

Panel III:

The Role of the National Intellectual Property Office  
in the Implementation of the Madrid Protocol and  
its Impact on the Office

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1. Impact: JPO's Experience
2. Roles of National IPOs
3. Efforts to Make the System More Attractive

# Impact: JPO's Experience

## Result of User-needs Survey (in 1998)

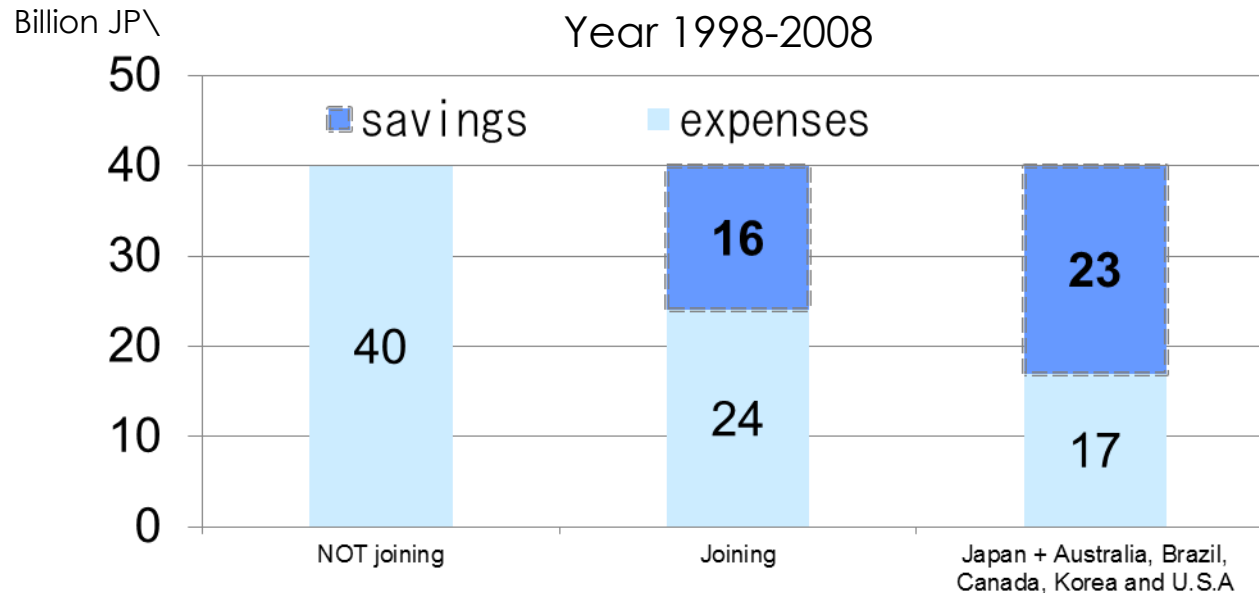
Q1. Do you think Japan's accession to the Protocol would benefit your company?

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?

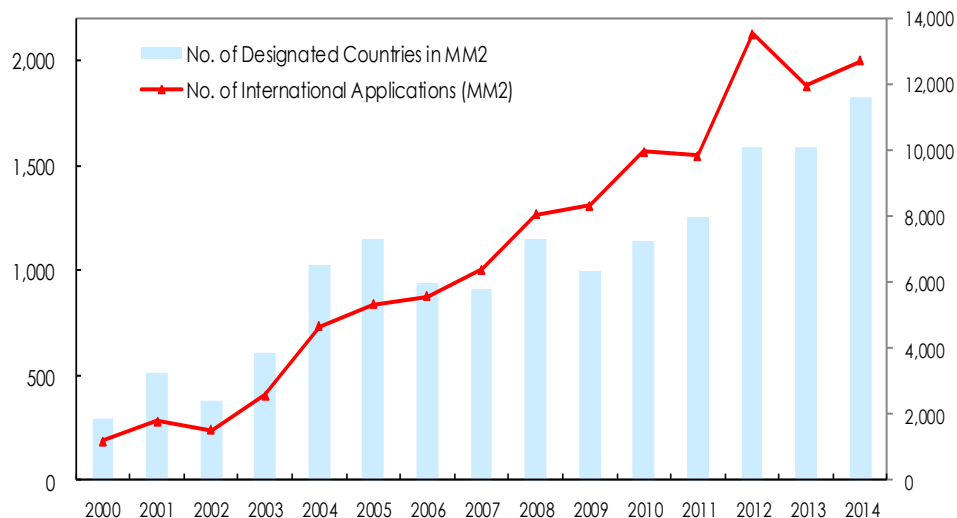
Yes 95% (741 companies)  
No 5% (36 companies)

## Ascertaining the Economic Benefits (as of 1998) - Under assumption of Japan's Accession to the Protocol -



# Impact: The JPO as Office of Origin (OoO)

No. of Int'l Applications (IA)



