ANALYSIS ON THE IMPACT OF MADRID PROTOCOL FOR THE ECONOMIES OF DEVELOPING COUNTRIES

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ABSTRACT

The study is based on the Impact of Madrid Protocol for the Economies of Developing Countries. In this aspect, different parameters are studied which can play an important role for Developing Nations before acceding to Madrid Protocol. These parameters includes the Amendments in the Trade Marks legislation, Awareness and Support Measures for facilitation of the user of the system, Fees for the International Registration of a Mark through Madrid Protocol, Strategy of the Japanese Companies with emphasis on Small and Medium Enterprises to utilize the Madrid Protocol and the Operating System of Japan Patent Office (JPO) for handling the International Applications filed via Madrid Protocol both as an “Office of Origin” and as a “Designated Contracting Party”.
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INTRODUCTION

1.1 Background of the Research Theme;
Madrid Protocol is an effective international procedural mechanism for the registration of Marks around the globe but there are a number of things concerning this protocol that are of great concern for the developing nations. The objectives of my research theme are based on the following background information:

- The current legislation is required to be amended before acceding to the Madrid Protocol in order to prevent implications after the accession to the treaty;
- Most of the industries in Pakistan consist of Small and Medium Enterprises that are not well aware of the importance of registration of trademarks at national and international levels;
- The SME sector of developing countries is financially not so strong to afford the fees for the international registration of marks via Madrid Protocol;
- The economy of Japan is mainly based on Small and Medium Enterprises; and
- The staff requirements, capacity building of the staff, workload analysis and automation requirements are also the key factors before accession to the Madrid Protocol.

1.2 Objectives of the Research Theme;
The objective of my research theme is to study the impact of Madrid Protocol for the economies of developing countries in terms of the following hypotheses based on the aforesaid information:

1.2.1 Current Trade Marks Law have to be amended in line with the Madrid Protocol;
1.2.2 Capacity building of the SME sector of Pakistan to understand the importance of registration of marks through public awareness campaigns;

1.2.3 Financial support to the SME sector for the international registration of marks via Madrid Protocol;

1.2.4 Strategy by the Japanese companies especially the small and medium enterprises to draw maximum benefit from the Madrid Protocol; and

1.2.5 Study of the operating system of Japan for handling applications filed through Madrid Protocol.

1.3 Methodology of the Research Theme;

The following methodology will be adopted in order to accomplish the above mentioned objectives of the research:

1.3.1 Comparison of the Common Provisions of the Madrid Protocol in the National Trade Marks Legislations of Japan, Singapore and United States of America and the Conflicts between the National Trade Marks Legislation of Pakistan and Madrid Protocol;

1.3.2 Study of the public awareness strategy and support for Small and Medium Enterprises in Japan;

1.3.3 Comparison of the fees of national registration of a mark in Pakistan with the fees of international registration of a mark via Madrid Protocol;

1.3.4 Distribution of questionnaire to the Japanese companies particularly small and medium enterprises and interviews of Trademark Attorneys practicing Madrid Protocol in Japan;

1.3.5 Distribution of questionnaire to the Japan Patent Office and Interview of the Officials of JPO; and

1.3.6 Recommendations.
OVERVIEW OF THE MADRID PROTOCOL

2.1 What is Madrid Protocol;

The Madrid Protocol is a part of the Madrid System for the International Registration of Marks. Madrid System is composed of two separate treaties namely Madrid Agreement concerning the International Registration of Marks of April 14, 1891 and revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957 and at Stockholm on July 14, 1967 and as amended on September 28, 1979\(^1\) and Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on June 27, 1989, entered into force on December 1, 1995, came into operation on April 1, 1996 and amended on October 3, 2006\(^2\). Due to the lengthy names, the former usually referred as the Madrid Agreement or sometimes only Agreement and the latter usually referred as the Madrid Protocol or sometimes only Protocol. The Madrid System is administered by the World Intellectual Property Organization (WIPO), a specialized agency of the United Nations\(^3\) for developing a balanced and accessible International Intellectual Property System. The International Bureau of WIPO maintains the International Register of Marks and publishes the WIPO Gazette of International Marks\(^4\).

The nationals of a country which is a member to either the Madrid Agreement or the Madrid Protocol or both can register their marks in any of the member countries by filing a single application in their National Trade Marks Office. The National Trade Marks Office,

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\(^{3}\) [www.wipo.int/treaties/en/general](http://www.wipo.int/treaties/en/general)

after checking some formalities, will forward the application to the
International Bureau of WIPO for the international registration of the
mark. After checking the procedural requirements, the mark is
published in the WIPO Gazette of International Marks and then the
application is forwarded by WIPO to the designated Contracting
Parties mentioned in the application of the applicant for the
registration of the mark according to the national legislation of the
designated Contracting Parties. A flow chart of an international
application under the Madrid Protocol is as under:\footnote{5}{www.ipos.gov.sg/\%leftNav\%tra/Applying+for+a+Trade+Mark+Outside+Singapore.htm}

\begin{figure}[h]
\centering
\includegraphics[width=\textwidth]{flow_chart.png}
\caption{Flow Chart of an International Application under the Madrid Protocol}
\end{figure}

The members of the Agreement and the Protocol forms a Madrid
Union and as on February, 2008, 82 countries are members of the
Madrid Union\footnote{6}{www.wipo.int/madrid/en/members}. Out of which 56 countries are members of the Madrid
Agreement and 75 countries are members of the Madrid Protocol\footnote{7}{www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf}. Apparently, the total numbers of countries in the Madrid Union are
less as compared to the sum of number of countries members to the
Agreement and the Protocol, this is because of the fact that some
countries are members of the Agreement, some countries are
members of the Protocol and some countries are members of both the

\footnote{5}{www.ipos.gov.sg/\%leftNav\%tra/Applying+for+a+Trade+Mark+Outside+Singapore.htm}
\footnote{6}{www.wipo.int/madrid/en/members}
Agreement and the Protocol.

2.2 Difference in procedure between Paris Convention and Madrid Protocol for International Registration of Marks;

The international registration of marks can also be sought through the route of Paris Convention for the Protection of Industrial Property of March 20, 1883 as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958 and at Stockholm on July 14, 1967 and as amended on September 28, 1979. According to the Paris Convention, the nationals of the signatory states must be treated in the same way as that of its own nationals, a phenomenon known as “National Treatment”. Currently, 172 countries are party to the Paris Convention.

When an application is filed by the owner of the mark under the Paris Convention, it is usually filed by a local attorney, in the local language, on the prescribed forms and the fees must be paid in the local currency. In addition to these problems, the mark can only be registered in the foreign countries, if the mark is already registered in the country from which the application is initiated. Above all, filling an application in a foreign country does not mean that the mark is registered, there are various stages through which the application is processed and in case of any abnormality in the application at any stage, the applicant needs to pay a lot of attention by himself to his application until and unless the mark is registered in the foreign country. This will result a heavy mental and financial burden on the shoulders of the applicant.

On the contrary, the Madrid Protocol provides an easy approach
for the international registration of marks. The pre-requisite for filing an application via Madrid Protocol is that the application must be filed in the National Trade Marks Office. Once the application is filed for national registration, the applicant is eligible to apply for the international registration of mark through Madrid Protocol. The applicant can file the application for the international registration by submitting the prescribed form of WIPO to the National Trade Marks Office which is the “Office of Origin”. The Office of Origin will check whether the facts mentioned by the applicant in the international application are same with the national application or not. After checking these facts, the application is forwarded from the Office of Origin to the International Bureau of WIPO. The International Bureau of WIPO, after publishing the mark in the WIPO Gazette, will forward the application to the Designated Parties, where the application is processed according to the national legislation of the Designated Party.

The application for the international registration of mark will be filed in one language and the fee is paid in one currency to the International Bureau of WIPO either directly or through the Office of Origin. There is no need of a local attorney for filing an application in the Designated Party. However, in the later stages of the application, the services of a local attorney may be required. In this way, Madrid Protocol provides an easy solution for the international registration of marks as compared to the burdensome procedure available in the Paris Convention.

It should not be out of place to mention that the Paris Convention offers individual application routes for international registration of the mark in each country whereas the Madrid Protocol provides automatic application routes for international registration of
the mark in each country\textsuperscript{11}.

\section*{2.3 Essentials of Madrid Protocol;}

Any state that is party to the Paris Convention for the Protection of Industrial Property may become a party to the Madrid Protocol\textsuperscript{12}. In addition to the states, an intergovernmental organization may become a party to the Madrid Protocol (but not the Madrid Agreement) where the following conditions are fulfilled\textsuperscript{13}:

\begin{enumerate}
  \item At least one of the Member States of the organization is a party to the Paris Convention; and
  \item The organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.
\end{enumerate}

The States that are party to the Madrid Protocol are referred as “Contracting States” and the Organizations which are party to the Madrid Protocol are referred as “Contracting Organizations”. Collectively, the Contracting States and Contracting Organizations are termed as “Contracting Parties”. The Contracting Parties of the Madrid Protocol and the Contracting States of the Madrid Agreement are members of the Madrid Union\textsuperscript{14} that is a special union established under Article 19 of the Paris Convention\textsuperscript{15}. Every member of the Madrid Union is a member of its Assembly\textsuperscript{16}.

\textsuperscript{12} Article 14 (1) (a) of the Madrid Protocol
\textsuperscript{13} Article 14 (1) (b) of the Madrid Protocol
\textsuperscript{14} Article 1 of the Madrid Protocol
\textsuperscript{15} www.wipo.int/madrid/en/general/intro.html
\textsuperscript{16} Article 10 of the Madrid Protocol
2.3.1 Eligible Applicant;

In order to file an international application through Madrid Protocol, it is necessary that the applicant must file a basic application in his National Trade Marks Office for local registration of the basic mark\(^{17}\). On the basis of this pending or registered basic application, the applicant is eligible to apply for the international registration through his National Trade Marks Office that is referred as “Office of Origin” in the framework of Madrid Protocol\(^{18}\).

2.3.2 Requirements of Marks for International Registration;

The basic requirements of a mark for international registration are that a mark must be identical to the mark in the basic application and the goods/services must be same as that of the basic mark or falls within the category of the goods/services of the basic mark.

2.3.3 Forms for Procedures;

The prescribed forms for the international registration of a mark are available on the website of WIPO\(^{19}\). There are total nineteen forms starting from MM1 up to MM19. The MM1 form is for filing an application under the Madrid Agreement, MM2 form is for filing the application under the Madrid Protocol and MM3 form is for filing the application governed by both the Agreement and the Protocol. Forms MM4 to MM19 are for both the Agreement and the Protocol that are required for miscellaneous matters like subsequent designations, change of records, cancellation of the international registration, renewal of international registration, recording of a license etc.

\(^{17}\) Article 2 (1) of the Madrid Protocol
\(^{18}\) Article 2 (2) of the Madrid Protocol
\(^{19}\) [www.wipo.int/madrid/en/forms](http://www.wipo.int/madrid/en/forms)
2.3.4 Acceptable language;

In the Madrid Protocol, there are three acceptable languages in which the international registration of marks can take place. These languages are English, French and Spanish\(^{20}\). The members of the Madrid Protocol are bound to use any of the three languages mentioned above otherwise the members of Madrid Protocol will have to hire the services of translators who will translate from one of the official languages of Madrid Protocol to the official language of their own countries.

2.3.5 Points to be noted in using the Protocol;

The following points must be taken in to consideration before filing the international application to the Office of Origin:

2.3.5.1 Designating United States;

The United States is a country where the use of marks is highly weighed. Therefore, if United States of America is designated in the MM2 form then it is compulsory for the applicant to annex the MM18 form for the declaration of intention to use the mark with the international application. The subsequent proof of use is not currently part of the procedures under the Madrid Protocol, although this may be revised in the future\(^{21}\).

2.3.5.2 Designating European Community;

The European Community Trade Mark System allows claims of “Seniority”. This system was established to promote distribution within the territory irrespective of independent Trade Mark systems in member states. Based on the background, a system of Community

\(^{20}\) Article 16 (1) (a) of the Madrid Protocol and Common Regulations, Rule 6 (1) (b)

Trade Mark Registration is established to maintain the continuity of marks that are already registered and enforced in member countries. This is known as the “Seniority System”. So, if the applicant wishes to claim the seniority of an earlier mark registered in a Member State of the European Community, the official form MM17 must be annexed with the international application.

Moreover, if the European Community is designated in the MM2 form then it is compulsory to indicate a second language before the Office of the European Community from the options of French, German, Italian and Spanish languages.

2.3.5.3 Designating Ireland, Singapore or the United Kingdom;

If Ireland, Singapore or the United Kingdom is designated, the applicant must declare that he has the intention to use the mark but no official form with the international application is required as the statement on the international application form indicates that by designating such a Contracting Party, the applicant declares that he has the intention to use the mark by him or with his consent in that Contracting Party for the goods and services covered by the international application.

2.3.5.4 Central Attack;

The defeat of an international registration as to all designated Contracting Parties through invalidation of its basic application or registration is known as “Central Attack”. The international registration depends on the national registration of the mark for the

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23 Common Regulations, Rule 9 (5) (f)
first five years. If during this time period, the national registration of a mark is lapsed by any means then the international registration will be automatically cancelled. Similarly, if the basic registration of the mark is cancelled as a result of any type of action that was started within the period of five years then again the mark will be revoked from the international register and consequently in the designated Contracting Parties.

But, after the period of five years, the international registration is independent to that of the national registration of the mark provided that no adverse action taken during the first five year period that could still result in cancellation of the national registration of the mark.

However, if the international registration is cancelled through the Central Attack, the owner of the international registration may apply for the registration of the same mark with the offices of all the designated Contracting Parties where the registration had effect and whose designation was governed by the Madrid Protocol within three months after the international registration is cancelled by Central Attack. The national applications that results from the aforesaid procedure are known as “Transformations” and are given the date of the original international registration. It should be noted that the mechanism of transformation of international registration in to national or regional applications is not available where the owner himself opted to cancel the international registration.

