

Introduction of the Madrid Protocol

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Introduction

With the globalization of business activities, the number of companies operating globally is increasing and the need for international trademark protection has also increased. It is essential for companies engaging in operations in global markets to obtain trademark protection abroad. However, the trademark system is independent for each country in principle. Therefore, in order to obtain trademark protection, it is necessary to obtain individual protection under the trademark system in each country.

The Madrid System is an international system for obtaining a trademark right in a foreign country in a convenient and inexpensive way. It is predicted that the number of applications using this system will increase further in contracting countries and it seems that the demand to use the system will also increase in non-contracting countries.

This book aims to introduce one of the Madrid Systems, the Madrid Protocol, as a reference to relevant persons in countries that are considering joining the system.

1 Outline of the Madrid System

1.1 Background

In order to obtain trademark protection in foreign countries, it is required to file an application for the trademark under the legal system of each country and to obtain a trademark right individually.

If a person is a national of a contracting party of the Paris Convention for the Protection of Industrial Property of March 20, 1883 (known as the “Paris Convention”), “they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with” (Article 2 (1) of the Paris Convention). Therefore, a national of a contracting party who files an application for a trademark in a foreign member country, can obtain the same trademark protection as the nationals of the foreign country where the application is filed.

If a person obtains a trademark protection by directly filing an application in a foreign country using the Paris Convention, the procedures of the patent office (or intellectual property office) of the country (hereinafter referred to as the “Subject Country”) where the application is filed will usually be performed by a representative of the Subject Country. This is because if a person who lives in a foreign country performs the procedure, many countries require the person to have a representative in their country (Subject Country) in order to implement the procedures of the patent office of their country smoothly.

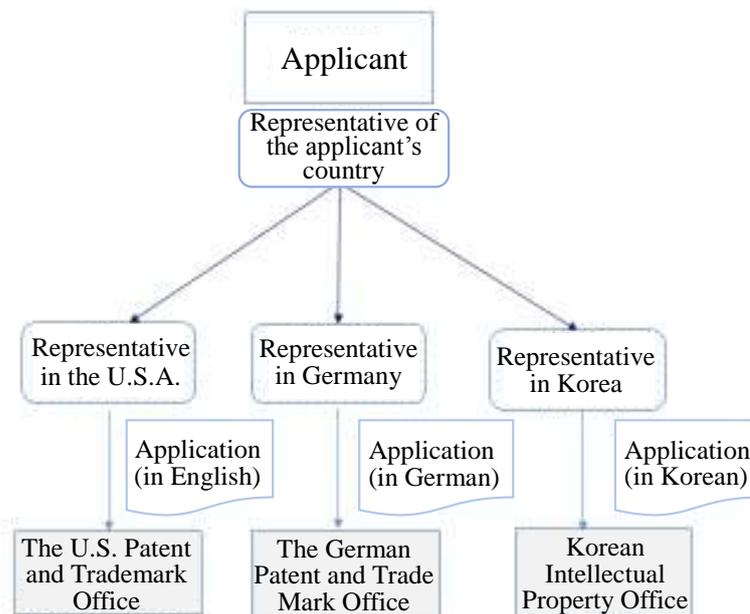
A representative of the Subject Country prepares the application documents; however, they must be translated since it is usually required that the documents be prepared in the language of the Subject Country. In addition, some countries require submission of a proxy or various types of certificates, and other countries require a notary or a consular authentication of those documents. Therefore, the applicants must accept the economic burden, such as expenses for representatives of the local site, expenses for translation, notary expenses, and spend time preparing the application. In addition, since the registration fee must be paid in local currency, there is a risk of foreign exchange loss. Moreover, the renewal period and other matters must be managed after the registration; however, since this management is required for every right, the burden on applicants is not light.

However, when filing an application directly in the Subject Country, since the procedures will be performed by a local representative who is familiar with the trademark system of the country before filing the application, it is predictable that

modification and handling of rejection can be performed without any problems in the filing process and therefore it is possible to obtain the right effectively. Furthermore, the application in the Subject Country is independent from applications in other countries in principle and it will not be influenced by the examination results of other countries.

The flow of a direct application is approximately as stated below.

Direct Application (Example: U.S.A., Germany, and Korea)



1.2 Background of the Madrid System

The Madrid Protocol, which this book will explain, is a treaty on the national registration system of trademarks and the official name is the “Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989.”

In 1891, before the Madrid Protocol was adopted, the Madrid Agreement was established as a system to facilitate international protection of marks and the Agreement is still in effect. The system based on both treaties, the Madrid Agreement and the Madrid Protocol, is called the Madrid System.

1.3 Madrid Agreement

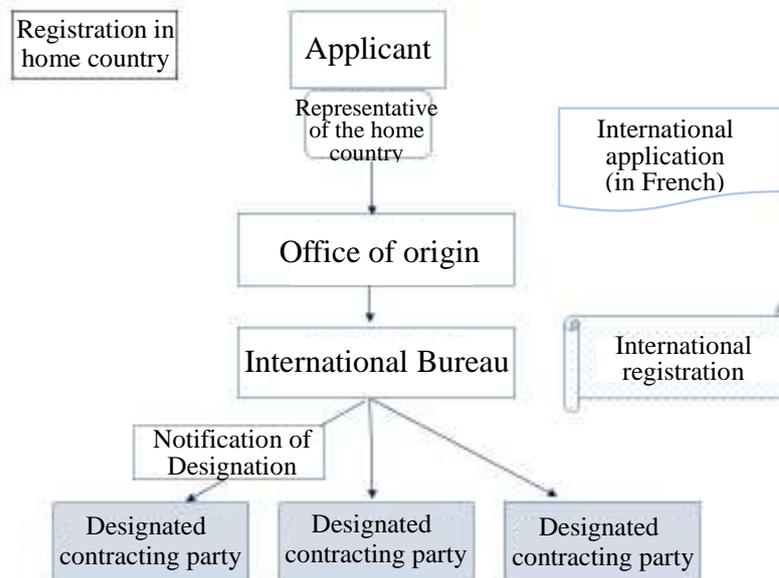
The Madrid Agreement was established in 1891 based on Article 19 of the Paris Convention as special rules related to the provision of Article 6-5 of the Paris Convention, “Marks registered in one country of the Union shall be protected in the other countries of the Union,” which aimed to simplify procedures for filing an application for trademark registration, for maintaining the right, etc. in order to obtain international protection of marks. The treaty came into effect the following year, 1892, and the signatory countries were limited to the contracting countries of the Paris Convention.

The basic idea of the Madrid Agreement is to expand the protection of registration in the home country to the designated countries. The outline of the Agreement is based on registration in the home country. If an application in the specified form is submitted to the International Bureau of WIPO via the authorities of the home country (hereinafter referred to as the “Office of origin”) by designating the Subject Country (limited to contracting parties) in which protection is claimed, the International Bureau makes an international registration in the international register and the applicant can gain the same effects as the case where there is a direct application for a mark in the country at the time of international registration and after. If the Office of the designated contracting party cannot protect the trademark in question due to domestic laws and regulations, the Office will report to that effect to the International Bureau along with the grounds for rejection within one year from the day when the notification of designation from the International Bureau is received. The International Bureau that received the notice of rejection will notify the applicant of the rejection and the applicant can respond to the Office of the designated contracting party. In cases where rejection is not notified within one year from the notification of designation or where the rejection is cancelled due to responses even if the notification of rejection was issued, the internationally registered trademark will be protected by the law of the specified country in the designated contracting party.

According to the System, application procedures are easier than cases of obtaining protection of trademarks by means of the aforementioned direct application in each country since the applicant prepares the application in the specified form and files it with the International Bureau via the Office of origin. In addition, it is not always necessary to appoint a local representative for filing an application and it is not necessary to translate documents into the local language. Therefore, the financial expenses are considered to be less than a direct application.

The following figure is the procedure for obtaining protection in the designated contracting party under the Madrid Agreement.

Application using the Madrid Agreement



The Madrid Agreement has a long history and has been used mainly in European countries; however, its language requirements and basic requirements for protection are strict and therefore the number of contracting parties of this treaty was limited.

The specific reasons why the number of contracting parties of the Madrid Agreement has not increased are stated below.

- (1) The working language is limited to French.
- (2) The basis of international registry is limited to registration in the home country. If the home country is a country that performs substantive examinations, it is naturally considered that it will take time from filing an application until registration; however, the applicant cannot use the system until the application is registered. In addition, if the examination requires six months or longer, the applicant cannot file an international application within the period where the applicant can claim a right of priority set forth in Article 4 of the Paris Convention. As a result, the applicant cannot claim a priority right.
- (3) If the Office of the designated contracting party refuses the protection, notification of refusal must be made within one year from the notification of designation; however, completing the examinations within one year will be a considerable burden on the country performing the substantive examinations if they have backlogs, and in other cases.

- (4) If a basic registration becomes invalid or is cancelled within five years of international registration, the international registration is cancelled and the applicant cannot obtain protection in the designated contracting party (this is commonly referred to as “central attack”). There is no remedy in this case. If a basic registration is invalidated or cancelled after an international registration is made and protection in the designated contracting party is approved, the protection in the designated contracting party will not be obtained and the stability of the right is insufficient.

1.4 Madrid Protocol

Based on the aforementioned reasons, the number of contracting parties of the Madrid Agreement was not large and the system was not fully used. Therefore, in 1989, the Madrid Protocol was adopted as a system which many countries can easily join and where international protection of trademarks can be obtained in an easy, quick, and inexpensive manner.

The official name of the Madrid Protocol is the “Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989” and it is a special rule based on Article 19 of the Paris Convention, just like the Madrid Agreement. Therefore, countries that can join in this Protocol are limited to contracting parties of the Paris Convention.

The Madrid Protocol came into effect on December 1, 1995 and started to be used in April 1996.

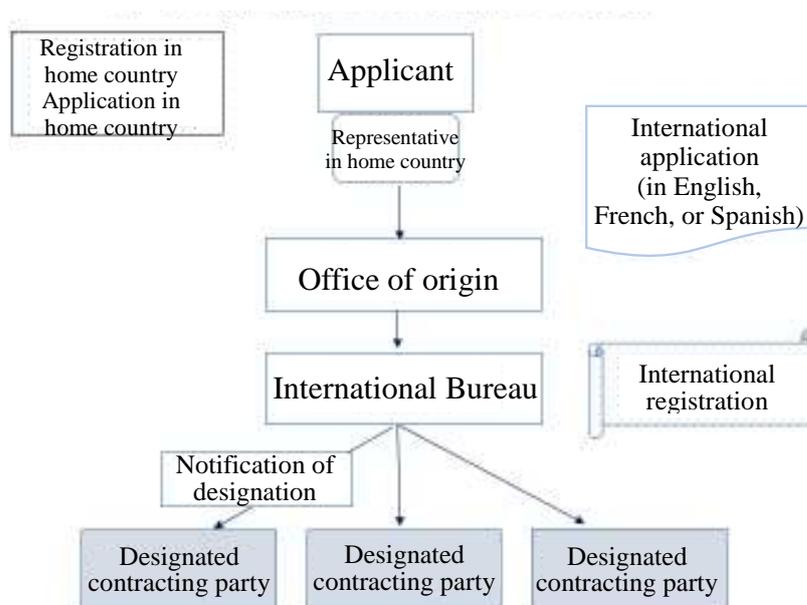
The Madrid Protocol and the Madrid Agreement are independent conventions; however, their purposes are the same and they have common rules.

The outline of the Madrid Protocol is as stated below.

First, based on trademark registration or trademark application in the home country, the applicant submits an international application to the International Bureau of WIPO via the Office of origin by designating the contracting parties from which protection is requested. The International Bureau will make an international registration of the trademark for an international application on the international register. When the international registration is made, the same protection as that provided when the application is filed directly in the designated contracting party will be granted. In addition, the International Bureau will send a notification of designation to the designated contracting party. If the Office of the designated contracting party refuses the protection, the Office will notify the International Bureau of the refusal within one year or 18 months from the notification of designation. The applicant may respond to the Office of the designated contracting party with respect to the refusal of the protection.

A flow chart of international applications based on the Madrid Protocol is shown below.

Application using the Madrid Protocol



1.5 Differences with the Madrid Agreement

The Madrid Protocol aims to overcome problems with the Madrid Agreement and it differs with the Madrid Agreement on the following points.

- (1) English and Spanish are approved as working languages in addition to French. The contracting parties will determine which language is to be used.
- (2) The basis for international registration is the registration or application in the home country. If it has not been registered, but the application has been filed, the application can be used as the basis for international registration.
- (3) The notification period for refusing protection in the designated contracting party can be one year or 18 months if a declaration is made.
- (4) There is a remedy provision that the application can be changed to a domestic application in the designated contracting party while maintaining the interest of the date of international registration even if the international registration is cancelled by a central attack.

The following table is a summary of the major differences between the Madrid Agreement and the Madrid Protocol.

Madrid Agreement and Madrid Protocol

	Madrid Agreement	Madrid Protocol
Base trademark requirements	Basic registration	Basic application Basic registration
Language of application	French	French, English, and Spanish
Period for notification of provisional refusal	One year from the notification	One year from the notification or 18 months if a declaration is made
Duration	20 years	10 years
Remedy in cases of a central attack	None	The applicant can file a domestic application with the designated contracting party (transformation).

1.6 Member Countries of the Madrid Protocol

There are 55 contracting parties of the Madrid Agreement and 97 contracting parties of the Madrid Protocol as of December 2015. Contracting parties of the Paris Convention can join in the Madrid Agreement or Madrid Protocol or both. Intergovernmental institutions, such as the Office for Harmonization in the Internal Market (OHIM) or the African Intellectual Property Organization (AIPO), can join in the Madrid Protocol.

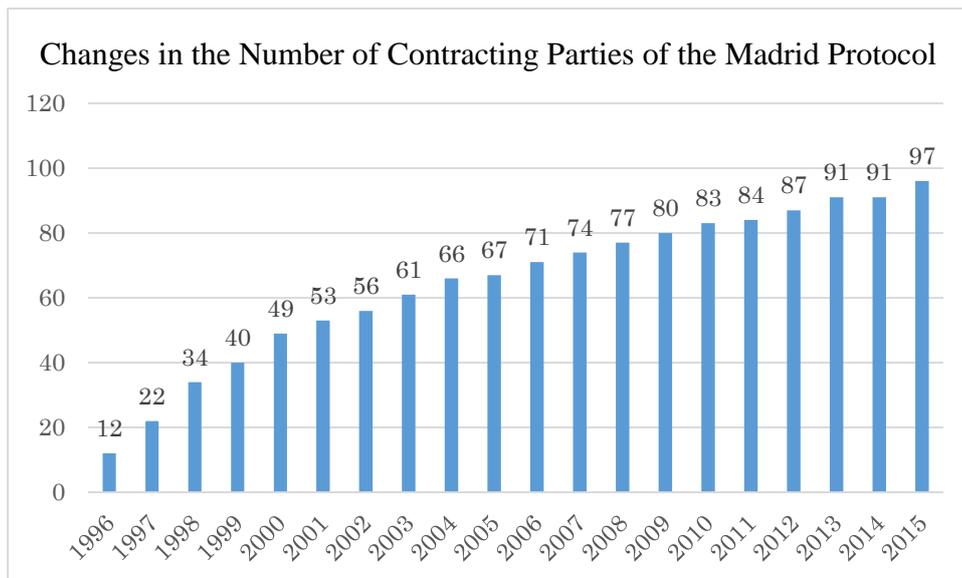
Since the Madrid Agreement and the Madrid Protocol are independent treaties, the applicable treaty is different depending on the treaty of which the country is a member. For example, since there are no common treaties between countries that are only members of the Madrid Agreement and countries that are only members of the Madrid Protocol, the Madrid Agreement and the Madrid Protocol cannot be applied together and the system cannot be used. On the other hand, it is stipulated that the Madrid Protocol will be applied to the relationship between countries that are only contracting parties of the Madrid Protocol and countries that are contracting parties of both the Madrid Agreement and Madrid Protocol (Article 9-6). Therefore, the Madrid Protocol may be used.

On the other hand, Algeria was only a contracting party of the Madrid Agreement until July 2015, and therefore, the Madrid System could not be used between a country that was only a contracting party of the Madrid Agreement and Algeria. However,

Algeria became a contracting party of the Madrid Protocol on July 31, 2015 and the Protocol became valid for Algeria starting on October 31, 2015. Therefore, all of the contracting parties of the Madrid Agreement became contracting parties of the Madrid Protocol and the Madrid System was unified under the Madrid Protocol.

The following graph shows changes in the number of contracting parties of the Madrid Protocol.

The number of contracting parties has increased every year since the Madrid Protocol came into effect in 1996. The Madrid Protocol came into effect with the African Intellectual Property Organization (AIPO) on March 5, 2015; with Zimbabwe on March 11, 2015; with Cambodia on June 5, 2015; and with Algeria on October 31, 2015; and with Gambia on December 18, 2015; and will come into effect with Lao PDR on March 17, 2016.



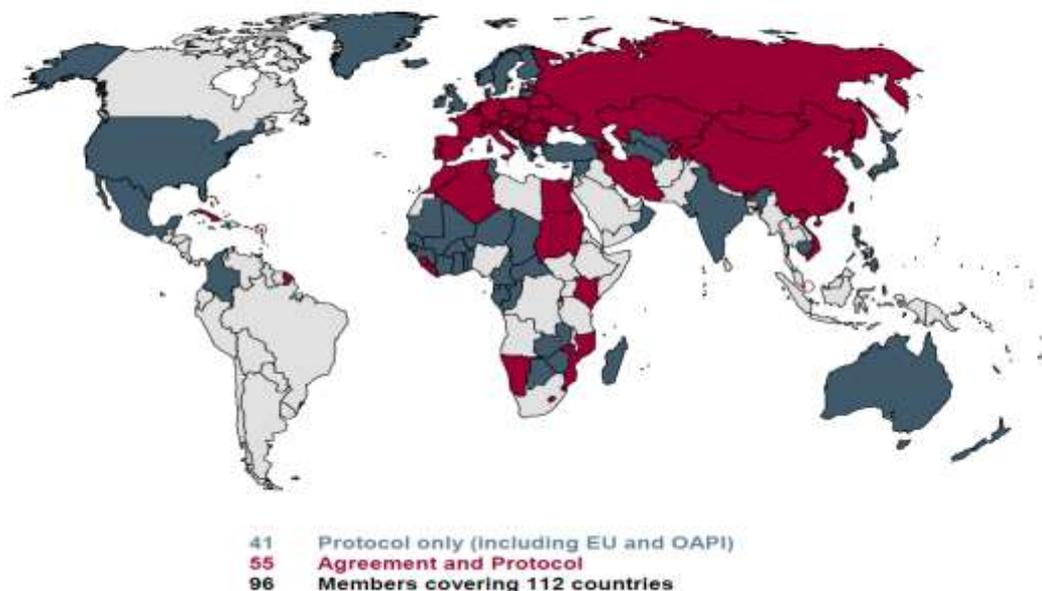
The following is taken from the WIPO website and indicates the member countries of the Madrid System as of September 2015.

http://www.wipo.int/export/sites/www/madrid/en/highlights/2015/pdf/madrid_highlights_3_2015.pdf

There are many European countries that are contracting parties of both the Madrid Agreement and Madrid Protocol. Japan, Korea, the U.S.A., and other countries are only contracting parties of the Madrid Protocol. On the other hand, there are few contracting parties in South America and Southeast Asia. However, in particular in the

ASEAN region, many countries are preparing to join in the Madrid Protocol. Therefore, it is expected that they will become contracting parties in the future.