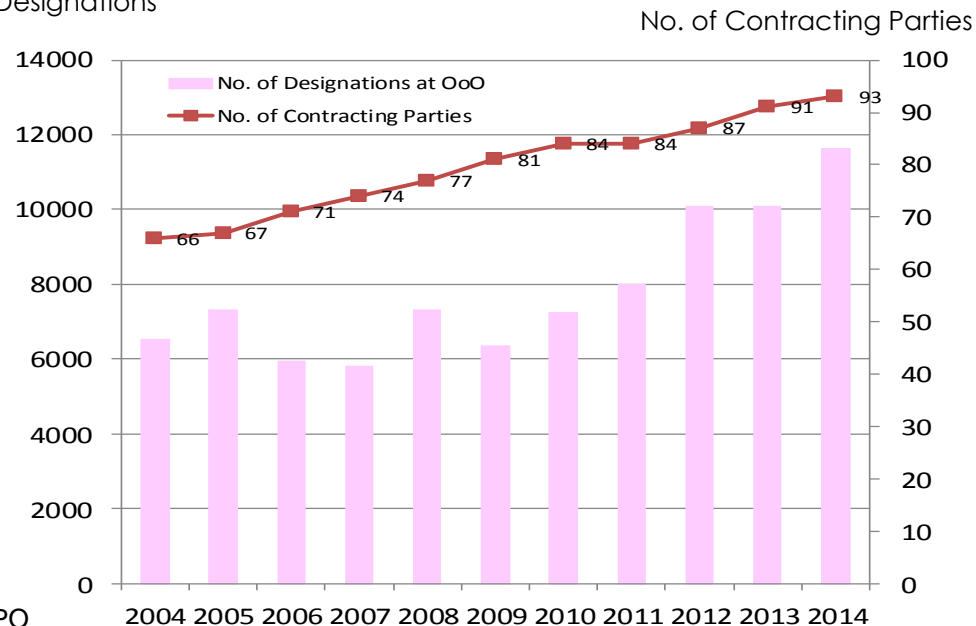
*The more contracting parties we have, the more IAs and designations are filed.*

## To Do at the OoO:

### ➤ Certification of the IAs;

- ✓ Filing date
- ✓ Applicant's name, address, etc.
- ✓ **MARK**; Same as in the basic application/registration?
- ✓ **GOODS & SERVICES**; Fall within the scope of the basic application/registration?
- ✓ Others (e.g. description of the color claimed in the IA, transliteration of the mark )

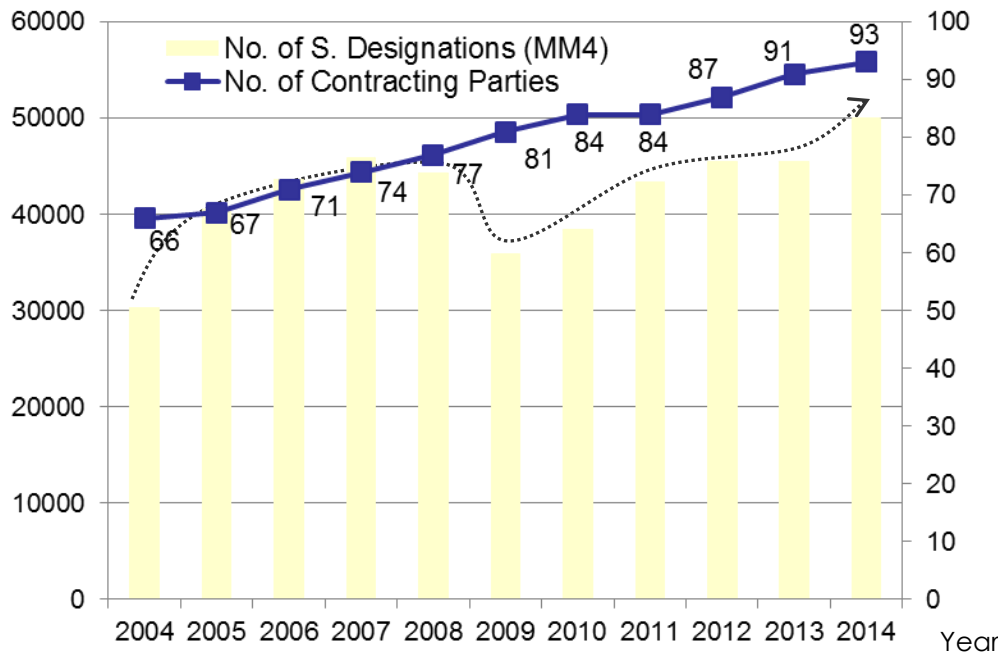
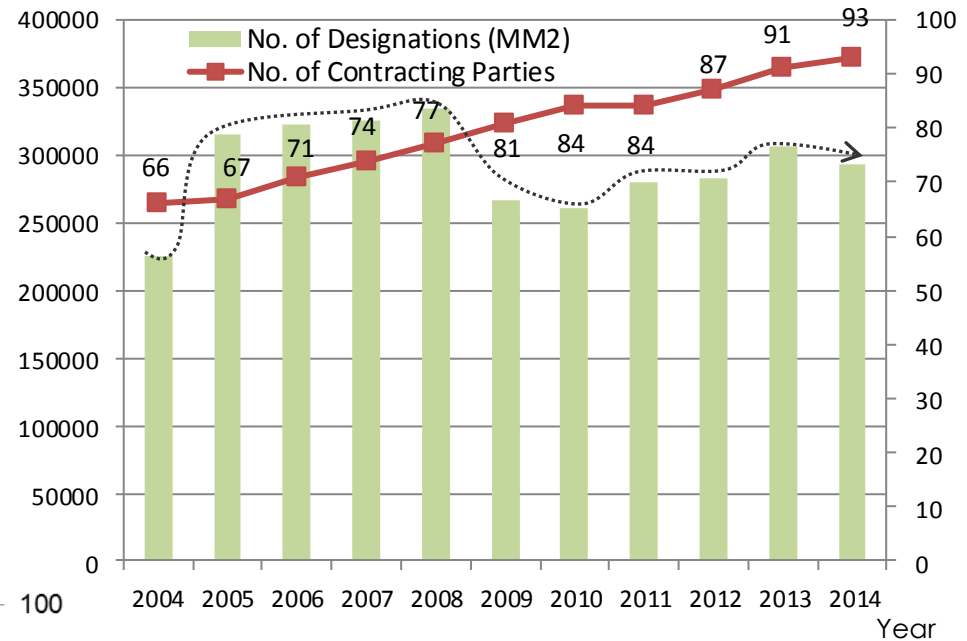
No. of Designations



