

# *The outline of the Madrid Protocol*

6 July, 2009  
International Trademark Application Office  
Japan Patent Office

1

## *Introduction*

- ◆ The Protocol Relating to the Madrid Agreement was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996.
- ◆ December 14, 1999. Japan deposited a Instrument of accession.  
Japan became the 42nd Contracting Party.
- ◆ March 14, 2000. The Protocol entered into force in Japan.
- ◆ As of July 2009, 78 countries have joined the Madrid Protocol.

2

## *What prepared(1)*

### At the end of 1997

- ◆ The study was begun for the issues of legislation, Business and system by the In-house subcommittee
- ◆ Three project teams were set up
  - Legislation and Fee team
  - Business operation and system team
  - Substantial examination team

### Beginning of 1998

- ❖ Study visit to Germany, UK and WIPO
- ❖ The result of study was reported by the In-house subcommittee

## *What prepared(2)*

### Beginning of 1999

- ❖ Started discussion regarding basis system design

### April, 1999

- ❖ Established the International Trademark Application Office
- ❖ Revised Trademark Act

### Until March, 2000

- ❖ Study and research
- ❖ promotional activity for users
- ❖ Established the Substantial examination Office

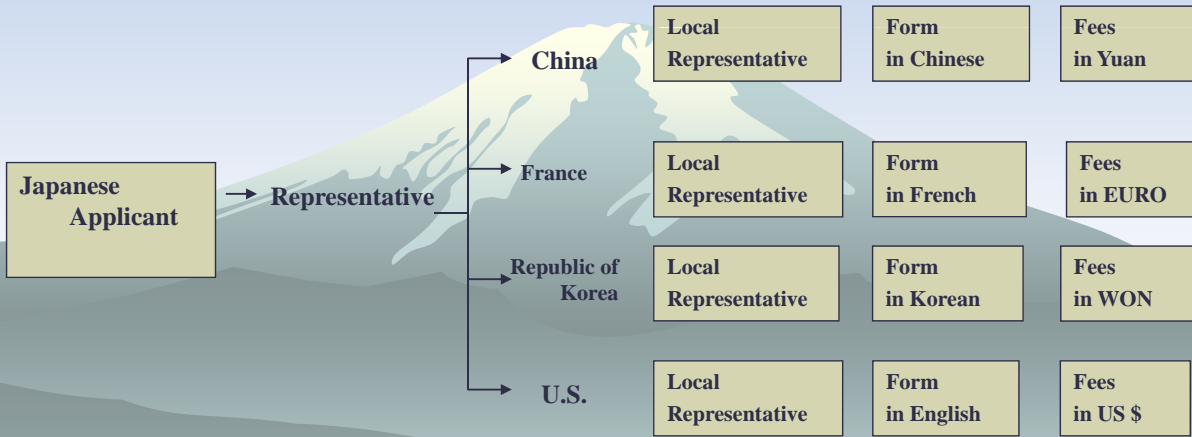
## *Organization composition of International Trademark Application Office*

- Office of Origin      2 formality examiner  
                                 2 temporary staff
  - Designated Office    4 formality examiner  
                                 2 part-time staff (formality examiner)  
                                 3 temporary staff
  - Management section 1 director  
                                 1 assistant director  
                                 1 part-time staff
- Total                      16 staffs

## *Madrid Agreement and Madrid Protocol*

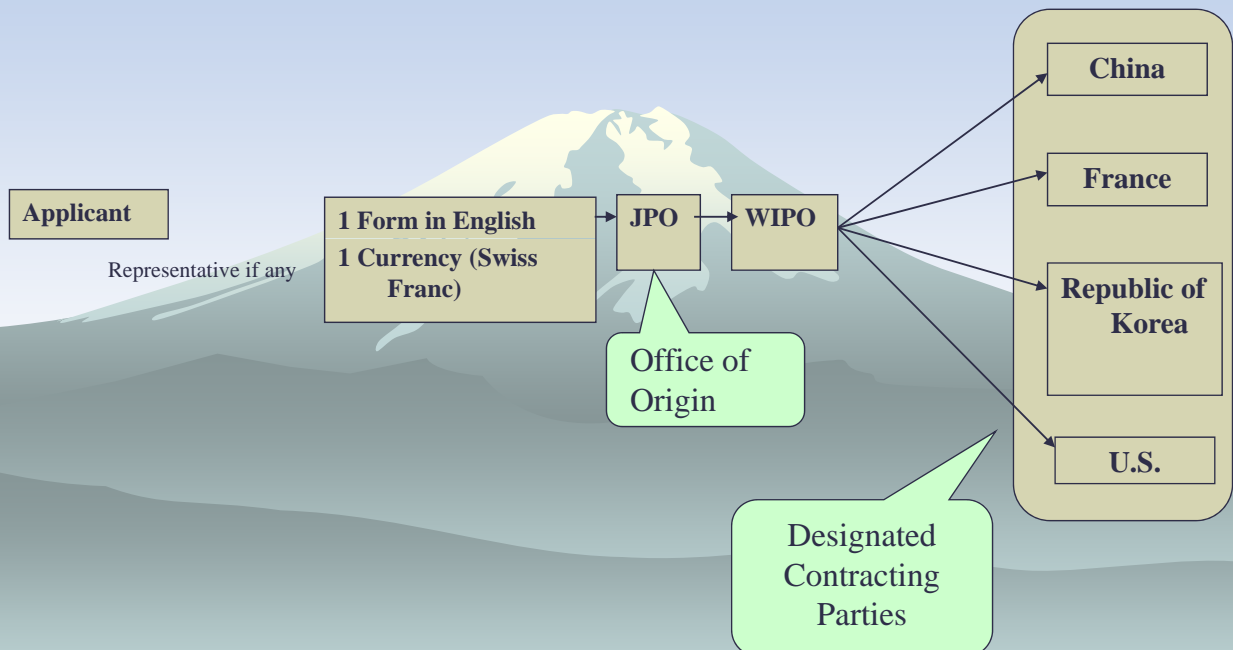
	Madrid Agreement	Madrid Protocol
Membership	A party to the Paris Convention	A party to the Paris Convention and Intergovernmental organization
Bases for International Applications	Basic Registration	Basic application / basic registration
Period for refusal	12 months	12 months / 18 months
Period for registration	20 years	10 years
Fees	Fixed fees	Fixed fees /individual fees
Language	French	French / English / Spanish
Remedies for Central Attack	No remedies	Transformable to national applications