2.3.5.5 Safeguard Clause;

The Madrid Agreement and the Madrid Protocol are independent parallel treaties with separate but overlapping memberships. As long

25 Article 6 (3) of the Madrid Protocol
26 Article 6 (2) of the Madrid Protocol
27 Article 9quinquies of the Madrid Protocol
as all countries that are party to the Madrid Agreement have not joined the Madrid Protocol, there will be three groups of members of the Madrid Union, namely:

i. States party only to the Madrid Agreement;

ii. States and Organizations party only to the Madrid Protocol;

iii. States party to both the Madrid Agreement and the Madrid Protocol.

The question arises that which treaty will binding between States party to both the Agreement and the Protocol. This situation is regulated by the ”Safeguard Clause” of the Madrid Protocol. According to the safeguard clause, if the Office of Origin is party to both the Agreement and the Protocol and the Designated State is also a party to both the Agreement and the Protocol then the governing treaty will be the Agreement\textsuperscript{28}. Similarly, if the Office of Origin is a party to both the Agreement and the Protocol and the Designating State is only party to the Agreement then the governing treaty will be the Agreement and if the Office of Origin is a party to both the Agreement and the Protocol and the Designating State is only party to the Protocol then the governing treaty will be the Protocol and vice versa.

2.3.6 Fees for International Registration;

The application for the international registration of a mark under Madrid Protocol is filed in the Office of Origin then the application is forwarded to WIPO that subsequently forward the application to the designated Contracting Parties. At the first stage, the Office of Origin may collect the following fees:

\textsuperscript{28} Article 9sexies of the Madrid Protocol
Fees for the international registration of a mark from the applicant;

Fees for the renewal of the international registration from the right holder of the mark\textsuperscript{29}.

Fees for transformation of international registration into national applications;

Fees to record replacement of registered Trade Mark with international registration;

Fees for filing of address for service/agent; etc.

For the second and third stages of the application, the applicant must pay fee in advance to the International Bureau of WIPO\textsuperscript{30} prescribed as under:

I. A basic fee of 653 Swiss francs for filing the international application or 903 Swiss francs where the mark is in colour;

II. A supplementary fee of 73 Swiss francs for each class (exceeding more than 3 classes) of the International Classification that is the Nice Classification of goods and services beyond three classes; and

III. A complementary fee of 73 Swiss francs for the designation of each designated Contracting Party.

There is a concession in the basic fee for the applicant for international registration whose Office of Origin belongs to a Least Developed Country in accordance with the list established by the United Nations. The basic fee is reduced to 10\% of the prescribed amount. In such case the basic fee is reduced to 65 Swiss francs for

\textsuperscript{29} Article 8 (1) of the Madrid Protocol
\textsuperscript{30} Article 8 (2) of the Madrid Protocol
filing the international application or to 90 Swiss francs where the mark is in color\textsuperscript{31}.

At the end of each year, the annual product of the various receipts from International Registration shall be divided equally among the Contracting Parties by the International Bureau after deduction of the expenses and charges necessitated by the implementation of the Madrid Protocol\textsuperscript{32}. The International Bureau of WIPO will also divide the supplementary and complementary fees among the Contracting Parties in proportion to the number of marks for which the protection has been applied for in each Contracting Party during the year\textsuperscript{33}.

However, any Contracting Party has the right to receive an “Individual Fee” instead of a share in the revenue generated by the supplementary and complementary fees whose amount shall be indicated in the declaration and can be changed in further declarations\textsuperscript{34}. It should be noted here that the individual fee fixed by the Contracting Party may not be higher than the equivalent amount which the assumed Contracting Party will receive from an applicant for a ten year registration or from the holder of a registration for a ten year renewal of that registration\textsuperscript{35}.

2.3.7 Responsibilities of the Office of Origin;

The applicant may file the application for the international registration of mark in the National Trade Marks Office referred to as the Office of Origin in the context of Madrid Protocol. The Office of Origin shall certify that the particulars appearing in the international application correspond to the particulars appearing in the basic

\begin{itemize}
  \item \textsuperscript{31} www.wipo.int/edocs/madrdocs/en/2005/madrid_2005_17.pdf
  \item \textsuperscript{32} Article 8 (4) of the Madrid Protocol
  \item \textsuperscript{33} Article 8 (5) and Article 8 (6) of the Madrid Protocol
  \item \textsuperscript{34} www.wipo.int/export/sites/www/madrid/en/fees/pdf/individ.pdf
  \item \textsuperscript{35} Article 8 (7) (a) of the Madrid Protocol
\end{itemize}
application or basic registration\textsuperscript{36}. In case of a basic application, the Office of Origin must indicate the date and number of that application\textsuperscript{37} and in case of a basic registration, the Office of Origin must specify the date and number of that registration as well as the date and number of the application from which the basic registration is resulted\textsuperscript{38}.

The Office of Origin must also check whether the classes are according to the classification established by the Nice Agreement concerning the International Classification of Goods and Services\textsuperscript{39} for the purposes of the Registration of Marks or not and shall also mention the date of the international registration.

The international registration shall bear the date on which the international application was received in the Office of Origin provided that the international application has been received by the International Bureau of WIPO within a period of two months from the date by which the application is submitted in the Office of Origin for international registration. Otherwise, the international registration shall bear the date on which the complete international application was received by the International Bureau of WIPO\textsuperscript{40}.

It is the duty of the Office of Origin to remedy any deficiencies in the international application. If the deficiencies in the international application are corrected within two months from the date of filing of the international application to the International Bureau then the date of the international registration will be the same as the date of filing. But, if the deficiencies are not corrected within three months of notification by the International Bureau to the Office of Origin, the

\textsuperscript{36} Article 3 (1) of the Madrid Protocol
\textsuperscript{37} Article 3 (1) (i) of the Madrid Protocol
\textsuperscript{38} Article 3 (1) (ii) of the Madrid Protocol
\textsuperscript{39} Article 3 (2) of the Madrid Protocol
\textsuperscript{40} Article 3 (4) of the Madrid Protocol
international application will be considered abandoned\textsuperscript{41}.

\textbf{2.3.8 Responsibilities of the International Bureau;}

The International Bureau of WIPO is responsible for the international registration of marks as well as all other administrative matters concerning the Madrid Protocol\textsuperscript{42}. After receiving the international application, the International Bureau of WIPO establishes that the application has all the necessary information, the international classes are properly mentioned and the required fee has been paid. If the applications met the aforesaid criteria, the International Bureau will register the mark to its international register and publishes the mark in the WIPO Gazette of International Marks\textsuperscript{43}. If the mark is in colour, it will be reproduced in black and white in its main entry in the Gazette and will be published in colour in a separate section at the end of the Gazette\textsuperscript{44}. At the same time, the International Bureau give notice of the International registration to the Office of Origin, provide the applicant with the registration certificate and notifies the Trade Marks Offices of the designated Contracting Parties.

At this stage, the International Registration does not mean that the mark is registered in all the designated Contracting Parties. Rather, it means that the applicant for the international registration gains the right to apply for registration in the Contracting Parties and if any designated Contracting Party refuse to register the mark, the international registration will remains in force and the applicant is eligible to apply in other Contracting Parties of the Madrid Protocol.

It must be in the fitness of things to say that the applicant may only designate that Contracting Party who is the member of the same

\textsuperscript{41} Common Regulations, Rule 11 (4)
\textsuperscript{42} Article 11 (1) of the Madrid Protocol
\textsuperscript{43} Common Regulations, Rule 32 (1) (b)
\textsuperscript{44} Common Regulations, Rule 32 (1) (c)
treaty as that of his Office of Origin. Therefore, if a country is a member of the Agreement, it can only designate that Contracting State which is member to the Agreement. Similarly, if a country is a member of the Protocol, it can only designate that Contracting Party which is member to the Protocol. Whereas, a country that is member of the Madrid System has the liberty to designate both the Contracting State that is member to the Agreement and the Contracting Party that is member to the Protocol.

2.3.9 Responsibilities of the Designated Parties;

The International Bureau of WIPO will forward the international application to the designated Contracting Parties that are mentioned in the international application. The Trade Marks Office of the designated Contracting Party will treat the international application in the same manner as it treats its national applications. In other words, the international application for the registration of a mark will be examined according to the National Trade Marks legislation of the designated Contracting Party.

The Trade Marks Office of the designated Contracting Party is under obligation to the Madrid Protocol to issue a statement of grant of protection, if it decides to extend protection to the mark, within twelve months after receiving the notice from the International Bureau or eighteen months, if declared separately, which may be further extended in case that the Trade Marks Office of the designated Contracting Party inform the International Bureau that oppositions might be filed with respect to the international registration or sent a notification of refusal based on an opposition, but not more than

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45 Common Regulations, Rule 9 (4) (a) (xv)
46 Article 5 (2) (a) of the Madrid Protocol
47 Article 5 (2) (b) of the Madrid Protocol
seven months after the beginning of the opposition period\textsuperscript{48}.

If office of the designated Contracting Party is not been able to register the mark within 12 or 18 months, as the case may be, then it must issues a notice of provisional rejection to the applicant within the prescribed period as mentioned above. This notice should be issued to the International Bureau along with the documents elucidating the reasons for rejection\textsuperscript{49}. The International Bureau in turns forwards a copy of the notice of provisional rejection to the owner of the international registration\textsuperscript{50}. It should be noted that if a provisional rejection is not issued to a mark within the prescribed period, the mark will be granted the same protection as given to an application filed directly to the Trade Marks Office of the designated Contracting Party\textsuperscript{51}.

All proceedings after the provisional refusal are between the right holder of the international registration and the Trade Marks Office of the designated Contracting Party. Upon receiving a provisional refusal from the designated Contracting Party via the International Bureau of WIPO, the right holder of the international registration should hire a local representative familiar with the relevant laws, practice and language of the designated Contracting Party. After the proceedings are over, the designated Contracting Party must confer notice to the International Bureau whether it has confirmed or withdrawn its provisional refusal. The result will be recorded in the International Register and published in the WIPO Gazette of International Marks.

A detailed flow sheet diagram of the responsibilities of the Office of Origin, the International Bureau of WIPO, the designated Contracting Party and the applicant to administer the Madrid

\textsuperscript{48} Article 5 (2) (c) of the Madrid Protocol
\textsuperscript{49} Article 5 (2) (a) of the Madrid Protocol
\textsuperscript{50} Article 5 (3) of the Madrid Protocol
\textsuperscript{51} Article 5 (5) of the Madrid Protocol
Protocol\textsuperscript{52} is as under:

**Flow Chart of International Registration of Marks under Madrid Protocol**

\textbf{2.3.10 Effects of International Registration;}

If the International Bureau did not receive any refusal within the prescribed time period from the designated Contracting Party then the protection of the mark in the designated Contracting Party will be the same as if the mark had been directly registered with the Trade Marks Office of that designated Contracting Party\textsuperscript{53}.

An applicant may claim priority for an earlier filing under Article 4 of the Paris Convention for the Protection of Industrial Property\textsuperscript{54} provided the applicant applies for the international registration or makes a subsequent designation within six months of filing of his


\textsuperscript{53} Article 4 (1) (a) of the Madrid Protocol

\textsuperscript{54} Article 4 (1) (c) of the Madrid Protocol
basic application in the Office of Origin. It should be noted that the applicant may not claim a priority date that is more than six months earlier than the date of international registration.

An applicant may designate a Contracting Party where his mark is already registered by using the route of Paris Convention. In this case, the international registration via Madrid Protocol will replace the international registration via Paris Convention in that particular Contracting Party. This will be advantageous in a sense that the renewals of the international registration will become more convenient than renewing separate registrations under the Paris Convention. Such replacements would take place automatically without review of the Trade Marks Office of the designated Contracting Party.

2.3.11 Post Registration Procedures;

After the registration of the mark in the designated Contracting Party, there are a number of post-registration procedures that the holder of the mark may pursue from time to time according to his requirements. These post-registration procedures are discussed below:

2.3.11.1 Renewal of Registration;

The international registration of a mark may be renewed for a period of ten years from the end of the preceding period by submitting the MM11 form for renewal of international registration and paying the necessary fee to the International Bureau of WIPO. The

56 Common Regulations, Rule 14 (2) (i)
57 Article 4bis of the Madrid Protocol
59 Article 6 (1) and Article 7 (1) of the Madrid Protocol
International Bureau will send an un-official notice to the applicant before six months of the expiry date of the international registration. The holder of the international registration may choose to renew the registration for less than all of the designated Contracting Parties mentioned in the international application at the time of registration. The holder has the right to renew the international registration up to six months of the expiry of the international registration on payment of a surcharge that is half of the basic fee. If the holder did not renew its international registration, the registration lapses and the International Bureau will notify the Trade Marks Offices of the designated Contracting Parties and publishes a notification in the WIPO Gazette of International Marks.

**Complementary Renewal;**

If an International Registration has been renewed in respect of only some of the designated Contracting Parties and the holder decides, after the due date, to renew in respect of a designated Contracting Party not covered by the renewal already effected, this may be done through a so-called “Complementary Renewal,” provided that the period of grace of six months has not yet expired. The fees payable are the basic fee, a complementary or individual fee in respect of the Contracting Party concerned and the surcharge which amounts to 50% of the basic fee for renewal.

**2.3.11.2 Subsequent Designation;**

The holder of the international registration may designate any other Contracting Party at any time that is not mentioned in his original international application by filing MM4 form for designation.