Source: JPO

# Impact: IAs and Subsequent Designations

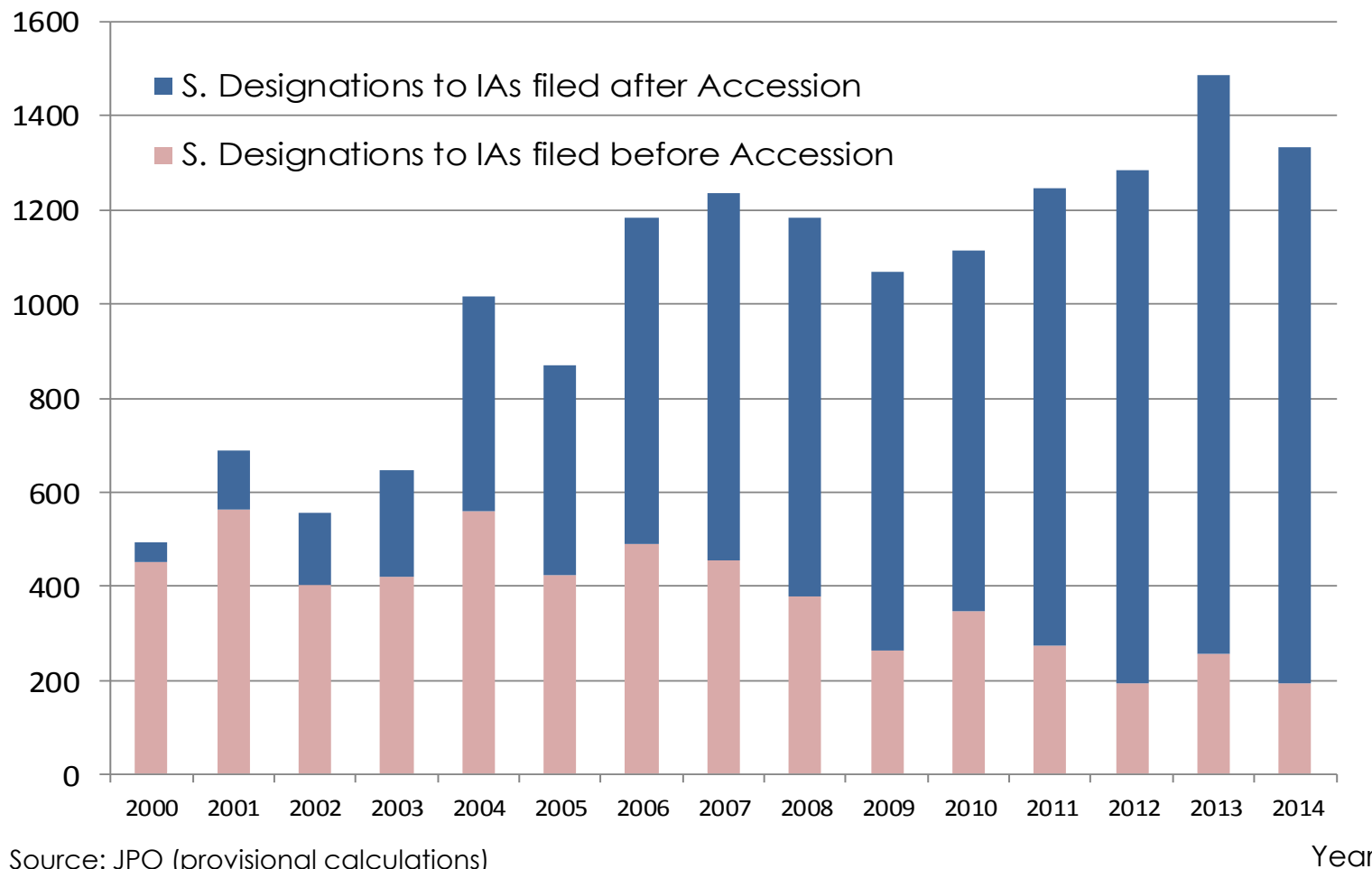
The Number of Contracting Parties, IAs (MM2) and Subsequent Designations (MM4) in the World



The number of MM4s might show a bit more clear correlation with the number of contracting parties. This is probably because the usage of MM4; It extends the international registration to (new) contracting parties.

