

“The Industrial Property Rights System in Japan”

Chapter 3. The Trademark System in Japan

Madrid Protocol

Let's take a look at the Madrid Protocol.

While the Madrid Protocol requires a basic application or basic registration in one's own country, it's possible to submit a single application to multiple countries.

Instead of having to file separately in different languages, the procedures can be carried out in one of the three prescribed languages: English, French or Spanish.

In the case of Japan, the procedures are carried out in English.

Negotiation with an agent in each country is required when submitting individual applications to different countries. But under the Madrid Protocol, the application documents submitted to the Office of Origin are sent via the International Bureau of the World Intellectual Property Organization (WIPO) to the Office of the Contracting Party in the country for which registration is requested. They are then treated in the same way as if the application had been made individually.

Because the selection of representatives in each country is not required, merits include simplifying application document preparation and procedures, as well as the possibility of cost reduction.

In addition, because the time limit for making notifications regarding any provisional refusal is specified at 12 months, or 18 months from the date notified by the International Bureau, acquisition of the right is facilitated at an early stage.

The simplification of rights management is also an advantage, owing to the centralized management of the International Register recorded and administered by the International Bureau.

The amendment of domestic trademark laws is required for accession to the Madrid Protocol.

For example, international registration will no longer be protected when the basic application or registration ceases to have effect within a five-year period from the date of international registration.

This is known as “central attack”. For this reason, Japan has prescribed “Special Provisions under the Protocol relating to the Madrid Agreement” as remedial provisions to deal with accession.