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60 Article 7 (3) of the Madrid Protocol
61 Common Regulations, Rule 30 (2) (a)
62 Article 7 (4) of the Madrid Protocol
63 Guide to the International Registration of Marks by WIPO, Part-B, Chapter-II, P-88, 2008
subsequent to the international registration along with the prescribed fee to the International Bureau of WIPO\textsuperscript{64}. It does not mean that the holder can only designate that Contracting Party that is not mentioned in his original international application. If the holder of the international registration believes that the grounds of refusal of designated Contracting Party in his original application are no more applicable then he can also designate that Contracting Party where the extension of protection is rejected on some grounds of refusal. Furthermore, the holder of the international registration may designate that Contracting Party that is not member to the Madrid Protocol when he filed his international application and now it has acceded to the Madrid Protocol.

The subsequent designation may be made either for all or for only part of the goods and services in the international registration and there may be several subsequent designations for one contracting party with different goods and services referred in each. The International Bureau of WIPO will publish the subsequent designation in the WIPO Gazette\textsuperscript{65}. The renewal of the subsequent designations will be the same as that of the international registration regardless of when the subsequent designations were recorded\textsuperscript{66}. The refusal for protection of the subsequent designation will follow the same procedures as for refusal of the original international registration\textsuperscript{67}.

**A Particular Case of Subsequent Designation;**

Under the European Community Trade Marks system, where a Community Trade Mark application is with drawn or refused or where a Community Trade Mark registration ceases to have effect, the

\textsuperscript{64} Article 3bis of the Madrid Protocol
\textsuperscript{65} Article 3ter (2) of the Madrid Protocol
\textsuperscript{66} Common Regulations, Rule 31 (2)
\textsuperscript{67} Common Regulations, Rule 24 (8)
proprietor of that Community Trade Mark may request its conversion in to a National Trade Mark application with the Office of one or more Member States of the European Community. The effect of conversion is that the National Trade Mark application resulting from conversion is allocated the same filing date as that of the Community Trade Mark application or registration provided in particular that the request for conversion is filed within the time limit prescribed by the Community legislation.\textsuperscript{68}

Having regard this feature of the Community Trade Mark system, the Common Regulations provide that, where a Contracting Organization (in practice the European Community) is designated in an International Registration and to the extent that such designation has been withdrawn, refused or has ceased to have effect, conversion may also be requested through a subsequent designation of its Member States under the Madrid System.\textsuperscript{69}

This mechanism offering the holder of an International Registration the option of converting the designation of the European Community in to either a national application filed directly with the Office of the Member State or a subsequent designation of that Member State under the Madrid System is often referred to as the “Opting-Back” provision.\textsuperscript{68} A subsequent designation resulting from the conversion must be presented on the official form MM16 established by the International Bureau of WIPO and must always be presented to the International Bureau through the Office of the Contracting Organization (in practice, OHIM).\textsuperscript{70}

\textbf{2.3.11.3 Assignment;}

The right holder of the international registration can only

\textsuperscript{68} Guide to the International Registration of Marks by WIPO, Part-B, Chapter-II, PP 59-60, 2008
\textsuperscript{69} Common Regulations, Rule 24 (7) (a)
\textsuperscript{70} Guide to the International Registration of Mark by WIPO, Part-B, Chapter-II, Page 61, 2008 and Common Regulations, Rule 24 (2) (a) (iii)
assign to a national or domiciliary of a contracting party, or a country that is a member of an intergovernmental organization that is a contracting party, or to a person with a bonafide and effective industrial or commercial establishment in such a country\textsuperscript{71}. In other words, the assignee must be the one who would be entitled to file an international application on its own at the time of assignment. The holder of the international registration may choose to assign some or all of its goods or services and may assign as to one or all of its designated Contracting Parties. The assignment of marks is accomplished through filing of MM5 form for the change in the ownership of an international registration referred to be as Assignment accompanied with the prescribed fee to the International Bureau of WIPO.

\textbf{2.3.11.4 Limitation, Renunciation or Cancellation;}

The holder of the international registration may limit his list of goods and services as to some or all designated Contracting Parties by filing MM6 form with the prescribed fee to the International Bureau\textsuperscript{72}. The holder may renounce protection as to some but not all of the designated contracting parties as to all of its listed goods and services by filing MM7 form with no fee to the International Bureau. The holder may cancel his international registration as to all of the designated contracting parties for some or all of its listed goods and services by filing MM8 form with no fee to the International Bureau\textsuperscript{73}.

The most important point to be noted over here that the goods and services that are subject to limitations or renunciations may be recovered by a subsequent designation on payment of the prescribed fee but after cancellation of the international registration, the former

\textsuperscript{71} Article 9 of the Madrid Protocol
\textsuperscript{72} Article 9bis (iii) and Article 9ter of the Madrid Protocol
\textsuperscript{73} Article 9bis (iv) and Article 9ter of the Madrid Protocol
holder of the registration may not been able to file a subsequent designation to revive his listed goods and services in the designated Contracting Parties.

2.3.11.5 Amendment;

A mark cannot be amended in the international register even if the mark required to be used slightly differs from that in the international registration or if the mark was amended in the basic registration. In this case, the holder of the international registration will have to file a new international application. Similarly, in order to extend the list of goods and services on his international registration, the holder of the international registration must file a new international application to the International Bureau of WIPO.

2.3.11.6 Licenses;

The holder of the international registered mark may record his licenses in the international register by filing MM13 form with the prescribed fee either to the International Bureau of WIPO or to the office of his own Contracting Party or to the office of a Contracting Party where the license is granted74.

2.3.11.7 Change of Name or Address of the Right Holder or its Representative;

The right holder may change his name and/or address on his international registration by submitting MM9 form along with the prescribed fee to the International Bureau of WIPO. Similarly, the right holder may also change the name and/or address of his representative by filing MM10 form with no fee to the International Bureau of WIPO75.

74 Article 9bis (ii) and Article 9ter of the Madrid Protocol
75 Article 9bis (i) and Article 9ter of the Madrid Protocol
2.4 Pros and cons of the Madrid Protocol;

The developed countries are of the view that Madrid Protocol is a very good way to register the marks internationally whereas the developing countries have various observations on the Madrid Protocol. Some of the ins and outs of this treaty are elaborated as under:

2.4.1 Advantages;

I. The applicant of the mark has only to file one application, in one language and pay one fee in single currency instead of filing separate applications in the Trade Marks Offices of the various countries in different languages and paying a separate fee in the local currency to each country76;

II. The applicant does not need to hire the services of a local agent to file the application for the registration of a mark that will reduce the legal fees. However, the applicant may consider for a local foreign counsel to conduct searches for the marks. But, if the National Trade Marks Office of the designated Contracting Party issues a notification of refusal then the applicant will need to hire the services of a local foreign counsel to pursue registration in that designated Contracting Party77;

III. More applications means an increased workload for the National Trade Marks Office, which means more objections and all of this will lead to more work for the local counsels. So, although counsels may suffer from a reduction in filing instructions from foreign clients, they will probably find an increase in their litigation workload. Moreover, there will be

76 Publication on The Madrid Agreement concerning the International Registration of Marks and the Protocol relating to that Agreement: Objectives, Main Features & Advantages, WIPO, P-13, 2002
an increase in oppositions, in assignments, in licensing and franchising work and it is a requirement of most of the National Trade Marks Offices to appoint a local attorney in such kind of matters⁷⁸;

IV. The applicant does not have to wait for the office of each Contracting Party in which the protection is sought. If no refusal is notified by the office of the Contracting Party within the applicable time period, the mark will automatically be protected in that Contracting Party⁷⁹;

V. The changes after the international registration of the mark like change in the name or address of the holder or a change in ownership or a limitation of the list of goods and services etc. may be recorded by following a single procedural step and the payment of the requisite fee to the International Bureau of WIPO. These changes will automatically be recorded in the designated Contracting Parties mentioned in the international application⁸⁰;

VI. The National Trade Marks Offices do not need to examine the international application when it works as an Office of Origin or classify the goods or services or publish the marks etc.⁸¹; and

VII. The National Trade Marks Offices are compensated for the work that they will perform by transferring the Individual Fees collected by the International Bureau of WIPO to the Contracting Parties while the Supplementary and Complementary Fees are distributed annually to those

⁷⁸ Report on The Madrid System for the International Registration of Marks, International Trademark Association (INTA), P-8, 2000
⁷⁹ Publication on The Madrid Agreement concerning the International Registration of Marks and the Protocol relating to that Agreement: Objectives, Main Features & Advantages, WIPO, P-14, 2002
⁸⁰ ibid
⁸¹ ibid
Contracting Parties in proportion of the number of designations that do not receives any Individual Fee.\(^{82}\)

### 2.4.2 Drawbacks;

I. The procedure of the Madrid Protocol makes it so easy to apply for Trade Marks protection in other countries without knowing the local standards and searching the local marks. Thus, applicants may lose the benefit of input from informed local counsels and makes it more difficult to address the potential problems that will arise in the later stages of the registration of a mark.\(^{83}\);

II. The Madrid Protocol may flood the National Trade Marks Offices with foreign applications allowing the foreign applicants to make broad claims of coverage in the designated Contracting Party.\(^{84}\);

III. The National Offices will attract more workload as a result of ratifying the Madrid Protocol, whether acting as an Office of Origin or an Office of the designated Contracting Party.\(^{85}\);

IV. The Trade Marks maintenance may become more costly under the Madrid Protocol, if the mark owners file a greater number of oppositions against the international application for the registration of a mark in the designated Contracting Party.\(^{86}\);

V. The specification of list of goods and services in the International Registration is a difficult task because every Contracting Party has its own interpretations of goods and services.\(^{82,83,84,85,86}\)

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\(^{82}\) ibid


\(^{84}\) ibid

\(^{85}\) Report on The Madrid System for the International Registration of Marks, International Trademark Association (INTA), P-9, 2000

services and in most of the cases the provisional refusal is based on the list of goods and services that is mentioned in the International Registration; and

VI. The provision of “Central Attack” in the Madrid Protocol is also a major disadvantage of the system because the International Registration is based on the basic application or basic registration for the first five years that will clearly have an effect on the stability of the Marks and is of great concern of the right holders.
IMPLEMENTATION OF METHODOLOGY

The implemented methodology to prove the hypotheses deduced from the background information is discussed as under:

3.1 Comparison of the Common Provisions of the Madrid Protocol in the National Trade Marks Legislations of Japan, Singapore and United States of America and the Conflicts between the National Trade Marks Legislation of Pakistan and Madrid Protocol;

The first hypothesis of my research theme is to amend the National Trade Marks Legislation in order to bring it in line with the provisions of the Madrid Protocol. In this regard, the Trade Marks legislations of three countries were studied namely: Japan, Singapore and the United States of America. These three countries are members to the Madrid Protocol and are not signatories to the Madrid Agreement. It is for this very reason that I chose the legislations of these countries in order to study the provisions that gives effect to the Madrid Protocol in these countries. In addition to the comparison of the legislations of the aforesaid countries, I have also compared the National Trade Marks legislation of Pakistan with that of the Madrid Protocol in order to find out conflicts in between the two texts.

In Japan, Chapter VII-BIS of the Trade Marks Law titled, Special Provisions under the Protocol of the Madrid Agreement deals with the Madrid Protocol87 (Annex-I). There are three parts of this chapter, namely:

1. Application for International Registration [Sections 68bis (68-2) to 68octies (68-8)];
   - Section 68-2 deals with the application for international

registration;

- Section 68-3 deals with the responsibilities of the Office of Origin for the international registration;
- Section 68-4 deals with the later designation;
- Section 68-5 deals with the request for renewal of international registration;
- Section 68-6 deals with the request for recordal of change in the ownership of international registration;
- Section 68-7 deals with the application mutatis mutandis of provisions on application for Trade Mark registration; and
- Section 68-8 deals with the delegation to Ordinance of the Ministry of Economy, Trade and Industry.

2. Special Provisions Relating to Application for International Trade Mark Registration [Sections 68novies (68-9) to 68untricies (68-31)];

- Section 68-9 deals with the Trade Mark application based on request for territorial extension;
- Section 68-10 deals with the special provisions for time of filing of application for international Trade Mark registration;
- Section 68-11 deals with the special provisions for time of filing of application;
- Section 68-12 deals with the special provisions for division of applications;
- Section 68-13 deals with the special provisions for conversion of applications;
- Section 68-14 deals with the special provisions for matters published in Trade Mark Gazette relating to publication of applications;
- Section 68-15 deals with the special provisions for proceedings for priority claim under the Paris Convention, etc.
Section 68-16 deals with the special provisions for rights resulting from applications for Trade Mark registration;
Section 68-17 deals with applications for international Trade Mark registration resulting from change in the ownership of an international registration;
Section 68-18 deals with the special provisions for new application for Trade Mark as amended;
Section 68-19 deals with the special provisions for registration of establishment of Trade Mark right;
Section 68-20 deals with the effects of extinguishment of international registration;
Section 68-21 deals with the term of Trade Mark right based on international registration;
Section 68-22 deals with the special provisions for registration of renewal of term;
Section 68-23 deals with the special provisions for division of Trade Mark rights;
Section 68-24 deals with the special provisions for transfer of Collective Trade Mark right;
Section 68-25 deals with the special provisions for surrender of Trade Mark rights;
Section 68-26 deals with the special provisions for effects of registration of Trade Mark rights;
Section 68-27 deals with the special provisions for registration in Trade Mark register;
Section 68-28 deals with the special provisions for amendments of proceedings;
Section 68-29 deals with the special provisions for exceptional provisions on Trade Marks for two or more designated goods or designated services;
Section 68-30 deals with the individual fee of Trade Mark
rights based on international registration; and

- Section 68-31 deals with the delegation to Ordinance of the Ministry of Economy, Trade and Industry.

3. Special Provisions for Applications for Trade Mark Registration, etc. [Sections 68duotricies (68-32) to 68undequadragies (68-39)].

