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WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Fifth Session
Geneva, May 5 to 9, 2008

CONTRIBUTION BY JAPAN

Document prepared by the International Bureau

1. In a communication dated January 29, 2008, the International Bureau received a contribution from Japan on the subject of improving the accessibility of information regarding the fate of international registrations in designated Contracting Parties, for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its fifth session to be held in Geneva from May 5 to 9, 2008.

2. The said contribution is annexed to this document.

3. The Working Group is invited to note the contents of the attached contribution by Japan.

[Annex follows]

ANNEX

Contribution from Japan

Japan provides the contribution on the basis of paragraph 19 of document MM/A/38/3 adopted by the 38th Madrid Union Assembly.

1. Japan thinks that the proposal by the Delegation of Australia (MM/LD/WG/4/4) is basically supportable.

2. Japan recognizes that notification under Rule 17(6) of Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as "Rule 17(6)") is one of the means by which information on the status of international registrations in designated Contracting Parties is provided timely. Japan sends this notification. According to the WIPO website, so far only 15 Contracting Parties send this notification.

3. According to Rule 17(6), even when a designated Contracting Party does not issue any provisional refusal based on examination or opposition within the applicable refusal period, the designated Contracting Party need not send a Statement of Grant of Protection to the International Bureau. This means that the holder has no way to confirm whether a mark has become protected in the designated Contracting Party until the applicable refusal period (12 months or 18 months) has passed. The user survey for the Madrid System conducted in Japan shows that many users desire to confirm whether their mark has become protected in the designated Contracting Party even before the applicable refusal period has passed.

4. Japan understands that shortening the length of the refusal period could enable holders to confirm the status of international registrations in designated Contracting Parties before 12 months or 18 months have passed. However, Japan believes that almost the same effect can be expected by improving accessibility of information regarding international registration without shortening the length of the period. For instance, if the notification under Rule 17(6) is sent to the International Bureau as soon as the result of examination comes out, and if the notification is sent before the refusal period has passed, this notification will enable holders to confirm the status of international registrations in designated Contracting Parties before 12 months or 18 months have passed[1].

5. Attention should be paid to the fact that one of the reasons for increasing the number of Contracting Parties of the Madrid Protocol is the option of the 18-month period. The option has been introduced so as to induce countries which carry out extensive examination to join the Madrid System. It is not desirable if the number of countries that wish to join the Madrid System decreases because the length of the applicable refusal period has been shortened[2].

6. It should be added that making it compulsory for countries to provide information can become an obstacle to joining the Madrid System, and this situation should be avoided.

[End of Annex and of document]

[1] A similar remark was made by the delegation of the European Community. (see MM/LD/WG/1/3 paragraph 23)

[2] Several similar remarks were made by Contracting Parties. (see MM/LD/WG/1/3 paragraph 22 and 24)