MADRID UNION MAP



2 Advantages and Disadvantages of the Madrid Protocol

Cases of using the Madrid Protocol for obtaining a trademark right in a foreign country and cases of filing an application directly have been briefly described above. In this section, the advantages and disadvantages in cases of using the Madrid Protocol are explained from the standpoint of users and the standpoint of the Office of the designated contracting party by comparing them with cases of filing applications directly.

2.1 Advantages and Disadvantages for Users

(1) Advantages

(i) Simple application procedures

An application is prepared with a single form (official form MM2) using the language specified by the Office of origin and is submitted to the International Bureau via the Office of origin. Therefore, applicants can file an application using

a simple and easy procedure compared with the procedures for filing an application directly to the Subject Country via a local representative in the language specified by the Subject Country. In addition, a single international application can specify multiple designated contracting parties from which the applicant desires to obtain protection and therefore it is not necessary to file an application in each country.

Furthermore, in cases of filing an application directly, there are countries requiring submission of notary or consular authentication along with a proxy, which makes the procedures troublesome. In cases of international application, however, it is not necessary to prepare and submit these documents. Even in cases of an international application along with the claim of a priority right, it is not required to submit documents related to the priority rights.

(ii) Reduction of expenses

When filling an application, it is not always necessary to appoint a local representative and to translate the application into the language of the designated contracting party. Therefore expenses can be reduced. In cases of renewing the right, it is not necessary to take procedures individually for each country, but to renew the international registration of the International Bureau. Therefore, expenses can be saved.

(iii) Centralization of rights control

The international registration is controlled by the international register of the International Bureau. Therefore, it is not necessary to implement procedures for renewal, changing the name of the right holder, transferring registration, etc. individually for each country as mentioned above. It is also possible to designate the contracting party in which protection is desired after international registration and to extend the territory of protection (subsequent specification).

(iv) Prompt establishment of right

If there are reasons for refusal of protection of international registration, the Office of the designated contracting party must make a notification of refusal to the International Bureau within one year after the notification of designation sent by the International Bureau or within 18 months if a declaration is made. If a notification of refusal is not made within the period, the international registration will be protected by the designated contracting party in question. Therefore, if the applicant files an application, the applicant for the international registration can obtain examination results within one year or 18 months after the notification of designation and can avoid the situation in cases of filing an application directly,

such as that it is not sure how long it will take to complete the examination and that it is difficult to establish a plan for when to start the trademark.

(2) Disadvantages

When using the Madrid Protocol, there are some disadvantages for users.

(i) Basic registration or basic application is required.

The basic concept of the Madrid System is to extend the territory of protection for trademarks registered (applied) in the home country. Therefore, in cases of using the Madrid Protocol, basic registration or basic application in the home country is required and the following requirements must also be fulfilled.

- Identity of right holder or applicant

The international application must be filed by the right holder or applicant who is identical to the basic registration or basic application.

- Identity of marks

The mark under the international registration or application must be identical to the mark for the basic registration or application in the home country. The requirements for the identity of marks are interpreted rigidly. Therefore the use of the Madrid System is not appropriate for cases where the mark is used by changing it by country.

- Scope of specified goods and specified services (hereinafter referred to as the “Goods and Services”) for the international registration and application
- The scope of Goods and Services of the international registration and application must be identical to the scope of Goods and Services of the basic registration or basic application or be within the scope. Therefore, if an applicant desires to develop goods and services that are not specified by the basic registration and basic application in a foreign country, the Madrid Protocol is not appropriate.

(ii) Dependency on basic registration and basic application

If the basic registration or application in the home country is refused, invalidated, cancelled, renounced, or ceased within five years from international registration, the international registration is also cancelled. If the Goods and Services are limited due to amendment, the limited part is removed from the list of Goods and Services of the international registration and, as a result, the protection will not be obtained in the designated contracting party (this is commonly referred to as a “central attack”).

However, with respect to cancelled international registration or limited Goods and Services, if specified procedures are taken within the specified period, the international registration can be changed to domestic registration in the designated contracting parties (transformation).

(iii) Language

The working language in the international application is the one that the Office of origin selects among English, French, and Spanish; however, this will be a burden to applicants of contracting parties that do not use these languages.

(iv) Countries and territories to which protection can be extended

The countries and territories to which protection can be extended are limited to the contracting parties and institutions of the Madrid Protocol. Therefore, if the country where the applicant desires to obtain protection is a non-contracting party or territory, the Madrid Protocol cannot be used.

2.2 Advantages and Disadvantages for Office of Contracting Party

Use of the Madrid Protocol offers advantages and disadvantages to users and it also has effects on the Offices of the contracting parties.

The following points are considered to be advantages and disadvantages for the Offices of the contracting parties.

(1) Advantages

- (i) Substantive examinations only are enough for the examination of applications in the designated contracting parties. In other words, statements of goods or services and classes of goods or services are examined by the International Bureau before making a notification of designation. Therefore, a formality examination is not necessary in the designated contracting parties.
- (ii) When the International Bureau makes an international registration with the international registry, the registration is published on the gazette issued regularly by the International Bureau. Therefore, it is not necessary to publish the international registration in the contracting parties.
- (iii) In the contracting parties which collect individual fees, after the individual fee is collected from the applicant by the International Bureau, it will be the revenue of the designated contracting parties.
- (iv) In contracting parties that do not collect individual fees, a complementary fee and supplementary fee will be collected every year based on the number of designations in the international application.

(2) Disadvantages

- (i) If there are reasons that the designated contracting parties cannot protect a trademark under an international application, a provisional refusal will be issued within one year from the notification of designation or within 18 months if a declaration is made. If the notification of provisional refusal is made within the

period, the trademark under application will be protected in the designated contracting party in question in principle. Completing examinations in one year or 18 months is a burden on contracting parties that have backlogs.

3 Use of the Madrid Protocol

The international registration procedures using the Madrid Protocol will be briefly explained below by dividing them into the following steps: preparation for international application; examination by the Office of origin; registration by the International Bureau; and examination by the designated contracting party.

3.1.1 Preparation for International Application

The Madrid Protocol is intended to extend the territory of protection of a registered trademark or a trademark for which an application is filed in the home country. The international application is a procedure to record a bundle of trademark rights that are effective in the territories of the designated contracting party on the international register of the International Bureau and the requirements for the procedures are stated below.

(i) Existence of basic registration or basic application

The mark under an international application must be identical to the mark under the basic registration or basic application that exists in the Office of origin.

The Goods and Services of the international application must be identical to or within the scope of the Goods and Services of basic registration and basic application. The applicant cannot indicate goods or services that are beyond the scope of the Goods and Services.

Multiple registrations and applications in the same Office of origin can be used as the basis of international application. Under the Madrid Protocol, applicants may select an Office of origin based on their address, domicile, or location of business office.

(ii) Entitlement of Applicant

A person who can file an application is a national of a contracting party of the Madrid Protocol or a foreigner who is domiciled or has a residence (in cases of a juridical person, business office) in the contracting party.

The international application can be filed by multiple persons (joint application); however, it is necessary that both the basic registration and basic

application have been made by the same multiple applicants and it is required that each applicant must meet applicant eligibility.

(iii) Application form

The international application must be submitted in the official form (in writing). If the application is filed under the Madrid Protocol, the application must be prepared in form MM2.

Form MM2 is available for download from the following WIPO website; however, since the form is changed as necessary, the latest version must be used.

The form is available here: <http://www.wipo.int/madrid/en/forms/>

Official forms MM1 and MM3 were the forms that contracting parties of the Madrid Agreement used for an international application; however, there are no longer any countries that are solely members of the Madrid Agreement since Algeria joined the Madrid Protocol. Therefore, the official form for applications has been unified to MM2.

3.1.2 How to Prepare an MM2

MM2 is a multi-page document and applicants will enter the items indicated in the following columns 1 through 12.

The form must be filled out in the language selected by the Office of origin in advance from the three languages: English, French, and Spanish. The Office of origin can select only one language or two languages, or all three languages. The Japan Patent Office selected English only.

The MM2 must be prepared using a device, such as a typewriter, and handwriting is not allowed except for signatures.

An explanation of the items to be entered in each column of MM2 is stated below.

Column 1: Contracting Party that is the Office of Origin

The Office of origin shall enter the name of the contracting party or intergovernmental institution (ex.: EU) where the basic registration or basic application was filed.

Column 2: Name, Address, and Contact of the Applicant

If the name of the applicant is written in characters other than the Latin ones in the column of the applicant's name, the pronunciation is indicated by replacing

it with Latin characters. If the applicant is a juridical person, enter its official name.

In the address column, enter the address where communication from the International Bureau can be received.

If an address is not stated in Column 4: Representative, all communication from the International Bureau will be sent to the address of the applicant.

In the contact column, phone numbers and facsimile numbers can be indicated. If an e-mail address is indicated as a contact, subsequent communication from the International Bureau will be changed to electronic form via e-mail to the e-mail address in the column.

If the applicant is a natural person, the applicant may be requested to indicate his/her nationality, and if the applicant is a juridical person, the legal nature of the juridical person and the name of the country or region which holds the grounds for establishment of the juridical person may be required depending on the designated contracting party.

Column 3: Entitlement to File an Application

Check the corresponding box with respect to the relationship between the Office of origin and applicant.

If there is good reason to question the content of the indication, the authorities involved in the international application can request that evidence be presented.

Column 4: Appointment of a Representative

Fill out this column if the applicant desires to appoint a representative for the International Bureau. If a representative is appointed, all communications from the International Bureau will be sent to the appointed representative. It is not necessary to submit a proxy to the International Bureau for the appointment.

If a representative is appointed for the international application, the representative may engage in procedures with the International Bureau.

Column 5: Basic Application or Basic Registration

If the basic trademark is an application, enter the application number and application date.

If the basic trademark is a registration, enter the registration number and registration date only, but do not enter the application number and application date.

If multiple trademarks under application are submitted for international application as basic trademarks, enter all of their application numbers and application dates. In cases of multiple basic registrations, enter all of their registration numbers and registration dates.

Column 6: Priority

It is possible to claim priority set forth in Article 4 of the Paris Convention with respect to a prior application. The prior application is usually the basic application or basic registration for the international application.

In case of claiming priority, check the corresponding box, enter the name of the authorities to which the prior application was submitted and the application date, and enter the application number if it is available. If there are multiple prior applications, it is possible to claim multiple priority rights. Partial priority can be claimed. If the Goods and Services of the prior application are not related to the Goods and Services of the international application, indicate the Goods and Services related to the prior application.

It is not necessary to submit a certificate for the priority right.

Column 7: The Mark

Provide a reproduction of the mark for which international registration is being sought. The mark is required to be identical to the basic trademark. Therefore, if the mark has no color (black and white), provide the black and white mark in Column 7 (a); if the basic trademark has colors, provide the mark with the same colors in Column 7 (b).

Provide the mark in a size that fits inside an 8cm x 8cm square.

If the mark for which protection is being sought is a special mark, such as a three-dimensional trademark or a sound trademark, indicate the same one as the reproduction that was submitted for the basic registration or basic application in Column 7 (a). If there are supplemental indications regarding the reproduction, indicate them in Column 9.

If the applicant desires that the mark for which protection is being sought be handled as a mark in standard characters, check the box that indicates to that effect. However, since the content of standard characters differs by country, the effect is judged by each country and it is not always possible to obtain the same effects as those in the home country.

Column 8: Color Claim

In cases of claiming that the colors are characteristics that represent a distinctive feature of the mark, check the box that indicates to that effect and present the colors in words.

The major part of the mark to which colors are given can be indicated in words.

Column 9: Miscellaneous Indications

- (a) Transliteration: If the mark is a mark including characters other than Latin characters, or numbers other than Arabic numbers or Roman numbers, indicate the transliteration.
- (b) Translation: If the mark includes a word(s) that can be translated, the term may be indicated in a translation into English, French, and/or Spanish.
- (c) If the mark is a made-up word and cannot be translated, check the box indicating to that effect.
- (d) Special type of mark: In cases where the basic trademark is an explanation of a three-dimensional trademark, a sound trademark, a collective trademark, or a certification or guarantee mark and the basic trademark with descriptions, the same indications can be stated in the explanation column of the mark; provided, however, that if the descriptions of the basic trademark are in a language that is not used in the international application, they are translated accordingly.
- (e) If there are descriptions of the mark in the basic registration or basic application, the same descriptions can be included.
- (f) Verbal element of the mark: The International Bureau will capture the verbal element essential to the mark.
- (g) If an applicant does not claim protection for a part of the mark, indicate the part for which the protection is not claimed in a disclaimer. Disclaimers can be made for the entire international application, but the disclaimer cannot be made only for part of the designated contracting parties.

Even if there is no disclaimer in the basic registration or basic application, a disclaimer can be made for the international registration. If a disclaimer is made for the basic registration or basic application, the applicant is not required to include it in the international registration. After an international registration that has no disclaimer is made by the International Bureau, the disclaimer can no longer be made.

Column 10: Indication of Goods and Services

Indicate Goods and Services of the international application in accordance with the International Classification of Goods and Services for the Purpose of the Registration of Marks (the Nice Classification), together with the class. Indicate the class numbers in order of the number of the international classification and indicate Goods and Services by class. In order to accurately

indicate Goods and Services, it is recommended to indicate them by using words appearing in the Alphabetical List of the Nice Classification.

The list of Goods and Services of the international application should be identical to or narrower than the list of Goods and Services of the basic registration or basic application; however, the list cannot be extended; provided, however, that it does not mean that Goods and Services must be indicated in completely the same terms as those used for the basic registration or basic application.

In cases where there are multiple designated contracting parties, it is possible to indicate the Goods and Services of the international registration by limiting the class, goods, or services for each designated contracting party. Therefore, the goods and services for which protection is necessary can be considered and applied for by each designated contracting party.

In addition, requirements by contracting parties vary, such as countries which approve comprehensive indications of goods, countries which require specific indications of goods and services, etc. Therefore, it is possible to indicate Goods and Services differently for each designated contracting party within the list for the basic application and registration.

In particular, the U.S.A. has unique criteria for terms indicating goods and services. Therefore, the U.S. Patent and Trademark Office has sent the International Bureau a document to draw attention to this fact, "Indication of Goods and Services: United States of America (Madrid/2003/24)" and recommends indicating a reference to the "U.S. Acceptable Identification of Goods and Services Manual (ID Manual)," which is disclosed on the website as an indication of goods and services approved by the U.S. Patent and Trademark Office, if designating the U.S.

<http://tess2.uspto.gov/netathtml/tidm.html>

Column 11: Designated Contracting Party

Check the box of the country (designated contracting party, designated territory) from which protection for a trademark is sought. Applicants cannot designate their home country.

In case of designating the European Community (EC), the second working language can be selected from English, French, Spanish, German, and Italian, which are the official languages of the OHIM. The language selected here is used for specific communications from the OHIM only and is not used for communication with the International Bureau.

In case of applying for the same mark as the mark that has been registered in the contracting party of the EC as a community trademark, the applicant can

claim that the community trademark should succeed the interests of the mark that has been registered in the contracting party (seniority). If the application under the Madrid Protocol designates the EC as the territory and claims seniority, check the corresponding box in Column 11 and submit the official form MM17 along with the international application form.

Enter the following matters in MM17.

- Contracting party(s) where the prior mark has been registered
- Effective date of relevant registrations
- Number of relevant registrations
- Goods and services for which the prior mark has been registered

In case of designating the U.S. as a territory, check the corresponding box and submit MM18 as a written oath related to the intention of using the mark along with the application form.

Column 12: Signature by the Applicant or his/her Representative

The applicant or representative must sign the international application form. The signature may take the form of a seal, etc.

Column 13: Certification and Signature by the Office of Origin

Since the day when the Office of origin receives an international application form is the date of international registration in principle, the office of origin will check the following matters and make a declaration.

- (i) Day of receipt of the international application form
- (ii) Relationship with the basic registration or basic application
 - Name of the owner or applicant: The applicant of the international registration indicated in Column 5 shall be identical to the holder of the basic registration or applicant of the basic application.
 - Mark: The mark indicated in Column 7 is identical to the mark of the basic registration or basic application.
 - Goods and Services: The goods and services indicated in the international application are required to be the same as the Goods and Services of the basic registration or basic application, or to be included in the Goods and Services of the basic registration or basic application. The scope of the list of the Goods and Services of the international application may be smaller than the scope of the list of Goods and Services of the basic registration or basic application.

If the international application fulfills the aforementioned requirements, the Office of origin will sign in Column 13 of the international application form, indicate the signature date, and send it to the International Bureau.

If there is a discrepancy between the content of the international application and the basic registration or basic application, the Office of origin will request that the applicant correct the discrepancy. The Office of origin will not sign in the column as long as the discrepancy is unresolved.

Fees Calculation Sheet: The last page of the application is the fee calculation table.

The fee consists of a basic fee, a complementary fee, a supplementary fee, or an individual fee in lieu of the complementary fee and the supplementary fee.

The fee amount to be paid, payment method, etc. can be entered in the fee calculation table; however, the calculation of the payment amount is very complicated since the fee varies by the existence of color(s) on the mark, the designated contracting party, etc. Therefore, WIPO has made a FEE CALCULATOR available on its website to calculate the payment amount automatically.

URL for the FEE CALCULATOR:

<http://www.wipo.int/madrid/feecalc/FirstStep>

3.1.3 Fee (Commission Fee) and Payment

Types of Fees

Types of fees and amount of fees to be paid to the International Bureau when filing an application are stated below:

- Basic fee
 - where no reproduction of the mark is in color 653 CHF
 - where any reproduction of the mark is in color 903 CHF
- Complementary fee for the designation of each designated contracting party 100 CHF
- Supplementary fee for each class of goods and services beyond the three classes 100 CHF
- Individual fee: Contracting parties may declare that they will receive individual fee in lieu of the aforementioned complementary fee and supplementary fee. The amount of the individual fee is determined by each contracting party.