## Direct Filings



7

## Filings under the Madrid Protocol



8

## Main features of the Madrid Protocol

(1)

“Central Attack” (Article 6 (3))

Basic application / Basic registration

International Registration

Invalidation, cancellation, etc.  
in 5 years

The protection may no  
longer be invoked

Transformation into National Applications

9

## Main features of the Madrid Protocol

(2)

Subsequent Designation (Article 3ter(2) and Rule 24 )

International Registration

Country A: goods X, Y

Country B: goods X  
Country C: goods X, Y

10

## *Advantages of the Madrid Protocol for users*

- ◆ At the application stage:
  - ❖ a single application in one language and one currency;
  - ❖ file with the Office of origin of home country;
  - ❖ may obtain protection in several countries in one procedure
- ◆ At the post-registration stage:
  - ❖ At the elapse of 12 / 18 months, it is thought that trademark right has been granted in the designated countries
  - ❖ possibility of designating other countries after registration; and
  - ❖ easy handling of trademark management:
    - ◆ a single request to record changes (transfers, changes of names or addresses, etc.) which may affect the registration as a whole or in part
    - ◆ a single request for renewal

11

## *Main roles of JPO*

- ◆ Positive appeal for Madrid Protocol system improvement
- ◆ Promotion activities for users
- ◆ Development of new administrative processing system

12

## Main roles of the JPO as an Office of Origin and Designated Office

- ◆ Main roles of the JPO as the Office of Origin:
  - ❖ Receives an International Application
  - ❖ Certifies that a mark and others in International applications are the same as those in the basic application/registration; and
  - ❖ Communications with the WIPO
  
- ◆ Main roles of the JPO as the Designated Office:
  - ❖ examine the international registration under the Japanese Trademark Act; and
  - ❖ Notify provisional refusals to the WIPO within 18 months

13

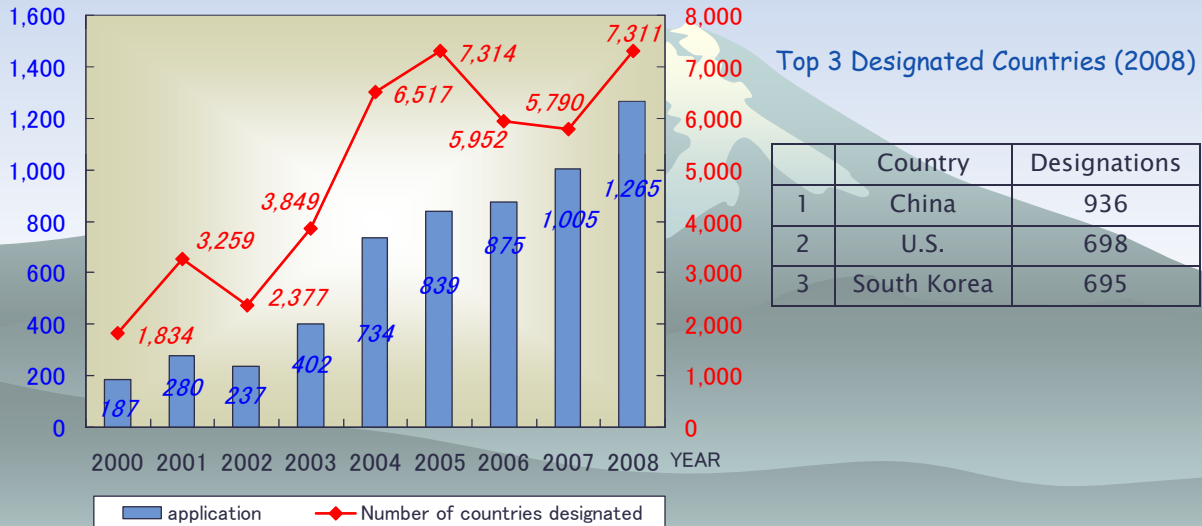
## *Recent discussion at the WIPO-WG*

- ◆ Discussion about the requirement of basic application or registration
- ◆ Study on the Possible Introduction of “filing languages”
- ◆ Expansion of the automation of procedures including electronic communication of notifications

14

## Statistics (1)

### International Applications originating from Japan



Top 3 Designated Countries (2008)

	Country	Designations
1	China	936
2	U.S.	698
3	South Korea	695

## Statistics (2)

### International Applications designating from Japan



Top 3 Nationalities (2008)

	Country	Designations
1	U.S.	1,991
2	Germany	1,929
3	EM	1,257