

The Role of National IP Offices in Promoting the Strategic Use of the Madrid System

Atsuko SATO

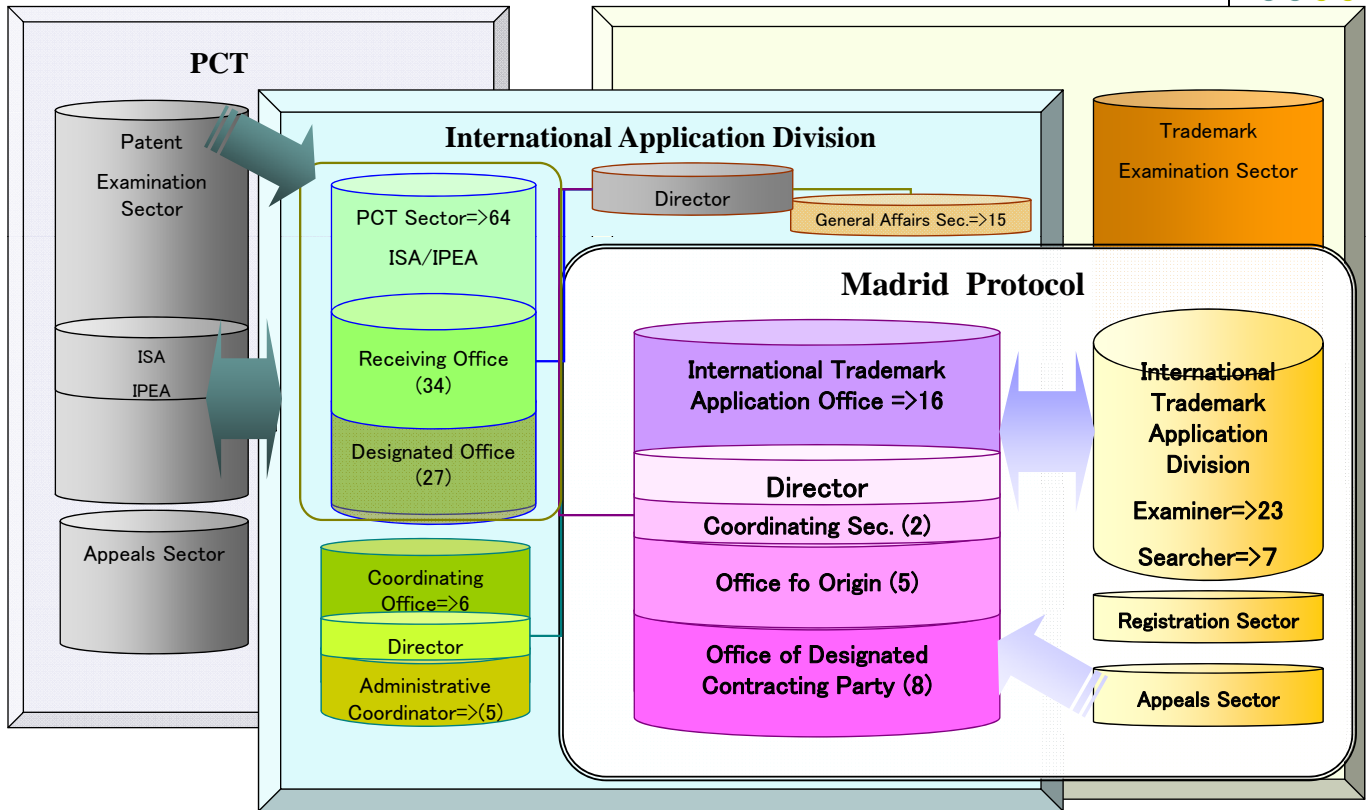
International Trademark Application Office
Japan Patent Office