Contracting parties can inform the Director General of the International Bureau of dividing the individual fee into two parts. In this case, the first part of the individual fee shall be paid at the application or at the subsequent designation, and the second part shall be paid on a later date that is specified in accordance with the laws and regulations of the contracting party in question. Individual fees paid to the International Bureau will be transferred to the current account at WIPO of the contracting party in question after the procedures are recorded.

In addition, contracting parties may request fees to be paid directly to the Office of origin when receiving application documents as the Office of origin.

The fees paid to the International Bureau will not be added depending on the number of goods or services in one class. Therefore, even in cases where an applicant designates a contracting party which imposes an excess charge if the number of goods designated in one class is more than a specified number (ex.: China, Korea), an additional fee will not be required unless the number of classes increases.

Payment method

The application fee shall be paid to the International Bureau in Swiss Francs before filing an application.

Payment methods are as follows.

- i) Bank transfer to the specified bank account of the International Bureau
- ii) Open a current account at the WIPO International Bureau in advance and debit the fee from the opened account to which the amount has been credited in advance.
- iii) If the payment is made within Europe, a postal transfer to the postal account is also available.

If the fee is sent to the International Bureau, a receipt will be sent to the payer around ten days later from the International Bureau.

Since submission of application documents and payment of application fees are implemented separately, in case of sending the fee by bank transfer, if there is a column for communication on the transfer application sheet, enter information, such as the purpose of the transfer and the name of the right holder or applicant, etc. so that the International Bureau can specify the subject case of the payment. If the International Bureau cannot specify the case for the payment, an irregularity notification will be issued with respect to the international application.

In case of submitting application documents by designating a contracting party which requests payment of fees from the Office of origin, as the Office of origin, applicants shall pay the specified amount of fees to the Office of origin at the application.

Incidentally, when designating Japan as the Office of origin, the applicant must attach patent revenue stamps of 9,000 yen on the application form at the application.

3.1.4 Other Precautions at Application

Indications of goods and services when designating the U.S. have been mentioned above. The U.S. has sent to the International Bureau “Tips for Holders of International Registrations Seeking Extension of Protection to the United States of America: Avoiding Provisional Refusals (Information Notice No. 4/2009)” and explains and proposes indications of specified matters based on the provisional refusals that are often issued in order to facilitate examinations of international trademark registration applications designating the U.S.

3.1.5 Submission of International Application

The application documents shall be submitted to the authorities where the basic application is filed and basic registration will have been recorded (Office of origin). As mentioned above, the applicant may select only one Office of origin from the contracting parties based on nationality, address, location of business office, etc. In more detail, the Office of origin is a contracting party where the basic application or basic registration exists and a country or area in which the applicant or the right holder (natural person or juridical person) (1) holds nationality, (2) is domiciled, or (3) has a real and effective industrial or commercial establishment; and the requirements of (1) and (2) above are determined by the law of the contracting party. Fraudulent or fictitious establishments are excluded from “real and effective industrial or commercial establishment.”

3.2 Procedures by the Office of Origin

3.2.1 Examination by the Office of Origin

When an international application is filed, the Office of origin checks statements in the received international application form, bibliographical matters, and statements of basic registration or basic application. With respect to

statements in the international application, the following points are examined in relation to basic registration or basic application.

(1) Identity of name of applicant or right holder

The name of applicant of the international application is required to be completely the same as the name of the applicant or right holder of the basic application or basic registration. In cases of a joint application, all the applicants are required to be the same.

(2) Identity of the Mark

The identity of the mark is strictly interpreted.

(3) Identity of Goods and Services

Goods and Services are required to be the same as or be included in the range of Goods and Services of basic registration or basic application.

Since the Madrid Protocol stipulates that the protection of basic registration or basic application in the home country will be expanded to the contracting parties and be valid in the territory of the designated contract parties, the aforementioned requirements (1) through (3) shall be examined by the Office of origin where the basic registration or basic application exists, before sending an application to the International Bureau.

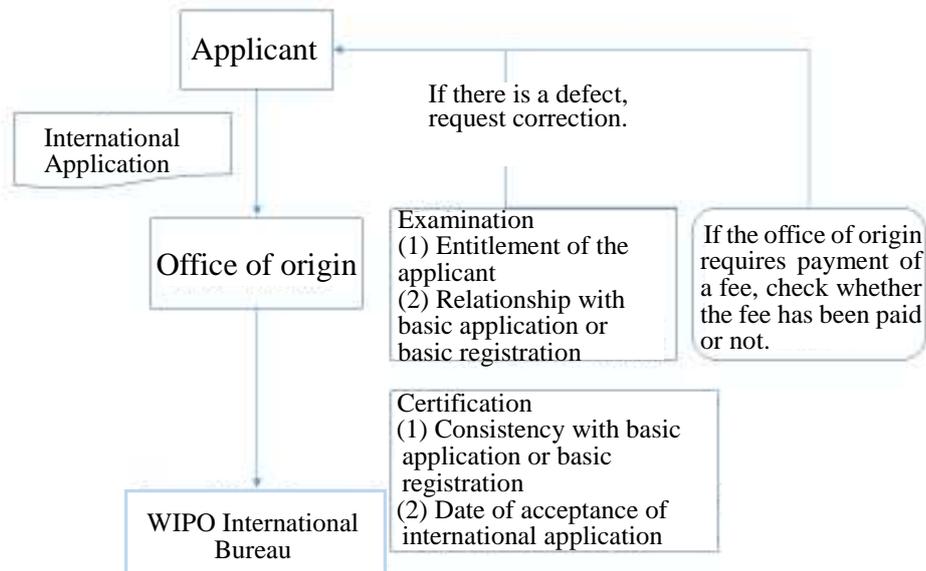
If there is no defect in the aforementioned requirements (1) through (3) and there is no problem with consistency between statements in the international application form and basic registration or basic application, the Office of origin shall sign in Column 13 of international application form MM2 and certify the date of acceptance of the international application.

In cases of requiring payment of fees to the Office of origin at the international application in addition to the aforementioned examination, whether the fee has been paid or not will also be checked.

In cases where the Office of origin is the Japan Patent Office, if a defect is found with respect to requirements (1) through (3), a notification of incomplete application will be issued to the applicant or right holder and the applicant or right holder who receives the notification may submit to the Office of origin corrected replacement documents within 14 days from the notification date.

If the fee has not been paid to the Office of origin or the fee is insufficient, it shall be handled by each contracting party. If the Office of origin is Japan, an order for amendment of fees will be issued. If the appropriate fee is paid by amendment of procedures within 14 days in response to the order, the procedure will continue; however, if the fee is not paid, the international application will be refused.

Examination by the Office of Origin



The Office of origin shall certify the following matters with the application form (MM12).

(Rule 9)

- Date of acceptance of the application
- Relationship with basic registration or basic application
- The applicant of the international application is identical to the holder of the basic registration or applicant of the basic application.
- The mark for the international application is identical to the mark of the basic registration or basic application. If the mark for the international application is indicated as a three-dimensional mark, sound trademark, collective trademark, or if a certification or guarantee mark, the mark is indicated in terms, or a color is claimed, the same is indicated as for the basic registration or basic application.
- The goods or services for the international application are included in the indication of the goods or services for basic registration or basic application.

The Office of origin shall check the content of the submitted application form to the extent necessary.

3.2.2 Certification of the Office of Origin and Sending the Application to the International Bureau

After the aforementioned examinations with respect to the international application, the Office of origin shall send the international application with its certification to the International Bureau (Article 3).

If there is a defect in the international application with respect to certified matters by the Office of origin and the defect is not corrected despite the request of the Office of origin, the defective international application will be sent to the International Bureau without certification of the Office of origin. In this case, an irregularity notification will be issued by the International Bureau.

In cases where the International Bureau receives the application documents from the Office of origin within two months from the day when the Office of origin received the application, the date of receipt by the Office of origin will be the date of international registration. In cases where it took more than two months for the International Bureau to receive the international application due to examination by the Office of origin, the date of receipt by the International Bureau will be the day of international registration and the registration date will be postponed. Therefore, it is preferable that the international application is received by the International Bureau within two months from the date of receipt by the Office of origin.

3.3 Examination Procedures by the International Bureau

3.3.1 International Examination Procedures

The International Bureau will implement the formality examination specified in the Rules with respect to the international application received from the Office of origin. If there is an irregularity, the International Bureau will send an irregularity notification to the Office of origin and to the applicant. There are the following three types of irregularity notifications.

- (1) Classification irregularity notification with respect to the classification of goods and services (Rule 12)

If the International Bureau judges that the Goods and Services for the international application are not classified in the appropriate class, the class number is not provided, or the class number is wrong, the International Bureau

will present a class proposal and notice to the Office of origin and send a copy to the applicant.

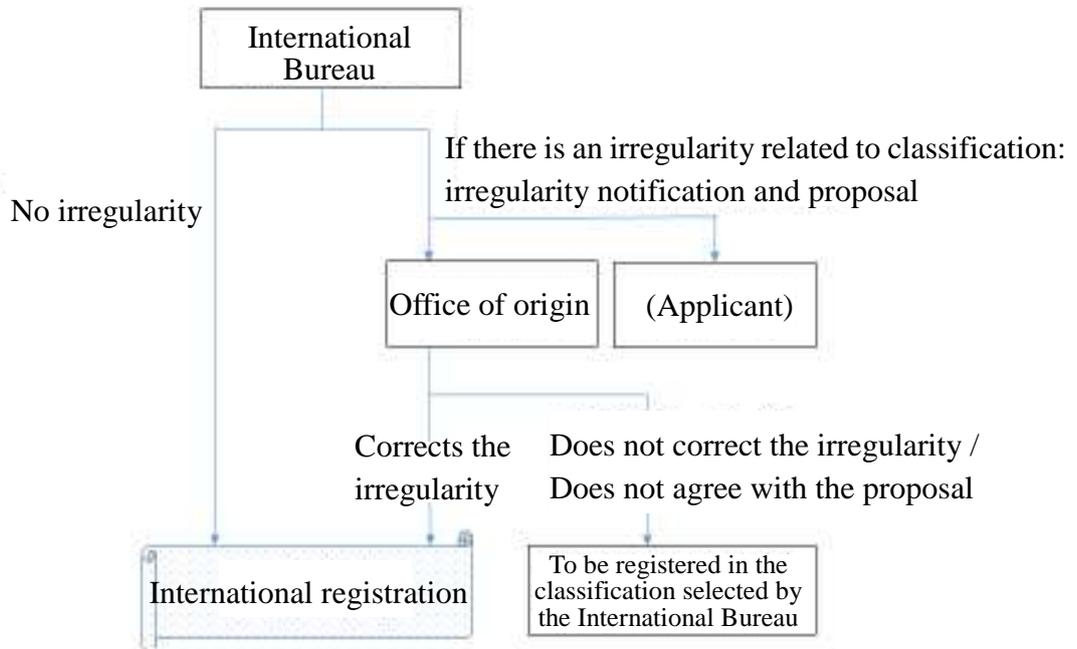
The Office of origin which receives the classification irregularity notification may state opinions with respect to the proposal by the International Bureau within three months from the date of notification. The applicant may communicate his/her opinion to the International Bureau via the Office of origin; provided, however, that the applicant shall not reply directly to the International Bureau.

The International Bureau may review the opinions via the Office of origin, judge whether to withdraw, correct, or confirm the prior proposal, and issue another notification.

The International Bureau shall issue a final decision on the class of Goods and Services and have responsibility and authority for the final decision. The International Bureau implements international registration based on the final decision and the registered class will not be changed later. If the number of classes increases by the final decision of the International Bureau, it is necessary to pay a supplementary fee. The fee will be paid directly to the International Bureau.

A summary of examination procedures by the International Bureau with respect to irregularities related to classification is shown in the following flowchart.

Examination by the International Bureau
(Irregularity related to classification)



(2) Irregularity notification with respect to indication of goods and services (Rule 13)

If the International Bureau judges that the language used to indicate the Goods and Services in the international application is too vague for the purposes of classification or is incomprehensible or linguistically incorrect, it will notify the Office of origin and the applicant to that effect.

The Office of origin may propose a correction of the irregularity within three months from the date of notification. The applicant may communicate his/her opinion via the Office of origin; however, the applicant cannot communicate directly with the International Bureau as in the case of (1) above: classification irregularity notification.

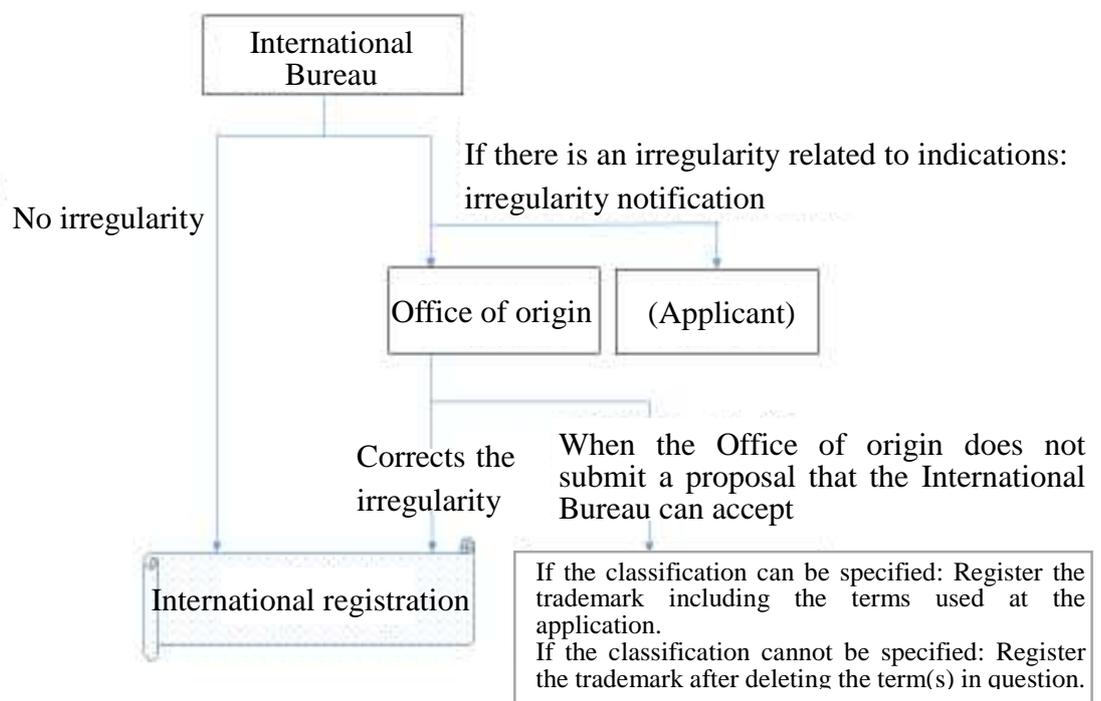
If the International Bureau agrees with the proposal of the Office of origin or if the Office of origin agrees with the proposal of the International Bureau, the term(s) will be changed based on the agreed proposal.

On the other hand, in cases where no proposal for correcting the irregularity can be agreed upon, if the class of said goods and services is specified by the Office of origin, the International Bureau indicates “incomprehensible,” etc. and

leaves the indication in the international registration; or if the class of the goods and services is not specified, the term(s) in question are deleted.

A summary of examination procedures by the International Bureau with respect to irregularities related to the indication of goods and services is shown in the following flowchart.

Examination by the International Bureau
(Irregularity related to indication of goods and services)



(3) Other irregularity notification (Rule 11)

If there is an irregularity that the Office of origin should correct or the applicant should correct other than those irregularities related to the aforementioned classification and indication of goods and services, the International Bureau will send an irregularity notification to the Office of origin and the applicant.

Examples of irregularities to be corrected by the Office of origin are an application that is not prepared in conformance with the correct official form, an application that has no signature of the Office of origin, etc.; examples of irregularities to be corrected by the applicant are an application with insufficient indications and designations related to a priority right, with an unclear copy of

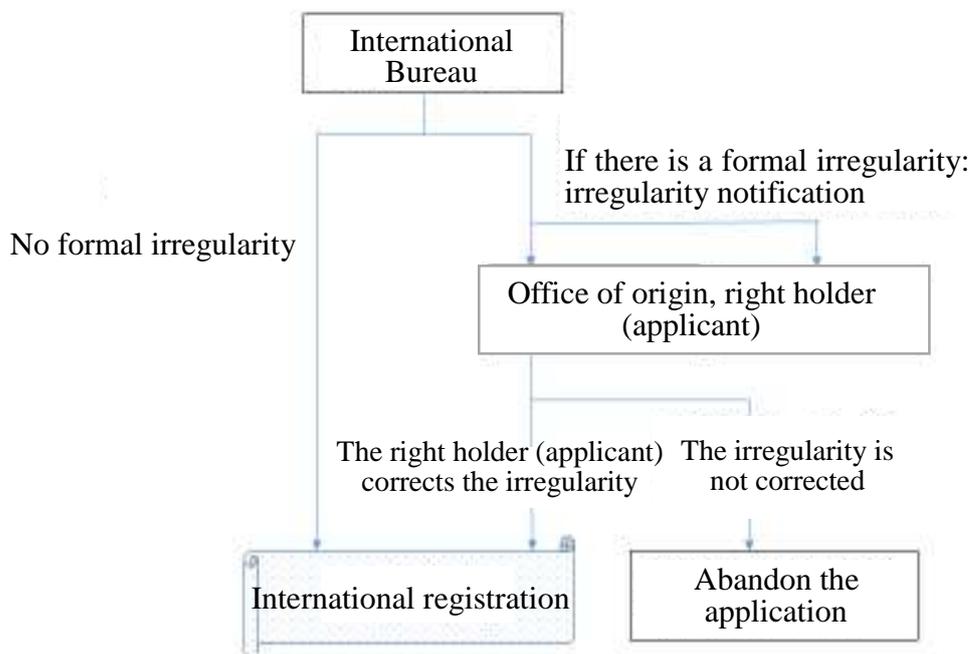
the mark, with which the Goods and Services with respect to the designated contracting party for the international application are not included in the major indication of goods and services, or for which the fee is insufficient or has not been paid.

In response to the irregularity notification, the Office of origin or applicant may correct the irregularity within three months from the date of notification; however, if the irregularity is not corrected, it is considered that the international application is abandoned and the International Bureau informs the Office of origin and the applicant of this fact.

If the international application is considered to be abandoned, the International Bureau will refund the fee that has been paid after deducting half of the basic fee.

A summary of general examination procedures by the International Bureau related to other irregularities is shown in the following flowchart.

Examination by the International Bureau
(Irregularity related to those other than classification or indication)



In cases where a country that requests the submission of a declaration of intention to use the mark (MM18) along with application documents, like the U.S., is included in the designated contracting parties, if there is an irregularity, such as when a required declaration is not submitted, the International Bureau will immediately inform the Office of origin and applicant of that fact.

