



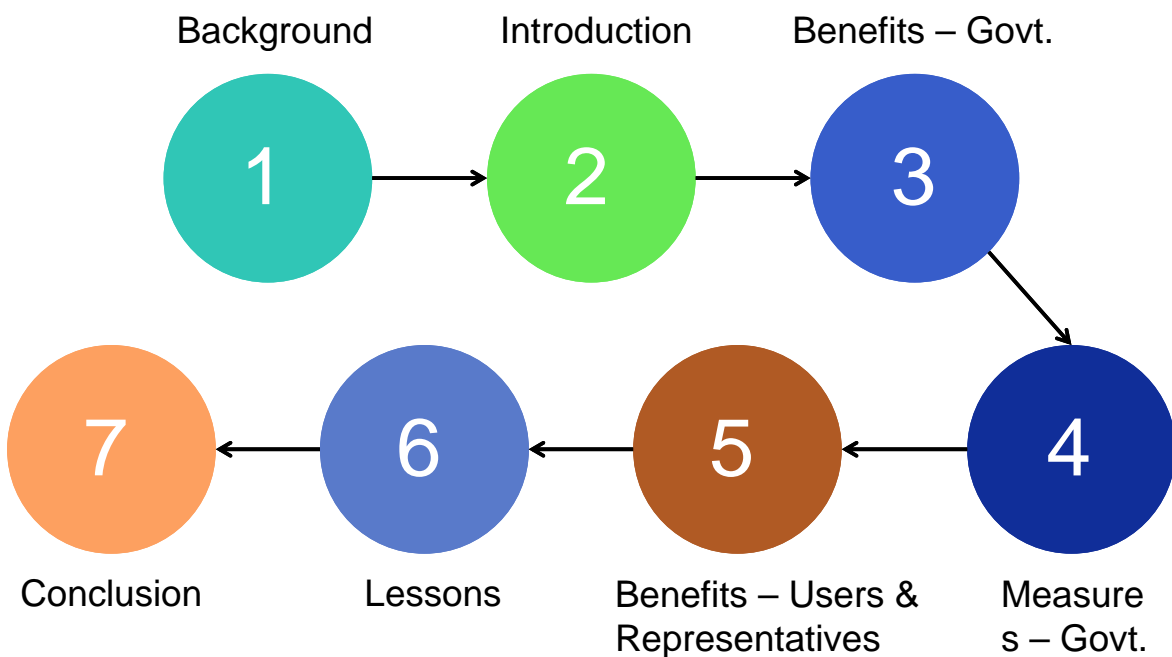
Madrid System Experience Sharing Report

Japan's Experience in Acceding to and Using the Madrid Protocol

Tokyo, Japan
9 March
2012

WIPO Japan Office

Agenda



Background

- Why Japan's experience?
 - About 10 years from accession
 - Not too short to accumulate experiences
 - Not too long to forget experiences
- Mood for accession in non Member States of Protocol in expansion of global economy
 - e.g. ASEAN IPR Action Plan 2011-2015 (Accession to Madrid Protocol by 2015)