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Outline

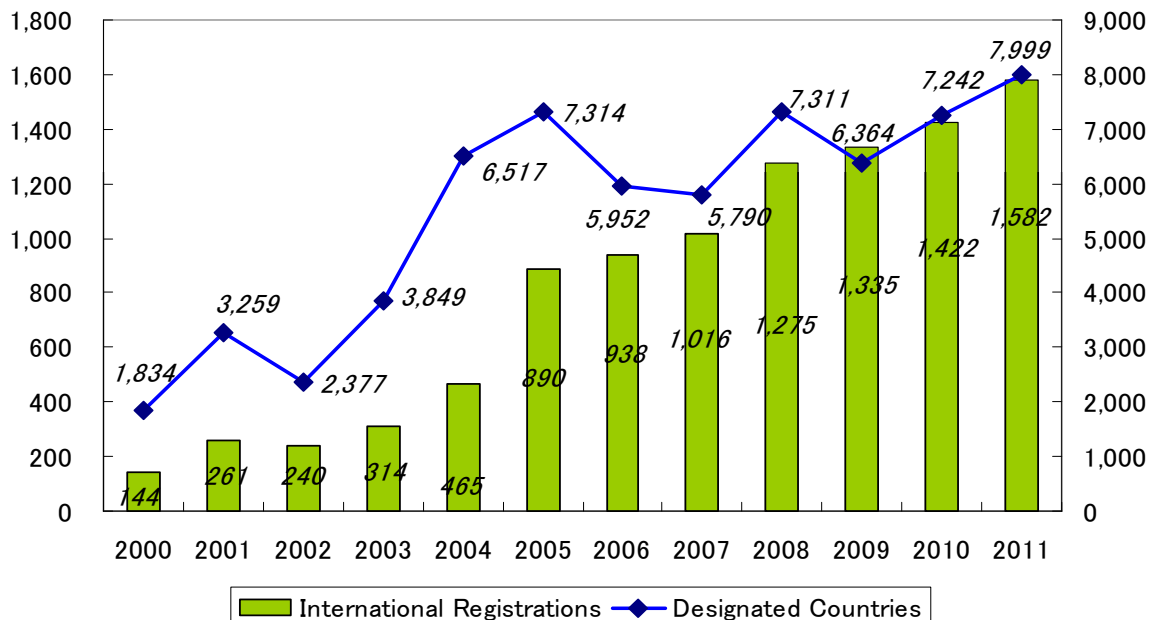
- **International Trademark Application Office of the JPO**
- **Statistics**
- **Main Roles of the JPO as the Office of Origin and Designated Office**
- **JPO's Efforts to Promote the Use of the Madrid Protocol among Applicants**
- **JPO's Efforts to Increase Utilization of the Madrid System**
- **Summary**

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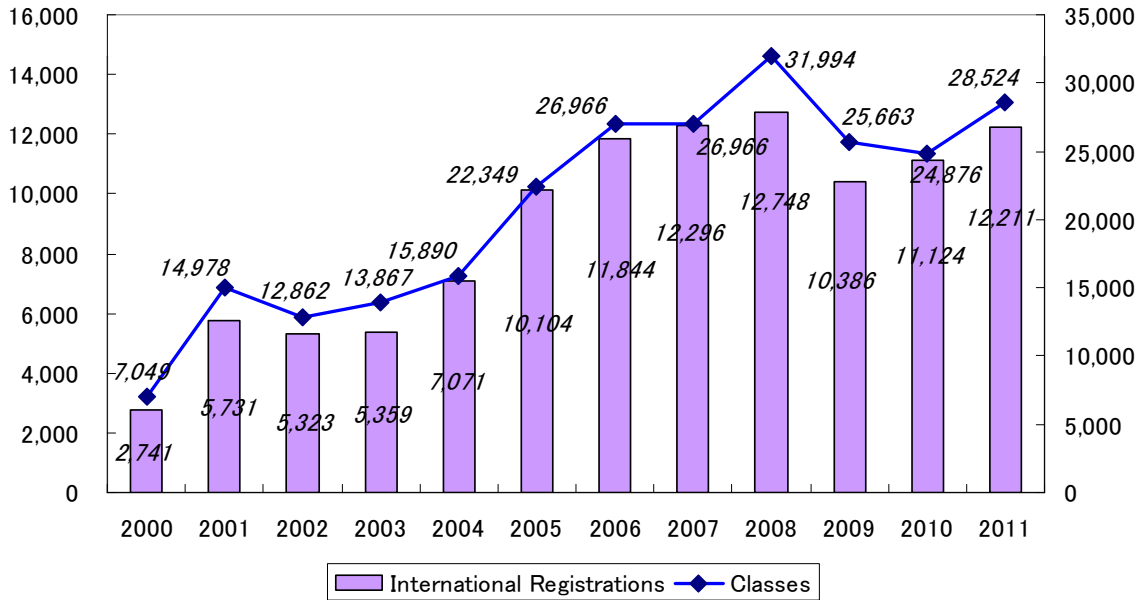


Statistics

International Trademark Applications — Office of Origin —



International Trademark Applications
— Number of Designations per Contracting Party —