If the applicant submits a corrected declaration form to the Office of origin and the declaration form is accepted by the International Bureau within two months from the date of acceptance of the international application by the Office of origin, the declaration form is treated as if it was accepted by the International Bureau along with the international application. However, if the corrected declaration form is not accepted by the International Bureau within a period of two months, it is considered that the contracting party requesting the declaration of intention to use the mark was not designated and the International Bureau will inform the Office of origin and the applicant of that fact.

3.3.2 International Registration Procedures

(1) International registration and notifications to relevant offices

When the International Bureau judges that the international application has no irregularity, it registers the mark on the international register and notifies the office of the designated contracting party(s) that the international registration is complete (notification of designation). In addition, the International Bureau will notify the Office of origin to that effect as well as send a registration certificate and receipt to the applicant (or right holder); provided, however, that if the Office of origin desires to send the registration certificate to the applicant via the Office of origin and informs the International Bureau to that effect, the registration certificate will be sent to the right holder via the Office of origin.

The languages to be used for the international application are three languages, including English, French, and Spanish. (Rule 6)

The international registration contains the following matters (Rule 14 (2)).

- (i) All information related to the international application (the name and address of the right holder or applicant, the representative, mark, Goods and Services, etc.)
- (ii) Date and number of the international application
- (iii) Whether each designated contracting party is designated based on the Madrid Agreement or Madrid Protocol
- (iv) If the mark can be classified according to the International Classification of Figurative Elements and a declaration of a mark in standard characters is not contained, the relevant classification symbols of the said Classification
- (v) If seniority is claimed, the relevant information

(2) Date of international registration

If the International Bureau accepts the international registration within two months from the day when the Office of origin accepts the international

application, the day when the Office of origin accepts it is the date of international registration.

If the International Bureau does not accept the international application within two months from the day when the Office of origin accepts the International Application, the day when the International Bureau actually accepts the international application is recorded as the date of international registration.

If the international application accepted by the International Bureau does not contain all of the following elements, the International Bureau will notify the Office of origin of the irregularity. In cases where the International Bureau accepts the last element that was insufficient within two months from the date of notification, the date of international registration is the day when the Office of origin accepts the international application containing the insufficient elements (Rule 15).

On the other hand, in cases where the day when the International Bureau accepts the insufficient element is more than two months from the notification, the date of the international application is the day when the last insufficient element is accepted by the International Bureau; provided, however, that if the irregularity is not corrected within three months from the notification, the international application is considered to be abandoned (Rule 11).

All of the following elements are to be contained in the international application.

- (i) Identification of applicant
- (ii) Designated contracting party
- (iii) Reproduction of the mark
- (iv) Indications of goods and services for which registration of the mark is sought

(3) International publication

When the international registration is made, the International Bureau posts the international registration data on the gazette that is regularly published by the International Bureau, and prepares and publishes an electronic database. The publication is in the language of the registration record: English, French, and Spanish.

(4) Effects of international registration

- (i) Expansion of effects of international registration

The effects of international registration will expand to the contracting party(s) designated by the applicant in the international application (Articles 3bis and 3ter).

After the date of recording the international registration, the mark in each designated contracting party will receive the same protection as that given when the application for the mark was directly submitted to the Office of each designated contracting party (Article 4).

If the Office of the designated contracting party does not make a notification of refusal within the period of notification of refusal (one year or 18 months if a declaration is made) and the period elapses, the mark in each contracting party will receive the same protection on the date of international registration and after as the marks registered to the Office.

The protection of each contracting party is granted individually in accordance with the laws of each party.

(ii) Duration

The duration of the international registration is ten years from the date of international registration and it can be renewed every ten years.

3.4 Examination Procedures by the Office of the Designated Contracting Party

After international registration, a designated contracting party which receives a notification of designation from the International Bureau will start substantive examination of the international application. The designated contracting party may declare that they cannot grant protection by issuing a notification of refusal within one year from the notification or within 18 months if a declaration is made (notification of provisional refusal) (Article 5 (2)).

3.4.1 Examination and Notification of Refusal

(1) Grounds for refusal

The Office of the designated contracting party will examine the international registration based on the laws of its country. If there are grounds for refusal of protection, the party will notify the International Bureau of the refusal, indicating all grounds. A template of the notification form is posted as information for the Offices on the WIPO website (Form 3).

http://www.wipo.int/madrid/en/contracting_parties/model_forms.html

Grounds for refusal are usually as follows: absolute grounds for refusal related to distinctive characters of the mark and to public order and morals, and relative grounds for refusal related to conflicts with existing trademark rights of a third

party. There are two types of contracting parties: parties that examine both grounds of refusal, such as Japan; and parties (or territories) that examine only absolute grounds for refusal and have a system for relative grounds of refusal where conflicts are resolved between parties if an opposition is filed, etc.

However, even in cases where the laws of each contracting party do not allow registration of marks designating more than the specified number of classes or goods or services, they cannot refuse protection based on the aforementioned grounds alone with respect to international application (Article 5 (1)). In other words, contracting parties cannot refuse protection of international registration on the grounds alone that the laws and regulations of the designated contracting party allow registration only for a limited number of classes or only for a limited number of goods or services.

The decision of the classification of Goods and Services by the International Bureau is final and therefore classification of the international registration shall be followed. On the other hand, the designated contracting parties may request to limit the indication of goods and services to a specific indication and request amendment of the indications on the grounds that they are vague, according to the laws of the designated contracting parties.

Even if there is a declaration of a mark in standard characters in the international application, the effects of standard characters may be judged by the contracting party, since the scope of standard characters may vary by the contracting party.

(2) Period of notification of refusal

The International Bureau will be notified of the grounds for refusal within one year from the date of notification of designation of territory by the International Bureau, and within 18 months if a declaration of 18 months has been made; however, a notification within the period does not have to be a notification of final disposition, but means a notification of provisional refusal.

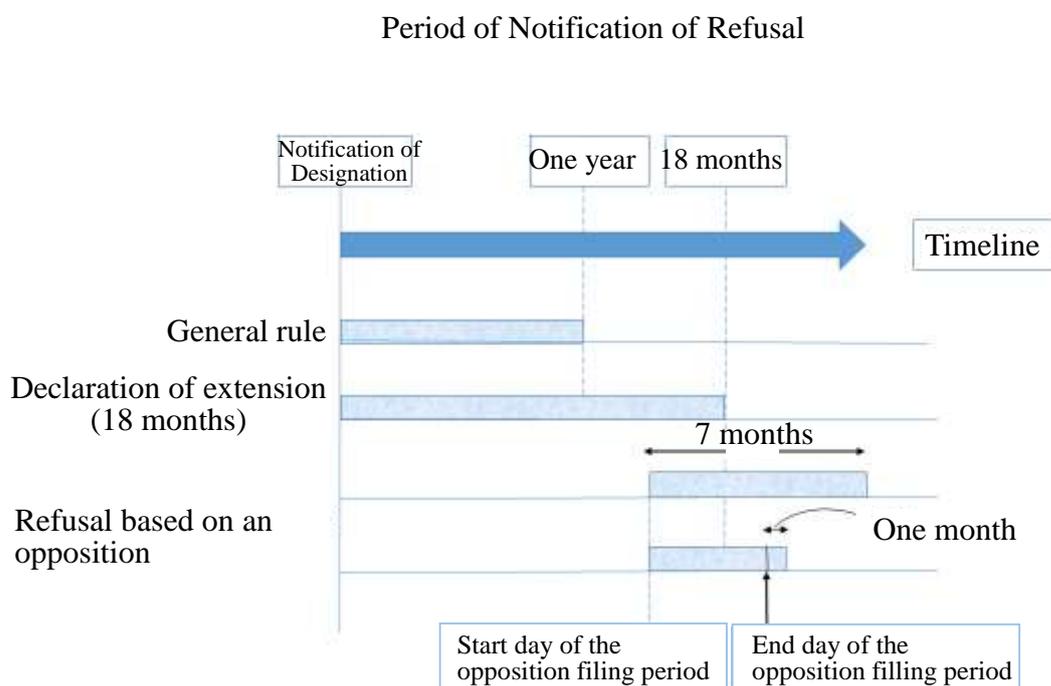
If a designated contracting party that made a declaration of 18 months fulfills the following conditions with respect to the period of notification of refusal based on an opposition, it can notify of the refusal after 18 months have elapsed (Article 5 (2)).

- (i) It has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and
- (ii) The notification of refusal is made within one month from the expiry of the opposition period and, in any case, no later than seven months from the date on which the opposition period begins (Article 5 (2) (c)).

If dates to start and end filing an opposition are available, indicate the dates in the notification (1) above. If the dates are not available at the time of notification, they shall be reported to the International Bureau immediately when they are found out. The templates (form 1 and 2) for the format of the notification (1) above are posted on the website of WIPO.

http://www.wipo.int/madrid/en/contracting_parties/model_forms.html

The following figure indicates the period of notification of refusal by case.



(3) Notification of provisional refusal

A notification of provisional refusal may be comprised of a declaration stating the grounds on which the Office making the notification considers that protection cannot be granted in the contracting party concerned ("ex officio provisional refusal") or a declaration that protection cannot be granted in the contracting party concerned because an opposition has been filed ("provisional refusal based on an opposition") or both. A notification of refusal is stated for one international registration only.

A notification of provisional refusal contains the following information (Rule 17 (2))

- (i) The Office making the notification

- (ii) The international registration number
- (iii) All the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law
- (iv) In cases where the provisional refusal indicates application or registration of a prior mark with which the mark subject to the international registration is considered to conflict, the application date and number of the cited mark, name of the mark holder, list of goods or services subject to the cited mark, etc.
- (v) Grounds that the grounds for provisional refusal are the basis of a refusal that will affect all goods and services, or indication of goods and services that are affected by the provisional refusal or indication of goods and services that are not affected by the provisional refusal
- (vi) Response period for the provisional refusal and whether it is necessary to appoint a representative who has a domicile in the designated contracting party for the response
- (vii) Reference provisions of laws and regulations that are the basis of the grounds for provisional refusal
- (viii) If the provisional refusal is based on an opposition, the fact that an opposition has been filed, the name and address of the opponent, the prior and cited trademark that is the basis of the opposition, and a list of its goods and services, in addition to the aforementioned matters

The provisional refusal is prepared in a language selected by each designated contracting party from among English, French, and Spanish; however, the list of goods and services of the cited trademark can be indicated in the language used for the cited application or registration.

As mentioned before, the notification of provisional refusal will be sent to the International Bureau within the specified period with the date.

The judgment on whether the notification of provisional refusal was sent within the specified period or not is based on the postmark if it is sent by mail.

3.4.2 Procedures after Receipt of a Notification of Provisional Refusal

(1) Procedures by the International Bureau

The International Bureau records the notification of provisional refusal on the international register as well as the indication of the date when the notification of provisional refusal was sent, and publishes it in the gazette by indicating whether the provisional refusal is a general refusal or partial refusal. In case of a partial refusal, the class of goods affected by the provisional refusal will be published.

If the Office of origin has informed the International Bureau that it desires to receive a copy of the provisional refusal, its copy will be sent to the Office of origin as well as to the applicant or right holder (Rule 17 (4)).

Even if the notification of provisional refusal that is sent by the Office of the designated contracting party to the International Bureau has an irregularity, such as when the international registration number is not contained, when the grounds for refusal are not indicated, when the sending of the notification of refusal was delayed, etc., the International Bureau will record the provisional refusal on the international register and order the Office that notified it of the provisional refusal to send an amended notification within two months. The irregular notification of provisional refusal will also be sent to the right holder. In cases where the International Bureau notifies the right holder that it is not considered as a notification of provisional refusal by itself and it has also notified the Office of origin of the provisional refusal, it will notify the Office of origin, which received the notification, that it is an irregular provisional refusal (Rule 18).

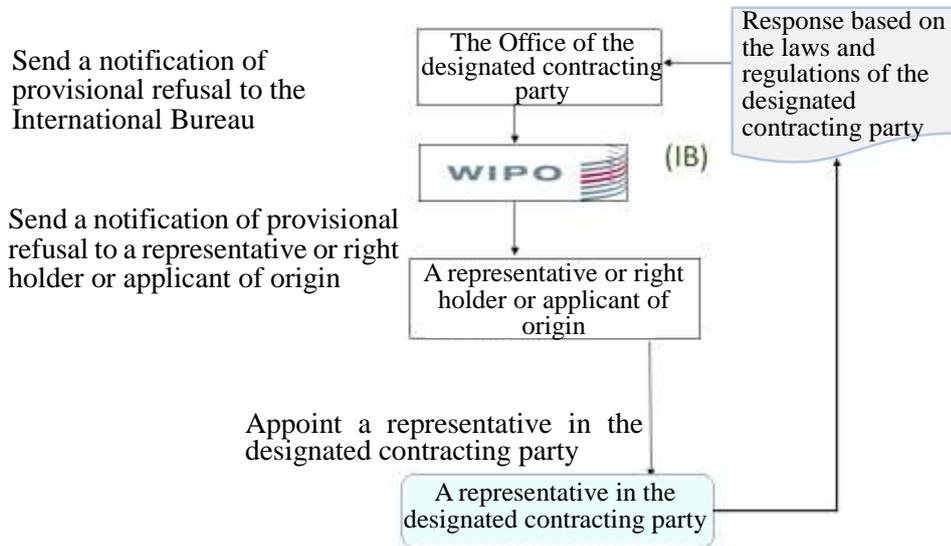
(2) Procedures by the right holder or applicant

(i) Responses

The right holder or applicant who received the notification of provisional refusal may receive the same remedy as in the case of filing an application directly to the Office of the designated contracting party that issued the notification of refusal (Article 5 (3)). Therefore, the right holder or applicant who received the notification of refusal may take some response procedures against the Office of the designated contracting party; provided, however, that, since there are many contracting parties that require procedures to be taken by a representative who has a domicile in the country of origin in cases where an overseas resident to the Office of origin takes procedures, a representative who is domiciled in the designated contracting party is usually appointed to take response procedures.

The outline of the flow of procedures from the sending of a notification of provisional refusal by the Office of the designated contracting party until taking response procedures by the right holder or applicant (or its representative) is indicated below.

Notification of Provisional Refusal and Responses



(ii) Responding to the grounds of refusal related to Goods and Services

In cases where the grounds for refusal are related to indications of Goods and Services, or prior trademark cited by a third party, if it is handled directly to the Office of the designated contracting party by correcting or limiting the indications of Goods and Services in order to resolve the refusal, the Goods and Services of international registration are changed only in the relationship to the designated contracting party with respect to the amendment and limitation of the goods and services. In other words, the amendment and limitation of Goods and Services in a designated contracting party will not affect the protection of international registration in the other designated contracting parties.

(iii) Response procedures to the International Bureau

In cases where the grounds for refusal are related only to indications of Goods and Services, the Goods and Services may be limited in the designated contracting parties by submitting an MM6 form as a Request for the Recording of a Limitation of the List of Goods and Services to the International Bureau, but not by amending or limiting them directly to the Office of the designated contracting party.

However, if the Goods and Services are not limited during the response period to the notification of provisional refusal in the designated contracting party, a decision of refusal may be issued since there is no response during the specified period depending on the Office of the designated contracting parties.

- (iv) Grounds for provisional refusal related to indications or limitations of goods and services

If a provisional refusal is on the basis of grounds other than those related to Goods and Services, such as absolute grounds for refusal, the right holder or applicant will submit a written response, including a written opinion, to the Office of the designated contracting party as a response procedure.

3.4.3 Statement of Grant of Protection

If a notice of designation is sent to the designated contracting party and a notification of provisional refusal is not sent within the period of notification of refusal, protection is granted to the mark automatically in the designated contracting party. However, since a right holder or applicant may become anxious if he/she does not receive any information, the amended rule that came into effect on September 1, 2009, stipulated that the Office of the designated contracting party sends a statement of grant of protection to the International Bureau when the examination stage is completed so that the right holder or applicant can check the protection status in the designated contracting party, and it became obligatory in 2011 and after (Rules 18bis and 18ter).

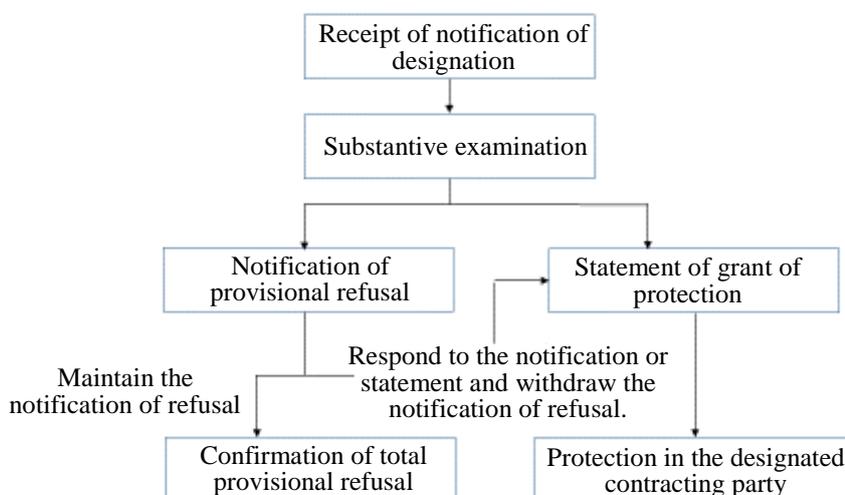
The Office of the designated contracting party is required to send a statement of grant of protection; however, the Office of the designated contracting party has no legal responsibility.

- (1) Final disposition by the Office of the designated contracting party (Rule 18ter)
 - (i) In cases where the examination by the designated contracting party is completed before expiry of the period of notification of refusal and no grounds for refusal are found, the Office of the designated contracting party will promptly send a statement of grant of protection to the International Bureau before the end of the notification period.
 - (ii) After sending a notification of provisional refusal and all procedures to the Office of the designated contracting party are completed, the Office of the designated contracting party will send any of the following to the International Bureau.
 - i) A statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the designated contracting party concerned, for all goods and services for which protection has been requested, or

- ii) A statement indicating the goods and services for which protection of the mark is granted in the designated contracting party concerned.
- (iii) In cases where a notification of total provisional refusal to the International Bureau is sent, all examinations are completed, and the Office has decided to confirm refusal of the protection of the mark in the contracting party concerned for all goods and services, send to the International Bureau a statement to that effect (a confirmation of total provisional refusal).
- (iv) If an additional decision that is made after sending the aforementioned statement of grant of protection or confirmation of total provisional refusal affects the protection of the marks, send a further statement to the International Bureau.

For formats of these statements there are WIPO forms 4 through 7.

