



ROLES AND JOBS OF TRADEMARK AGENTS AND SPECIALISTS UNDER THE MADRID SYSTEM AND CREATING JOBS THROUGH THE MADRID SYSTEM

Changes before /after the accession to the Madrid Protocol, etc.

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Roles and jobs of trademark agents and specialists under the Madrid System

Before the accession to the Madrid Protocol

- Necessary to file a national trademark application in each country of interest (except for a few multi-country filing systems, like CTM)
 - Generally, time consuming:
 - High filing costs:
 - Maintenance of any resulting registration in each country:

Roles and jobs of trademark agents and specialists under the Madrid System

After the accession to the Madrid Protocol

Need to consider and choose the best way to protect your client's trademark abroad :

1. The national route: File trademark application with the Trademark Office of each country in which you want protection
2. The regional route: Apply in countries which are members of a regional trademark registration system with effect in all member states (ARIPO, Benelux Trademark Office, OHIM and OAPI)
3. The international route: File through the Madrid System

Roles and jobs of trademark agents and specialists under the Madrid System

National/Regional or Madrid ?

National/Regional

Madrid

File with various national / regional Offices	File with one Office of Origin
Different procedures	One procedure
File in different languages	File in one language
Fees in different currencies	Fees in one currency
Correspond with local representatives	Foreign representative not required unless a refusal is issued
Translation, notarization, legalization, PoA costs (if necessary)	No translation, notarization, legalization, PoA costs
There may be No time limits for objections.	Strict time limits (12 or 18 months) for objections to be raised by the Designated Contracting Parties
Many registrations, many renewal	One international registration, one renewal via the IB
Changes, if any, to be recorded with each national offices	Changes recorded centrally via the IB

Roles and jobs of trademark agents and specialists under the Madrid System

Madrid Route? – other aspects to consider

- Country of interest must be a contracting party
- Basic mark is necessary
- Dependency and Central Attack (Transformation is possible, though)
- Possibility of subsequent designation?
- Nature of Mark
 - fully distinctive even in other jurisdictions ?
 - prior similar marks in possible DCPs?
- The goods/services of interest are listed on Alphabetical List /Goods and Services Manager?

Roles and jobs of trademark agents and specialists under the Madrid System

- The Madrid Route may be the preferred option when
 - an applicant seeks protection in multiple countries;
 - an applicant wants flexibility to add new markets as their export plans develop;
 - an applicant has limited budget and/or time to spend on registration and management of their trademarks; and
 - a mark is not vulnerable

Roles and jobs of trademark agents and specialists under the Madrid System

1. As a representative before OO / IB of WIPO

 Typically, you will be appointed by Cambodian Companies or Individuals

2. As a representative before a Designated Contracting Party

 Typically, you will be appointed by Holders / foreign trademark attorneys who receive a notification of refusal issued by Cambodian Office (DIP)

Roles and jobs - As a representative before OO / IB

(1) Pre-application procedures

- Arranging availability search in possible DCPs and advising on the adoption of the mark
- Whether to use Madrid system, etc.

(2) Registration Procedures

- Preparing and filing MM2, MM4 and other forms
- Receiving and responding to irregularity notification by IB
- Receiving notification of provisional refusals from DCPs and considering how to proceed
- Procedure in case of Opposition

(3) Post-Registration Procedures

- Renewal, Assignment, and/or License Procedure
- Recording change in ownership, change in name and/or address of holder
- Trademark watch in DCPs , etc.

Roles and jobs - before a Designated Contracting Party

(1) Pre-application procedures

- Conducting availability search and advising on the adoption of the mark in your jurisdiction .

(2) Registration Procedures

- Providing legal advice on overcoming Notification of Provisional Refusals
- Preparing and filing response against the Notification of Provisional Refusals
- Procedure in case of Opposition

(3) Post Registration Procedures

- Procedure in case of invalidation/cancellation action
- Sending a reminder to a Holder/its representative informing the deadline of an affidavit of use (?)

Creating Jobs through The Madrid System

Job increase?