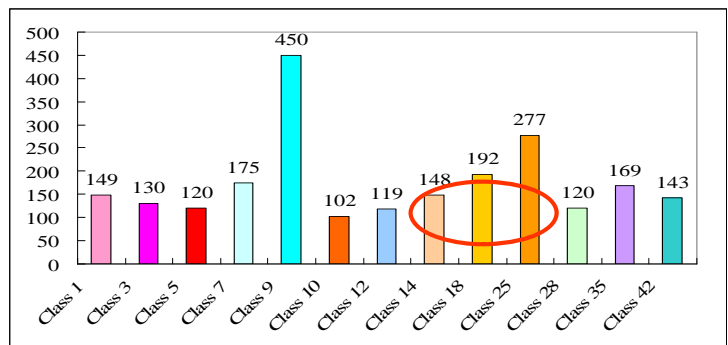


International Trademark Applications Originating from Japan

	Goods and Services	
Class 1	Chemicals,	9.4%
Class 3	Cleaning and toilet preparations	8.2%
Class 5	Pharmaceutical preparations	7.6%
Class 7	Machines	11.1%
Class 9	Apparatus and instruments for scientific, computer software.	28.4%
Class 10	Medical apparatus	6.4%
Class 12	Vehicles	7.5%
Class 14	Jewelry	
Class 18	bags, umbrellas	39.0%
Class 25	clothing, footwear, headgear	
Class 28	Games and playthings	7.6%
Class 35	Advertising, retail services or wholesale services	10.7%
Class 42	Design and development of computer hardware and software	10.7%

Top 3 Designated Counties(2011)

	Country	Designations
1	China	1,199
2	South Korea	928
3	U.S.	839



➤ Main Roles of the JPO as an Office of Origin:

The JPO receives an International Application, conducts a formality check, and forwards it to the WIPO,

- certifying that the applicant in the International application is the same as that in the basic application/ registration,
- certifying that the mark, color and other details in the International application are the same as those in the basic application/ registration,
- certifying that the goods and services in the International application are covered by the list of goods and services in the basic application/registration; and,
- certifying the date of receipt of the international application.

The JPO monitors the application, giving notification relating to Cease in Effect of the basic application/registration.

➤ Main Roles of the JPO as the Designated Office:

The JPO examines the international registration in the same way as it does for an application filed directly with the JPO. Any provisional refusal must be notified to the WIPO within 18 months.

➤ How do Japanese (non-native speakers of English) make use of the Madrid Protocol System?

2007 User Report on the Current Status of Utilization of the Madrid Protocol System

- Explanatory meetings

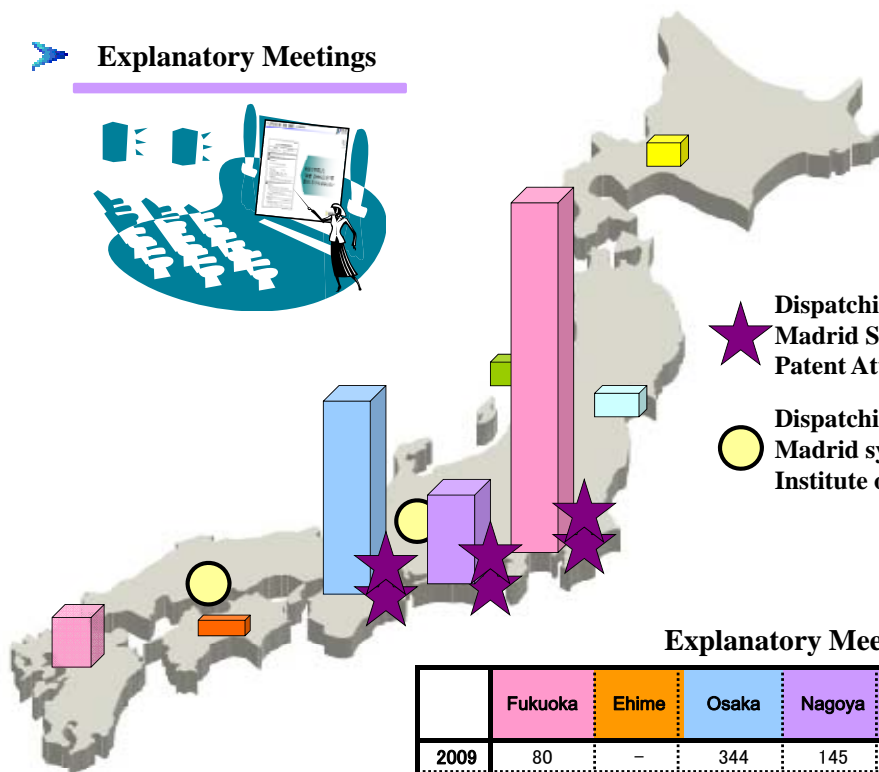
- Support and consultation to Japanese users of the Madrid System

- Website content and publications explaining the Madrid Protocol

- Information and consultation on how to respond to irregularly notices

- Research reports on member countries' national trademark systems (Manuals detailing national and regional procedures; and ways to respond to provisional refusals)