Examination Procedures in the Designated Contracting Party



(2) Issuance of certification

After a statement of grant of protection is issued, some of the Offices of the contracting parties (U.S., Korea, Japan, etc.) may issue its original certificate to indicate the scope of protection. There are also parties that issue a certificate upon request (China, etc.).

(3) Interim status (Rule 18bis)

After completion of the ex-officio examination, when a third party may file an opposition or state opinions, the Office of the designated contracting party may arbitrarily send a statement to that effect to the International Bureau.

The International Bureau records any statements received from the designated contracting party on the international registry and informs the right holder or applicant of that fact.

(4) Invalidity of international registration in the designated contracting party

There are cases where international registration becomes invalid in territories of the contracting party. In this case, the authorized office cannot make a decision of invalidity without giving right holders or applicants opportunities to protect their right (Article 5 (3)). In cases where the international registration becomes invalid and the invalidity is no longer subject to appeal, the Office of the contracting party that declared the invalidity will notify the International Bureau of the decision. The notification will contain the following matters (Rule 19).

- (i) The authority that declared the invalidity
- (ii) The fact that the invalidity is no longer subject to appeal
- (iii) International registration number
- (iv) Name of the right holder or applicant
- (v) If the invalidity does not concern all the goods and services, the goods and services for which invalidity is declared or the goods and services for which invalidity has not been declared
- (vi) Date on which the invalidity was declared, and its effective date

The International Bureau which received the notification of decision of invalidity will record the invalidity and information contained in the notification of invalidity in the international register and inform the right holder or applicant of the fact.

(5) Payment of individual fees in two parts

Each contracting party may declare to collect individual fees in two parts (Rule 34(3)). As of September 2015, two countries, Japan and Cuba, request payment of the second part of the individual fee after issuing a statement of grant of protection. Ghana requested payment of the second part of individual fee until 2015; however, it changed the individual fee amount as well as issuing a notification to withdraw the notification of payment in two parts. Then, it is no longer necessary to pay the second part of the individual fee in Ghana on August 10, 2015 and after.

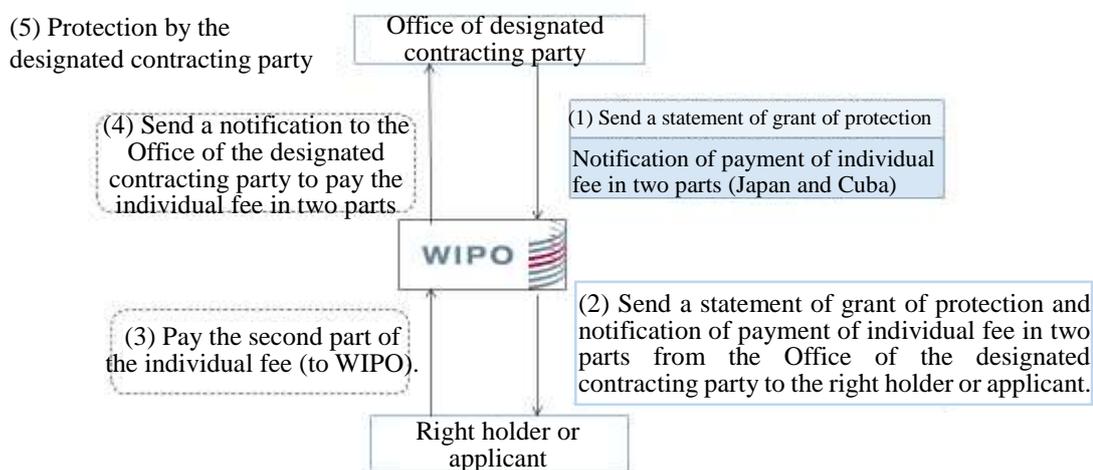
Designated contracting parties that declare the collection of the individual fee in two parts will notify the International Bureau of the time to pay the second part of the individual fee, international registration number in question, name of right holder or applicant, etc. as well as statement of grant of protection, and the International Bureau will send said notification to the right holder or applicant (or his/her representative to the International Bureau). The right holder or applicant (or his/her representative) will pay the second part of the individual fee to the International Bureau.

When the right holder or applicant (or his/her representative) pays the second part of the individual fee to the International Bureau within the specified period, the International Bureau will inform the relevant designated contracting parties to that effect. If the designated contracting party is Japan, the Japan Patent Office will register the trademark right after accepting the notification and then a trademark registration certificate will be delivered to the right holder or applicant (or his/her representative in Japan) based on the Trademark Act of Japan.

However, if the second part of the individual fee is not paid within the specified period, the International Bureau notifies the relevant contracting parties of this fact, cancels the international registration on the international register related to the relevant contracting parties, and notifies the right holder or applicant of this fact.

There are no remedies with respect to cancellation of the protection due to an unpaid second part of the individual fee. Since Rule 5bis, which came into effect on January 1, 2015, stipulated remedies for the International Bureau in cases where the period of the specified procedures elapses (continued processing), the procedures can be continued by the applicant or right holder filing an application (MM20) and by payment of the specified fee. However, procedures for continued processing must be implemented within two months from the due date of payment and all of the amount of the second part of the individual fee must be paid within said period. If the procedures are not implemented and the fee is not paid within the period, the protection of the mark is cancelled in the designated contracting party.

Payment of Individual Fee in Two Parts



3.4.4 Effects of Registration at the Office of the Designated Contracting Party

If the Office of the designated contracting party does not issue a notification of provisional refusal within one year or within 18 months if a declaration is made, the same effects as if the mark has been registered at the Office of the designated contracting party from the date of international registration are granted when the period elapses or at the time of cancellation if the notification of provisional refusal has been cancelled (Article 4 (1) a).

3.5 Replacement

3.5.1 Replacement

If an identical person to the holder of the international registration had a domestic registration in each designated contracting party before the international registration and the mark under the international registration and the mark under the domestic registration are identical, the domestic registration may be replaced with the international registration without prejudice to any rights acquired by the domestic registration (Article 4bis) and the replacement enables the holder to unify the trademark that he/she has already obtained in the designated contracting party with the international registration.

The replacement becomes effective automatically by fulfilling the following conditions.

- (1) The trademarks are the same.
- (2) The right holders are the same.
- (3) The protection of the international registration is effective for the designated contracting party after the domestic registration.
- (4) All of the Goods and Services under the domestic registration are contained in the international registration.

3.5.2 Effects of Replacement

The effect of replacement automatically arises; however, the domestic registration that is replaced with the international registration will not cease. The priority claim that was approved under the domestic registration will not be harmed and the prior domestic registration can be renewed. In particular, in consideration of the fact that the international registration may be cancelled before five years elapse from the international registration based on the dependence of the international registration, if the prior domestic registration expires within the period subject to the basic application or basic registration, the right holder should renew the domestic registration in question.

3.5.3 Notification of Replacement

The Office of the designated contracting party records the replacement on the domestic register and if the requirements for replacement are fulfilled, it will notify the International Bureau.

The right holder may request to record the replacement on the international register via the Office of the designated contracting party. When the International Bureau receives a notification from the Office of the designated contracting party, it will register the replacement on the international registry and notify the right holder.

3.6 Dependency on International Registration

International registration is subject to basic application or basic registration for five years from the date of registration. This means that if a basic application is withdrawn or refusal is confirmed before five years have expired from the date of international registration, or if invalidity, abandonment, cancellation, etc. of basic registration is confirmed, all or part of the Goods and Services of the international registration in question will be cancelled within the scope where basic application or basic registration is cancelled (Article 6 (3)).

If an appeal against a refusal decision or an appeal for invalidity is filed before expiry of the five-year period and the refusal, invalidity, etc. is confirmed after the five-year period has elapsed, the international registration will be cancelled within the scope that is cancelled with basic registration or basic application. The same applies to an opposition to the basic application.

If the international registration is canceled, the protection in the designated contracting party will lapse.

In this system, if a third party desires the protection of the mark to lapse in the designated contracting party where the trademark is protected under the international registration, the protections in multiple designated contracting parties may lapse by taking procedures with the Office of origin to request cancellation of the basic application or basic registration that is the basis of the international registration; therefore, it is called “Central Attack.”

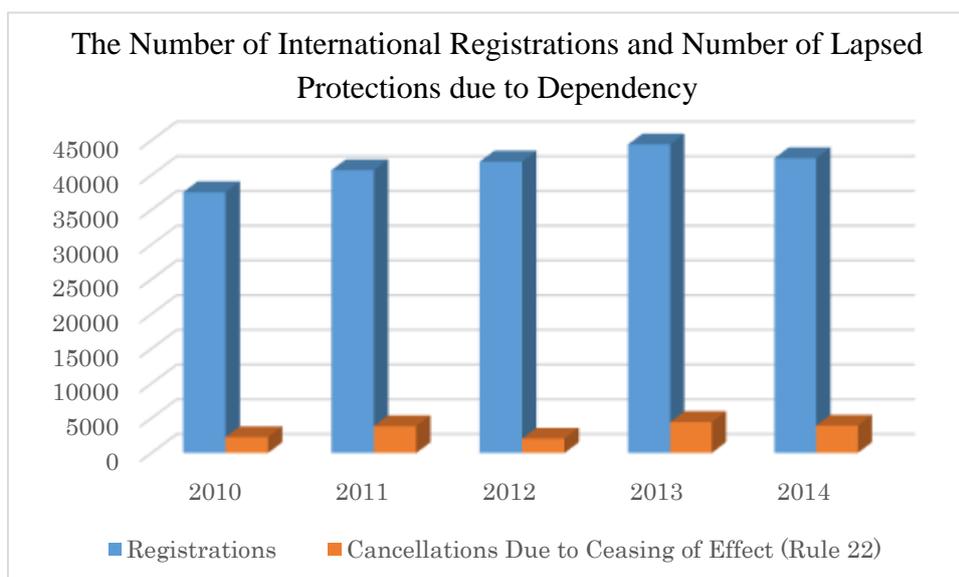
However, not only by the third party’s request for cancellation, but also in cases where an application in origin is set as a basis of international registration and the applicant limits the Goods and Services in the examination process of the application, the protection of the international registration will lapse within the scope of limitation and the protection will lapse in said scope in the designated contracting parties. If the refusal decision is confirmed as a result of examination of basic application by the Office of origin, the protection in the designated contracting party also lapses. Therefore, in particular, if the Office of origin is the country that performs a substantive examination also with relative grounds for the trademark application, the applicant (or right holder) should pay careful attention to the dependency of the international registration.

If the applicant or right holder of an international registration, basic application or basic registration is changed due to transfer, the dependency will not be affected.

When five years have elapsed from the date of international registration, the international registration will become independent from the basic application

and basic registration (Article 6 (2)). If a subsequent designation, which will be indicated later, is made, the start date of the five-year period is the date of international registration.

The possibility of central attack is often indicated as one of the disadvantages to the applicant (or right holder) with the Madrid System; however, there are not many cases where protection of international registration actually lapses due to a third party’s action to claim invalidity or cancellation of the basic registration. According to the statistics of WIPO, there were 3,917 cases of international registration for which protection lapsed due to central attack in 2014; however, most of them were on the basis of marks under application. It is said that the number of cases where protection of international registration lapsed due to cancelation of the basic registration by the third party’s claim of invalidity was less than 1% of all cases for which protection lapsed due to dependency of international registration. (Source: “Outline of Procedures in the Madrid System”)



Source: WIPO Statistics

3.6.1 Procedures at the Office of Origin

If the following matter occurs with the basic application or basic registration before five years elapse from the date of international registration, the Office of

origin will send the International Bureau the “Notification Relating to Ceasing the Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration.”

- (1) In cases where withdrawal, extinguishment, abandonment, refusal, or invalidity of the basic application or basic registration is confirmed
- (2) In cases where an appeal against refusal decision, appeal for invalidity, or procedures to file opposition has been started before expiry of the five-year period and refusal, extinguishment, cancellation, or invalidity is confirmed after the expiry of the period
- (3) In cases where the Goods and Services are limited by correction

The international registration number, name of right holder or applicant, and the facts and decision that affect the basic application or basic registration are indicated in the aforementioned notification that the Office of origin sends to the International Bureau; provided, however, that the grounds for decision may not be presented to the International Bureau.

If it affects only part of the goods and services subject to the international registration, the goods and services which are affected or are not affected must be indicated in the notification.

WIPO form 9 is presented as a notification form to the International Bureau. Form 9 has a column where the Office of origin requests cancellation of the international registration for the corresponding scope from the International Bureau.

3.6.2 Procedures by the International Bureau

When receiving the aforementioned notification from the Office of origin, the International Bureau records the content of the notification on the international register and sends a copy of the notification to the Office of the designated contracting party and trademark holder. If the notification from the Office of origin requests to cancel the international registration, the International Bureau cancels the international registration to the corresponding extent, notifies the Office of the designated contracting party and the right holder or applicant of the following matters, and publishes them in the gazette (Article 6 (4)).

- (1) The day when the international registration is cancelled on the international register
- (2) If the cancellation is related to all goods and services, that fact
- (3) If the cancellation is related to part of the goods and services, the goods and services that are affected by the cancellation or the goods and services that are not affected by the cancellation

3.6.3 Effects in the Designated Contracting Party

Based on the notification from the International Bureau, the right holder or applicant can no longer claim the protection in the designated contracting party (Article 6 (3)).

3.6.4 Transformation

Even if the international registration is cancelled for all or part of the Goods and Services by a central attack, the right holder or applicant may transfer it to the national or regional application while maintaining the interests of the date of international registration under the following specified conditions (“Transformation”; Article 9quinquies).

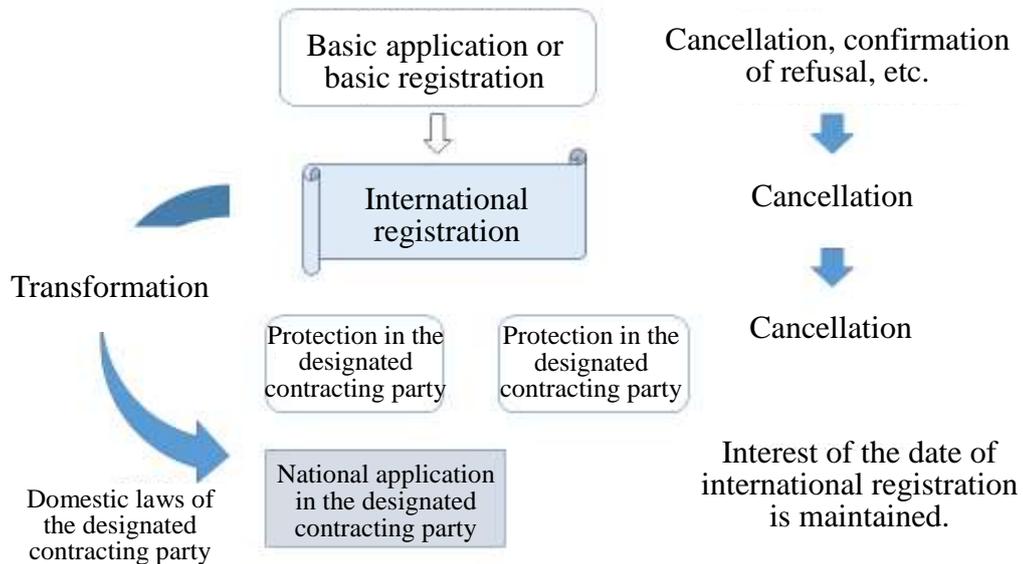
The conditions to allow transformation are as stated below.

- (1) File an application for trademark registration in accordance with the laws and regulations of each contracting party within three months from the date on which the international registration was cancelled. The date on which the international registration was cancelled means the day when the cancellation is recorded on the international register.
- (2) The goods and services listed in the application for mark registration are actually contained in the goods and services specified under the international registration in respect of the contracting party concerned.
- (3) All of the requirements of the relevant laws and regulations are fulfilled, including payment of fees for the application for mark registration in the designated contracting party.

If the transformation procedures are completed properly, the mark of the international registration for which protection lapsed is deemed to be applied in the designated contracting party on the date of international registration (in cases of subsequent designation, the date of subsequent designation).

If a priority right is claimed for the international registration, the same priority right can be claimed.

Central Attack and Transformation

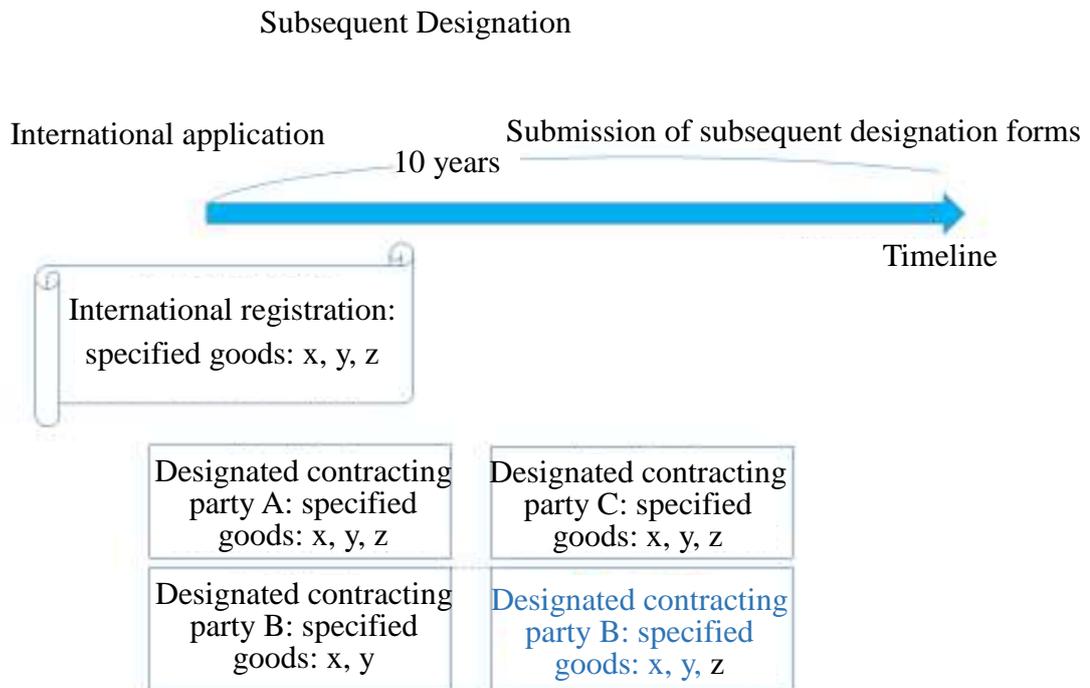


3.7 Subsequent Designation

After international registration, the right holder or applicant may add a designated contracting party(s) and Goods and Services with respect to the international registration (“Subsequent designation” (Article 3ter (2)). In other words, it is possible to request expansion of protection after international registration in the contracting party that was not designated at the time of international application. In cases where the goods and services in the designated contracting party were limited at the international application, protection may be requested by adding Goods and Services within the scope of the international registration by a subsequent designation. Therefore, the protection may be extended with respect to contracting parties that were not designated at the time of international application on the grounds that the protection of the mark was not necessary in cases where the protection is required subsequently for business development, etc.