- Section 68-32 deals with the subsequent to cancellation of international registration;
- Section 68-33 deals with the special provisions for application for Trade Mark registration subsequent to denunciation of Protocol;
- Section 68-34 deals with the special provisions for reasons for refusal;
- Section 68-35 deals with the special provisions for registration of establishment of Trade Mark right;
- Section 68-36 deals with the special provisions for term;
- Section 68-37 deals with the special provisions for opposition to registration;
- Section 68-38 deals with the special provisions for trial for invalidation of Trade Mark registration; and
- Section 68-39 deals with section 47 for the Trade Mark registration for the re-filing of the application for the registration of Trade Mark right based on any formal international registration.

In Singapore, Part VII of the Trade Marks Act, 1998 deals with the international matters, the Madrid Protocol etc\(^8\) (Annex-II). Where as, separate rules were formulated for administering the

Madrid Protocol in Singapore known as the Trade Marks (International Registration) Rules, 2000\(^89\). There is only one section with four sub-sections in the Trade Marks Act, 1998 that deals with the Madrid Protocol.

- Section 54 (1) is an enabling provision of the Madrid Protocol in the Trade Marks Act. According to this provision, the Minister may make rules to give effect in Singapore to the provisions of the Madrid Protocol or of any treaty, convention, arrangement or engagement relating to Trade Marks to which Singapore is a party;
- Section 54 (2) specifies the guidelines for formulation of the rules;
- Section 54 (3) corresponds to section 35 and Parts VI and X of the Trade Marks Act, 1998 of Singapore; and
- Section 54 (4) defines the International Bureau, International Trade Mark (Singapore) and the Madrid Protocol.

In **United States of America**, Title 15 of the United States Code outlines the role of commerce and trade in the United States Code. There are total 103 chapters in the Title 15 of the United States Code and chapter 22 is the Trade Marks Act (Lanham Act). There are 4 sub-chapters of the Trade Marks Act and sub-chapter-IV deals with the Madrid Protocol\(^90\) (Annex-III). Whereas, Part 7 of Title 37 of the Code of Federal Regulations deals with the Rules of Practice in filings pursuant to the Protocol relating to the Madrid Agreement concerning

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the International Registration of Marks. There are total fifteen sections in sub-chapter-IV of chapter-22 of the Trade Marks Act starting from 1141, 1141a to 1141n. These sections deal with the following:

- Section 1141 deals with the definitions;
- Section 1141a deals with the international applications based on United States applications of registrations;
- Section 1141b deals with the certification of the international application;
- Section 1141c deals with the restriction, abandonment, cancellation or expiration of a basic application or basic registration;
- Section 1141d deals with the request for extension of protection subsequent to international registration;
- Section 1141e deals with the extension of protection of an international registration to the United States under the Madrid Protocol;
- Section 1141f deals with the effect of filing a request for extension of protection of an international registration to the United States;
- Section 1141g deals with the right of priority for request for extension of protection to the United States;
- Section 1141h deals with the examination of and opposition to request for extension of protection; notification or refusal;
- Section 1141i deals with the effect of extension of protection;
- Section 1141j deals with the dependence of extension of protection.

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protection to the United States on the underlying international registration;

- Section 1141k deals with the affidavits and fees;
- Section 1141l deals with the assignment of an extension of protection;
- Section 1141m deals with the incontestability; and
- Section 1141n deals with the rights of extension of protection.

Comparison of the Common Provisions of Trade Marks Law of Japan, Singapore and United States of America Dealing with the Madrid Protocol:

| JAPAN | SINGAPORE | USA
|-------|------------|---|
| Application for International Registration | Power to Make Provision Giving Effect to Madrid Protocol, etc. | §1141a.
| 68bis.- (1) A Japanese national or an alien who is domiciled or resident (or, in the case of a legal entity, established) in Japan, who desires to seek an international registration (hereinafter referred to as "the international registration") as referred to in Article 2(1) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as adopted at Madrid on June 27, 1989 (hereinafter referred to as "the Protocol"), shall file with the Commissioner of the Patent Office an application (hereinafter referred to as "international application"), as referred to in Article 2(2) of the Protocol, based on either one of the following paragraphs. In such a case, where it complies with the requirement specified in an ordinance of the Ministry of Economy, Trade and Industry, two or more persons may | International applications based on United States applications or registrations | (a) In general
The owner of a basic application pending before the United States Patent and Trademark Office, or the owner of a basic registration granted by the United States Patent and Trademark Office may file an international application by submitting to the United States Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Director.
(b) Qualified owners
A qualified owner, under subsection (a) of this section, shall—
(1) be a national of the United States;
(2) be domiciled in the United States; or

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make a joint international application:

(i) their application for trademark registration or for defensive mark registration pending with the Patent Office (hereinafter referred to as "application for trademark registration, etc.");

(ii) their trademark registration or defensive mark registration (hereinafter referred to as "trademark registration, etc.").

§ 1141b. Certification of the international application

(a) Certification procedure
Upon the filing of an application for international registration and payment of the prescribed fees, the Director shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification.

(b) Transmittal
Upon examination and certification of the international application, the Director shall transmit the international application to the International Bureau.

§ 1141d. Request for extension of protection subsequent to international registration

(3) have a real and effective industrial or commercial establishment in the United States.
### Request for Recordal of Change in the Ownership of International Registration

#### 68sexies.

(1) As provided for in an ordinance of the Ministry of Economy, Trade and Industry, the holder of international registration or his assignee may present a request for the recordal of change in the ownership of the international registration to the Commissioner of the Patent Office under Article 9 of the Protocol (hereinafter referred to as "the change in the ownership of the international registration").

(2) The request as referred to in the preceding subsection may be made in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods or services listed in the registration.

### § 1141l.

Assignment of an extension of protection

An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.
### Trademark Application Based on Request for Territorial Extension

68novies.-(1) A request for territorial extension with respect to Japan shall be considered to be an application for trademark registration having been filed on the date of international registration made in accordance with Article 3(4) of the Protocol (hereinafter referred to as "the date of international registration"). However, in the case of later designation, under Article 3ter(2) of the Protocol, the application for trademark registration shall be considered to be the application having been filed on the date (hereinafter referred to as "the date of later designation") on which later designation is recorded in the register of the International Register defined in Article 2(1).

### Special Provisions for Time of Filing of Application for International Trademark Registration

68decies.-(1) Where a registered trademark (hereinafter in this Section referred to as "the registered trademark based on international registration") relating to the request for territorial extension considered to be an application for trademark registration under 68novies(1) (hereinafter in this Chapter referred to as "the application for international trademark registration") is identical with a

### § 1141e. Extension of protection of an international registration to the United States under the Madrid Protocol

(a) In general
Subject to the provisions of section 1141h of this title, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.

(b) If the United States is office of origin
Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.

### § 1141f. Effect of filing a request for extension of protection of an international registration to the United States

(a) Requirement for request for extension of protection
A request for extension of protection of an international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a
trademark prior to the trademark registration (excluding trademarks based on international registration; hereinafter in this Section referred to as "the registered trademark based on national registration"), and the designated goods or designated services relating to the registered trademark based on international registration are the same as the designated goods or designated services relating to the registered trademark based on the national registration, and also where the trademark holder of the registered trademark based on the international registration and the trademark holder of registered trademark based on the national registration are identical, the application for international trademark registration shall be deemed to have been made to the extent that such scope has overlapped on the date of the application for trademark registration relating to the registered trademark based on the national registration.

(2) Section 68duotricies (3) and (4) shall apply mutatis mutandis to the application for international trademark registration in the preceding subsection.

### Special Provisions for Proceedings for Priority Claim under the Paris Convention, etc.

68quindecies.- (1) Section 43(1) to (4) of the Patent Law, as applied under Section 13(1) of this Law shall not apply to the applications for international trademark registration.

(2) For the purpose of Section 1141g. Right of priority for request for extension of protection to the United States

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris
43(1) of the Patent Law, as applied under Section 43bis (3) of the said Law as applied under Section 13(1) of this Law for applications for international trademark registration, "simultaneously with the patent application" in the said Section 43(1) shall read "within 30 days from the date of filing of the application for international trademark registration".

<table>
<thead>
<tr>
<th>Special Provisions for Registration of Establishment of Trademark Right</th>
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</thead>
<tbody>
<tr>
<td>68undevicies.-(1) For the purpose of Section 18(2) for applications for international trademark registration, &quot;when the registration fee under Section 40(1) or the registration fee due to be paid within 30 days from the date of the transmittal of the examiner's decision or the trial decision that the trademark is to be registered under Section 41bis(1) has been paid&quot; in Section 18(2) shall read &quot;when the examiner's decision or the trial decision that the trademark is to be registered has been rendered&quot;.</td>
</tr>
<tr>
<td>(2) For the purpose of Section 18(3) for applications for international trademark registration, &quot;the number and date of the application for trademark registration&quot; shall read &quot;the number and date of the application for trademark registration&quot;.</td>
</tr>
</tbody>
</table>

Convention for the Protection of Industrial Property if—

1. the request for extension of protection contains a claim of priority; and

2. the date of international registration or the date of the recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).

§ 1141i. Effect of extension of protection

(a) Issuance of extension of protection

Unless a request for extension of protection is refused under section 1141h of this title, the Director shall issue a certificate of extension of protection pursuant to the request and shall cause notice of such certificate of extension of protection to be published in the Official Gazette of the United States Patent and Trademark Office.

(b) Effect of extension of protection

From the date on which a certificate of extension of protection is issued under subsection (a) of this section—

1. such extension of protection
registration" in Section 18(3)(ii) shall read "the number of the international registration and the date of the international registration (the date of later designation in the case of the application for international trademark registration with respect to the later designation," and "the registration number and date of the registration of the establishment" in Section 18(3)(v) shall read "the number of the international registration and the date of the registration of the establishment".

<table>
<thead>
<tr>
<th>Effects of Extinguishment of International Registration</th>
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<tbody>
<tr>
<td>§ 1141c. Restriction, abandonment, cancellation, or expiration of a basic application or basic registration</td>
</tr>
<tr>
<td>With respect to an international application transmitted to the International Bureau under section 1141b of this title, the Director shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration—</td>
</tr>
<tr>
<td>(1) within 5 years after the international registration date; or</td>
</tr>
<tr>
<td>(2) more than 5 years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.</td>
</tr>
</tbody>
</table>

(68)vicies.-(1) Where all or some of the international registration on which it is based has been extinguished, application for international trademark registration shall be deemed to have been withdrawn to the extent all or some of the designated goods or designated services has been extinguished.

(2) Where all or some of the international registration on which it is based has been extinguished, the trademark right which has been granted the registration of the establishment under Section 18(2) as applied under Section 68vicies (1) (hereinafter referred to as "the trademark right based on the international registration") shall be deemed to have been extinguished to the extent that all or some of the designated goods or designated services has been extinguished.

(3) The effects under the
preceding two subsections shall come into force from the date on which the international registration in the International Register has been extinguished.

**Term of Trademark Right Based on International Registration**

68unvicies-(1) The term of a trademark right based on the international registration shall be ten years from the date (the date of its latest renewal, if the term of international registration has been renewed prior to the registration of the establishment of the trademark right) of the international registration.

(2) The term of the trademark right based on the international registration may be renewed on the renewal of the term of the international registration.

(3) When the term of the international registration has been renewed, the term of the trademark right based on international registration shall be deemed to have been renewed upon expiration of the term.

(4) When the term of the international registration has not been renewed, the trademark right based on international registration shall be deemed to have been extinguished retroactively from the time of the expiration of the term.

§ 1141k. Affidavits and fees

(a) Required affidavits and fees
An extension of protection for which a certificate of extension of protection has been issued under section 1141i of this title shall remain in force for the term of the international registration upon which it is based, except that the extension of protection of any mark shall be canceled by the Director—

(1) at the end of the 6-year period beginning on the date on which the certificate of extension of protection was issued by the Director, unless within the 1-year period preceding the expiration of such 6-year period the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) of this section together with a fee prescribed by the Director; and

(2) at the end of the 10-year period beginning on the date on which the certificate of extension of protection was issued by the Director, and at the end of each 10-year period thereafter, unless—

(A) within the 6-month period preceding the expiration of such 10-year period the holder of the international registration files in the United States Patent and Trademark Office an affidavit
under subsection (b) of this section together with a fee prescribed by the Director; or

(B) within 3 months after the expiration of such 10-year period, the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) of this section together with the fee described in subparagraph (A) and the surcharge prescribed by the Director.

(b) Contents of affidavit
The affidavit referred to in subsection (a) of this section shall set forth those goods or services recited in the extension of protection on or in connection with which the mark is in use in commerce and the holder of the international registration shall attach to the affidavit a specimen or facsimile showing the current use of the mark in commerce, or shall set forth that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.

(c) Notification
The Director shall notify the holder of the international registration who files 1 of the affidavits of the Director’s acceptance or refusal thereof and, in case of a refusal, the reasons therefore.

(d) Service of notice or process
The holder of the international
Subsequent to Cancellation of International Registration

68duotricies.—(1) Where the international registration is cancelled under Article 6(4) of the Protocol in respect of all or some of the goods and services listed in the said registration, the person who was the holder of international registration, may file an application for the registration of the same mark which was registered in the International Register with respect to Japan in respect of all or some of the said goods or services.

(2) The application for the trademark registration under the preceding subsection shall be deemed to have been filed on the

registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person so designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation so filed. If the person designated cannot be found at the address given in the last designation, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.

§ 114j.

Dependence of extension of protection to the United States on the underlying international registration

(a) Effect of cancellation of international registration

If the International Bureau notifies the United States Patent and Trademark Office of the cancellation of an international registration with respect to some or all of the goods and services listed in the international registration, the Director shall cancel any extension of protection to the United States with respect to such goods and services as of the date on which the international registration was canceled.
| **date of international registration as referred to in the said subsection (in the case of the international registration as referred to in the said subsection in respect of subsequent designation, the date of said subsequent designation) provided that the said application falls under any one of the following paragraphs:** |
| **(i)** such application in the preceding subsection is filed within three months from the date on which the international registration as referred to in the preceding subsection was cancelled; |
| **(ii)** the trademark of which registration is sought is identical with the trademark in respect of such international registration in the preceding subsection; |
| **(iii)** the designated goods or the designated services in respect of such application are in fact covered by the list of goods and services contained in such international registration in the preceding subsection. |

**3** Where the international registration as referred to in Subsection (1) enjoyed the right of priority provided for by Article 4 of the Paris Convention, that application under Subsection (1) shall enjoy the same right of priority.