➤ Explanatory Meetings

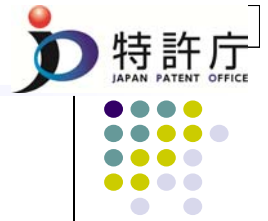


- ★ Dispatching of JPO staff to give the lecture on the Madrid System at seminars by organized Japan Patent Attorney's Association (JPAA)
- Dispatching of JPO staff to give the lecture on the Madrid system at seminar by organized Japan Institute of Invention and Innovation (JIII)

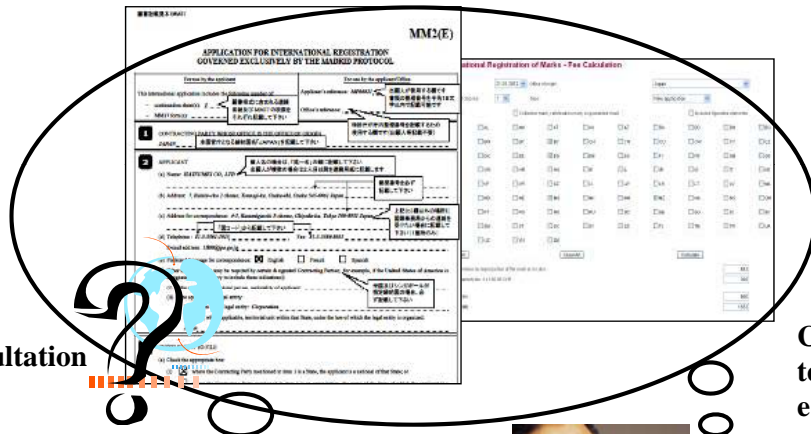
Explanatory Meetings by JPO

	Fukuoka	Ehime	Osaka	Nagoya	Tokyo	Sendai	Niigata	Sapporo
2009	80	-	344	145	780	-	-	-
2010	90	22	630	302	1305	-	32	38
2011	88	-	423	204	665	28	-	25

JPO's Efforts to Promote the Use of the Madrid Protocol among Applicants



Support and consultation to Japanese users of the Madrid System



Face-to-face consultation

Consultation by telephone, FAX, and e-mail



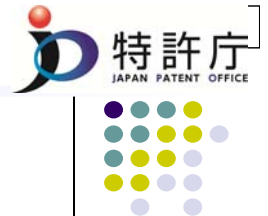
9:00a.m – 5: 00p.m



9:00a.m – 6:15p.m



JPO's Efforts to Promote the Use of the Madrid Protocol among Applicants



Website and publications explaining the Madrid Protocol

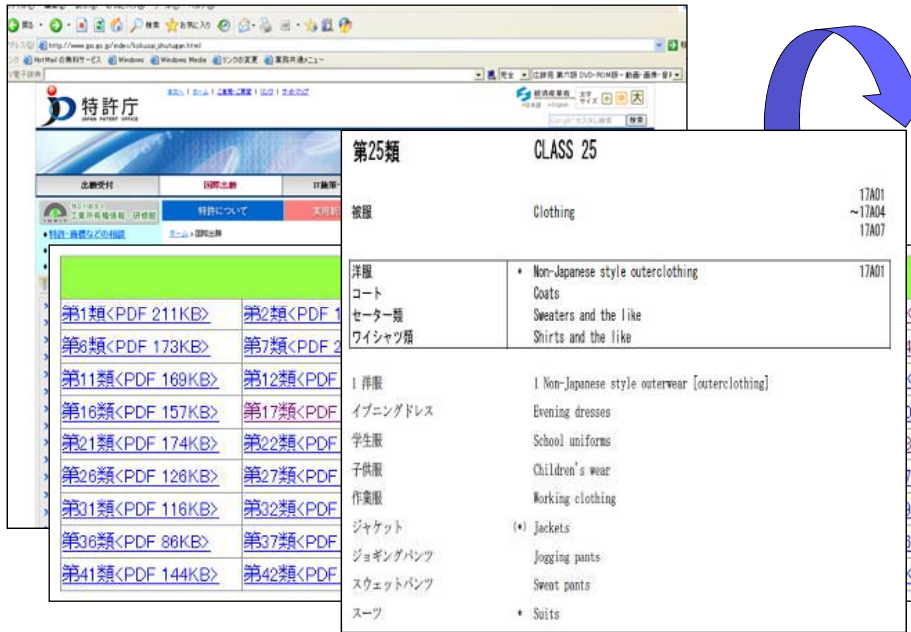
- What is the Madrid Protocol?
- How do I protect my trademarks overseas?