Interview-Based



Governmental Officials

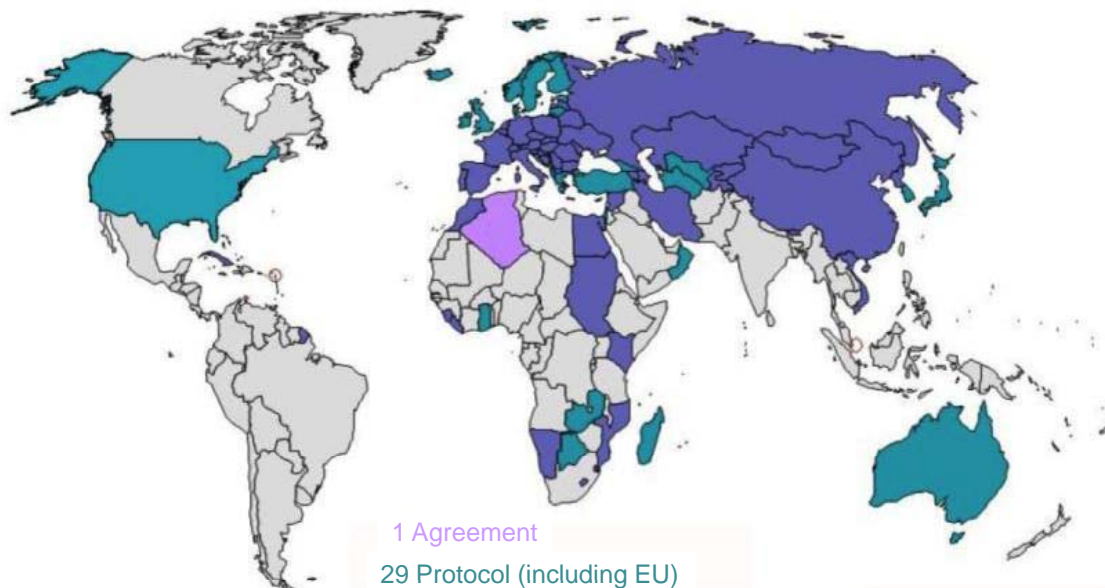


Users



Representatives

Introduction

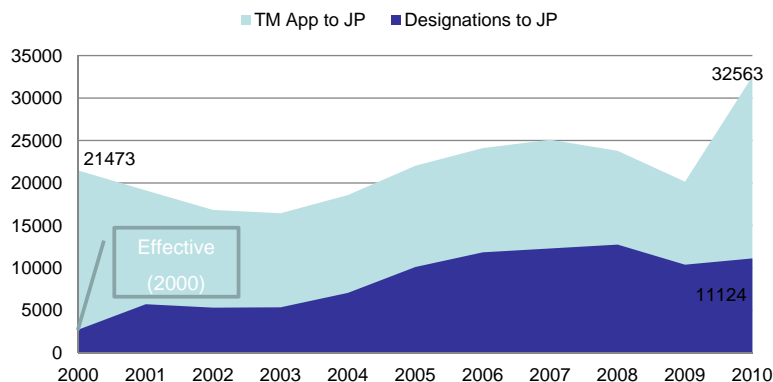


85 Madrid Union Member States

Benefits for the Government

■ Increase Filings from Abroad

Trademark Applications from abroad and Designations (JP)



Benefits for the Government

- Revenue Creation
 - Supplementary and Complementary Fees
 - Individual Fees
- No Formality Checks
 - All undertaken by the IB, thus lessening workload
- Increase in Motivation Among Examiners
 - Sense of internationalization
 - Increased language skills

Accession Measures



Legislative



Practical



Internal

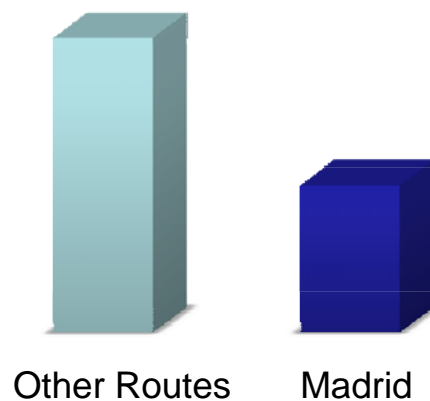
Benefits for Users

■ Cost-Effective

- One application for many designated countries
- Around 50% cheaper than other methods
- Even with subsequent action
- Cost-effective even when representatives are used
- Only one subsequent designation application required for additional countries



Cost Effective



**Around 50%
Cheaper**

Benefits for Users

- Quick Examination and Registration
 - Maximum of 12 or 18 months
 - Brings assurance and peace of mind
 - Provides concrete timeframe for use of mark
 - Increased efficiency
 - Facilitates expansion and entering new markets
 - Minimal time required from application to registration, but great potential return
 - Nearly half of interviewees cited the speed of the Madrid system as the primary reason for its use

Benefits for Users

- Easy and Cost-Effective Maintenance
 - Nearly all interviewees found Protocol registrations easier and cheaper to maintain
 - Over half found this brought time and financial savings
 - One application means one renewal date, one subsequent designation, and one-time changes for many designated countries
 - Over half of interviewees continue to use the Protocol specifically because of easy and cheap maintenance

Changes Necessary for Users

- Learn how to make and manage Protocol applications and registrations
 - Nearly all interviewees found the learning process not to be difficult or time consuming
 - About half of interviewees said that experience was the best way to learn the workings of the Protocol
- New internal management system
 - Three types: update previous system; develop Protocol-only system; or develop completely new system
 - Nearly all interviewees were not burdened financially or otherwise with the implementation of new systems

Benefits for Representatives

- Decrease in workload and increase in efficiency
- Easier Management
 - Nearly all interviewed representatives found Protocol registrations easier to manage
- Increase in applications coming from abroad
 - Applications designating Japan
 - New clients requiring assistance with issues such as provisional refusal or other follow-up actions
 - Higher linguistic capacity for such issues