(b) **Effect of failure to renew international registration**

If the International Bureau does not renew an international registration, the corresponding extension of protection to the United States shall cease to be valid as of the date of the expiration of the international registration.

(c) **Transformation of an extension of protection into a United States application**

The holder of an international registration canceled in whole or in part by the International Bureau at the request of the office of origin, under article 6(4) of the Madrid Protocol, may file an application, under section 1051 or 1126 of this title, for the registration of the same mark for any of the goods and services to which the cancellation applies that were covered by an extension of protection to the United States based on that international registration. Such an application shall be treated as if it had been filed on the international registration date or the date of recordal of the request for extension of protection with the International Bureau, whichever date applies, and, if the extension of protection enjoyed priority under section 1141g of this title, shall enjoy the same priority. Such an application shall be entitled to the benefits conferred by this subsection only if the application is filed not later than 3 months after the date on which the international registration was canceled, in whole or in part, and only if the application complies...
Considerations of the Comparison of Trade Marks Law of Japan, Singapore and United States of America:

The considerations of the comparison of three Trade Marks legislations on the basis of their provisions for different actions required under the auspices of Madrid Protocol are discussed as follows:

1. The provision for application for international registration of a mark is better in the US Law;
2. The provision of certification of the international application with that of the basic application or basic registration is more clear in the US Law;
3. There is a difference in the provision of subsequent designation in the Japanese and US Trade Marks legislations. In case of Japan, the request for subsequent designation will be forwarded to the International Bureau of WIPO through the Japan Patent Office whereas in case of USA, the request for subsequent designation can either be forwarded directly from the applicant to the International Bureau of WIPO or through the United States Patent and Trade Mark Office. In my opinion, it will be better to forward the application for subsequent designation through the Patent Office;
4. The provision of request for recordal of change in ownership of international registration is more elaborated in the Japanese Trade Marks law;
5. The provision of extension of protection of international registration in the designated Contracting Parties of the
Madrid Protocol is clearer and more specific in the Japanese Trade Marks law;

6. In case of filing a request for extension of protection in Japan, a declaration of the bona fide intention to use the mark is not required to be submitted by the applicant. Whereas in the case of USA, the applicant has to submit this declaration. In this provision, Japanese law is more convenient and flexible as compared to US law;

7. The provision for claiming a right of priority under the Paris Convention is more comprehensive in the US Trade Marks law;

8. The provision of effect of extension of protection of a Trade Mark right is more simpler and easy to understand in the US Trade Marks legislation;

9. The provision of effects of extinguishment of international registration is more comprehensive in the US Trade Marks law in which the provision of “Central Attack” of Madrid Protocol is clearly described;

10. The provision of term of Trade Mark right based on international registration is more clearer in the Japanese Trade Mark law whereas US Trade Marks law have different requirements for the term of a Trade Mark right;

11. The provision of transformation of international application into national applications is more elaborated in the Japanese Trade Mark law.

**Note:** One thing should be kept in mind that in the above considerations, the provisions of Trade Marks law of Singapore are not taken into consideration due to the fact that there is only one enabling provision for giving effect to Madrid Protocol in the Trade Marks Act of Singapore and all the functional provisions are explained in the Trade

Conflicts between the Trade Marks Legislation of Pakistan and the Provisions of Madrid Protocol:

In order to identify the conflicts between the National Trade Marks legislation of Pakistan and that of the provisions of the Madrid Protocol, I have consulted the Trade Marks Ordinance, 2001, Trade Marks Rules, 2004, Articles of the Madrid Protocol, Common Regulations of the Madrid Protocol and the Madrid Guide. After going through the above reference material, I come across with the following four conflicts that in my observation exist between the National Trade Marks law and provisions of the Madrid Protocol:

<table>
<thead>
<tr>
<th>Trade Marks Rules, 2004</th>
<th>Common Regulations of the Madrid Protocol and Madrid Guide</th>
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<tbody>
<tr>
<td>9. Address for service.— (1) For the purposes of any proceedings before the Registrar under these rules, an address for service in Pakistan shall be filed by—</td>
<td>Rule 3: Representation Before the International Bureau (1) [Representative; Number of Representatives] (a) The applicant or the holder may have a representative before the International Bureau.</td>
</tr>
<tr>
<td>(a) every applicant for the registration of a trade mark;</td>
<td>(b) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.</td>
</tr>
<tr>
<td>(b) every person opposing an application for registration of a trade mark;</td>
<td>(c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.</td>
</tr>
<tr>
<td>(c) every applicant applying to the Registrar under section 73 for revocation of the registration of a trade mark, under section 80 for invalidation of the registration of a trade mark, or under section 96 for rectification of the register;</td>
<td></td>
</tr>
<tr>
<td>(d) every person granted leave to intervene under rule 67 (the intervener), and</td>
<td></td>
</tr>
<tr>
<td>(e) every proprietor of a registered trade mark, which is the subject of any application to the Registrar for</td>
<td></td>
</tr>
</tbody>
</table>
the revocation, invalidation or rectification of the registration of the mark.

13. Application to be confined to one class.– Every application for the registration of a trade mark shall be in respect of goods or services in one class only of the Fourth Schedule.

14. Separate application.– An application for the registration of the same trade mark in different classes shall be treated as separate and distinct applications, and in all cases where a trade mark is registered under the same official number for goods or services in more than one class, whether on conversion of the specification under rule 71 or otherwise, the registration in respect of goods or services included in each separate class shall be deemed to be a separate registration for all the purposes of the Ordinance.

18. Additional representations.– Every application for the registration of a trade mark shall, except as hereinafter provided, be made in duplicate and shall be accompanied by six additional representations of the mark on the application and its duplicate and the additional representations shall correspond exactly with the other. The additional representations shall in all cases be noted with all such particulars as may from time to time be required by the Registrar. Such particulars shall, if required, be signed by the applicant.

Rule 9: Requirements Concerning the International Application

(1) [Presentation] The international application shall be presented to the International Bureau by the Office of origin.

(2) [Form and Signature] (a) The international application shall be presented on the official form in one copy.

(b) The international application shall be signed by the Office of origin and, where the Office of origin so requires, also by the applicant. Where the Office of origin does not require the applicant to sign the international application but allows that the applicant also sign it, the applicant may do so.

54. Alteration of registered trade mark.– (1) The proprietor may
request the Registrar in the form as set out in Form TM-38 for such alteration of his registered mark as is permitted under section 37; and the Registrar may require such evidence by statutory declaration or affidavit or otherwise as to the circumstances in which the application is made. The proprietor shall furnish six copies of the mark as it will appear when so added to or altered.

(2) Where, upon the request of the proprietor, the Registrar proposes to allow such alteration, he shall publish the mark as altered. The proprietor shall supply “film positives” of the mark so altered or added to for advertising in the Journal.

(3) Any person claiming to be affected by the alteration may within three months of the date of publication of the alteration under sub-rule(2) send a notice in the form as set out in Form TM-39, in duplicate, to the Registrar of opposition to the alteration and shall include a statement of the grounds of opposition; the Registrar shall send a copy of the notice and the statement to the proprietor and thereafter the procedure specified in rule 30 shall apply to the proceedings as they apply to proceedings relating to opposition to an application for registration.

69.02 In particular, there is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration, as the case may be (where such change is possible according to the law of the Contracting Party whose Office is the Office of origin).

Considerations of the Conflicts of Trade Marks Legislation of Pakistan and Madrid Protocol;

The considerations of the conflicts between the Trade Marks legislation of Pakistan and that of the provisions of Madrid Protocol are discussed as under:

1. An address for service in Pakistan is necessary under the current Trade Marks law of Pakistan whereas in case of
Madrid Protocol, the address for service in the designated Contracting Party is not required at the time of filing an international application. However, the applicant may have a representative before the International Bureau of WIPO;

2. In Pakistan, separate applications will be filed for each class whereas in Madrid Protocol, all the classes can be included in one international application;

3. According to the Trade Marks law of Pakistan, every application for the registration of a mark shall be made in duplicate along with six additional representations of the mark on the application whereas in Madrid Protocol, the international application shall be presented on the official form in one copy; and

4. In Pakistan, the proprietor of a mark may request the Registrar for alteration of his registered mark whereas in case of Madrid Protocol, no alteration is allowed in the registered mark and the holder of the mark has to file a new international application.

3.2 Study of the Public Awareness Strategy and Support for Small and Medium Enterprises in Japan;

Small and medium enterprises (SMEs) have been recognized as the seedbed of employment, particularly in a developing country. Thus, SMEs have been regarded as having an important role in economic development. The public awareness strategy and support for the Small and Medium Enterprises can play a very significant role in developing the capacity building of the SMEs in the context of IP consciousness and human resource development that will help them in the protection of their IP rights not only in their own country but around the world for strengthening their businesses.

As compared with large companies, the small and medium
enterprises and start-ups have yet to fully understand the importance of intellectual property strategies and they do not have sufficient financial and human resources to be invested in intellectual property strategies. The Government of Japan should promote support measures for SMEs and start-ups as expected to create new technologies in various fields relating to creation, protection and exploitation of intellectual property as well as the development of human resources\textsuperscript{92}.

The comprehensive strategy for the development of human resource related to intellectual property was formulated on January 30, 2006 for the development of a variety of human resources that are related to intellectual property\textsuperscript{93}. In order to develop information and human resource, the National Centre for Industrial Property Information and Training (INPIT) in cooperation with the JPO is swiftly and accurately conducting a range of operations\textsuperscript{94}. The Japan Patent Office (JPO) has conducted IP human resource development programs that are suitable for elementary schools, junior high schools, high schools, universities, adults in general, researchers, entrepreneurs including SMEs and experts\textsuperscript{95}:

\textsuperscript{93} Annual Report, Japan Patent Office, Part 3, Chapter 5, P-86, 2007
\textsuperscript{95} Annual Report, Japan Patent Office, Part 3, Chapter 5, P-86, 2007
There are a number of support measures for the small and medium enterprises that are taken by the Japan Patent Office. These support measures are elaborated as under:\(^6\):

**A. Comprehensive Support Measures for SMEs;**

The JPO provides comprehensive support through various measures to SMEs that sustain the industrial foundation in Japan and play significant role as the driving force of regional economies, as well as to venture companies that are expected to create new industries.
I. Support in the Areas of Diffusion, Human Resources Development, and Consultation Concerning Industrial Property Rights;

i) Explanatory Meetings on the Intellectual Property Rights System (for introductory and advanced levels);

The JPO holds explanatory meetings on intellectual property rights for those at the introductory level who wish to start learning about intellectual property rights, and those who have just been transferred to the intellectual property division in their companies.

In addition, the JPO also holds explanatory meetings for those who engage in intellectual property affairs. These meetings cover the various systems that are indispensable for intellectual property affairs, such as examination standards, the PCT international application system, operation of the appeals and trials system, and the International Patent Classification (IPC).

ii) Seminars and Training for SMEs
and Venture Companies;

The JPO holds seminars on strategic acquisition of intellectual property rights that meet regional needs and on how to utilize such rights, for people such as corporate managers and people responsible for R&D.

In addition, training programs for SMEs and venture companies have been implemented at the INPIT.

iii) Consultation Services on Industrial Property Rights;

Dedicated staff members in the Patent Offices in the respective Regional Bureaus of Economy, Trade and Industry offer regular consultation services regarding basic matters from the filing of applications to registration and the actual procedure for filing an application. (Number of consultations conducted in FY2006: 20,665).

In addition, the INPIT offers a consultation service for all types of inquiries, such as having an idea but not knowing how to obtain rights for it or wishing to file a patent application but not knowing the actual procedure. The consultation service is offered in person, by e-mail, or by telephone.

iv) Comprehensive Support by Intellectual Property Right Specialists for SMEs;

The JPO has a staff of intellectual property right specialists who provide comprehensive support to SMEs. They serve as lecturers at various seminars held by the JPO, based on requests from related organizations, and they visit SMEs to provide individual consultations, with the objective of raising awareness on IP systems and support measures, and developing human resources in local areas and SMEs.

Achievements in FY2006:

➢ Wide range of promotion activities and human-resource development through seminars (168 seminars);
v) Free Consultation Sessions;
The JPO offers free individual consultation services by experts (patent attorneys, etc.) on specific matters related to industrial property rights nationwide.

Achievements in FY2006
- Free patent consultation services: 4,474 sessions;
- Patent-training/guidance consultation sessions: 56 sessions;
- Regional brand-training/guidance consultation sessions: 102 sessions.

vi) Support for Regional IP Advisory Counters;
The JPO will provide support to the Regional IP Advisory Counters, which were established in July 2006 at chambers of commerce and industry throughout Japan, such as holding seminars and sending experts (starting from FY2007).

vii) Consultation Service on the Industrial Property Rights Systems of Other Countries;
The Asia-Pacific Industrial Property Center of the Japan Institute of Invention and Innovation (JIII) provides domestic SMEs with a consultation service on industrial property right systems in other countries and IP infringement cases inside and outside Japan.
(Number of consultations conducted in FY2006: 836; conducted by the JIII, commissioned by the JPO).

The JPO holds training sessions, seminars and individual consultations in order to publicize and diffuse information on industrial property right systems in other countries.

II. Support for Exploitation of Intellectual Property Rights Information and the Application Procedures;

i) Industrial Property Digital Library (IPDL);

The IPDL provides access to about 6.1 billion official gazettes of patents, utility models, designs and trademarks via the Internet. These can be searched by various document numbers or by various classifications. It also provides industrial property information including information on the legal status, which allows users to easily check the examination status of specific applications.