The collage includes:

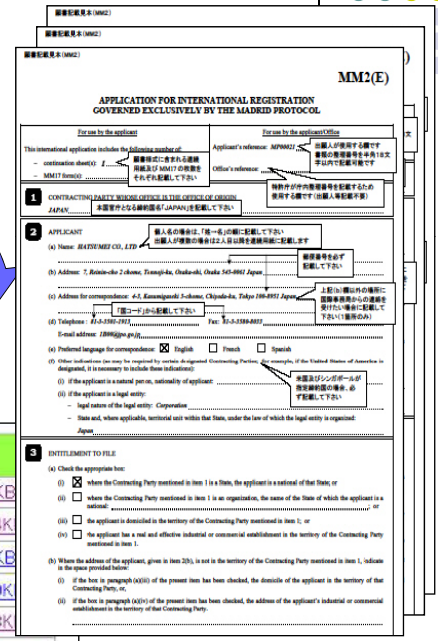
- A screenshot of the JPO website's 'International Registration' section.
- A screenshot of the WIPO Trademarks Gateway website with a blue arrow pointing to it from the JPO website.
- A document from the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks, dated April 11, 2010.

Website and publications explaining the Madrid Protocol

- How do I prepare a MM2
- How do I indicate goods and services in English?



第25類	CLASS 25	17A01 ~17A04 17A07
洋服	Clothing	
コート	Non-Japanese style outerclothing	17A01
セーター類	Coats	
ワイシャツ類	Sweaters and the like	
	Shirts and the like	
1 洋服	1 Non-Japanese style outerwear [outerclothing]	
イブニングドレス	Evening dresses	
学生服	School uniforms	
子供服	Children's wear	
作業服	Working clothing	
ジャケット	(*) Jackets	
ジョギングパンツ	Jogging pants	
スウェットパンツ	Sweat pants	
スーツ	Suits	



MM2(E)
APPLICATION FOR INTERNATIONAL REGISTRATION GOVERNED EXCLUSIVELY BY THE MADRID PROTOCOL

Form to be filled by the applicant

Form to be filled by the applicant

1 CONTRACTING PARTY: JPO OFFICE IN THE OFFICE OF RECORD JAPAN

2 APPLICANT

(a) Name: SEITESSAI CO., LTD.

(b) Address: 7, Bldg-2e 2-206, Tsuzuki-4, Ohta-ku, Osaka 545-0862 Japan

(c) Address for correspondence: 40, Kamagishi 1-chome, Chiyoda-ku, Tokyo 100-8552 Japan

(d) Telephone: 81-3-3582-2822 Fax: 81-3-3582-8857

(e) E-mail address: JPM@jpo.go.jp

(f) Preferred language for correspondence: English French Spanish

3 ENTITLEMENT TO FILE

(a) when the Contracting Party mentioned in item 1 is a firm, the applicant is a resident of that State; or

(b) when the Contracting Party mentioned in item 1 is an organization, the name of the State of which the applicant is a resident;

(c) when the applicant is domiciled in the territory of the Contracting Party mentioned in item 1; or

(d) when the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party mentioned in item 1.

(Preparing a MM2)

Website and publications explaining the Madrid Protocol

Japanese-language manuals and international forms

Website (JPO)

Textbooks (Japanese)

Brochure (Japanese)

平成22年度 知的財産権制度説明会(実務者向けテキスト)

マドリッド協定議定書(マドリッドプロトコル)に基づく
国際商標出願
様式集

平成23年度
特許庁
国際商標出願室


平成22年度 知的財産権制度説明会(実務者向けテキスト)

