

Measures for Accession to, And Effective Use of, the
Madrid System



Legislative & Institutional Measures to be Considered by
the Government and Intellectual Property (IP) Office in
Joining the Madrid System

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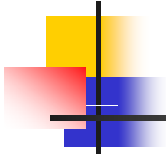


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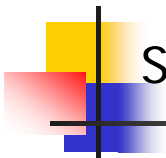
**Institutional measures needed for accession to
the Madrid Protocol**



- Step-1 Making Feasibility Study
- Step-2 Conducting User-needs Survey
- Step-3 Ascertaining Economic Benefits of the Protocol

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**Institutional measures needed for accession to
the Madrid Protocol**



Step 2: Conducting User-needs Survey (July 1998)

Q1. Do you think Japan's accession to the Protocol would benefit your company?

Yes 94% (861 companies)

No 2% (14 companies)

Q2. If Japan joined the Protocol, would your company consider making use of the Protocol for filing abroad?

Yes 95% (741 companies)

No 5% (36 companies)

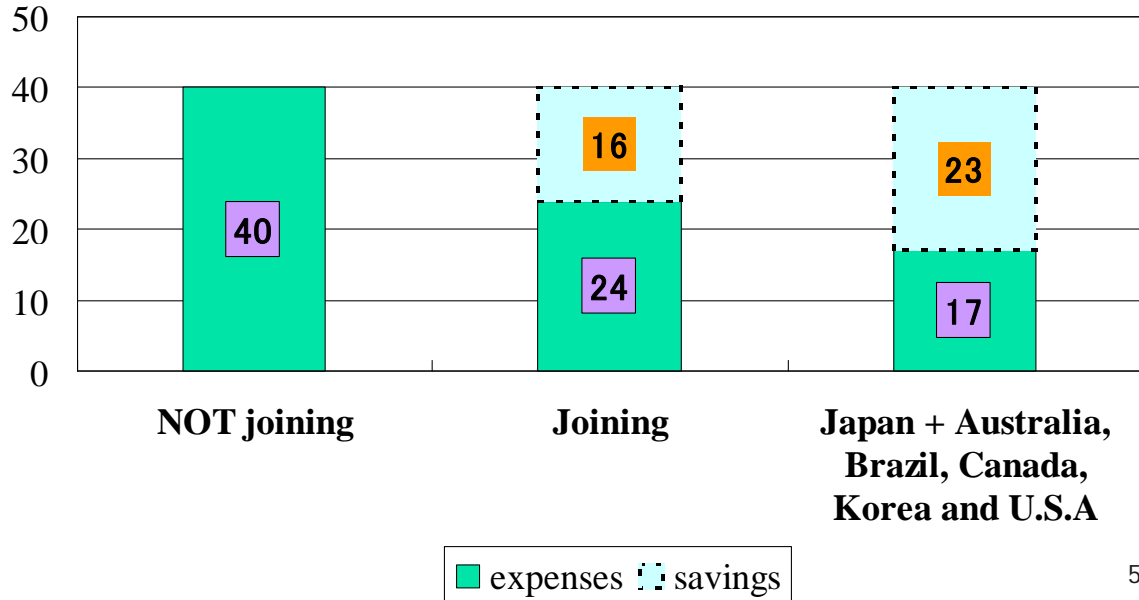
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Institutional measures needed for accession to the Madrid Protocol

Step 3: Ascertaining the Economic Benefits (in 1998)
-Under assumption of Japan's accession to the Protocol-