Furthermore, the IPDL Help Desk of the INPIT offers information services on how to operate and use the IPDL.

ii) Patent Information Advisors;

In order to help local industry to become active through use of patent information, the INPIT dispatches Patent Information Advisors, who are experts in utilizing patent information, to various locations in response to requests by local governments (54 advisors as of the end of April 2007). The advisors provide mainly to universities and SMEs instruction on how to search for patent information, and they provide consultation services on how to utilize such information, as well as hold workshops in response to various requests related to patent information.
Achievement in FY2006

- Patent Information Advisors visited about 8,000 SMEs including individuals and about 800 universities and research institutions.

iii) Application Advisors;

Application advisors who work full-time in the electronic application consultation offices of JIII branches nationwide offer consultation services on filing procedures, how to use the shared-use PCs, and the electronic application system (undertaken by the JIII commissioned by the JPO). When users do not have the time to go to the electronic application consultation offices, or ask the advisors to provide explanations at regional events, the application advisors provide visit consultations and guidance services (Number of consultations/guidance services provided in FY2006: 112,768).

iv) Installation of Shared-use PCs for Filing Electronic Applications;

The Japan Institute of Invention and Innovation, commissioned by the JPO, has installed shared-use PCs at its branches nationwide in order to allow those who do not have the necessary equipment for filing electronic applications from PCs to file electronic applications. These PCs not only consist of the necessary equipment, but also provide optional document-editing and checking functions and an optional file conversion function to enable efficient operations.

Achievements in FY2006

- Number of visitors: 24,785;
- Number of applications sent on line: 16,260;
- Number of requests for browsing: 5,273.

The JPO selects themes, mainly in eight fields (life science, information and communications, environment, nanotechnology materials, energy, manufacturing technology, social infrastructure, and frontier science), and performs comprehensive analyses with a focus on "technical trends in patent applications." Information regarding the technological issues related to these themes and the future direction of technological development is available on the JPO website.

III. Support Related to Examination Requests for Industrial Property Applications;

i) Support of Prior Art Searches for SMEs;

In order to support proper assessment as to whether an examination should be requested or not and whether applications abroad should be filed or not, private searching organizations commissioned by the JPO perform prior art searches free of charge for patent applications of SMEs and individuals prior to requests for examination, upon request of the applicant, and deliver the search results by mail. (Number of uses in FY2006: 3,088).

ii) Reduction of or Exemption from Examination Request Fees;

The JPO grants an exemption from or a 50% reduction of examination request fees for individuals, companies or R&D oriented SMEs that lack funds if they comply with certain requirements.

IV. Support for Examinations and Appeals/Trials of Industrial Property Applications;

i) Accelerated Examinations/Accelerated Appeal and Trial Examinations;

In cases in which a patent applicant is an SME or an individual, or if the applicant is already employing the invention, examination or
appeal/trial examination is conducted more quickly than in the case of regular applications if the applicant submits an "explanation of circumstances concerning accelerated examination (accelerated trial/appeal examination)."

Although there are accelerated examination and accelerated appeal/trial examination systems for designs and trademarks, the requirements are different from those for patents.

ii) Interview Examinations and Interview Appeal/Trial Examinations, Circuit Examinations and TV Interview Examinations;

The JPO supports more precise acquisition of rights by offering opportunities for applicants or their agents and the examiners or appeal examiners to meet in person and deepen their understanding of the applications and the technologies/designs.

In addition to interview examinations and interview appeal/trial examinations conducted at the JPO, the JPO examiners or appeal examiners also visit various locations nationwide to conduct circuit examinations, regional interview appeal/trial examinations, and circuit appeals/trials. Also, the JPO conducts TV interview examinations using a TV conference system installed at the patent offices of the respective Regional Bureaus of Economy, Trade and Industry.

Achievements in FY2006

- Regional interview appeal/trial examinations: 162;
- Circuit examinations: 30;
- TV interview examinations: 36.

iii) Refund System on Examination Request Fee;
Under this system, if an applicant withdraws or abandons the application prior to the first action after having requested an examination, 50% of the fee is refunded to the applicant. Exceptionally, if an applicant withdraws or abandons the application from August 9, 2006 to August 8, 2007, the full amount of the fee will be refunded.

V. Support for Registration of Intellectual Property Rights;

i) Reduction of or Exemption from the Patent Annual Fees;

The JPO grants an exemption (from the first year to the third year), a grace period of three years, or a 50% reduction of patent annual fees, to individuals, companies or R&D oriented SMEs that lack funds if they comply with certain requirements.

VI. Support for Utilization of Industrial Property Rights;

i) Measures for Encouraging Patent Licensing by the INPIT;

Patent Licensing Advisors;

With the aim of grasping licensable patents owned by universities, public research institutions and companies, understanding the needs of SMEs and venture companies for introducing technology, and matching those needs, the INPIT dispatches Patent Licensing Advisors, who are experts with a wealth of knowledge and experience on intellectual property rights and technology transfers, upon request of prefectural governments and Technology Licensing Organizations (106 advisors as of the end of April 2007).
There are a number of successful patent licensing cases from universities to SMEs and venture companies through the use of consultations and advice on technology transfers by Patent Licensing Advisors.

Starting in 2007, in addition to the above-mentioned activities, the INPIT provides support to local governments to develop human resources and pass down their know-how on patent licensing owned by Patent Licensing Advisors, in order to develop an environment in which patent licensing activities take root in the region and become autonomous.

- **Patent Licensing Database;**

  In order to ensure a smooth transfer of licensable patents within the industrial sector and between local companies and to promote their practical application, the INPIT has built a database of licensable patents owned by universities, public research institutes and companies, which it makes available to the public as the Patent Licensing Database via the Internet. This database is an open system where anyone can register data concerning "license information (including transfers)" and "information on needs (information of licenses sought)."

  The number of "license information" stores in the Patent Licensing Database was about 58,600 as of the end of April 2007. Of these, about 24,000 stores represented licensable patents of universities and public research institutions.

  The Patent Licensing Database has an SDI system that allows for automated retrieval using the saved retrieval style, with the results e-mailed to the user every time the Patent Licensing Database is updated.

  The Patent Licensing Database also provides a virtual DB function that allows the websites of companies and universities to
display their licensable patents that have been stored in the Patent Licensing Database, thus promoting transfer of technologies developed through university research.

- **Examples of Licensable Patent Utilization;**
  The INPIT has selected patents with high potential for commercialization among the licensable patents registered in the Patent Licensing Database, and has created the Examples of Licensable Patent Utilization, which highlights such patents along with potential product images as possibilities for business sector application. In addition to its distribution in brochure form, this example is also available on the INPIT website.

- **Patent Business Market;**
  The INPIT holds fairs in which companies that own technological seeds, such as patented technology, present the details of their technological developments and business plans, and seek various forms of cooperation from participants, such as the conclusion of licensing agreements, the conducting of joint research, and the offering of financial assistance. The INPIT also provide support and cooperation for Patent Business Markets planned and held by local governments.

Achievement in FY2006
- The first Patent Business Market (Tokyo) held on September 20, 2006; 174 participants;
- The second Patent Business Market (Osaka) held on December 6, 2006; 140 participants; and
- The third Patent Business Market (Tokyo) held on January 23, 2007; 178 participants.
Training Seminars for Fostering Patent Licensing Experts;

The INPIT provides Training Seminars for Fostering Patent Licensing Experts (introductory and advanced levels) as part of its awareness with a view to increasing the number of patent-licensing market participants.

Achievement in FY2006

- Introductory level:
  10 sessions [Tokyo (3 times), Osaka, Nagoya, Kumamoto, Tokushima, Matsue, Sapporo, Morioka]; 762 participants
- Advanced level:
  3 sessions [Tokyo (2 times), Osaka]; 328 participants

Projects for Supporting the Intellectual Property Strategies of Regional SMEs;

Project for Supporting the Formulation of Intellectual Property Strategies;

The SME support centers of prefectural governments intensively dispatch intellectual property experts for certain periods to local SMEs and venture companies in coordination with the prefectural intellectual property centers in order to support the companies in their formulation of business plans for utilizing intellectual property and their creation of intellectual property strategies.

Project on Model Utilization of Intellectual Property Rights;

The Organization for Small & Medium Enterprises and Regional Innovation, JAPAN (SMRJ)\textsuperscript{97} has contributed to the emergence of successful model cases in which SMEs have used the support of local

\textsuperscript{97} www.smrj.go.jp/utility/english/index.html
intellectual property experts and commercialized technology through strategic utilization of intellectual property. The SMRJ has released a "Manual on Intellectual Property Strategies of SMEs and Venture Companies 2006" which is a report based on such achievements, and held Symposia on Intellectual Property Strategies of SMEs as part of its efforts to provide information on the achievements of the project and to spread and raise public awareness of the project (from FY2004 to FY2006).

iii) Distribution of a Compendium of Examples of Patent Utilization;

The JPO compiled a booklet "Companies Actively Utilizing IP 2007," which covers nationwide SMEs that actively utilize IP rights in their business strategy and strive for strategic IP-right acquisition and utilization, in order to motivate reforms to IP-focused management and provide reference for SMEs wishing to implement strategic IP right utilization. Copies of this are widely distributed through the Patent Offices of Regional Bureaus of Economy, Trade and Industry.

B. Regional Support Frameworks;

In order to develop an environment that allows for IP promotion activities and strategic IP utilization in local areas, the JPO established a "Regional Headquarters for Intellectual Property Strategy" in each region (nine regions) under the jurisdiction of Regional Bureaus of Economy, Trade and Industry in FY2005. Based on the regional intellectual property strategy-promotion program developed by the Regional Headquarters for Intellectual Property Strategy, the JPO intensively implements measures such as raising SMEs' awareness on IP and promotion of appropriate use of IP, while strengthening the
network with local support organizations and networking intellectual property-related human resources.

[Major activities]

The JPO, by placing Patent Offices of Regional Bureaus of Economy, Trade and Industry at its center, conducted the following projects including consultation services.

- Periodical reviews and follow-up work on the regional intellectual property strategy promotion program;
- Holding of symposia and seminars (themes set according to regional needs and contents decided according their IP level);
- Establishment and maintenance of the website for information provision.

At the same time, a Patent Office has been established in each Regional Bureau of Economy, Trade and Industry in order to provide support that meets local needs, such as offering information on and promoting utilization of industrial property rights in the region. These offices, along with the regional reference rooms of the INPIT and Intellectual Property Centers of prefectural government, constitute a comprehensive support framework. The JPO aims to establish an effective support framework for SMEs in close coordination with the aforementioned Regional Headquarters for Intellectual Property Strategy.
Small and Medium Enterprise Agency;

The Small and Medium Enterprise Agency under the Ministry of Economy, Trade and Industry is responsible for implementing the different policies regarding SMEs in Japan. The flow chart of the implementation system of policies for SMEs in Japan by the Small and Medium Enterprise Agency is elaborated as under:

Flow Chart of Implementation System of Policies for SMEs in Japan


98 www.chusho.meti.go.jp/sme_english/outline/05/01.html
3.3 Comparison of the Fees of National Registration of a Trade Mark in Pakistan with the Fees of International

Source: Website of Small and Medium Enterprise Agency

Tokyo, September 2008
Registration of a Trade Mark via Madrid Protocol;

The comparison of fees of the local registration with that of the international registration via Madrid Protocol is a very important aspect that the developing countries should take into consideration before acceding to the Madrid Protocol. Most of the developing nations are based on small and medium enterprises and it is very important to note whether the SMEs can afford to pay the fees for the international registration or not. Secondly, if a country party to the Madrid Protocol has decided to take an individual fee instead of having a share from the supplementary and complementary fees from the international Bureau of WIPO then again the issue of total fees for a local registration comes under discussion because a country can not fix the individual fee greater than the fee required for a ten year registration or for a ten year renewal of that registration in that country\textsuperscript{99}.

3.3.1 Fee for Registration of a Mark in Pakistan;

In Pakistan, Marks are administered under the Trade Marks Ordinance, 2001 and Trade Marks Rules, 2004 that are TRIPS compliant. The details about the fees for different actions are given in The First Schedule of the Trade Marks Rules, 2004\textsuperscript{100}. The following fees are required to register one mark in one class in Pakistan:

<table>
<thead>
<tr>
<th>S. No.</th>
<th>Description</th>
<th>Amount (PKR)</th>
<th>Amount (Sfr)</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>For search of mark in respect of each class (Optional).</td>
<td>500</td>
<td>7.6</td>
</tr>
<tr>
<td>2.</td>
<td>For filing an application to register a mark for a specification of goods or services included in one class.</td>
<td>1000</td>
<td>15.2</td>
</tr>
<tr>
<td>3.</td>
<td>For filing a notice of opposition, for each application opposed.</td>
<td>3000</td>
<td>45.5</td>
</tr>
<tr>
<td>4.</td>
<td>For filing a counterstatement to a notice of opposition, for each application</td>
<td>500</td>
<td>7.6</td>
</tr>
</tbody>
</table>

\textsuperscript{99} Article 8 (7) (a) of the Madrid Protocol
\textsuperscript{100} www.ipo.gov.pk/Trademark/Downloads/TM-rules%202004.pdf
5. For filing a notice of intention to attend hearing by each party to the proceeding concerned.