マドリッド協定議定書(マドリッドプロトコル)に基づく
国際商標出願
手続集

平成23年度
特許庁
国際商標出願室

Research reports on member countries' national TM systems

2010 CN,EM,KR,SG,US
2011 AU,CH,GB,RU,VN
2012 DE,FR,IS,NO,ES



マドリッド出願利用のメリット

1. 出願書類の作成が簡単でわかりやすい

2. 出願手続が簡単



マドリッド出願制度に基づく商標の国際登録申請

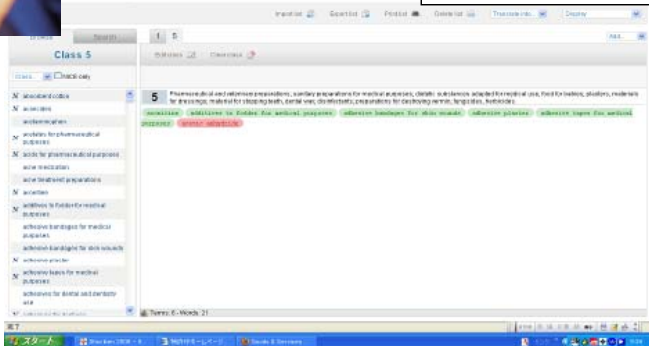
商標の国際登録活用ガイド

本ガイドは、商標の国際登録申請の手続き、費用、効果、留意点などを詳しく説明しています。



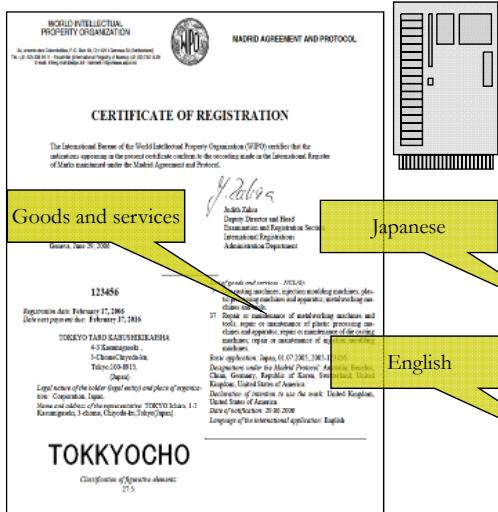
JPO's Efforts in Promote the Use of the Madrid Protocol among Applicants

Information and consultation on how to respond to irregularly notices



JPO's Efforts to Promote the Use of the Madrid Protocol among Applicants

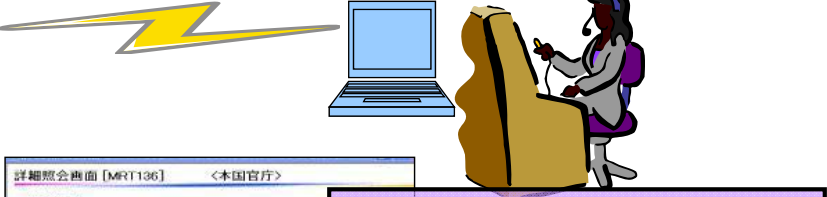
Terms of designated goods and services accepted by the JPO and the WIPO both



Goods and services

Japanese

English



Database table of goods and services terms both Japanese and English

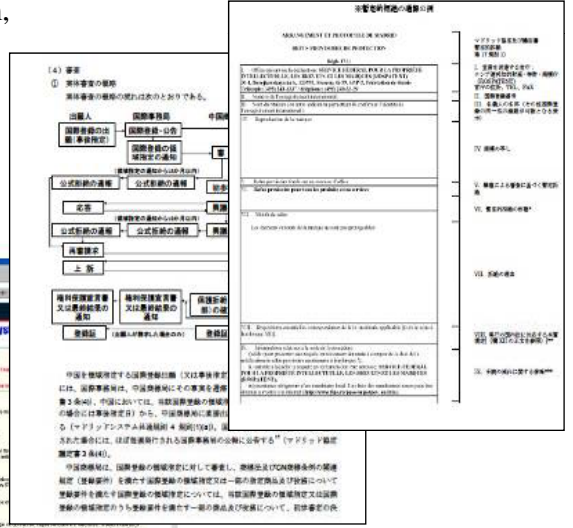


品名/役務名(英)	区分	品名/役務名(日)	区分
Providing information on newspaper articles	10	新聞記事情報の提供	10
Publication of information on newspaper articles	10	新聞記事情報の提供	10
Publication of information on newspaper articles	10	新聞記事情報の提供	10
Subscriptions (Arranging newspaper -) for others	10	新聞の予約購読の取次ぎ	10
Subscriptions (Arranging newspaper -) for others	10	新聞の予約購読の取次ぎ	10
electronic publications of music, images, video images, sounds, text, character data of magazines, books, newspapers, mass, pictures and drawings	09	電子出版物	09
electronic publications of music, images, video images, sounds, text, character data of magazines, books, newspapers, mass, pictures and drawings	09	電子出版物	09
entrusted delivery of newspapers	10	委託による新聞等の配達	10
entrusted delivery of newspapers	10	委託による新聞等の配達	10
printed matter, namely, magazines, books, newspapers, newsletters, textbooks, atlases, calendars, periodicals, almanacs and bulletins	16	印刷物	16
printed matter, namely, magazines, books, newspapers, newsletters, textbooks, atlases, calendars, periodicals, almanacs and bulletins	16	印刷物	16

Research reports on member countries' national trademark systems

Manuals detailing national and regional procedures; and ways to respond to Provisional Refusals