Benefits for Representatives

- Positive influence on internal management system
 - Most interviewed representatives used the Protocol as an opportunity to streamline their internal management systems
 - New systems brought increased efficiency

Benefits for Representatives

- Easier communication
 - Most representatives found they can easily communicate with the IB in one language instead of with many different IP offices in many different languages as in direct national applications

Lessons Learned

- Simple but Cumbersome Procedures
 - Nearly all interviewees learned the simplicity of the Protocol is extremely advantageous
 - Most interviewees were able to quickly and easily make Protocol applications without prior experience and without any major problems
 - Nearly half of interviewees learned that different laws, rules, and regulations of each Member State can make a Protocol application cumbersome and not always as fast as a national application

Lessons Learned

- Language Has Positive and Negative Aspects
 - + Communication will always be in English, French, or Spanish
 - - Communication with the Designated Office required to be in the local language

Lessons Learned

- Interpretation of Classification of Goods and Services
 - Varies between the Country of Origin, the Designated Office, and the IB
 - About half of interviewed users found this can cause difficulties (such as a classification change) in an application

Lessons Learned

- Domestic and International Representation is Desirable
 - Most interviewees learned applications and registrations are easier to manage
 - Communication is easier and more effective
 - Representatives have greater linguistic capacity
 - Representatives provide a sense of security
 - Allows a user's trademark division to focus on other important issues such as combating infringement
 - Nearly all interviewed users utilize domestic representatives
 - Most interviewed users also utilize local representatives abroad

Lessons Learned

■ Basic Mark Requirement

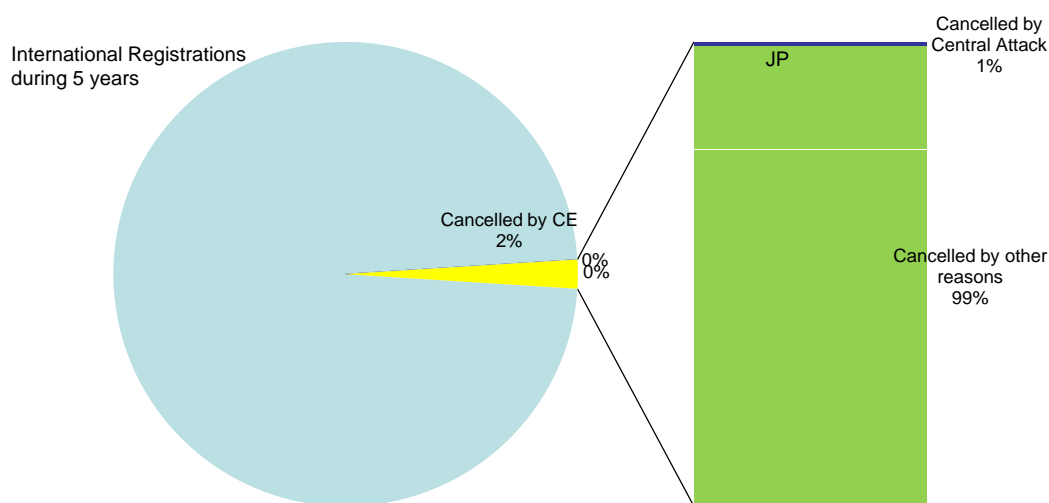
- Nearly half of interviewed users ran into difficulties due to linguistic issues with a basic application
 - These interviewees feel that this an issue unique to countries that use pictographic writing scripts
- About one-fourth of interviewed users learned the risk of Central Attack can increase if a basic application is used instead of a basic registration

Lessons Learned

■ Low Risk of Central Attack

- Nearly all interviewed users have found through their experience that Central Attack is not a significant risk
- These users also learned that with a proper prior TM search, all risk of Central Attack can be averted
- Only a few interviewed users had experience with Central Attack
 - Nearly all resolved the issue successfully and continue to use the Protocol

Risk of Central Attack



Important Notes

- No Job Losses Among Users and Representatives
 - Not one interviewee experienced job losses due to Protocol accession
 - Nearly all interviewees believe there is no direct correlation between Protocol accession and job loss
 - Nearly one-fifth of interviewees think that accession has actually created more jobs
- Strong Need for the Protocol in Southeast Asia
 - Nearly all interviewed users specifically highlighted ASEAN
- Nearly one-fifth of interviewed users want to use the Protocol more in African countries