<p>| | |</p>
<table>
<thead>
<tr>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>5.</td>
<td>200</td>
</tr>
<tr>
<td>6.</td>
<td>3000</td>
</tr>
<tr>
<td>7.</td>
<td>5000</td>
</tr>
</tbody>
</table>

In Pakistan, a mark is first published after examination in the Trade Marks Journal for inviting oppositions then the mark is registered unlike Japan where the mark is first registered after examination and then published for inviting oppositions against the registered mark. Therefore, the fees mentioned at serial numbers 1, 2, 6 & 7 are fixed but the fees mentioned at serial numbers 3, 4 & 5 are not fixed because an application for the registration of a mark may or may not receive oppositions and one can not determine the number of oppositions that an application may receive during the course of registration of a mark. However, in an ideal condition where no opposition is received against the registration of a mark, the total amount that is required for the registration of a mark in one class in Pakistan is around PKR 5,000 (76 Swiss Francs) [1CHF = 66PKR]. But if an application receives oppositions then the registration fee of a mark will increase depending on the number of oppositions filed against the registration of a mark.

3.3.2 Fee for Registration of a Mark by Madrid Protocol;

The fee for the registration of a mark by Madrid Protocol is collected by the International Bureau of WIPO prescribed as under:\footnote{Article 8 (2) of the Madrid Protocol}

I. A basic fee of 653 Swiss francs for filing the international
application or 903 Swiss francs where the mark is in colour;

II. A supplementary fee of 73 Swiss francs for each class of the International Classification that is the Nice Classification of goods and services beyond three classes; and

III. A complementary fee of 73 Swiss francs for the designation of each designated Contracting Party.

There is a concession in the basic fee for the applicant for international registration whose Office of Origin belongs to a Least Developed Country in accordance with the list established by the United Nations. The basic fee is reduced to 10% of the prescribed amount. In such case the basic fee is reduced to 65 Swiss francs for filing the international application or to 90 Swiss francs where the mark is in color\textsuperscript{102}.

At the end of each year, the annual product of the various receipts from International Registration shall be divided equally among the Contracting Parties by the International Bureau after deduction of the expenses and charges necessitated by the implementation of the Madrid Protocol\textsuperscript{103}. The International Bureau of WIPO will also divide the supplementary and complementary fees among the Contracting Parties in proportion to the number of marks for which the protection has been applied for in each Contracting Party during the year\textsuperscript{104}.

However, any Contracting Party has the right to receive an “Individual Fee” instead of a share in the revenue generated by the supplementary and complementary fees whose amount shall be indicated in the declaration and can be changed in further

\textsuperscript{103} Article 8 (4) of the Madrid Protocol
\textsuperscript{104} Article 8 (5) and Article 8 (6) of the Madrid Protocol
declarations\textsuperscript{105}. It should be noted here that the individual fee fixed by the contracting party may not be higher than the equivalent amount which the assumed Contracting Party will receive from an applicant for a ten year registration or from the holder of a registration for a ten year renewal of that registration\textsuperscript{106}.

3.4 Distribution of Questionnaire to the Japanese Companies particularly Small and Medium Enterprises and Interviews of Trademark Attorneys practicing Madrid Protocol in Japan;

In order to understand the strategy of Japanese Companies particularly small and medium enterprises to extract maximum benefit from the Madrid Protocol, a questionnaire is forwarded to the Japanese Companies and Interviews are conducted with the Trademark Attorneys of well reputed Patent Offices who are practicing the applications filed through Madrid Protocol in Japan.

3.4.1 Questionnaire to Japanese Companies;

A questionnaire is prepared (Annex-IV) for the Japanese Companies particularly small and medium enterprises and distributed in around one hundred companies of Japan. Out of 100, replies of 23 Japanese Companies are received. The name of the companies replied to the questionnaire along with their industrial field, number of employees and annual sales (Billion Yen) are mentioned below:

\textsuperscript{105} \url{www.wipo.int/export/sites/www/madrid/en/fees/pdf/individ.pdf}

\textsuperscript{106} Article 8 (7) (a) of the Madrid Protocol
## Details of the Japanese Companies Replied to the Questionnaire

<table>
<thead>
<tr>
<th>S. No.</th>
<th>Name of the Company</th>
<th>Industrial Field</th>
<th>Number of Employees</th>
<th>Annual Sales (Billion Yen)</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>“A”</td>
<td>Electric Equipment.</td>
<td>21</td>
<td>0.09</td>
</tr>
<tr>
<td>2.</td>
<td>“B”</td>
<td>Medical Research and Development.</td>
<td>400</td>
<td>Nil</td>
</tr>
<tr>
<td>3.</td>
<td>“C”</td>
<td>Broadcast use System Equipment.</td>
<td>1024</td>
<td>38.484</td>
</tr>
<tr>
<td>4.</td>
<td>“D”</td>
<td>Synthetic Resin.</td>
<td>400</td>
<td>16.1</td>
</tr>
<tr>
<td>5.</td>
<td>“E”</td>
<td>Electric Equipment.</td>
<td>175</td>
<td>6.072</td>
</tr>
<tr>
<td>7.</td>
<td>“G”</td>
<td>Air Cleaner, Ion Generator.</td>
<td>15</td>
<td>0.3</td>
</tr>
<tr>
<td>8.</td>
<td>“H”</td>
<td>Electrical Product.</td>
<td>280</td>
<td>13</td>
</tr>
<tr>
<td>9.</td>
<td>“I”</td>
<td>Interior Goods.</td>
<td>145</td>
<td>5.9</td>
</tr>
<tr>
<td>11.</td>
<td>“K”</td>
<td>Manufacturing Kitchen Instruments.</td>
<td>1400</td>
<td>38.2</td>
</tr>
<tr>
<td>12.</td>
<td>“L”</td>
<td>Heat Sinks, Heat Absorbers.</td>
<td>8</td>
<td>0.4</td>
</tr>
<tr>
<td>13.</td>
<td>“M”</td>
<td>Manufacturing Measuring Equipment.</td>
<td>1073</td>
<td>42.3</td>
</tr>
<tr>
<td>14.</td>
<td>“N”</td>
<td>Industrial Ceramics.</td>
<td>1794</td>
<td>117.4</td>
</tr>
<tr>
<td>15.</td>
<td>“O”</td>
<td>Measurement Product and Consulting.</td>
<td>324</td>
<td>5.25</td>
</tr>
<tr>
<td>16.</td>
<td>“P”</td>
<td>Manufacturing Mechanical Parts.</td>
<td>230</td>
<td>8</td>
</tr>
<tr>
<td>17.</td>
<td>“Q”</td>
<td>Construction Materials.</td>
<td>627</td>
<td>18.2</td>
</tr>
<tr>
<td>18.</td>
<td>“R”</td>
<td>Powder Processing Machine.</td>
<td>150</td>
<td>3.5</td>
</tr>
<tr>
<td>19.</td>
<td>“S”</td>
<td>Electric Parts.</td>
<td>220</td>
<td>8</td>
</tr>
<tr>
<td>21.</td>
<td>“U”</td>
<td>Special Paint.</td>
<td>550</td>
<td>35</td>
</tr>
<tr>
<td>22.</td>
<td>“V”</td>
<td>Surface Processing Chemicals.</td>
<td>876</td>
<td>47.7</td>
</tr>
<tr>
<td>23.</td>
<td>“W”</td>
<td>High Performance Polyurethane.</td>
<td>550</td>
<td>120</td>
</tr>
</tbody>
</table>

The relationship between the company with their number of employees and annual sales can be depicted from the following two graphical representations:
The replies of the aforesaid Japanese Companies to the questionnaire are tabulated as under:

<table>
<thead>
<tr>
<th>Q. No.</th>
<th>QUESTIONS</th>
<th>YES</th>
<th>NO</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>What do you think that intellectual property rights are beneficial for your company?</td>
<td>23</td>
<td>0</td>
</tr>
<tr>
<td>2.</td>
<td>If the answer to the above question is YES then how many intellectual property rights are owned by your company?</td>
<td>01</td>
<td>01</td>
</tr>
<tr>
<td>3.</td>
<td>What do you think which is the most important intellectual property right for a small and medium enterprise to grow? You can select more than one option.</td>
<td>Patents</td>
<td>UMs</td>
</tr>
<tr>
<td></td>
<td></td>
<td>23</td>
<td>03</td>
</tr>
<tr>
<td></td>
<td></td>
<td>IDs</td>
<td>GIs</td>
</tr>
<tr>
<td></td>
<td></td>
<td>05</td>
<td>0</td>
</tr>
<tr>
<td>4.</td>
<td>Is your company has its own website?</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td></td>
<td></td>
<td>21</td>
<td>02</td>
</tr>
<tr>
<td>5.</td>
<td>If the answer to the above question is YES then whether the company has given its IP Profile (the number of IP rights that is owned by the company) on the website or not?</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td></td>
<td></td>
<td>04</td>
<td>19</td>
</tr>
</tbody>
</table>

**Questions of Trade Mark Portfolio**

<table>
<thead>
<tr>
<th>Q. No.</th>
<th>QUESTIONS</th>
<th>YES</th>
<th>NO</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>What do you think whether Trademarks are playing a key role in growing the business of your company or not?</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td></td>
<td></td>
<td>21</td>
<td>02</td>
</tr>
<tr>
<td>2.</td>
<td>What are the numbers of Trademarks that are owned by your company?</td>
<td>&lt; 5</td>
<td>&lt; 10</td>
</tr>
<tr>
<td></td>
<td></td>
<td>05</td>
<td>0</td>
</tr>
<tr>
<td>3.</td>
<td>What do you think that the number of Trademarks that are owned by your company will increase in future?</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td></td>
<td></td>
<td>19</td>
<td>04</td>
</tr>
<tr>
<td>4.</td>
<td>Is your company registering its Trademarks in the foreign countries?</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td></td>
<td></td>
<td>18</td>
<td>05</td>
</tr>
<tr>
<td>5.</td>
<td>If the answer to the above question is YES then what are the number of Trademarks that are registered abroad by your company?</td>
<td>&lt; 5</td>
<td>&lt; 10</td>
</tr>
<tr>
<td></td>
<td></td>
<td>05</td>
<td>01</td>
</tr>
<tr>
<td>Question</td>
<td>Options</td>
<td>Before Accession to Madrid Protocol</td>
<td>After Accession to Madrid Protocol</td>
</tr>
<tr>
<td>----------</td>
<td>---------</td>
<td>------------------------------------</td>
<td>-----------------------------------</td>
</tr>
<tr>
<td>6.</td>
<td>&lt;5</td>
<td>&lt;10</td>
<td>&lt;15</td>
</tr>
<tr>
<td></td>
<td>08</td>
<td>02</td>
<td>02</td>
</tr>
<tr>
<td>7.</td>
<td>Paris Convention</td>
<td>Madrid Protocol</td>
<td>Both</td>
</tr>
<tr>
<td></td>
<td>09</td>
<td>07</td>
<td>03</td>
</tr>
<tr>
<td></td>
<td>11</td>
<td>01</td>
<td>01</td>
</tr>
<tr>
<td></td>
<td>After Accession to Madrid Protocol</td>
<td>&lt;5</td>
<td>&lt;10</td>
</tr>
<tr>
<td></td>
<td>12</td>
<td>02</td>
<td>01</td>
</tr>
<tr>
<td></td>
<td>08</td>
<td>02</td>
<td>02</td>
</tr>
<tr>
<td></td>
<td>After Accession to Madrid Protocol</td>
<td>&lt;5</td>
<td>&lt;10</td>
</tr>
<tr>
<td></td>
<td>12</td>
<td>00</td>
<td>02</td>
</tr>
<tr>
<td>10.</td>
<td>Paris Convention</td>
<td>Trade Mark Agent</td>
<td>Company Itself</td>
</tr>
<tr>
<td></td>
<td>17</td>
<td>00</td>
<td>00</td>
</tr>
<tr>
<td></td>
<td>Madrid Protocol</td>
<td>Trade Mark Agent</td>
<td>Company Itself</td>
</tr>
<tr>
<td></td>
<td>11</td>
<td>00</td>
<td>00</td>
</tr>
<tr>
<td><strong>Questions of IP Department</strong></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>1.</td>
<td>What do you think whether it is in the benefit of a Company especially a small and medium enterprise to establish an IP Department?</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td></td>
<td>22</td>
<td>01</td>
<td></td>
</tr>
<tr>
<td>2.</td>
<td>Is there an IP Department in your company?</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td></td>
<td>16</td>
<td>07</td>
<td></td>
</tr>
<tr>
<td>3.</td>
<td>If the answer to the above question is YES then what is the number of employees of the IP Department?</td>
<td>&lt;5</td>
<td>&lt;10</td>
</tr>
<tr>
<td></td>
<td>13</td>
<td>03</td>
<td>01</td>
</tr>
<tr>
<td>4.</td>
<td>What is the role of the IP Department in your company?</td>
<td>Acquisition, management and maintenance of intellectual property rights, handling of licensing agreements</td>
<td></td>
</tr>
<tr>
<td>Questions of International Treaties</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>------------------------------------</td>
<td>---</td>
<td>---</td>
<td>---</td>
</tr>
<tr>
<td>1. Do you have some knowledge about the international treaties to which Japan is a signatory state?</td>
<td>YES</td>
<td>NO</td>
<td>19</td>
</tr>
<tr>
<td>2. If the answer to the above question is YES then whether these international treaties are helpful for your company or not?</td>
<td>YES</td>
<td>NO</td>
<td>No Reply</td>
</tr>
<tr>
<td>3. What do you think whether it is in the benefit of the industries to use the international treaties like Madrid Protocol, Patent Cooperation Treaty etc.?</td>
<td>YES</td>
<td>NO</td>
<td>20</td>
</tr>
<tr>
<td>4. If the answer to the above question is YES then is your company used any of the international treaty for registering its IP right?</td>
<td>YES</td>
<td>NO</td>
<td>No Reply</td>
</tr>
<tr>
<td>5. If the answer to the above question is YES then may I know the names of the international treaties that your company used to register its IP rights?</td>
<td>París Convention; Patent Cooperation Treaty; and Madrid Protocol.</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Questions of Madrid Protocol</th>
<th></th>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>1. Do you know that what is Madrid Protocol for the International Registration of Marks?</td>
<td>YES</td>
<td>NO</td>
<td>No Reply</td>
</tr>
<tr>
<td>2. Is your company used Madrid Protocol for the international registration of its marks?</td>
<td>YES</td>
<td>NO</td>
<td>No Reply</td>
</tr>
<tr>
<td>3. What do you think that Madrid Protocol is beneficial for your company?</td>
<td>YES</td>
<td>NO</td>
<td>No Reply</td>
</tr>
<tr>
<td>4. If the answer to the above question is YES then what are the benefits that your company have by using the Madrid Protocol?</td>
<td>Simple procedure, cost effective and provision of subsequent designation.</td>
<td></td>
<td></td>
</tr>
<tr>
<td>5. Is the Government of Japan received your company views before acceding to the Madrid Protocol?</td>
<td>YES</td>
<td>NO</td>
<td>No Reply</td>
</tr>
<tr>
<td>6. Did your company receive any kind of capacity building and awareness programs from the Government of Japan before or after acceding to the Madrid Protocol?</td>
<td>YES</td>
<td>NO</td>
<td>No Reply</td>
</tr>
</tbody>
</table>
### 7. Is your company ever used the route of Madrid Protocol for registering its marks to the countries that are party to the Madrid protocol?