Source: WIPO Statistics as of Jan. 2015

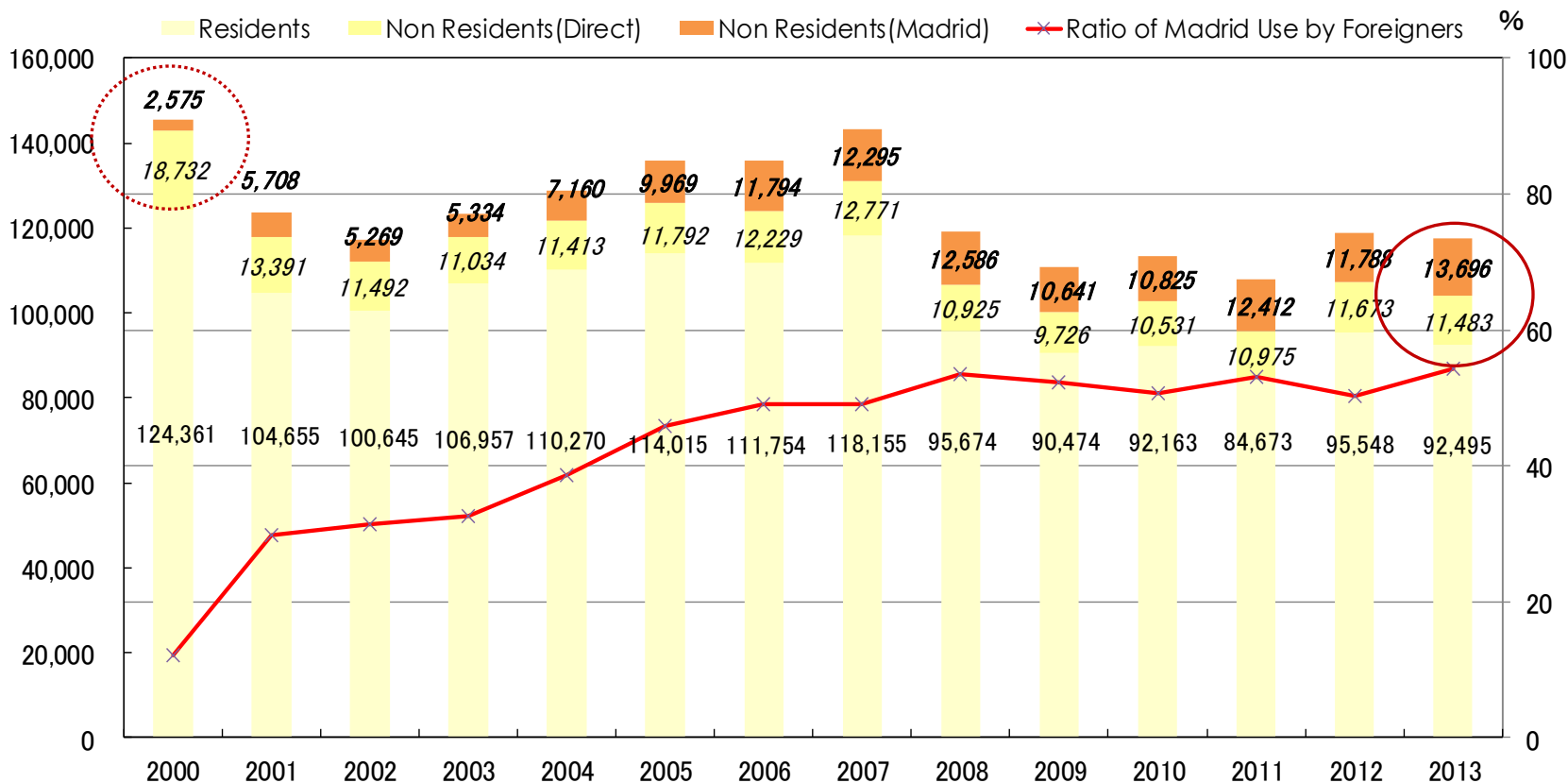
## Subsequent Designations in Japan Based on IAs filed Before/After the Accession to the Protocol



Source: JPO (provisional calculations)

