b>Question 15:</b> What is (are) the reason(s) for making a limitation in an international application (Form MM2)? <i>(It is possible to tick more than one box.)</i>
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- ☐ To reflect the applicant's business interest in a particular Contracting Party.
- ☐ To avoid a possible notification of provisional refusal in a particular Contracting Party.
- ☐ To avoid possible litigation in a particular Contracting Party.
- ☐ To exclude the business interests of a third party with whom the applicant has a trademark dispute.
- ☐ To comply with a settlement agreement in which the applicant has a binding obligation under the law of contracts to make the limitation as worded in the contract.
- ☐ To comply with a court order in a particular designated Contracting Party.
- ☐ Other(s) – please specify:

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Please, provide other relevant information or comment:

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<b>Question 16:</b> What is (are) the reason(s) for making a limitation in a subsequent designation (Form MM4)? <i>(It is possible to tick more than one box.)</i>
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- ☐ To reflect the holder's business interest in a particular Contracting Party.
- ☐ To avoid a possible notification of provisional refusal in a particular Contracting Party.
- ☐ To avoid possible litigation in a particular Contracting Party.
- ☐ To exclude the business interests of a third party with whom the holder has a trademark dispute.
- ☐ To comply with a settlement agreement in which the holder has a binding obligation, under the law of contracts, to make the limitation as worded in the contract.
- ☐ To comply with a court order in a particular designated Contracting Party.

☐ Other – please specify:

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Please, provide other relevant information or comment:

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**Question 17:** What is (are) the reason(s) for requesting the recording of a limitation as a change to the international registration (Form MM6)? (*It is possible to tick more than one box.*)

- ☐ To reflect the holder's business interest in a particular Contracting Party.
- ☐ To overcome a notification of provisional refusal (*ex-officio* or based on opposition).
- ☐ To exclude the business interests of a third party with whom the holder has a trademark dispute.
- ☐ To comply with a settlement agreement in which the holder has a binding obligation, under the law of contracts, to make the limitation as worded in the contract.
- ☐ To comply with a court order in a particular designated Contracting Party.
- ☐ To avoid cancellation due to non-use.
- ☐ To avoid possible litigation.
- ☐ Other(s) – please specify:

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Please, provide other relevant information or comment:

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**Question 18:** When filing an international application containing one or more limitations (Form MM2), does the applicant expect the Office of origin to deliver advice on such limitation?

☐ Yes.

☐ No.

Please, provide other relevant information or comment:

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**Question 19:** When making a subsequent designation containing a limitation (Form MM4) through an Office (the Office of the Contracting Party of the holder), does the holder expect this Office to deliver advice on such limitation?

☐ Yes.

☐ No.

Please, provide other relevant information or comment:

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**Question 20:** When presenting a request for the recording of a limitation (Form MM6) through an Office (the Office of the Contracting Party of the holder), does the holder expect this Office to deliver advice on such limitation?

☐ Yes.

☐ No.

Please, provide other relevant information or comment:

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**Question 21:** The Working Group on the Legal Development of the Madrid System for the International Registration of Marks would like to gather the views of the observer organizations on the subject of limitations to international registrations to further advance the Working Group's discussions; please, kindly elaborate on the views of the organization on this particular subject in a separate document and send it to the Secretariat along with the replies to this questionnaire.

[End of questionnaire]