In addition, a subsequent designation is possible in a country that was not a contracting party at the time of international application and joined subsequently in the contracting party. However, in this case, an international registration before the protocol comes into effect cannot be registered subsequently in a country which has declared that subsequent designation based on an international registration before the protocol comes into effect is not allowed (Article 14 (5)). As of September 2015, the following countries have made this declaration: Estonia, Namibia, Turkey, Philippines, and India.

The following is an example of a subsequent designation.



3.7.1 Procedures for Subsequent Designation

(1) Subsequent designation form

Procedures for subsequent designation can be implemented by the right holder or applicant via the Office of origin or directly with the International Bureau.

The subsequent designation form includes or indicates the following matters (Rule 24 (3)).

- International registration number concerned
- Name and address of the trademark holder
- Contracting party to be designated
- If the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, if the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services
- The amount of fees being paid
- If the subsequent designation is submitted by the Office, the date when said Office accepted it

The subsequent designation form may contain a request that the subsequent designation take effect after the recording of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration.

If the contracting party to be designated subsequently is the U.S., submit a Declaration of Intention to Use the Mark (MM18), and if claiming seniority, submit a Claim of Seniority (MM17) along with the subsequent designation form respectively.

(2) Language

If the subsequent designation form is submitted via the Office of origin, use the language selected by the Office of origin. If it is submitted directly to the International Bureau, use any of the languages among English, French, and Spanish.

(3) Fee

The specified fee shall be paid. If the Office of origin is the country that requests the fee, that amount shall also be paid.

3.7.2 Procedures by the International Bureau

If a subsequent designation form is submitted via the Office of origin, if the International Bureau accepts it within two months from the date of acceptance by the Office of origin, the date when the Office of origin accepted it is recorded as the date of subsequent designation.

If a subsequent designation is submitted directly to the International Bureau, the date when the International Bureau accepted it is the date of subsequent designation.

In cases where there is an irregularity with the international registration number, indication of the designated contracting party, specification of goods and services, Declaration of Intention to Use the Mark (MM18) to be submitted with the subsequent designation form, etc. in a subsequent designation form that the International Bureau accepted directly or via the Office of origin, if the subsequent designation form was submitted directly to the International Bureau, the International Bureau notifies the right holder of the irregularity, and if it was

submitted via the Office of origin, the International Bureau notifies the Office of origin of the irregularity.

If an irregularity notification is issued, the day when the irregularity is corrected is the date of the subsequent designation; however, the irregularity must be corrected within three months from the notification. If the irregularity is not corrected within the period, the subsequent designation is considered to be abandoned. However, the amendment of Rules in 2014 enabled the right holder to request continued processing by submitting a new form (MM20) within two months from the expiry of the period along with payment of the specified fee.

If the submitted subsequent designation form fulfills the requirements, the International Bureau registers the subsequent designation on the international register and posts it in the gazette. The International Bureau notifies the Office of the contracting party that is designated by the subsequent designation and the right holder, and if the subsequent designation is submitted via the Office of origin, the International Bureau notifies the Office of origin to that effect.

3.7.3 Effects of Subsequent Designation

When the subsequent designation is recorded on the international register, it is considered to be an international application filed on the date of subsequent designation that is recorded on the international register. It has the same effects as an application that is filed directly to each designated contracting party on the recorded date of the subsequent designation.

3.7.4 Procedures by the Office of the Designated Contracting Party

If there are grounds for refusal, the Office of the designated contracting party will notify of the refusal within one year from the date of notification of the subsequent designation or within 18 months if a declaration is made. If the notification of refusal is not issued within the period, the registration will receive the same protection as the international registration, in other words, it will receive the same protection as the national registration in the designated contracting party. The effects of the protection by the subsequent designation come into effect on the date when the subsequent designation is recorded on the international register; however, the duration is ten years from the date of international registration and the date when the subsequent designation is recorded is not used as a standard. Therefore, it is possible to unify management of the protection period on the international register.

3.8 Duration and Renewal

3.8.1 Duration of International Registration

The duration of international registration is ten years from the date of international registration and it can be renewed every ten years by paying the fee (Article 7 (1)). The International Bureau unofficially notifies the right holder (or representative) of the expiry date of the duration of international registration within six months before expiry of the protection period of ten years; provided, however, that the right holder cannot justify the fact that he/she did not pay the renewal fee on the grounds that he/she did not receive the notification.

Since the renewal means an extension of the duration of the international registration, the renewal procedures cannot include a change of content of the international registration, such as the change of name or address of the right holder or his/her representative, etc. If there is a change as mentioned above, it is required to take procedures for application for change with the International Bureau by using the specified format before taking the renewal procedures.

The renewal can be implemented by selecting the designated contracting parties in which the right holder desires to extend the protection.

Even if a refusal is recorded in a specific contracting party, the right holder may apply for renewal with respect to said contracting party (Rule 30 (2) b). This is to protect the right holder in cases where the refusal is subject to appeal and the final decision is not given by the due date of the renewal.

However, in this case, the right holder must submit a statement that he/she registers the renewal with respect to the contracting parties where said refusal is recorded when he/she pays the renewal fee.

On the other hand, the registration cannot be renewed in a designated contracting party where invalidity or abandonment of all goods and services is recorded (Rule 30 (2) c).

In the past, the right holder had to pay a renewal fee that was calculated by the number of classes for which protection is requested in the designated contracting party; however, the amendment of Rule 30 enables the right holder to renew only goods and services that are protected by the statement to grant protection, etc..

If the international registration was not renewed, the International Bureau was only required to notify all designated contracting parties with respect to said international registration of this fact and had no obligation to notify the right holder; however, the amendment of Rule 31 (4) requires that the International Bureau notify the right holder and the representative if any that the international registration was not renewed.

3.8.2 Renewal Procedures

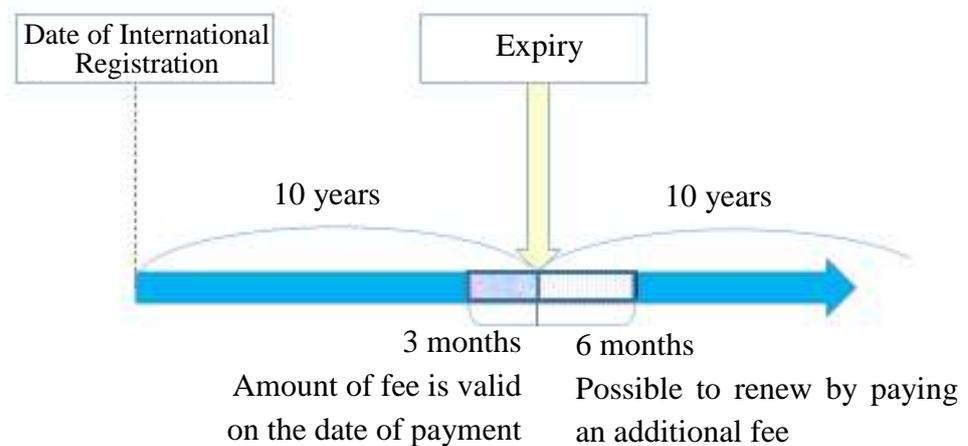
(1) Time of renewal

The renewal can be implemented before the expiry of the duration; provided, however, that the renewal procedure may be implemented even after expiry of the duration if it is within six months (grace period) after the expiry by paying an additional fee, 50% of the original fee.

If any payment made for the purpose of renewal is received by the International Bureau earlier than three months before the expiry date, it is considered as having been received three months before the date on which the renewal is due (Rule 30).

If renewal procedures are not implemented within six months after the expiry, the international registration ceases and the designated contracting parties are notified of the fact and it is published in the gazette.

Renewal Procedure Period



(2) Procedures

The application for renewal shall be filed by the right holder or his/her representative by any of the following methods.

- (i) Submit documents in which the international registration number, the designated contracting party to be renewed, the statement that the registration is renewed, and the method of payment of the fee are indicated, to the International Bureau and pay the specified fee. The format is not specified.
- (ii) Pay the fee by using non-official form MM11 provided by WIPO.
- (iii) Use E-renewal, which uses the WIPO on-line system.

The aforementioned documents (i) and (ii) can be submitted directly to the International Bureau or via the Office of origin; provided, however, that in cases of submitting the renewal application via the Office of origin, the date of submission is also the day when the application arrives at the International Bureau.

(3) Fees

The fees to be paid are the basic fee, complementary fee, supplementary fee, and individual fee.

In cases of implementing the on-line renewal ((iii) above), the fees will be paid by an available credit card or current account at WIPO if opened.

(4) Record of renewal

If the renewal is accepted, it is recorded on the international register on the day when the registration is to be renewed (expiry date of the duration) and the relevant Offices are informed. A certificate will be sent to the right holder.

3.9 Other Procedures

3.9.1 Change of Ownership

If a right holder of the international registration is changed due to transfer of international registration for all or part of the goods and services specified by the international registration or transfer of international registration by company merger, court decision, etc., the International Bureau records the change of ownership in question on the international register at the request of the right holder or Offices (Article 9).

The change of ownership may relate to all goods and services protected by the international registration or to only part of them.

As for designated contracting parties, the change may relate to all of the designated contracting parties or a part of the designated contracting parties.

However, the change of ownership of the international registration may be recorded only when a transferee (new right holder) is entitled to file an

international application under the treaty. In other words, the business offices, address, or nationality of the transferee are required to be in the contracting party.

(1) Procedures

Applications for recording the change of ownership may be filed by the former right holder (transferor), recorded representative of the former right holder, new right holder (transferee) or his/her representative.

If a transferor or his/her representative files the application, the application can be filed via the Office of the transferor or directly to the International Bureau. In cases of filing an application with the International Bureau, the signature of the right holder or his/her representative is required in the specified column of the application form.

On the other hand, if a transferee or his/her representative files the application, the application must be filed via the Office of the transferee, but not directly to the International Bureau. If the transferee has his/her representative take procedures, it is necessary to appoint a local representative in the country of the Office in question.

The application procedures are implemented by using official form MM5. In case of transferring all of the international registration, applications for recording the change can be filed for multiple international registrations under the same right holder by using one form, MM5; however, in cases of partial transfer, MM5 must be prepared for each international registration.

In case of submitting application documents to the International Bureau via the Office, the Office can request to submit evidence related to the change of ownership; however, the International Bureau does not request evidence to be submitted for the change of ownership and no supporting document, such as a transfer agreement, etc. should be sent to the International Bureau. The Office that accepted the application documents signs the documents and submits them to the International Bureau.

(2) Language and fee

The working languages for submission of MM5 to the International Bureau are English, French, or Spanish; provided, however, that they are English or French for an international registration filed before April 1, 2004.

It is required to pay the specified fee (177 CHF) for the procedures to record the change of ownership to the International Bureau before application.

(3) Procedures by the International Bureau

The International Bureau that received the application form shall check whether the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. If the application was filed by the relevant Office, the International Bureau notifies the Office concerned of the irregularity. The right holder may correct the irregularity within three months from the day when the International Bureau notifies him/her of the irregularity (Rule 26 (2)). If the irregularity is not corrected within the period, the application for change of ownership is considered to be abandoned.

However, the amendment of the Rules in 2014 enabled right holders to request continued processing by submitting a new form (MM20) to the International Bureau within two months of the expiry of the period as well as paying the specified fee.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly record the change of ownership in the international register and publish it in the gazette.

The International Bureau notifies the Office of the designated contracting parties which the change will affect and the right holder the fact of the record. If all of the right holders are changed, the International Bureau notifies the former right holder(s) of the change and if part of the right holders is changed, the International Bureau shall notify the fact also to the new right holder(s) for the corresponding part of the international registration (Rule 27 (1)).

The recording day of the international registration is the day when the International Bureau accepts the application form that fulfills the requirements; provided, however, that if there is an application with respect to the statement that should be recorded after the renewal of the international registration coinciding with another change, cancellation, or subsequent designation with respect to the relevant international registration, then the International Bureau shall follow that application.

If the right holder is changed due to transfer of part of the goods and services under the international registration or due to transfer in part of the designated contracting parties, it shall be recorded as a different international registration from the original international register.

(4) Effects

If the change of ownership is recorded on the international register, the right holder of the international registration in question is changed according to the record.

However, since the validity of the change of ownership is based on the laws and regulations of each designated contracting party, the Office of the designated

contracting party that received the notification of the change of ownership from the International Bureau can declare that the change of ownership has no effect in the designated contracting party in question (Rule 27 (4)). This declaration must be notified to the International Bureau within 18 months from the day when the notice of change of ownership is sent by indicating the reasons why the change of ownership has no effects, the main provisions of the corresponding laws and regulations, and whether the declaration can be subject to an appeal. An example of reasons why the change has no effect is a case where the contracting party in question does not allow a transfer that is likely to mislead the public. The International Bureau that received the notification of said declaration shall notify the applicant (or right holder or the Office) and the new right holder of the change.

(5) Merger of International Registration

In cases where the same natural person or legal entity has been recorded as the right holder of two or more international registrations resulting from the fact that the right holder of an international registration is changed with respect to part of the Goods and Services and part of the designated contracting parties and then the single international registration is divided into two or more international registrations, said person may file an application for merger of international registration (Rule 27 (3)). An application for merger of international applications is filed directly to the International Bureau or via the Office of the contracting party; however there is no specified format for the application form and no fee is required.

The merger of international applications facilitates management of international registrations.

3.9.2 Limitation of the List of Goods and Services

The right holder may limit the scope of goods and services with respect to all or part of the designated contracting parties for the international registration (Rule (1) (a)); this is called “Limitation of the List of Goods and Services.”

The limitation is to limit part of the Goods and Services. If there are no goods and services left, the application for limitation is not allowed. In case of deleting all of the Goods and Services, file an application for record of renunciation, which will be explained in the following section.

In cases where a right holder receives a notification of provisional refusal in the designated contracting party and it can be handled by limiting the Goods and Services, the right holder can resolve the grounds for refusal by taking procedures for limitation directly with the International Bureau.

(1) Procedures

The persons who can apply for recording limitation are the right holder and his/her representative. The right holder prepares the application form by using official form MM6 and sends it to the International Bureau. Enter the Goods and Services after limitation in MM6 and the right holder or his/her representative signs in the signature column.

In case of providing the same limitation to all designated contracting parties or the same designated contracting party of each international registration with respect to multiple international registrations with the same right holder, the procedures may be implemented by submitting one MM6.

On the other hand, if the content of the limitation varies by the designated contracting party, prepare an MM6 for each contracting party and submit it to the International Bureau.

(2) Language and fee

In case of preparing an MM6, any of the languages from among English, French, and Spanish can be used (Rule 6); provided, however, that an MM6 in case of limiting the Goods and Services with respect to an application filed before April 1, 2004 shall be prepared in English or French (Rule 40).

The fee is 177 CHF per international registration and it shall be paid to the International Bureau before starting the procedures.

(3) Procedures by the International Bureau

The International Bureau that received the application form shall check whether the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. The right holder may correct the irregularity within three months from the day when the International Bureau notifies him/her of the irregularity (Rule 26 (2)); however, if the irregularity is not corrected within the period, the application for limitation is considered to be abandoned and the International Bureau notifies the right holder of this fact. In this case, the amount obtained by deducting half of the paid fee will be refunded; provided, however, that the amendment of the Rules in 2014 enabled the right holder to request continued processing by submitting a new official form (MM20) within two months from the expiry of the period to the International Bureau and paying the specified fee.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly record the change of ownership on the international register and publish it in the gazette.

The recording day on the international register is the day when the International Bureau accepts the application that fulfills the requirements; provided, however, that if there is an application with respect to the statement that should be recorded after the renewal of the international registration coinciding with another change, cancellation or subsequent designation with respect to the relevant international registration, then the International Bureau shall follow that application.

The International Bureau notifies the Office of the designated contracting party and the right holder related to the registration of limitation of the list of Goods and Services.

(4) Effects

When the limitation of goods and services for the international registration is recorded on the international register, the limited goods and services for the international registration are eliminated with respect to all or part of the designated contracting parties for the international registration in accordance with the record.

However, the Goods and Services that have been limited by the limitation will not be deleted from the international registration, but the scope of protection is limited in part of the designated contracting parties or to the extent of the part of the Goods and Services. Therefore, subsequent designation can be provided to the limited goods and services subsequently.

The Office of the designated contracting party which has been notified of the limitation related to the list of goods and services that affect the designated contracting parties can declare that the limitation has no effect within its territories (Rule 27 (5)). This declaration will be sent to the International Bureau within 18 months from the aforementioned notification and the following matters will be indicated.

- (i) The reason for which the limitation has no effect (for example, in cases where the limitation is not an actual limitation, but an extension)
- (ii) If the declaration does not affect all the goods and services related to the limitation, those which are affected by the declaration or those which are not affected by the declaration
- (iii) Corresponding provisions of the laws and regulations
- (iv) Whether said declaration may be subject to an appeal, etc.

When the International Bureau receives the declaration, it shall notify the applicant to that effect. If an appeal can be filed, the Office shall notify the

International Bureau of its final decision and the International Bureau shall notify the applicants of the notification.

The limitations that have no effects and the final decision related to the declaration are recorded on the international register and published in the gazette.

3.9.3 Renunciation of International Registration

The right holder can abandon protection in part of the designated contracting parties with respect to all the Goods and Services of the international registration; this is called “Renunciation” (Rule 25).

Procedures to apply for recording of renunciation cannot be implemented if there is no designated contracting party left. In this case, the right holder shall implement procedures to apply for recording all cancellation of the international registration.

If the protection of all of the Goods and Services is renounced in part of the designated contracting countries, the renunciation is recorded on the international register; however, the international registration itself remains on the register and a subsequent designation is available also with respect to the designated contracting parties for which protection was renounced.

(1) Procedures

The right holder or his/her representative shall prepare an application form by using official form MM7 and submit it to the International Bureau. The list of contracting parties, etc. that are affected by the renunciation must be indicated in MM7 and the right holder or his/her representative signs in the signature column.

In case of renouncing the protection with respect to two or more international registrations for the same right holder, the same list is applied and the protections can be renounced at one time by submitting one MM7.

(2) Language and fee

Any language from among English, French, and Spanish can be used (Rule 6); however, that in cases of recording the renunciation with respect to an application filed before April 1, 2004, it shall be prepared in English or French (Rule 40).

An application fee for recording the renunciation is not required.