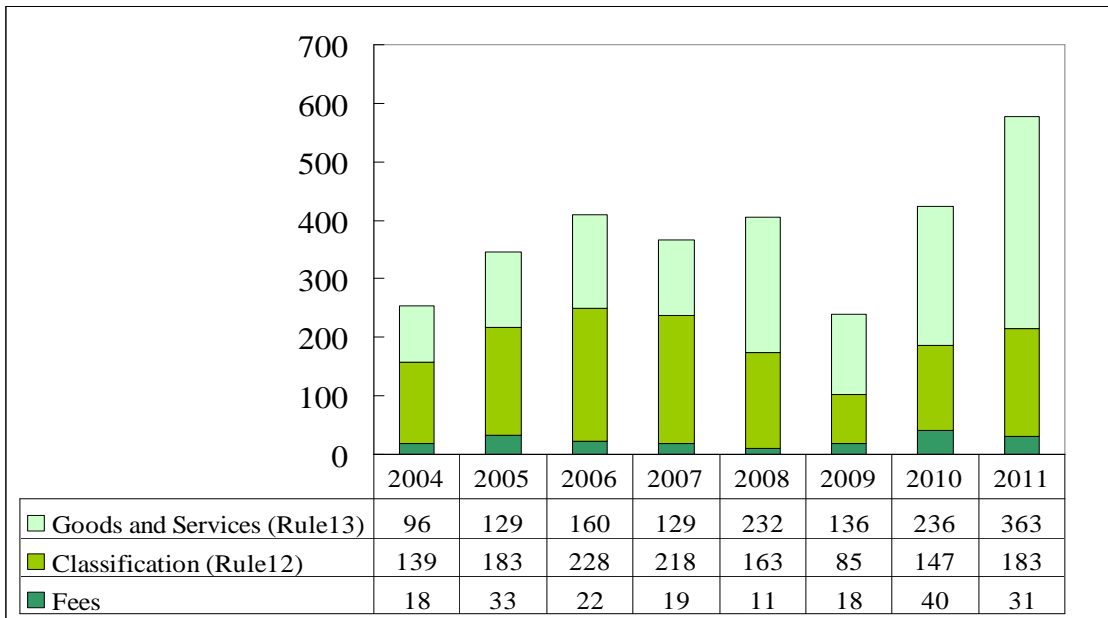
- 2010 China, European Union, Republic of Korea, Singapore, United States of America,
- 2011 Australia, Switzerland, United Kingdom, Russia, Vietnam,
- 2012 Germany, France, Iceland, Norway, Spain,



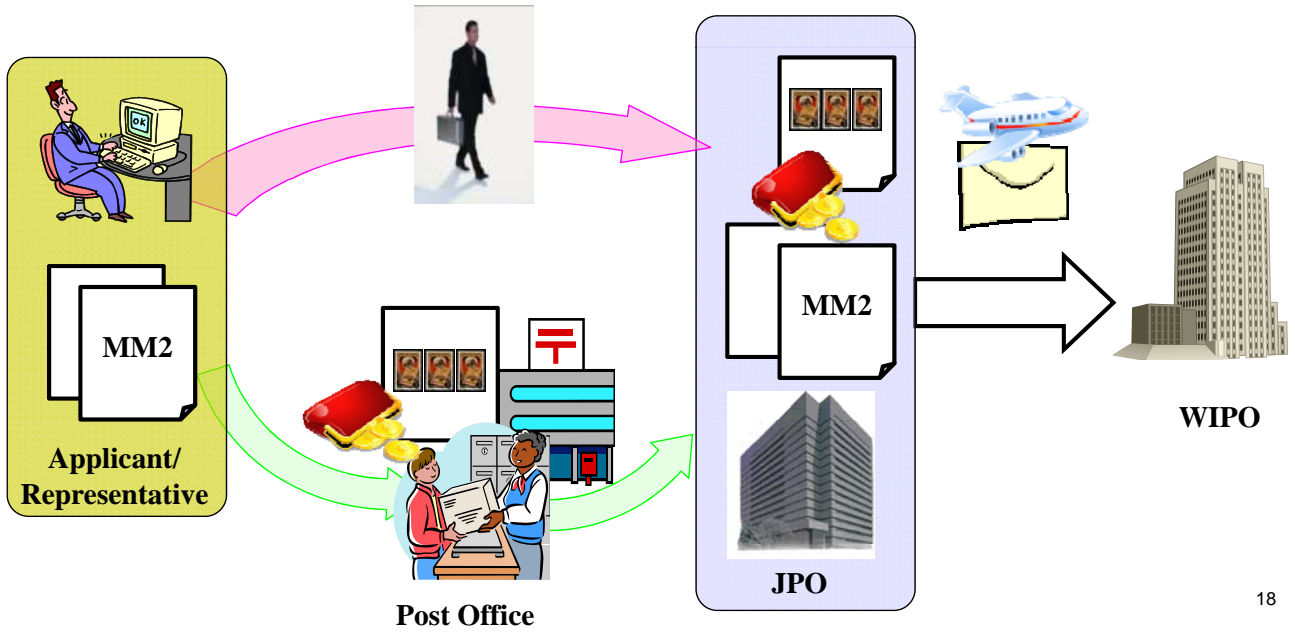
Trademark Electronic Application System (TEAS)の Response Form
(http://www.uspto.gov/teas/eTEASpage.htm)