Year

## Residents/Non-Residents and Direct/Madrid Filings in Japan



Source: JPO

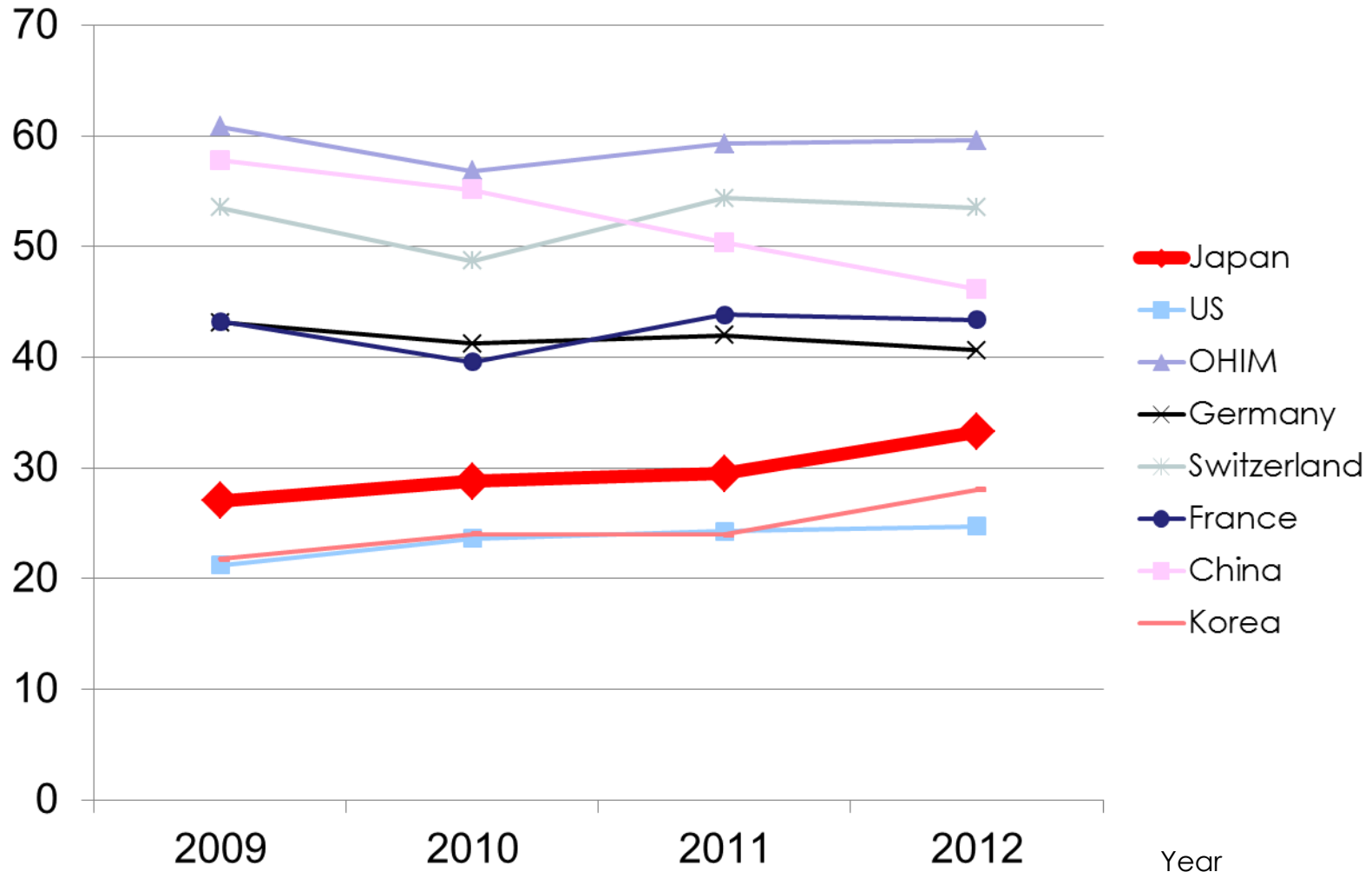
Year

*The Madrid route covers more than 50 % of incoming Trademark applications from outside Japan.*



