

Topics in Trademark Protection: The Madrid Protocol and Trademark Applications Designating Japan

Introduction to the Madrid System

The Madrid System is based on the Madrid Agreement of 1891 and seeks to streamline the process for obtaining and registering international trademarks. The Madrid Protocol which is based on the original Madrid Agreement serves numerous purposes which ultimately allow an applicant to file an international application in one of three languages (English, Spanish, or French) and pay a single set of fees for protection in up to 112 countries and territories.

Any citizen or legal entity which has established residency or a domicile in a country which is a Contracting Party of the protocol may use the system to file international trademark applications.

Brief Summary of the Application Process

Prior to the filing of the international application, the applicant must have registered or filed an application in the Intellectual Property or trademark office of their home country (often referred to as the "office of origin"). This registration or application is referred to as the "basic mark". The applicant may then submit an international application through the Intellectual Property offices of their home country which will send the international application to the World Intellectual Property Organization (WIPO). Unless further restricted by the office of origin, the applications are to be filed in English, Spanish, or French.

The WIPO will conduct a formal examination of the international application which includes whether the classification and the goods and services can be readily understood. If the application is approved, the mark will be recorded in the International Register and thereafter published in the WIPO Gazette of International Marks. The applicant and each of the Contracting Parties will also receive notification thereof and the applicant will receive a certificate of the international

registration of their mark. The WIPO will then inform all the IP Offices of the countries and territories in which the applicant is seeking protection, so that each of the designated IP offices may begin their own examination of the international trademark application.

A Contracting Party may be designated either under the Madrid Agreement or the Madrid Protocol which are parallel and independent treaties. If both Contracting Parties are parties to the Agreement, then the designation is based on the Agreement. If both Contracting Parties are parties to both the Agreement and the Protocol, then the Protocol has priority in the designation.

Each of the IP Offices of the countries and territories in which the applicant is seeking protection will determine within 12 to 18 months whether the applicant's mark may be protected, partially denied protection, or wholly denied protection, based on whether the applicant's mark is too similar to a previously registered mark at that specific Contracting Party's IP office. The applicant will be notified by the WIPO after the WIPO receives the decision from any of the IP offices designated by the applicant. The granting or the refusal (total or partial) of protection by one IP office does not impart an influence upon any of the other IP offices designated by the applicant.

Refusals may be contested by the applicant, although the procedures for contesting a refusal differ depending on the IP office which issued the refusal. Should an IP office decide to protect the applicant's mark, a statement of grant of protection will be notified to the applicant. As with all trademarks, the granted mark is valid for 10 years and is renewable by contacting the WIPO and paying fees before the end of each 10-year period.

As stated above, there are numerous advantages associated with using the Madrid System for filing international trademark applications.

- 1) Separate applications do not need to be filed for each country in which trademark protection is sought.

- 2) While some differences do exist among each Contracting Party, the examination systems, procedural rules, and regulations

are relatively similar.

3) One set of fees is required.

4) Applications may be filed in English, Spanish, or French.

5) The renewal of a registration is simplified and should aspects of an international registration be changed, such as an address, or should the registered trademark be assigned to a third party, the processes for recording this are streamlined for all designated Contracting Parties.

Madrid Protocol Applications Designating Japan

An international trademark application designating Japan as a Contracting Party is considered to be a Japanese trademark application filed on the international registration date.

There are aspects regarding how the Japan Patent Office (JPO) handles international trademark application designating Japan under the Madrid Protocol that are somewhat different than in other countries.

1) Second Portion of Individual Fee

The individual fee is split into two separate payments, the former payment essentially being the application fee, and the latter payment which must be made only if the JPO deems that the mark in question is eligible for protection. Accompanying the Statement of Grant of Protection, a notification regarding the date and amount due will be provided by the JPO to the International Bureau of the WIPO who will notify the applicant of such, and payment is made to the International Bureau of the WIPO by the applicant. Failure to pay the second portion of the individual fee will result in cancellation of the International Registration in the International Register.

The second portion of the individual fee must be paid within three (3) months from the date that the Statement of Grant of Protection was issued. There is no late payment system by which payment of the second portion of the individual fee may be delayed. Failure to pay the second portion of the individual fee within the designated time period will irrevocably result in cancellation of the applicant's international trademark registration with respect to Japan as a Contracting Party.

2) Indication of goods and/or services

Some of the class headings listed in the Nice Agreement are not accepted by the JPO. The following are a list of terms of the Class Headings (NICE Classifications) for the following classes not accepted by the JPO: https://www.jpo.go.jp/e/system/trademark/madrid/japan_under_the_madrid_protocol.html, and links to The International Classification of Goods and Services, 11th edition, version 2019 and the List of Goods in Alphabetical Order (from Class 1 to Class 34), in English and Japanese Translation with Similar Group Code: https://www.jpo.go.jp/e/system/trademark/gaiyo/bunrui/kokusai/kokusai_bunrui_11-2019.html.

While the JPO does not require verification of the "use" or the "intent to use" of the trademark in question, it does require that a Statement of Use or Declaration of Intent-to-Use be submitted with the trademark application in the case when the application designates retail goods and/or services for 8 or more similar goods in the same class. A Statement of Use or Declaration of Intent-to-Use may help overcome a Provisional Rejection in which the JPO has stated that the scope of the indications is too broad.

Detailed information such as the Notification of Provisional Refusal such as all international marks recorded under the WIPO's Madrid System may be obtained at <http://www.wipo.int/romarin/>.

For applicants who do not have a residence or domicile in Japan, a qualified legal representative having a residence or domicile in Japan is required for the prosecution of a trademark application in Japan.

The following link contains further information regarding Japan as the Office of Origin, Japan as the Office of Designated Contracting Party, fees, methods and procedures for responding to a Provisional Refusal, opposition procedures, as well as other

links relating to the Madrid Protocol.

<https://www.jpo.go.jp/e/faq/yokuaru/madrid.html>

Brief Overview for Responding to a Notification of Provisional Refusal

An amendment which changes the designated goods or services should be submitted to overcome the reasons for refusal stated in the Notification of Provisional Refusal, or a request to limit the good or services using Form MM6 should be filed with the WIPO. Note that, failure to respond to the Notification of Provisional Refusal will result in the trademark application being refused and a Decision to Refuse a Trademark Registration will be issued by the JPO.

The deadline to respond to a Provisional Refusal is three (3) months from the issuance of the Provisional Refusal. A one (1) month extension may be requested; however the time to respond to the Provisional Refusal may not be extended beyond four (4) months.

An appeal trial against the Decision to Refuse a Trademark Registration may be demanded within three (3) months of the issuance of the Decision to Refuse a Trademark Registration. Should the applicant choose not to appeal the decision or the appeal trial examiners uphold the Decision to Refuse a Trademark Registration, the International Bureau of the WIPO will receive a Confirmation of Total Provisional Refusal from the JPO which will be forwarded to the applicant. In the case when the applicant does not have a residence or domicile in Japan, all documents will be issued to the applicant's Japanese legal representative.

Other useful links

WIPO Madrid - International Trademark System page:

<http://www.wipo.int/madrid/en/>

WIPO Gazette of International Marks:

<http://www.wipo.int/madrid/gazette/>

List of Members of the Madrid Union:

<http://www.wipo.int/madrid/en/members/>