Issues to be solved as the office of origin

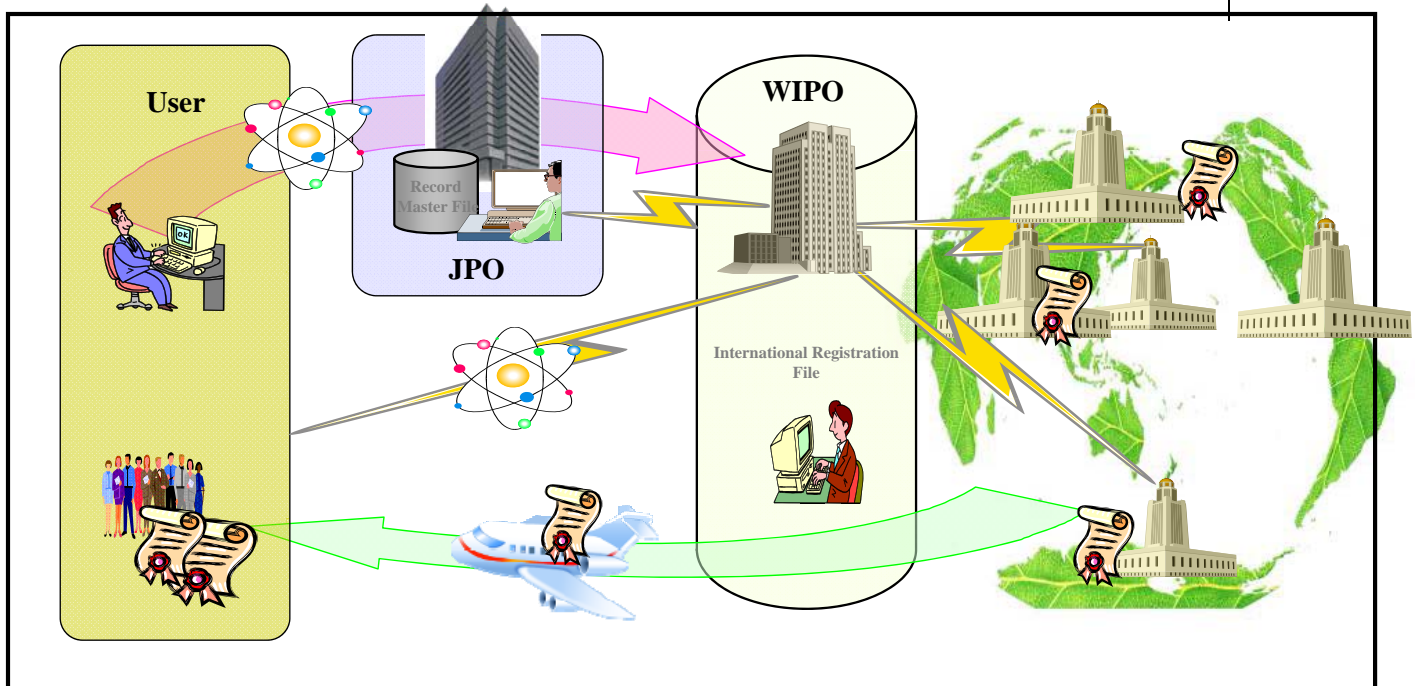
Number of applicants (filing with JPO) receiving irregularity notices from the WIPO



➤ User files an International Application with the JPO in person



➤ Issues to be solved





- **Explanation of the Madrid System to promote user understanding and utilization of the system**
- **JPO-provided user support for preparing application forms and responding to IB's irregularity notices**
- **Improvement in communication between the JPO and the WIPO Team 3 (sending staff members and receiving trainees)**
- **Accumulation and analysis of the terms of designated goods and services accepted under the Japanese Trademark Examination Standard, which are subject to irregularities**
- **Support for translating terms of goods and services accepted under the Japanese Trademark Examination Standard; and cooperating with the WIPO to reduce the number of irregularity notices**
- **Preparation of research reports on member countries' national trademark systems**
- **Gathering of user needs based on meetings with users; and compiling of reports on current status of Madrid System utilization**
- **Future implementation of an electronic filing system for international applications, with function to support users in preparing international application forms**