# Impact: Who Uses the Madrid System Most?

## Ratio of Madrid Use for Filing Foreign Trademark Applications

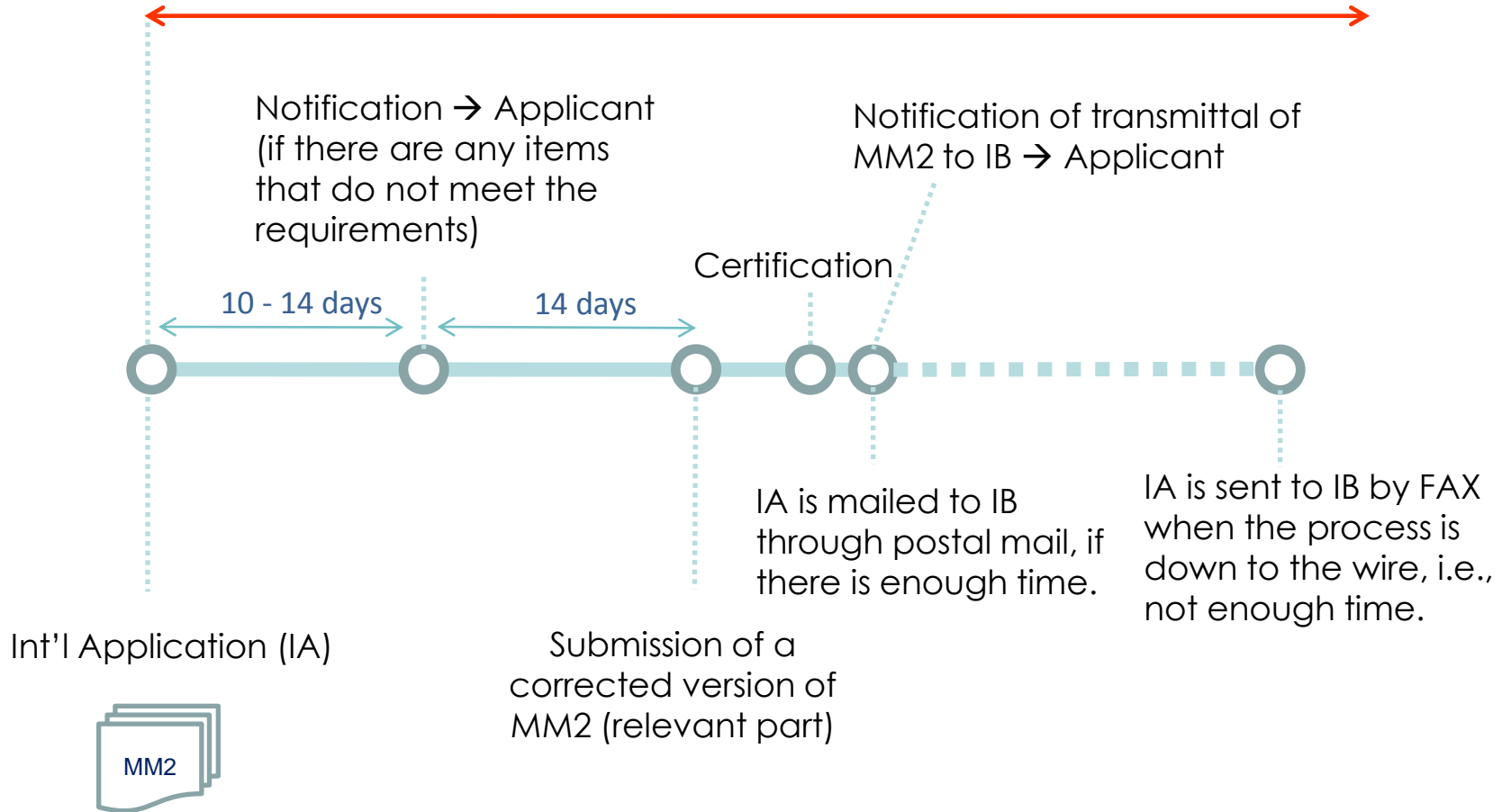


Source: JPO

# Roles of National IPOs

## Certification Process at the JPO as OoO

**2 months**

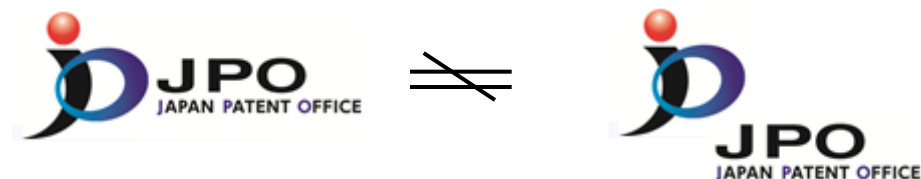


None of the following are considered to be “the same” mark:

Case 1 [Ratio]



Case 2 [Composition]

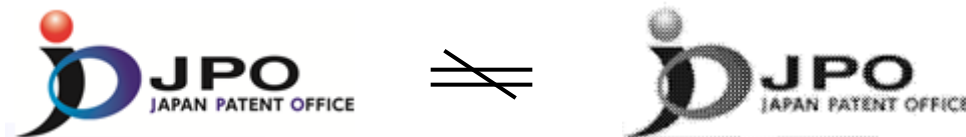


日本国特許庁  
Japan Patent Office  $\neq$  Japan Patent Office

Case 3 [Font]

**Japan Patent Office**  $\neq$  *Japan Patent Office*

Case 4 [Color]