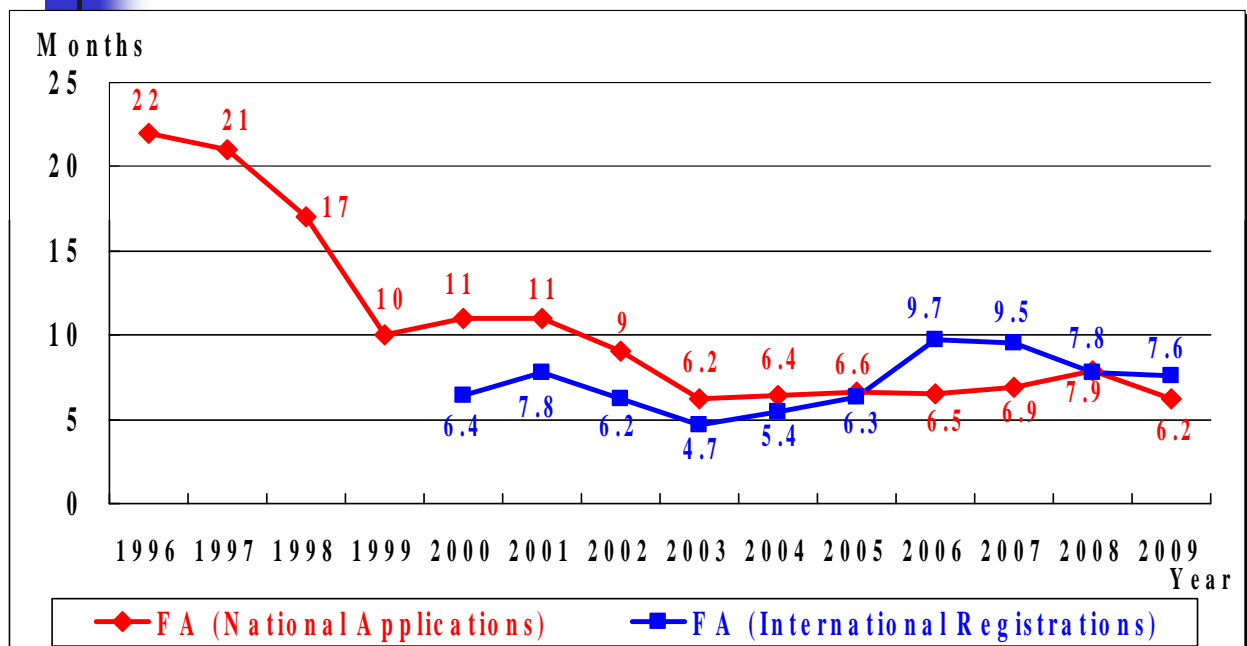
Billion JPY

<1998-2008>



Institutional measures needed for accession to the Madrid Protocol

First Action (FA) of Applications
1996-2009





Human-resource Issues

- Supporting the Examination process-
 - Outsourcing (Japan Patent Information Organization)
- Improving the examination system
 - Introducing (remodeled) computerization
- Hiring new assistants for examiners-
 - Rehiring former examiners

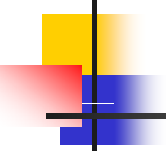
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- Revisions to the Trademark Act-

- Issues considered at the time by Industrial Property Council in revising Trademark Act :
 - ① Requests for early protection of trademark rights
 - +
 - ② Measures for the Madrid Protocol

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**Main articles in the Trademark Act corresponding
to Protocol Relating to the Madrid Agreement**

(1) For the Office of Origin:


The Trademark Act from Article 68-2 to Article 68-8

(2) For the Office of Designated Office:

The Trademark Act from Article 68-9 to Article 68-31

Article 68-9 Any request for territorial extension to designate Japan shall be deemed to be an application for trademark registration filed on the date of international registration provided in Article 3(4) of the Protocol (hereinafter referred to as the "date of international registration"); provided, however, that in the case of subsequent designation, such request shall be deemed to be an application for trademark registration filed on the date on which the subsequent designation pertaining to the international registration pursuant to Article 3ter(2) of the Protocol (hereinafter referred to as the "date of subsequent designation") is recorded in the International Register of the International Bureau provided in Article 2(1) (hereinafter referred to as the "International Register").

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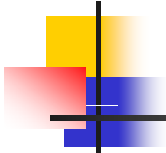
(3) Special provisions concerning re-application for
trademark registration after rescission of international
registration according to Central Attack:

The Trademark Act from Article 68-32 to Article 68-39

(4) Treating Madrid Protocol & Japanese Act equally:

- ① Examination within 18 months
- ② New protection from filing to registration
- ③ International register and National register
- ④ Publications (with Japanese translations)

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① Examination within 18 months (for early protection of trademark rights and (MP)Article 5)

(Trademark Act)

Article 16 Where no reasons for refusal are found in connection with an application for trademark registration within the time limit provided by Cabinet Order, the examiner shall render a decision to the effect that the trademark is to be registered.

* Article 2 of the Trademark Law Enforcement Order
(Assessment period of trademark registration)

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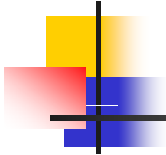
② New protection from filing to registration (for early protection of trademark rights and (MP)Article 4(1)(a))

(Trademark Act)

Article 13-2 (the right to monetary claims)

Where an applicant for trademark registration issues a warning after filing an application for trademark registration by presenting a document stating a description of the application, the applicant may claim against any person who uses the trademark pertaining to the application, for the designated goods or designated services in the application during the period from the warning up to the registration of establishing the trademark right, the payment of money in the amount equivalent to the loss incurred in the course of business due to such use.

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Requirement to make a monetary claim

- (1) When applicants suffer monetary damages because of trademark abuse by a third party, between the time they filed their international applications up to the time they are registered. .
- (2) When giving a warning.
- (3) When the establishment of rights for the trademark application is registered in Japan.
- (4) After the establishment of rights is registered, the rights holder can exercise the rights for monetary damages.

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③ International register and national register

● International register (basis)

trademark, goods and services, right holder, the others

● National register

trademark, goods and services, right holder, the others

(consider)
↓

+
record of licenses, creation of pledges, the others,,

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④ Publications

(for early protection of trademark rights and the right to make monetary claims)

- Disclosure/Publication provided two times
- “publication of application” ← **created**
- “publication of trademark registration”
(with Japanese translations to the designated goods and services)

(Trademark Act)

Article 12-2 Where an application for trademark registration is filed, the Commissioner of the Patent Office shall lay open the trademark application.

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Others

- Substitution for Protocol Relating to the (MP)Article 4bis
- The normal procedures by the Japanese Trademark Act are unavailable under centralized management by international registration
- Two-payment system (Rule 34(3)(a))

(Trademark Act)

Article 68-10 Where a registered trademark (hereinafter in this article referred to as a "registered trademark based on international registration") pertaining to the request for territorial extension which is deemed to have been an application for trademark registration pursuant to Article 68-9(1) (hereinafter in this chapter referred to as an "international application for trademark registration") is identical with the registered trademark prior to the trademark registration (except registered trademarks based on international registration, hereinafter referred to in this article as a "registered trademark based on national registration") and the designated goods or designated services pertaining to the registered trademark based on international registration overlap with the designated goods or designated services based on national registration, and further the holder of trademark right of the registered trademark based on international registration is identical with the holder of trademark right of the registered trademark based on national registration, the international application for trademark registration shall be deemed to have been filed on the date of filing of the application for trademark registration pertaining to the registered trademark based on national registration to the extent of the scope which is overlapping.

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- Accession Instruments -

**Declarations based on the Protocol
(Article base)**

- Receipt of Individual Fees ((MP)Article 8(7)(a))
- 18-Month Period for Refusal ((MP)Article 5(2)(b))

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Thank you!

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