- Simple procedure may lead an increase in designated contracting parties.
 - Smaller companies that have in the past had to forgo international trademark protection because it was cost prohibitive may be interested in the Madrid System.
 - Increased designations will create more business opportunities (substantive work);
Pre-searches, response to refusals, oppositions, request for cancellations, dispute settlements, license and assignments contracts, and enforcement
- ⇒ Applicants would need the services of local agents from pre-filing stage to post-registration stage

A few tips to create new jobs through The Madrid System:

How to create an opportunity to contact a holder / a representative before WIPO

1. Providing information on Notification of Provisional Refusal issued by Cambodia Office with an applicant/a representative before WIPO
 - Possible to obtain information on Notification of Refusal issued by a particular office of DCP timely through **“WIPO Gazette of International Mark”** (<http://www.wipo.int/madrid/en/madridgazette/>)
 - You may send such information to an applicant/ a representative before WIPO, and **offer them legal assistance as a local representative**
 - The Gazette is published online **every week on Thursdays**

A few tips to create new jobs through The Madrid System:

How to obtain information on Notification of Refusals recently issued by a Particular DCP

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The WIPO Gazette of International Marks is the official publication of the Madrid System. Every week the International Bureau publishes data regarding new international registrations, renewals, subsequent designations and modifications affecting existing international registrations.

Browse by chapter | Search by Registration Number or Mark or Holder | Frequently Asked Questions (FAQs)

Publication date: Year No.

Summary:

▪ Publication date: No Change

▪ Summary: Select “Notification of Provisional Refusal”

A few tips to create new jobs through The Madrid System:

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Publication date: Year No.

Summary:

State/IGO: Origin Interested Designated

▪ State / IGO: Select a DCP of Interest, (ex. Cambodia)

▪ Check “interested” Box

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Publication date: Year No.

Summary:

State/IGO: Origin Interested Designated

Notifications of provisional refusals

1 - 5 / 5

Mark	IRN	Holder	Origin	Transaction	Gazette
F. Façonnable	1229757	FACONNABLE S.à.r.l.		Refusal	2015 / 52
VINCE	1230411	Vince, LLC		Refusal	2015 / 52
TALACREST	1254203	Talacrest 2000 A.D. Limited		Refusal	2015 / 52
NUTRITION4U BY NUSCIENCE	1254988	Nuscience N.V.		Refusal	2015 / 52
HEALTH4U BY NUSCIENCE	1255913	Nuscience N.V.		Refusal	2015 / 52

1 - 5 / 5

Click "IRN" (International Registration Number)

A few tips to create new jobs through The Madrid System:

How to obtain information on Notification of Refusals recently issued by a Particular DCP

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

WIPO Gazette - Windows Internet Explorer
http://www.wipo.int/madrid/gazette/details.jsp?seq=1&lang=en

Notification of refusal (unless otherwise stated the refusal is subject to review or appeal)

Gazette No. 52/2015 - undefined

Total provisional refusal of protection

[1229757](#) (F. Façonnable)

833. Interested Contracting Party(ies)
JP (Japan)

732. Name and address of the holder of the registration
FACONNABLE S.à.r.l.
25 C, boulevard Royal
Luxembourg (LU (Luxembourg))

811. Contracting State of which the holder is a national
BX (Benelux)

812. Contracting State or Contracting Organization in the territory of which the holder has a real and effective industrial or commercial establishment
BX (Benelux)

842. Legal nature of the holder (legal entity) and State, and, where applicable, territory within that State where the legal entity is organized
Société à responsabilité limitée, Luxembourg

740. Name and address of the representative
MICHEL Arnaud,
Cabinet Gide Loyrette Nouel
A.A.R.P.I.
22 cours Albert 1er
F-75008 Paris (FR (France))

Origin
Refusal
Refusal
Refusal
Refusal
Refusal

Click the PDF Icon, then move to ROMARIN database

Name and address of the holder of the registration.

Name and address of the representative (before OO/ WIPO)

A few tips to create new jobs through The Madrid System:

How to obtain information on Notification of Refusals recently issued by a Particular DCP

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1229757 - F. Façonnable

Full details Summary By office Documents expand all MRS PDF

Only events for Japan are shown

all | granted | refusal | Final decision | No longer designated

AG AL AU BH BY CH CN CO CU CW EG GH IL IN JP KE KR MA MC MG MX MZ NO NZ OM PH RU SG ST SX SY TN
TR UA US VN Display all

151 Date of the registration
19.08.2014

180 Expected expiration date of the registration/renewal
19.08.2024

270 Language of the application
French

Current Status

732 Name and address of the holder of the registration
FACONNABLE S.à.r.l.
25 C, boulevard Royal
L-2449 Luxembourg
(LU)

812 Contracting State or Contracting Organization in the territory of which the holder has a real and effective industrial or commercial establishment
BX

811 Contracting State of which the holder is a national
BX

842 Legal nature of the holder (legal entity) and State, and, where applicable, territory within that State where the legal entity is organized
Société à responsabilité limitée, Luxembourg

740 Name and address of the representative

More than 35 Contracting Parties designated in this International Registration

Select the country of interest, then scroll down to the end of the page.