(3) Procedures by the International Bureau

The International Bureau that received the application form shall check whether the application form conforms to the requirements and if there is an

irregularity, it shall notify the right holder of that fact. The right holder may correct the irregularity within three months from the day when the International Bureau notified him/her of the irregularity (Rule 26 (2)); however, if the irregularity is not corrected within the period, the application of the renunciation is considered to be abandoned and the International Bureau shall notify the right holder to that effect; provided, however, that the amendment of the Rules in 2014 enabled right holders to request continued processing by submitting a new official form (MM20) within two months from the expiry of the period to the International Bureau and paying the specified fee.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly register the renunciation of the international registration on the international register and publish it in the gazette (Rule 27).

The recording day of the international registration is the day when the International Bureau accepts the application that fulfills the requirements; provided, however, that if there is an application with respect to the statement that should be recorded after the renewal of the international registration coinciding with another change, cancellation, or subsequent designation with respect to the relevant international registration, then the International Bureau shall follow that application.

The International Bureau shall record to that effect on the international register and notify the Office of the designated contracting party concerned and the right holder of the record.

(4) Effects

When the renunciation of the international registration is recorded on the international register, the protection under the international registration for all the Goods and Services is renounced with respect to the designated contracting parties in which the renunciation is recorded. However, the designated contracting parties for which the protection is renounced may be designated again at any time.

3.9.4 Cancellation of International Registration

In case of cancelling the international registration of all or part of the goods and services related to all designated contracting parties, it is called cancellation. The application procedure for recording cancellation can be implemented for all or part of the Goods and Services.

If the designated contracting parties remain with respect to protection under the international registration, the aforementioned application procedures for

recording renunciation shall be implemented, but not the following application procedure for recording the cancellation.

(1) Procedures

The right holder or his/her representative shall prepare the application form by using official form MM8 and submit it to the International Bureau. The MM8 requires the signature of the right holder or his/her representative.

If the same right holder files an application for recording cancellation of all the records of goods and services in multiple designated contracting parties, he/she can file an application with respect to multiple international registrations at one time by submitting one MM8.

On the other hand, in cases of filing applications for cancellation of part of the goods and services, the right holder must prepare an MM8 for each registration and apply for it.

(2) Language and fee

Any language from among English, French, and Spanish can be used (Rule 6); however, that in cases of applying for recording cancellation of the registration with respect to an application filed before April 1, 2004, it shall be prepared in English or French (Rule 40).

An application fee for recording cancellation is not required.

(3) Procedures by the International Bureau

The International Bureau that received the application form shall check if the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. The right holder can correct the irregularity within three months from the day when the International Bureau notifies him/her of the irregularity (Rule 26 (2)); however, if the irregularity is not corrected within the period, the application for cancellation is considered to be abandoned and the International Bureau shall notify the right holder to that effect; provided, however, that the amendment of the Rules in 2014 enabled the right holder to request continued processing by submitting a new official form (MM20) within two months from the expiry of the period to the International Bureau and paying the specified fee.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly register the cancellation of the international registration on the international register and publish it in the gazette (Rule 27).

The recording day of the international registration is the day when the International Bureau accepts the application that fulfills the requirements;

provided, however, that if there is an application with respect to the statement that should be recorded after the renewal of the international registration coinciding with another change, cancellation, or subsequent designation with respect to the relevant international registration, then the International Bureau shall follow that application.

The International Bureau shall record to that effect on the international register and notify the Office of the designated contracting party concerned and the right holder of the record.

(4) Effects

When the cancellation of international registration is recorded on the international register, the international registration is cancelled with respect to the goods and services. If part of the goods and services are cancelled, the registration of goods and services subject to the cancellation will be deleted. In cases of cancelling all of the registration, there will be no subject of the international registration and the right holder will no longer be able to implement subsequent designation.

In cases where part of the goods and services are cancelled, the right holder cannot implement subsequent designation with respect to the goods and services subject to the cancellation. If the right holder desires the protection of marks with respect to these cancelled goods and services, it is necessary to file a new international application.

3.9.5 Change of Name and Address of the Right Holder

In case of changing the name and address of the right holder of the international registration on the international register, the right holder shall apply for the change of record to the International Bureau (Rule 25 (1)).

(1) Procedures

The right holder or his/her representative shall prepare application documents indicating the changed part by using official form MM9 and apply directly to the International Bureau. The application can be submitted via the Office.

In cases where the same right holder has multiple international registrations and changes the name, etc. of the same right holder, he/she can apply for a change of record of ownership for multiple international registrations by indicating the international registration numbers on one MM9.

If an e-mail address is entered in the address column of the right holder, the subsequent communication is limited to electronic distribution and no documents will be received.

In addition, when filing an application for change of record of name, etc. of the right holder, a new representative may be appointed (enter the name of the representative to be appointed in Column 5 of MM9); provided, however, that if there is no change in the appointed representative, the application form shall be submitted with the column for the appointment of a representative left blank.

(2) Language and fee

Any language from among English, French, and Spanish can be used (Rule 6); provided, however, that in cases of applying for recording the change of name, address, etc. of the right holder with respect to an application filed before April 1, 2004, it shall be prepared in English or French (Rule 40).

The fee is 150 CHF per application and shall be paid before starting the application procedures. In cases of including multiple international registrations in one application, the fee is also 150 CHF.

(3) Procedures by the International Bureau

The International Bureau that receive the application form checks whether the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. The right holder can correct the irregularity within three months from the day when the International Bureau notifies him/her of the irregularity (Rule 26 (2)); however, if the irregularity is not corrected within the period, the application is considered to be abandoned and the International Bureau shall notify the right holder to that effect. In this case, half of the fee will be refunded by the International Bureau; provided, however, that the amendment of the Rules in 2014 enabled the right holder to request continued processing by submitting a new official form (MM20) within two months from the expiry of the period to the International Bureau and paying the specified fee.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly record the change of name, etc. of the right holder of the international registration on the international register and publish it in the gazette (Rule 27 (1)).

The recording day on the international register is the day when the International Bureau accepts the application that fulfills the requirements; provided, however, that if there is an application with respect to the statement that should be recorded after the renewal of the international registration coinciding with another change, cancellation or subsequent designation with respect to the relevant international registration, then the International Bureau shall follow that application.

The International Bureau shall record to that effect on the international register and notify the Office of the designated contracting party concerned and the right holder of the record.

(4) Effects

The international registration in which the change of name, address, etc. of the right holder is recorded on the international register, shall be changed to the name and address of the right holder in accordance with the registration.

3.9.6 Appointment of Representative

A representative for international registration can be appointed by indicating the representative in the specified form respectively at the application for international registration, subsequent designation, limitation of the Goods and Services, etc. In this case, it is not required to submit a proxy of the right holder.

A representative may be appointed by individual communication to the International Bureau. This communication shall be submitted to the International Bureau by the applicant, right holder, or appointed representative (Rule 3). One representative shall be appointed for the international registration, but may not be appointed by limiting to a specific designated contracting party.

(1) Procedures

In cases of appointing a new representative, the right holder or his/her representative shall submit an application form to the International Bureau. The format is not specified, but non-official form MM12 is available. The right holder shall enter the international registration number or the international application number for which the representative is appointed and sign the application form. As mentioned above, only one representative shall be recorded on the international register. If a new representative is appointed, the record of the former representative is overwritten.

(2) Language and fee

Any language from among English, French, and Spanish can be used (Rule 6); provided, however, that in cases of submitting an application for an application filed before April 1, 2004, it shall be prepared in English or French (Rule 40).

An application fee is not required.

(3) Procedures by the International Bureau

The International Bureau that received the application form shall check whether the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact.

If the application conforms to the requirements, the International Bureau shall promptly record the appointment of a representative for the international registration on the international register (Rule 27 (1)).

The recording day on the international register is the day when the International Bureau accepts the application that fulfills the requirements. The International Bureau shall notify the right holder and his/her representative of the fact of the recording.

(4) Effects

If the International Bureau finds that the appointment of a representative fulfills the requirements, the appointment of the representative shall be recorded on the International register. The effective date of the appointment of a new representative is the day when the International Bureau receives an international application for which a representative is appointed, application for subsequent designation, change of ownership, etc., or individual communication. After the recording, all communication from the International Bureau will be sent to the newly appointed representative. If another representative was recorded before, the record of the appointment of the representative will be cancelled by the ex officio of the International Bureau. The effect of cancellation of the record of the prior representative comes into effect on the day when the International Bureau receives the aforementioned communication (Rule 3 (6)).

3.9.7 Change of Name or Address of Representative

When there is a change to the name or address of the representative for international registration, the change shall be recorded on the international register by application.

(1) Procedures

The representative of the right holder shall submit an application to the International Bureau. The application format is not specified; however, the application may be filed by using unofficial form MM10. It is not necessary to indicate the name of the right holder in MM10; however, the content of the change related to the representative and international registration number shall be indicated.

(2) Language and fee

Any language from among English, French, and Spanish can be used (Rule 6); however, that in cases of applying for recording the change of representative with respect to an application filed before April 1, 2004, it shall be prepared in English or French (Rule 40).

The application fee is exempted.

(3) Procedures by the International Bureau

The International Bureau that received the application form shall check whether the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. The right holder can correct the irregularity within three months from the day when the International Bureau notified him/her of the irregularity (Rule 26 (2)); however, if the irregularity is not corrected within the period, the application in question is considered to be abandoned and the International Bureau shall notify the right holder to that effect.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly record the change of representative for the international registration on the international register and publish it in the gazette (Rule 27 (1)).

The recording day on the international register is the day when the International Bureau accepts the application that fulfills the requirements. The International Bureau shall record the change of name and address of the representative on the international register and notify the Office of the designated contracting party concerned and the right holder of the record.

(4) Effects

For an international registration for which the change of name, address, etc. of the representative is recorded on the international register, the name and address of the representative shall be changed in accordance with the registration.

Communications from the International Bureau will be sent to the representative after the change.

3.9.8 Correction of International Register

If there is an error in the international registration on the international register, the register shall be corrected by the ex officio of the International Bureau or at the request of the right holder or the Office (Rule 28 (1)).

The following matters are subject to correction.

- (i) Discrepancy with the application

It may occur due to an input error by the International Bureau. It shall be corrected by ex officio of the International Bureau or at the request of the Office of origin, right holder, or his/her representative.

(ii) Obvious description error

It is an obvious description error where there is no doubt it should be corrected; it shall be corrected by the ex officio of the International Bureau or at the request of the right holder or his/her representative.

(iii) Objective description error

A description error of name or address of the right holder, basic registration number, etc.; it shall be corrected at the request of the Office of origin.

In case of description error with the documents at the application by the applicant or his/her representative, such as incomplete list of goods (services) or incomplete indication of the designated contracting parties, etc., correction is not allowed.

The request for correction of description error attributable to the Office of origin shall be made within nine months from the posting in the gazette (Rule 28 (4)). After the period elapses, the application for correction cannot be filed.

(1) Procedures

Since there is no format for the form to request correction, the right holder shall send a document stating the name and address of the right holder, international registration number, points for correction, reason for correction, and signature as well as the statement that it is a request for correction, to the International Bureau.

(2) Language and fee

The application shall be prepared in English, French, or Spanish.

An application fee is not required.

(3) Procedures by the International Bureau

If there are differences between the recorded matter on the international register and documents submitted to the International Bureau, the International Bureau is incorrect and it shall be corrected.

If there is an apparent defect with the international register and the correction also has an apparent defect, it shall be corrected as soon as the International Bureau finds the defect.

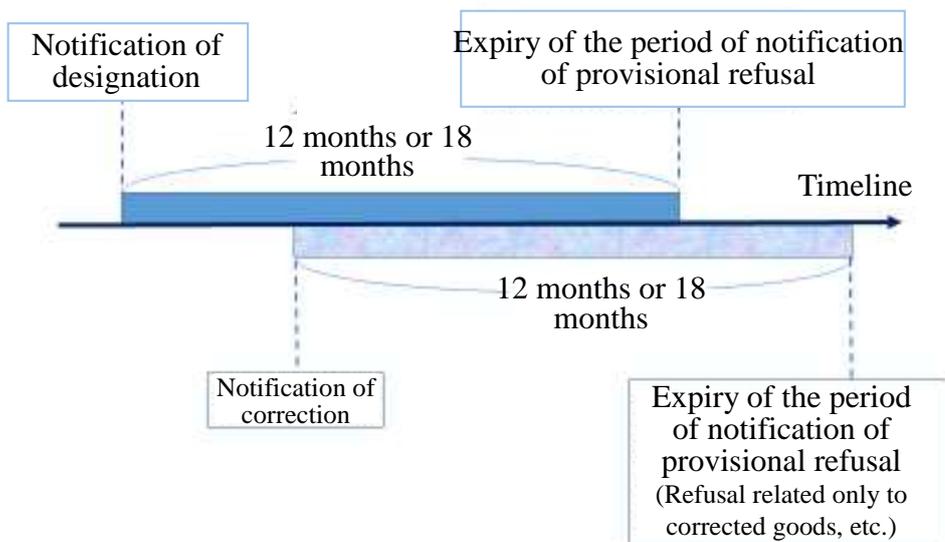
If there is actually an objective defect with the international register, it is corrected in most cases.

If an error on the international register is corrected, the International Bureau shall notify the right holder and the Office of the designated contracting party which the correction affects (Rule 28) of this fact. The correction is published in the gazette.

(4) Effects

If the Office of the designated contracting party that received notification of correction cannot grant the protection to the corrected international registration, it has a right to declare in the notification of provisional refusal to be sent to the International Bureau that the protection cannot be granted or that the protection is no longer allowed. The period of notification of refusal is calculated from the day when the notification of correction is sent.

Notification of Correction and Period of Notification of Provisional Refusal



3.10 Record of Status in Designated Contracting Party

3.10.1 Restriction of the Right Holder’s Right of Disposal (Rule 20)

In cases where the right holder’s right of disposal related to the international registration is restricted, such as cases where the disposal of the property of the right holder is restricted by court judgment, etc. or the property of the right holder becomes subject to a mortgage or security, etc., the right holder may inform the International Bureau of this fact.

However, the record of the license is stipulated separately and this provision shall not apply to it.

Information related to the restriction of the right holder's right of disposal shall be related to the restriction of the right of disposal with respect to all of the international registration or the restriction of the right of disposal with respect to part of the contracting parties.

(1) Procedures

The registration holder and the Office of the contracting parties of the registration holder may notify the International Bureau of the restriction of the right of disposal (Rule 20 (1) (a)). The Office of the designated contracting party may notify the International Bureau of the restriction of the right holder's right of disposal. In this case, the information that can be notified is limited to the information related to said designated contracting party only (Rule 20 (1) (b)). A third party cannot notify of the restriction of the right of disposal.

There is no official form for the notification; however, unofficial form MM19 can be used. The notification consists of a summary of major facts related to the restriction of the right of disposal. The notification must have the signatures of the right holder, his/her representative, or the Office of the contracting party in which the right holder is recorded. If the restriction of the right of disposal is subject to one designated contracting party, it requires the signature of the Office of the designated contracting party only.

(2) Language and fee

Any language from among English, French, and Spanish can be used (Rule 6); provided, however, that in cases of recording the restriction of the right of disposal with respect to an application filed before April 1, 2004, it shall be prepared in English or French (Rule 40).

An application fee is not required.

(3) Procedures by the International Bureau

If the notification fulfills the requirements, the International Bureau shall register the notification on the international register by designating the date of acceptance as the recording date and notifies the right holder, the Office of the contracting party of the right holder, and the Office of the designated contracting party concerned of this fact. It shall be published in the gazette (Rule 32 (1) (a)).

(4) Other

If the restriction of the right of disposal is released, the contracting party that notified the restriction of the right of disposal shall notify the International Bureau

of part or all of the release of the restriction. If the notification conforms to the requirements, the International Bureau shall record the fact on the international register and publish it in the gazette.

3.10.2 Recording of a License (Rule 20bis)

Some contracting parties register the license of an international mark under the national registration and consider that it has the same legal weight as the license of the national mark. Since the license of the international registration can be recorded on the international register from April 2002, the owner of the international registration does not have to register the license with the Office of the contracting party where the license is granted. Amendment and cancellation of the license that is recorded on the international register can also be recorded.

(1) Procedure

If a right holder who is a licensor can file an application for recording directly with the International Bureau and the Office allows it to be submitted, the Office of the contracting party of the right holder (or licensor) or the Office of a contracting party related to the grant of the license may file an application with the International Bureau. In cases where either of them files an application, official form MM13 shall be submitted (Rule 20); however, materials, such as the license agreement, cannot be attached to the application form.

The licensee may also file an application with the Office of the contracting party of the registration owner or the Office of the contracting party related to the grant of the license, and the Office that receives the application shall check whether the applicant is entitled to be recorded as a licensee and send the application to the International Bureau. In cases where the application by the licensee does not have the signature of the registration owner or the Office, the International Bureau shall not accept the application. In other words, procedures cannot be implemented by the licensee alone.

The following matters shall be indicated in official form MM13 that is used for application for recording of a license.

- (i) Relevant international registration number
- (ii) Name of trademark owner
- (iii) Name and address of the licensee
- (iv) Designated contracting party related to the grant of the license
- (v) The fact that the license is granted to all of the goods and services included in the international registration or the goods and services to which the license is granted

In addition to the aforementioned matters, the indications that the license is related only to part of the territories of the designated contracting party, that it is an exclusive license, and the license period can be included.

The application requires the signature of the right holder or the Office to which the application is submitted.

(2) Language and fee

Any language among English, French, and Spanish can be used (Rule 6); provided, however, that in cases of applying for the recording of a license that was filed before April 1, 2004, it shall be prepared in English or French (Rule 40).

The fee is 177 CHF per international registration and it shall be paid before starting the procedure.

(3) Procedures by the International Bureau

The International Bureau that received the application form shall check if the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. The right holder may correct the irregularity within three months from the day when the International Bureau notices the irregularity (Rule 26 (2)); however, if the irregularity is not corrected during this period, the application is considered to be abandoned and the International Bureau shall notify the right holder of this fact. In this case, half of the fee shall be refunded by the International Bureau; provided, however, that the amendment of the Rules in 2014 enabled the right holder to request the continued processing by submitting a new official form (MM20) to the International Bureau within two months from the expiry of the period and paying the specified fee.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly record the license of the international registration on the international registry, notify the Office of the designated contracting party where the license is granted of this fact, and also notify the right holder and the Office if the application is filed via the Office of this fact. It shall be published in the gazette (Rule 27 (1)).

The recording day on the international register is the day when the International Bureau accepts the application that fulfills the requirements.

(4) Effects

When the license is recorded, the license has legal weight in the designated contracting party.

However, it has no effect in the designated contracting parties where it is declared that the record of license does not have any effect.