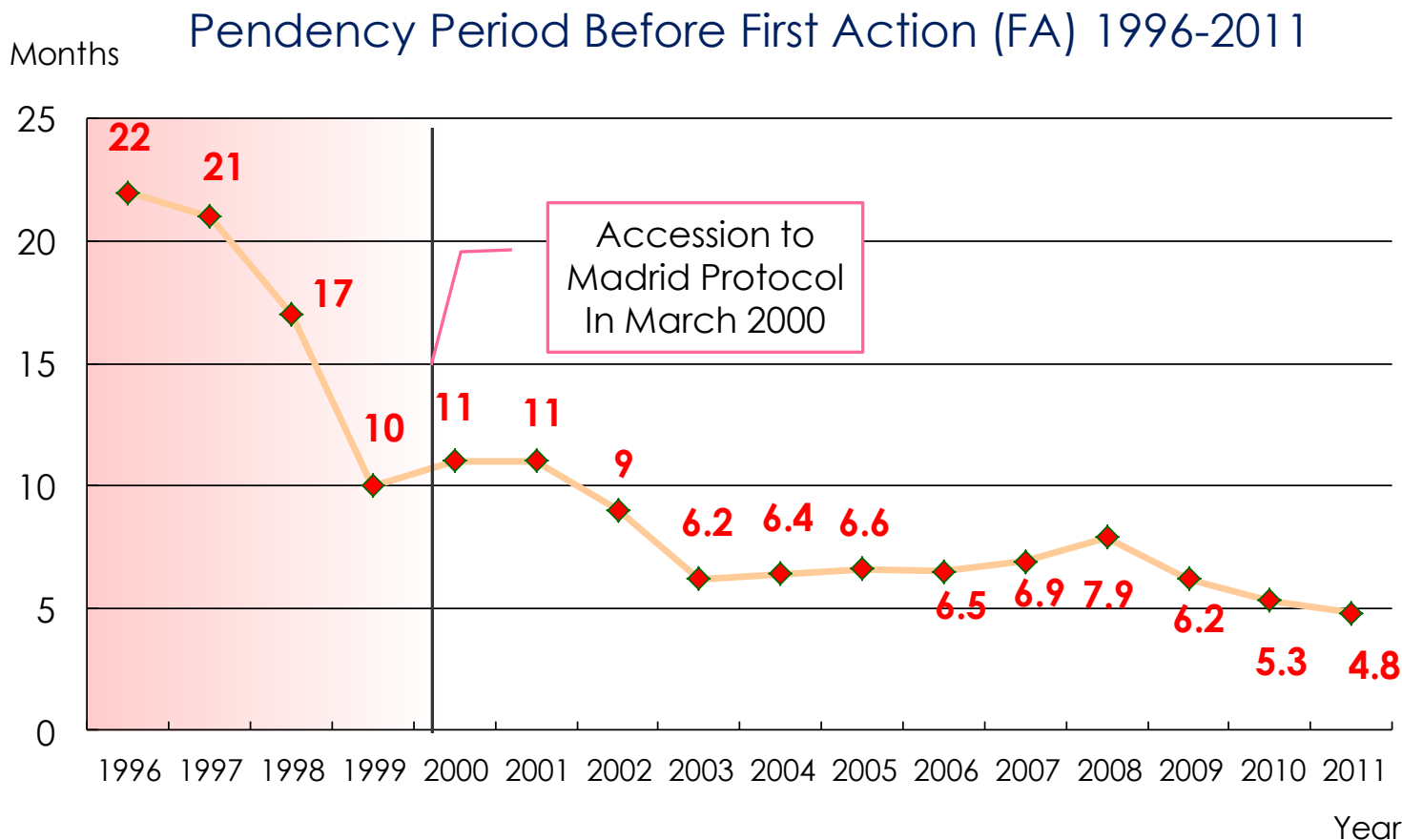


Case 5 [Translation/  
Transliteration]

日本国特許庁  $\neq$  Japan Patent Office

- Article 5(2)(b) of the Protocol:  
extending the refusal period to 18 months

<http://www.wipo.int/madrid/en/madridgazette/remarks/declarations.html>



## What Made It Possible to Shorten the Examination Period?

- ✓ Improved our IT system for examination;
- ✓ Outsourced some of the examination processes;
  - Pre-searches for absolute grounds for refusal
  - Preliminary searches for figurative trademarks
  - Pre-searches on goods and services
- ✓ Hired “new assistants” for examiners;
  - Recruitment of retired examiners
- ✓ Trained examiners

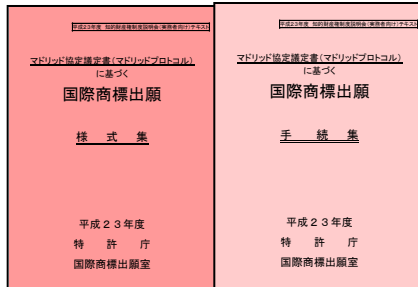
- ✓ Certificate of Trademark Registration
  - Issues a certificate to either the holder or a representative domiciled in Japan after the trademark has been registered in the Trademark Register in the JPO, apart from issuing the “Statement of Grant of Protection”

*Issuing this certificate is not obligatory under the system, although it might enable the trademark right to be enforced in countries where authorities concerned are not familiar with the Madrid system.*