A few tips to create new jobs through The Madrid System:

How to obtain information on Notification of Refusals recently issued by a Particular DCP

834 Designation(s) under the Madrid Protocol by virtue of Article 9sexies

AL - BY - CH - CN - CU - EG - KE - MA - MC - MZ - RU - UA - VN

527 Indications regarding use requirements

IN - NZ - SG - US

580 Date of recording (date of notification from which the time limit to notify the refusal starts)

10.09.2015

Total provisional refusal of protection : 2015/23 Gaz, 18.06.2015, JP

[PDF](#) JP

450 Publication number and date

2015/23 Gaz, 18.06.2015

580 Date of notification

18.06.2015

Date of receipt by the International Bureau

04.06.2015

Total provisional refusal of protection : 2015/52 Gaz, 07.01.2016, JP

[PDF](#) JP

450 Publication number and date

2015/52 Gaz, 07.01.2016

580 Date of notification

22.12.2015

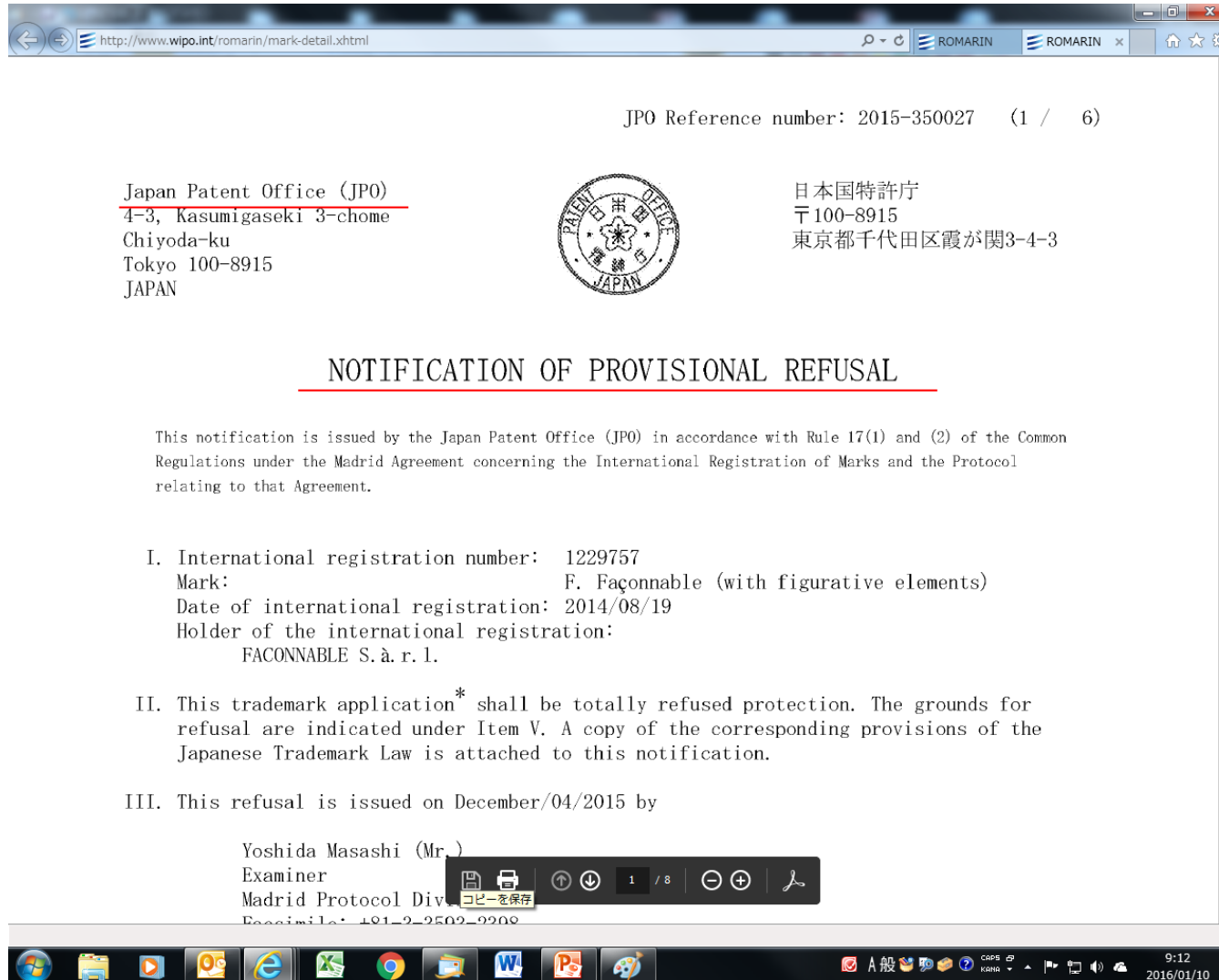
Date of receipt by the International Bureau