The Office of the designated contracting party that receives the notification of the record of license from the International Bureau may declare that the record of the license does not have effect in said contracting party. The declaration must be sent to the International Bureau within 18 months from the day when the notification of the fact that the license is recorded on the international register is sent to the Office concerned from the International Bureau. The International Bureau that receives the declaration shall record the fact on the international register and notify the person who filed the application for recording of the license.

The declaration that the record of license on the international register does not have effect may be in the following two cases: where the laws and regulations of the contracting party do not stipulate the record of the trademark license (Rule 20bis (6) (a)); and where the laws and regulations stipulate the record of the trademark license, but the record of license on the international register does not have effect in the contracting parties (Rule 20bis (6) (b)). The contracting parties that declared that the record of license on the international registration has no effect are Australia, Germany, China, and Japan, among others.

3.10.3 Amendment of the Record of License

After recording the license, the right holder may file an application for recording part of the content of the license, such as the license period, etc. When recording a new licensee on the international register, it is not a procedure of amendment of the license, but an application for a new record by using official form MM13.

(1) Procedures

The registration owner (licenser), the Office of the contracting party of the registration owner, or the Office of the contracting party where the license is granted shall file an application with the International Bureau as a procedure to amend the record of license by using official form MM14.

In addition, the licensee may also file an application with the Office of the contracting party of the registration owner or the Office of the contracting party related to the grant of the license. The Office that receives the application shall check whether the applicant is entitled to be recorded as a licensee, sign the application, and send it to the International Bureau. If the application by the licensee does not have the signature of the registration owner or the Office, the International Bureau shall not accept the application.

In cases where multiple licenses are recorded on the international register with respect to one international registration, the right holder shall clearly specify the license for which the amendment is to be made.

(2) Language and fee

Any language from among English, French, and Spanish may be used (Rule 6); provided, however, that the procedure of application for amendment of the record of license with respect to an application filed before April 1, 2004 shall be prepared in English or French (Rule 40).

The fee is 177 CHF per international registration and shall be paid before starting the procedure.

(3) Procedures by the International Bureau

The procedures are the same as the case of filling an application for the record of license. That means the International Bureau that accepts the application for amendment of the record of license shall check whether the application conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. The right holder may correct the irregularity within three months from the day when the International Bureau notifies him/her of the irregularity (Rule 26 (2)); however, if the irregularity is not corrected within the period, the application is considered to be abandoned and the International Bureau shall notify the right holder of this fact. In this case, half of the fee shall be refunded by the International Bureau.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly record the amendment of the record of the license of the international registration on the international register, notify the Office of the designated contracting party where the license is granted of the fact, and also notify the right holder and the Office if the application is filed via the Office of this fact. It shall be published in the gazette (Rule 27 (1)).

(4) Effects

The international registration for which amendment of license is recorded on the international register shall have legal weight in the designated contracting party concerned in accordance with the amendment record.

3.10.4 Cancellation of Record of License

After recording the license on the international register, the right holder may file an application for cancellation of the record.

(1) Procedures

The registration owner, the Office of the contracting party of the registration owner, or the Office of the contracting party where the license is granted may file an application by submitting official form MM15 to the International Bureau.

The licensee may also file an application with the Office of the contracting party of the registration owner or the Office of the contracting party related to the grant of the license. The Office that receives the application shall check whether the applicant is entitled to be recorded as a licensee and send the application to the International Bureau. If the application filed by the licensee does not have the signature of the registration owner or the Office, the International Bureau shall not accept the application.

If multiple licenses are recorded on the international registration with respect to one international registration, the International Bureau shall clearly specify the license for which the amendment is requested.

(2) Language and fee

Any language from among English, French, and Spanish may be used (Rule 6); provided, however, that the procedure of application for cancellation of the record of license with respect to an application filed before April 1, 2004 shall be prepared in English or French (Rule 40).

An application fee is not required.

(3) Procedures by the International Bureau

In the same way as the application for the recording of the license, the International Bureau that received documents for applying for cancellation of the record of the license shall check whether the application form conforms to the requirements and if there is an irregularity, it shall notify the right holder of that fact. The right holder may correct the irregularity within three months from the day when the International Bureau notifies him/her of the irregularity (Rule 26 (2)); however, if the irregularity is not corrected within the period, the application is considered to be abandoned and the International Bureau shall notify the right holder of this fact. In this case, half of the fee shall be refunded by the International Bureau.

On the other hand, if the application conforms to the requirements, the International Bureau shall promptly cancel the recorded license of the international registration, notify the Office of the designated contracting party where the license is granted of that fact, and notify the right holder and the Office if the application is filed via the Office of that fact.

(4) Effects

Once the application for cancellation is filed, the record of the license will be deleted from the international register.

The international registration for which the record of license is cancelled on the international register has legal weight for the cancellation of the record of the license in the designated contracting party concerned according to the record of cancellation.

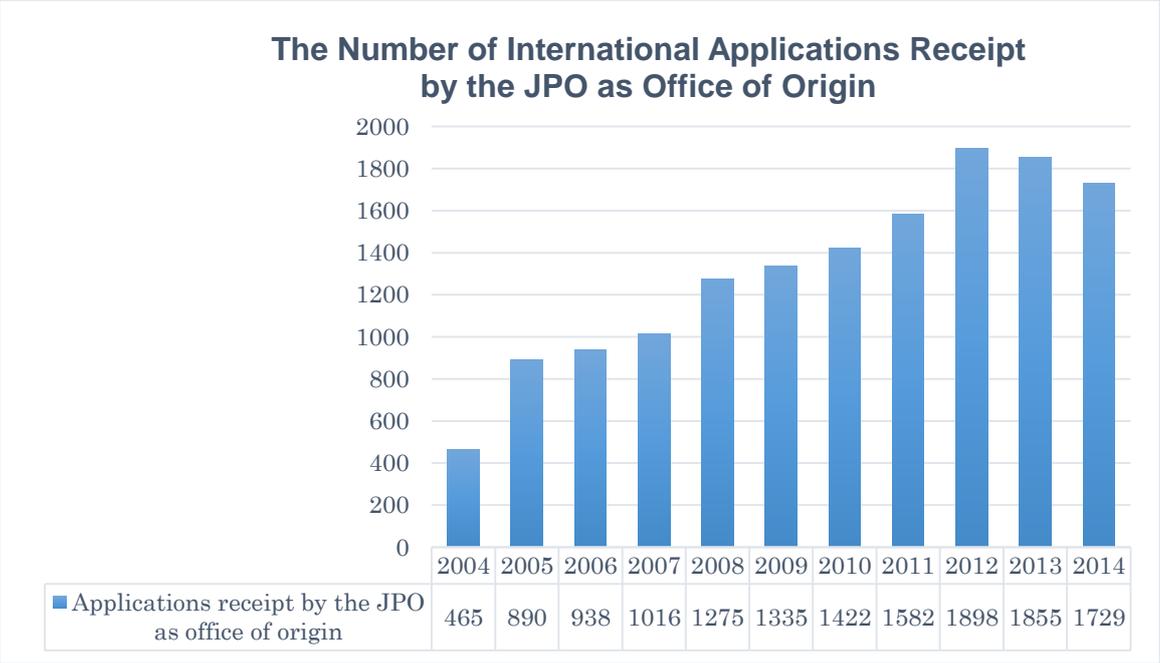
4 Status in Japan

The outline and various procedures of the Madrid System were mentioned above mainly with the Madrid Protocol. The experience of Japan is indicated in this section.

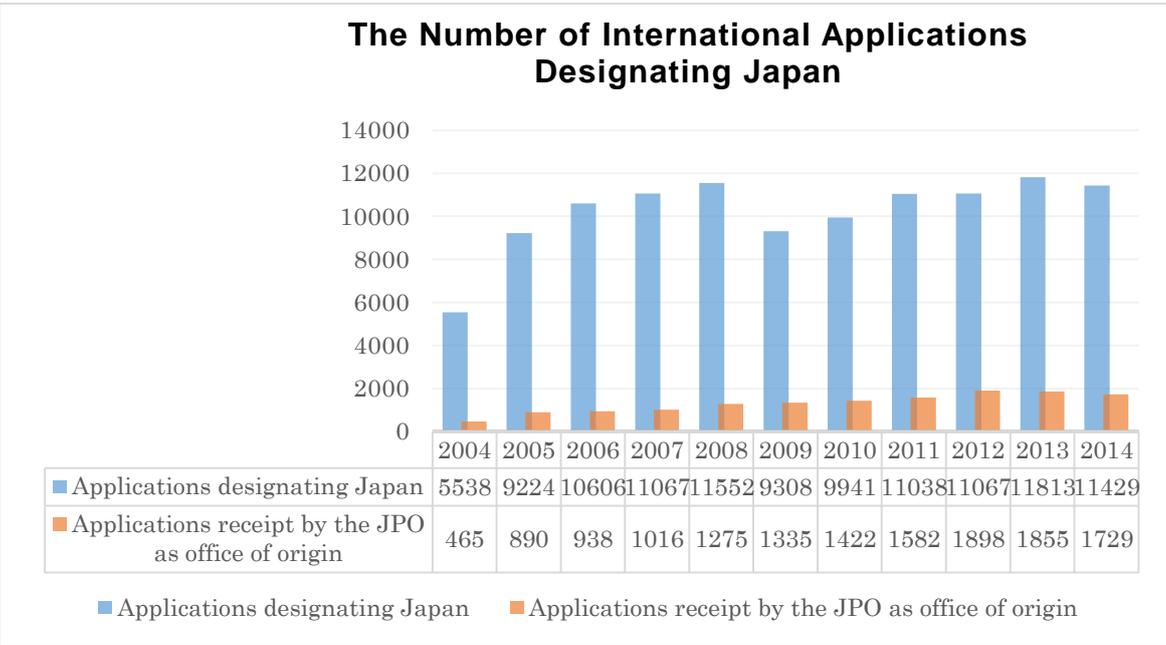
Japan submitted admission forms to WIPO and joined the Protocol on December 14, 1999 and it came into effect on March 14, 2000.

However, the number of international applications submitted by designating the Japan Patent Office as the Office of origin was fewer than 200 cases for the period from March 2000, when the international application became available in Japan, to December 2000. The number of international applications was not very large for several subsequent years.

Later, the number of applications gradually increased and the number of uses is increasing year by year. The following graph indicates the change in the number of international applications where the Japan Patent Office is defined as the Office of origin. (Source: WIPO)



On the other hand, changes in the number of international applications by overseas applicants designating Japan as the designated contracting party is shown in the following graph, and it considerably exceeded the number of applications designating Japan as the Office of origin. (Source: WIPO)



Some research and questionnaires have been implemented to determine the reason why the number of international applications designating Japan as the Office of origin is not large, and the major findings by the “Research and Study of Issues of Procedures for the Use of the Madrid Protocol” are as stated below.

- (1) Preparation of application documents and payment method of the fee are complicated.
- (2) With respect to the Goods and Services, there are cases where English translations of indications of Japanese goods and services which were included in the basic application or basic registration in Japan, are not accepted by the International Bureau or where English indications that are accepted by the International Bureau are not accepted by the designated contracting party.
- (3) Basic requirements are interpreted rigidly. In particular, with respect to the requirements for identity of marks, applications for a mark in alphabet with Kana characters are often filed; however, even in cases where the right holder desires to change the mark by deleting the Kana characters, the mark to which the change is added does not fulfill the requirements for identity.
- (4) The number of contracting parties is not large and countries in which protection is requested have not joined the Protocol. In particular, the Asian region, Brazil, Canada, and others have not joined the Protocol.
- (5) There is a possibility that the protection may lapse due to central attack. In this regard, it is reported that the number of cases where the international registration lapses due to a third party’s cancellation of basic registration is small.
- (6) Segmentation at the level of the designated contracting party is not allowed. Even if part of the goods and services are refused in the designated contracting party, the registration cannot be divided and therefore, the refusal cannot be handled flexibly.

On the other hand, the aforementioned research and study listed the following as problems in cases of designating Japan from overseas.

- (1) System to pay the fee in two parts
- (2) The fact that the period to submit an amendment to the Japan Patent Office is limited to three months in cases where a notification of provisional refusal is received, and a one month extension is allowed; however, no amendments are allowed with the Japan Patent Office after expiry of the period.

The Japan Patent Office established an Office for International Applications under the Patent Cooperation Treaty (PCT) in order to handle acceptance of applications (applications for international registration) under the Madrid Protocol and examinations of international trademark registration applications designating Japan, and explains in detail how to prepare application documents and how to pay fees in Japanese on the JPO website.

http://www.jpo.go.jp/index/kokusai_shutugan2/index.html

In addition, information for international registration owners who desire to extend the protection of marks by designating Japan are posted in English.

https://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_under_the_madrid_protocol.htm

5 Recent Movements

Former Article 5 (2) (e) and Article 9sexies (2) of the Madrid Protocol stipulated that specific provisions may be reviewed and amended at the Assembly of the Madrid Union when ten years elapsed from the effect of the Protocol (December 1, 2005). The common rules can be reviewed at any time at the Assembly of the Madrid Union.

Based on the provisions, the Ad Hoc Working Group on the Legal Development of the Madrid System for the International Registration of Marks was held in July 2005 at the main conference hall of WIPO in Geneva, Switzerland. Since then, the Working Group met once or twice a year to review various problems in order to improve the convenience of the Madrid system, and the Rules have been amended. For example, abolishment of the safeguard provisions (provisions stipulating that the Agreement continues to apply to states that are bound by both the Agreement and Protocol) (amendment of the Protocol in 2007), making it obligatory to send a statement of grant of protection (amendment of the Rules in 2009), and the introduction of remedies if an applicant or right holder cannot follow the specified time limit (amendment of the Rules in 2014), etc.

As for recent agendas of the Working Group, the appropriateness of allowing segmentation procedures at the level of designated contracting parties under the Madrid System and the abolishment of dependency and relaxing of the basic requirements in relation thereto were reviewed. In particular, there are arguments for and against dependency based on the user questionnaire conducted in 2014 and it will continuously be reviewed.

Conclusion

The recent developments related to the Madrid System, such as the increasing number of contracting parties of the Protocol and amendment of Rules, are astonishing. Indeed, the contracting parties when the Protocol first came into effect were four countries only, including China, Spain, Sweden, and the U.K. As of September 2015, the number of contracting parties is 96 countries and it became 97 countries when Laos newly joined in December 2015. It is considered that the number of contracting parties will keep increasing in the future.

There are many points to clear in order to join the Protocol, such as amendment of domestic laws, development of infrastructure, explanation to users, etc.; however, it would be my pleasure if the outline of the Madrid Protocol that is introduced in this book serves as a helpful reference for people in countries which are considering joining the Protocol.

Reference Information

WIPO provides helpful information related to the Protocol on its website.

1. Madrid Agreement, Madrid Protocol, Common Rules, and Administrative Instructions
http://www.wipo.int/treaties/en/registration/madrid_protocol/#treaties
2. Guides for international registration of marks based on the Madrid Agreement and Madrid Protocol
http://www.wipo.int/treaties/en/registration/madrid_protocol/#treaties

This guide explains the procedures and other aspects of the Madrid System in detail.

3. Information for Authorities
 - (1) Information for the Offices of contracting parties
http://www.wipo.int/madrid/en/contracting_parties/
 - (2) Information for countries considering joining the Madrid System
http://www.wipo.int/madrid/en/contracting_parties.html
4. Information of Contracting Parties
 - (1) List of contracting parties
http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf
 - (2) Information, such as procedures by the Office of contracting parties
http://www.wipo.int/madrid/en/members/ipoffices_info.html
5. Official Forms, such as Applications, etc. (MM2, MM4 through MM20)
<http://www.wipo.int/madrid/en/forms/>
6. Model Forms (Forms 1 through 9)
http://www.wipo.int/madrid/en/contracting_parties/model_forms.html
7. WIPO Gazette
<http://www.wipo.int/madrid/gazette/>
8. WIPO Online Service

(1) Preparation of Applications

(i) Fee calculation tool (Fee Calculator)

<http://www.wipo.int/madrid/en/fees/calculator.jsp>

International application fee, renewal fee amount, etc. can be calculated online.

(ii) Database of Indications of Goods and Services

(Goods and Services Manager)

<http://www.wipo.int/mgs/index.jsp?lang=en>

This is an online tool to support preparation of lists of Goods and Services; it includes indications of over 70,000 terms extracted from those often used in the Nice Classification, tripolar and U.S. databases, and the Madrid System, and allows searching by using key words and checking indications that can be adopted in the designated contracting parties.

(2) Specific Procedures

(i) Checking Procedure Status (Madrid Real-Time Status)

<http://www.wipo.int/mrs/IndexController?lang=EN>

The list of individual procedures for specific international registration is indicated and their current status is displayed. Acceptance and processing status of submitted documents can be checked.

(ii) Online Fee Payment (E-Payment)

<https://webaccess.wipo.int/epayment/>

The fee can be paid with a credit card, etc.

(iii) Online Subsequent Designation (E-Subsequent Designation)

<https://www3.wipo.int/osd/>

Subsequent designation procedures of the international registration and fee payment can be implemented online with a credit card, etc.

(iv) Online Renewal (E-Renewal)

https://webaccess.wipo.int/trademarks_ren/

Renewal procedures of international registration and fee payment can be implemented with a credit card, etc.

(3) Management

ROMARIN (Database of All International Registrations)

<http://www.wipo.int/madrid/en/romarin/>

The content and status of an international registration can be checked. Progress can be checked, including the content of notification of provisional refusal in designated contracting parties. Information is updated daily.

References

1. “Madrid Seido ni Okeru Tetsuzuki Gaiyo (Kanri Jitsumu) (*Outline of Procedures of the Madrid System (Management Practice)*)”: Training Text for Members of the Japan Patent Attorneys Association in FY2015, Japan Patent Attorneys Association
2. “Shohyo no Kokusai Toroku Seido (Madrid Seido) ni Tsuite (*Madrid – The International Trademark System*)”: Text for the Explanatory Meeting of the Intellectual Property System in FY2014, JPO/WIPO
3. “Madrid Kyotei Giteisho no Shokai (*Introduction of Madrid Protocol*),” JPO, Japan Institute of Invention and Innovation, Asia-Pacific Industrial Property Center
4. “Madrid Protocol Jitsumu no Tebiki (*Practice Manual on Madrid Protocol for Japanese Users*),” Chiaki Kawai and Junko Saito, Japan Institute of Invention and Innovation
5. “Madrid Kyotei Giteisho no Riyo ni Okeru Tetsuzuki no Kadai ni Kansuru Chosa Kenkyu (*Research and Study on Issues related to Procedures for the Use of the Madrid Protocol*),” Japan Patent Office, Research and Study Report on Problems with the Industrial Property Rights System in 2012
6. Madrid Experience Sharing Report
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