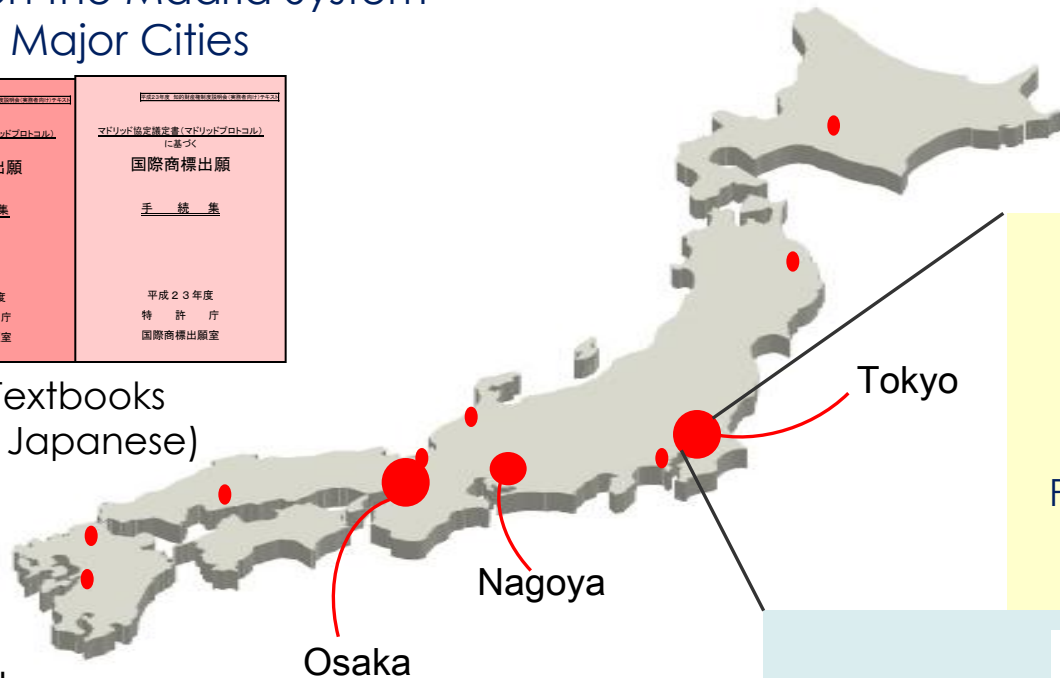


## Customer Support

### Seminars on the Madrid System in Major Cities



Textbooks  
(in Japanese)



Brochure  
(in Japanese)





(190) 【発行国】日本国特許庁 (JP)  
(441) 【公開日】平成25年5月23日 (2013. 5. 23)  
【公報種別】公開国際商標公報  
(210) 【国際登録番号】1148916  
(220) 【国際登録日】平成24年12月21日 (2012. 12. 21)  
(540) 【商標】

## ONE DIRECTION

【標準文字】

(511) 【商品及び役務の区分並びに指定商品又は指定役務】

Class 3

Bleaching preparations and other substances for laundry use; cleaning polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 9

Sound storage media, image storage media and data storage media, all being pre-recorded; exposed films, especially feature films; eyewear, spectacles, sunglasses, refrigerator magnets, covers for music storage devices.

*Language used: an issue to be addressed, in particular, by countries whose languages are not based on the Roman alphabet*

Translations of Goods & Services serve as references for the convenience of examiners (in our internal database) and users (in gazettes)

(511) 【商品及び役務の区分並びに指定商品又は指定役務の訳 (参考)】

第3類

漂白剤その他の洗濯に用いる物質, 清浄剤, つや出し剤, 擦り磨き剤及び研磨剤, せっけん, 香料類及び香水類, 精油, 化粧品, ヘアローション, 歯磨き

第9類

音響記録媒体・映像記録媒体及びデータ記録媒体 (すべて予め記録されたもの), 露光済みフィルム, 特に長編劇映画, 眼鏡類, 眼鏡, サングラス, 冷蔵庫用磁石, 音楽記憶装置のカバー

# Efforts to Make the System More Attractive

## Multilateral / Plurilateral

- ✓ Contribute to Geneva Based Discussions (Madrid Working Group, Committee of Experts on NICE Classification)
- ✓ Launched a Project to “Improve Convenience of Madrid Protocol Applicants by Enriching Information Provision” under the Framework of TM5 (CN, EP, JP, KR, US)
- ✓ Developed TM5 ID List (\*) Tool: <http://oami.europa.eu/ec2/tm5>

\*ID List :

The ID list is composed of some 14,000 pre-approved descriptions of goods and services (IDs) among TM5 , which are associated with the trademarks for which protection is sought.

**TM5**  
five trademark offices



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## Bilateral

- ✓ Measures to Reduce Irregularity Notices with regard to Identifications of Goods & Services: Enriching the Madrid Goods and Service Manager Database (MGS Database)
  - Provides Japanese translations of NICE classifications and indications of Goods & Services recorded in MGS Database with IB
- ✓ Assistance to non-member states for acceding to and implementing the Madrid Protocol , to encourage more membership;
  - Provides training programs, workshops, in particular, for trademark examiners from non-member states, in cooperation with WIPO, and WIPO Funds-in-Trust Japan
- ✓ Cooperation for processing at IB: Fellowship Program
  - Serves as focal point for processing IAs between an Office and IB

WIPO Interregional Seminar on the International Trademark Registration System:  
The Madrid System, in Puebla, Mexico, on March 23-24, 2015

Thank you!  
Gracias !  
Merci !