17.12.2015

Click the PDF icon

A few tips to create new jobs through The Madrid System:


How to obtain information on Notification of Refusals recently issued by a Particular DCP



http://www.wipo.int/romarin/mark-detail.xhtml

JPO Reference number: 2015-350027 (1 / 6)

Japan Patent Office (JPO)
4-3, Kasumigaseki 3-chome
Chiyoda-ku
Tokyo 100-8915
JAPAN



日本国特許庁
〒100-8915
東京都千代田区霞が関3-4-3

NOTIFICATION OF PROVISIONAL REFUSAL

This notification is issued by the Japan Patent Office (JPO) in accordance with Rule 17(1) and (2) of the Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol relating to that Agreement.

I. International registration number: 1229757
Mark: F. Façonnable (with figurative elements)
Date of international registration: 2014/08/19
Holder of the international registration:
FACONNABLE S.à.r.l.

II. This trademark application* shall be totally refused protection. The grounds for refusal are indicated under Item V. A copy of the corresponding provisions of the Japanese Trademark Law is attached to this notification.

III. This refusal is issued on December/04/2015 by

Yoshida Masashi (Mr.)
Examiner
Madrid Protocol Div.
Facsimile: +81-3-2502-9208

9:12
2016/01/10

A few tips to create new jobs through The Madrid System:

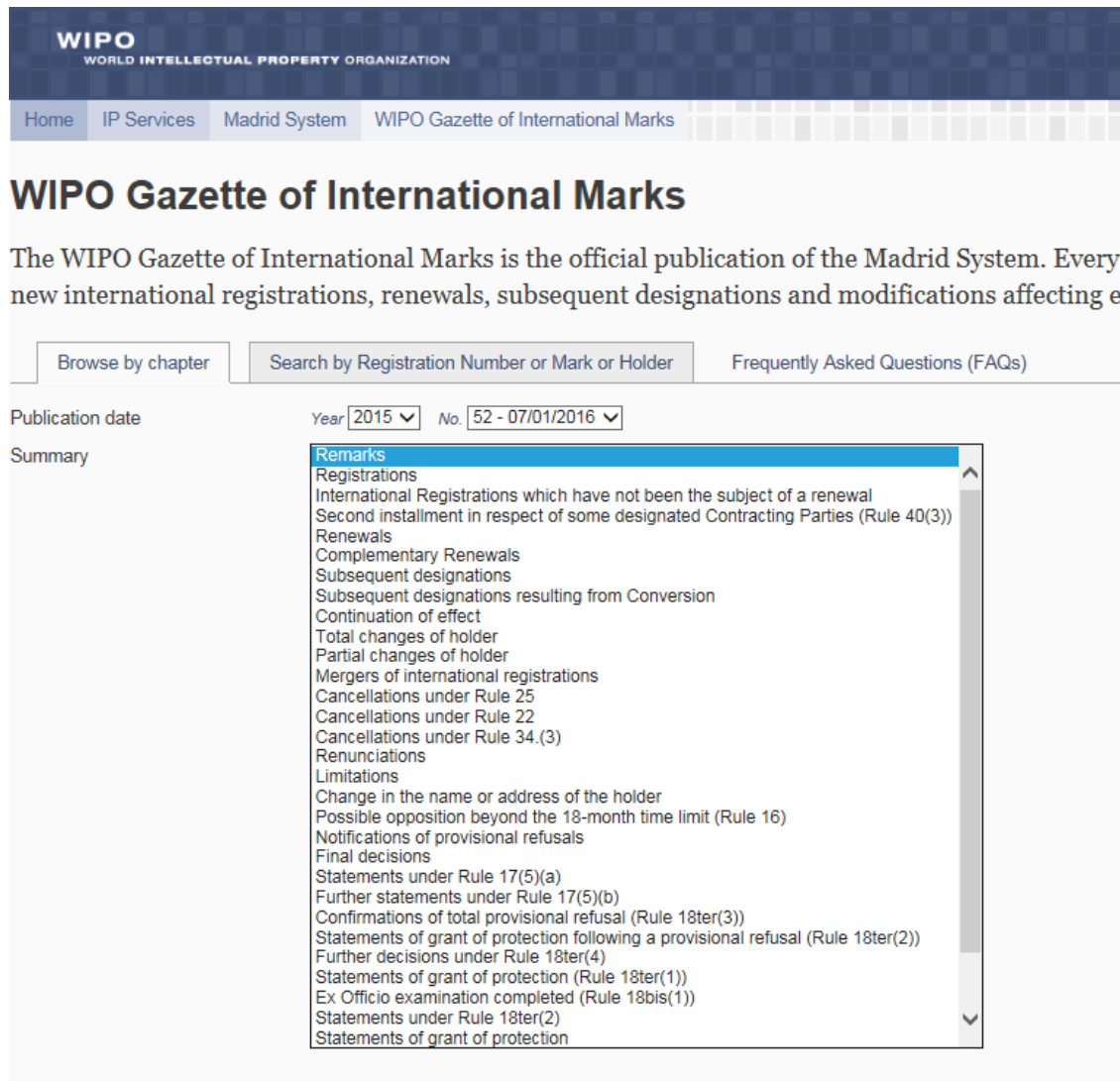
How to create an opportunity to contact a holder / a representative before WIPO

2. Providing information on special requirements in your country under Madrid System with an applicant/a representative before WIPO.

- Some countries have Maintenance Requirement even under Madrid System (ex. US, Philippines)
- Cambodia will also require a holder to submit an affidavit of use or an affidavit of non-use, but high possibility that the holder has not appointed a representative in Cambodia
- You may send a reminder letter to a holder /representative before WIPO, and **offer them legal assistance as a local representative**

A few tips to create new jobs through The Madrid System:

How to create an opportunity to contact a holder / a representative before WIPO



The screenshot shows the WIPO Gazette of International Marks website. The header includes the WIPO logo and navigation links for Home, IP Services, Madrid System, and WIPO Gazette of International Marks. The main heading is "WIPO Gazette of International Marks". Below this, a description states: "The WIPO Gazette of International Marks is the official publication of the Madrid System. Every new international registrations, renewals, subsequent designations and modifications affecting e:". There are three search filters: "Browse by chapter", "Search by Registration Number or Mark or Holder", and "Frequently Asked Questions (FAQs)". The search results are filtered by "Year" (2015) and "No." (52 - 07/01/2016). A "Summary" section is visible, and a scrollable list of "Remarks" is shown, including: Registrations, International Registrations which have not been the subject of a renewal, Second installment in respect of some designated Contracting Parties (Rule 40(3)), Renewals, Complementary Renewals, Subsequent designations, Subsequent designations resulting from Conversion, Continuation of effect, Total changes of holder, Partial changes of holder, Mergers of international registrations, Cancellations under Rule 25, Cancellations under Rule 22, Cancellations under Rule 34.(3), Renunciations, Limitations, Change in the name or address of the holder, Possible opposition beyond the 18-month time limit (Rule 16), Notifications of provisional refusals, Final decisions, Statements under Rule 17(5)(a), Further statements under Rule 17(5)(b), Confirmations of total provisional refusal (Rule 18ter(3)), Statements of grant of protection following a provisional refusal (Rule 18ter(2)), Further decisions under Rule 18ter(4), Statements of grant of protection (Rule 18ter(1)), Ex Officio examination completed (Rule 18bis(1)), Statements under Rule 18ter(2), and Statements of grant of protection.

Through WIPO Gazette of International Marks,

- Registration,
- Statements of Grant of Protection (Rule 18ter (1)),
- Statements of Grant of Protection following a provisional refusal (Rule 18ter (2)), etc.

can be searched.

Most commonly used Forms

MM2	International application* (MM17 and/or MM18 may be attached)	OO only
MM4	Designation subsequent to the international registration (MM17 and/or MM18 may be attached)	OO or IB
MM5	Request for the recording of a change in ownership	OO or IB
MM6	Request for the recording of a limitation of the list of goods and services	IB only
MM7	Request for the recording of a renunciation	IB only
MM8	Request for the recording of a cancellation of the international registration	IB only
MM9	Request for the recording of a change in name and/or address of the holder	IB only
MM10 (optional)	Request for the recording of a change in name and/or address of the representative	IB only
MM11 (optional)	Renewal of the international registration	OO or IB
MM12 (optional)	Appointment of a representative	IB only

* Forms MM1 and MM3 (international application forms) are no longer used.

Forms attached to MM2/MM4 (if necessary)

MM17

- If the **European Union** is designated and when the applicant claims seniority from earlier registrations, the MM17 form will need to be filled in and attached to MM2 or MM4.

MM18

- If the **United States of America** is designated, the MM18 form (declaration of intention to use the mark) will need to be filled in and attached to MM2 or MM4.



Thank you
for your attention

Contact:
Tadafumi Itagaki (Isshiki & Co.)
E-mail: itagaki@isshiki.com
Web: <http://www.isshiki.com/index.html>