<table>
<thead>
<tr>
<th>YES</th>
<th>NO</th>
<th>No Reply</th>
</tr>
</thead>
<tbody>
<tr>
<td>09</td>
<td>12</td>
<td>02</td>
</tr>
</tbody>
</table>

Understanding of the system, explanation of designated goods/services, submission of “record of use” and international application is based on domestic application/registration.

### 8. If the answer to the above question is YES then what are the difficulties that are faced by your company in using the Madrid Protocol?

- Understanding of the system, explanation of designated goods/services, submission of “record of use” and international application is based on domestic application/registration.

### 9. Is the fee structure including the fees of the Attorney, the Office of Origin, the International Bureau of WIPO and the designated Contracting Party (if any Individual Fee is fixed by the designated Contracting Party) for the international registration of a Mark via Madrid Protocol is acceptable to your company?

<table>
<thead>
<tr>
<th>YES</th>
<th>NO</th>
<th>No Reply</th>
</tr>
</thead>
<tbody>
<tr>
<td>13</td>
<td>06</td>
<td>04</td>
</tr>
</tbody>
</table>

### 10. Is the conventional way of registering the Marks internationally by Paris Convention is better than the Madrid Protocol?

<table>
<thead>
<tr>
<th>YES</th>
<th>NO</th>
<th>No Reply</th>
</tr>
</thead>
<tbody>
<tr>
<td>03</td>
<td>14</td>
<td>06</td>
</tr>
</tbody>
</table>

Paris Convention is simpler for small number of applications and it has more proven records.

### 11. If the answer to the above question is YES then why the Paris Convention route is better than the Madrid Protocol?

- Paris Convention is simpler for small number of applications and it has more proven records.

### 12. Do you have some know how about the provision of “Central Attack” in the Madrid Protocol?

<table>
<thead>
<tr>
<th>YES</th>
<th>NO</th>
<th>No Reply</th>
</tr>
</thead>
<tbody>
<tr>
<td>04</td>
<td>18</td>
<td>01</td>
</tr>
</tbody>
</table>

### 13. If the answer to the above question is YES then what do you think whether the provision of “Central Attack” is acceptable to your company or not?

<table>
<thead>
<tr>
<th>YES</th>
<th>NO</th>
<th>No Reply</th>
</tr>
</thead>
<tbody>
<tr>
<td>03</td>
<td>01</td>
<td>18</td>
</tr>
</tbody>
</table>

Due to a negative impression of making loss.

### 14. If the answer to the above question is NO then why this provision of “Central Attack” is not acceptable to your company?

**3.4.2 Interview of Trade Mark Attorneys;**

The Interview questions are prepared (Annex-V) and interview.
of the following two Trade Mark Attorneys are conducted in order to
listen their point of view about the international registration of Marks
through Madrid Protocol:

1. Ms. Takako Okada, Trade Mark Attorney, Miyoshi International
   Patent Office; and
2. Mr. Hirohisa Suzuki, Trade Mark Attorney, SHIGA International
   Patent Office.

3.4.2.1 Interview with Ms. Takako Okada;

The replies of Ms. Takako Okada on the questions asked in the
interview are elaborated as under:

<table>
<thead>
<tr>
<th>Q. No.</th>
<th>Question Asked</th>
<th>Reply Given</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Why Madrid Protocol is introduced in the presence of an already existed system of Madrid Agreement for the international registration of marks?</td>
<td>The Madrid Protocol is introduced in the presence of an already existed system of Madrid Agreement because the Protocol has more flexible provisions and it is more advantageous as compared to that of the Agreement.</td>
</tr>
<tr>
<td>2.</td>
<td>Why Contracting Organizations are made eligible to file an international application under the Madrid Protocol along with the Contracting States?</td>
<td>The Contracting Organizations are made eligible to file an international application under Madrid Protocol along with the Contracting States for increasing the number of users and to widen the scope of the Madrid Protocol.</td>
</tr>
<tr>
<td>3.</td>
<td>What are the disadvantages of the Madrid Protocol in the context of the interests of the developing countries?</td>
<td>In the view of the Trademark Attorney, the provision of Central Attack in the Madrid Protocol may be of great concern for the developing countries.</td>
</tr>
<tr>
<td>4.</td>
<td>Why MM18 and MM17 form must be submitted along with the MM2 form, if the applicant designates United States and the European Community respectively?</td>
<td>MM18 and MM17 form are submitted along with MM2 form in case of United States and the European Community because it may be the requirement of their national legislation.</td>
</tr>
<tr>
<td>5.</td>
<td>Why the applicant is under obligation to submit the aforesaid forms for the United States and the European Community as compared to Yes, this practice is against the harmonization of the system.</td>
<td></td>
</tr>
</tbody>
</table>
other Contracting Parties of the Madrid Protocol? Is it will not effect the harmonization of the system and against the global trend of the world?

6. If the applicant designate a Contracting Party that has its own Individual Fee then whether he also have to pay the supplementary and complementary fees to the International Bureau of WIPO or not?

The Attorney is of the opinion that no supplementary fee/complementary fee are payable when the applicant designates a contracting party which requires Individual fees as explained in Articles 8(7)(a)(i) and 8(7)(a)(ii) of the Madrid Protocol.

7. Where the applicant should submit the Individual Fee whether to the National Trade Marks Office of the designated Contracting Party or to the International Bureau of WIPO?

The applicant will submit the Individual Fee directly to the International Bureau of WIPO and will attach a sheet containing JPO official fee stamps, in case where Japan is the Office of Origin, but it is not necessary to attach a copy of the payment receipt of the fees paid directly to the International Bureau of WIPO by the applicant.

8. Where the applicant should submit the Supplementary and Complementary Fees whether to the Office of Origin or to the International Bureau of WIPO?

The applicant will submit the Supplementary and Complementary Fees directly to the International Bureau of WIPO and will attach a sheet containing JPO official fee stamps, in case where Japan is the Office of Origin, but it is not necessary to attach a copy of the payment receipt of the fees paid directly to the International Bureau of WIPO by the applicant.

9. What is the criterion for division of supplementary and complementary fees among the designated Contracting Parties?

This question may better be asked to the International Bureau of WIPO.

10. Is WIPO also divides the amount of Basic Fee that it receives from the applicant among the designated Contracting Parties?

This question may better be asked to the International Bureau of WIPO.

11. Is WIPO deducts some amount from the Individual Fee of a designated Contracting Party?

This question may better be asked to the International Bureau of WIPO.

12. What is the criterion for a Contracting Party to fix its own Individual Fee?

The Individual Fee fixed by a Contracting Party may not be higher than the fee which the office of the Contracting Party would receive for registering a Mark for a period of ten years or for the renewal of
### 13. What is your opinion whether a Contracting Party of the Madrid Protocol should fix its own Individual Fee or receive a share from the Supplementary and Complementary Fees from WIPO on annual basis?

In view of the Attorney, if the local fee for national trademark filing (in other words, Paris Convention Route) is too expensive than the fees required for the international registration of a Mark via Madrid Protocol than such kind of discrepancy can be remedied by fixing its own Individual Fee. In addition to the viewpoint of the Attorney, the interviewer is of the view that a Contracting Party may fix its own Individual Fee or may receive a share from WIPO but it all depends on the difference of the Individual Fee and that of the share that a Contracting Party will receive from WIPO on annual basis. If the amount of Individual Fee per application is greater than the amount of the share that the Contracting Party will receive from WIPO then the Contracting Party must fix its own Individual Fee and vice versa.

### 14. If the Office of Origin is using French language and the applicant designate a Contracting Party that is using English language then what will be the scenario in this type of situation?

In this case, the International Bureau of WIPO will first translate the application from French to English and then forward the application to the designated Contracting Party where the working language is English as mentioned in Rule 6 (4) of the Common Regulations under the Madrid Protocol.

### 15. Why the International Registration is dependent on the basic application or registration for the first 5 years?

The pre-requisite for the accession of the Madrid Protocol is that the country must be a signatory of the Paris Convention. In view of the Attorney, the dependence of international registration on the basic application or registration for the first 5 years is due to the Article 6quinquies of the Paris Convention. According to this Article “Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.”
16. What kind of enquiries you receive from the applicant regarding the Madrid Protocol?

The applicant mostly asks about the fees of the Madrid Protocol for the international registration, the registration time for the international registration of a Mark in the designated Contracting Parties and the procedures of registration in the designated Contracting Parties. The fees for the international registration can be easily calculated by using the Fee Calculator available on the website of WIPO. The registration time for the international registration in the designated Contracting Parties may be 12 or 18 months or more than 18 months, if the designated Contracting Party receives oppositions. The applicants are interested in knowing the procedures of registration in the designated Contracting Parties in order to file the application according to the national requirements of the designated Contracting Party and to know the implications that the applicant may face in the future.

17. What are the practices and processes of Trade Mark Attorneys to handle the international application via Madrid Protocol?

The application form is first filled by the Attorney on behalf of the information provided by the applicant. The applicant reviews the filled application form for checking of errors, if any. The fees is then deposited to the International Bureau of WIPO and to the Office of Origin, if the Office of Origin has fixed some amount of fee for filing of international application to WIPO, by the Attorney. The application form along with the receipt of JPO official fee stamps, in case where Japan is the Office of Origin, is submitted to the Office of Origin for formality examination and if there is no amendment is required in the application after the formal check, the application is forwarded to the International Bureau of WIPO by the Office of Origin otherwise the Office of Origin will inform the Attorney to amend the application and the Attorney after amending the application will again submit the application to the Office of Origin for onward transmission to WIPO. The International Bureau of WIPO again
do the formal examination before international registration of the Mark and if there is any discrepancy in the application, WIPO will inform the Office of Origin and the Office of Origin will inform the Attorney of the applicant to correct that discrepancy. After correction of the discrepancy, the Attorney again submit the application to the Office of Origin that in turns forward the corrected application to the International Bureau of WIPO for international registration of the Mark. The IB of WIPO registers the mark and forwards the request for extension of protection of the registered Mark to the designated Contracting Parties. At the same time, the IB of WIPO issues a Registration Certificate of international registration to the applicant. Afterwards, when WIPO forwards the request for extension of protection of the Mark to the designated Contracting Parties, they will examine the application according to their own national legislation and will inform WIPO about the registration or refusal of the application within 12 or 18 months or more than 18 months in case of an opposition. The WIPO then intimates the applicant or the Attorney of the applicant about the status of his application and afterwards there is no role of the Office of Origin is involved in the registration of the Mark in the designated Contracting Party.

<p>| 18. | What are the difficulties that are faced by the Attorneys to manage the Madrid Protocol applications? | According to the Attorney, the List of Goods and Services is a difficult task because every Contracting Party has its own interpretations of Goods and Services and in most of the cases, the provisional refusal is based on the list of goods and services that is mentioned in the International Registration. One thing should be kept in mind that once the Mark is registered in the International Register of WIPO, the list of goods and services that are mentioned on the International Registration Certificate will not change. In case where the |</p>
<table>
<thead>
<tr>
<th>19. What is the impact of Madrid Protocol on the attorneys that are practicing the Trade Marks Law?</th>
<th>The impact of the Madrid Protocol on the attorneys in Japan is the reduction of their business and in turn reduction in the revenues of the Patent Firms because previously the foreign applicant file the application in Japan through the Trademark Attorneys but after accession to the Madrid Protocol by Japan, the role of Trademark Attorneys is reduced and the international applications are directly filed to the Japan Patent Office by the International Bureau of WIPO. Anyhow, the Trademark Attorneys of Japan are still involved in filing of application for international registration in the Japan Patent Office and if an applicant who designated Japan and the Japan Patent Office issued a Provisional Refusal to the applicant then again the role of Trademark Attorneys comes in the picture.</th>
</tr>
</thead>
<tbody>
<tr>
<td>20. What is the impact of Madrid Protocol on the Industries of a country party to the Madrid Protocol?</td>
<td>According to the Attorney, most of the beneficiaries of the Madrid Protocol are the Industries of Japan because this system provides the industries an easy way to register and protect their Marks around the globe in an effective and efficient manner.</td>
</tr>
<tr>
<td>21. Are the Industries especially small and medium enterprises of developing countries will benefit from the Madrid Protocol? If yes then how?</td>
<td>Yes, because in the Madrid Protocol the filing cost is low and the procedures are much simple as compared to the conventional route of Paris Convention for the Protection of Industrial Property.</td>
</tr>
<tr>
<td>22. What are the implications that the Office of Origin will face after acceding to the Madrid Protocol?</td>
<td>This question may better be asked to the Japan Patent Office.</td>
</tr>
<tr>
<td>23. What is your opinion about the Madrid Protocol? A country should accede to it or not? If yes then why?</td>
<td>In the opinion of the Attorney, a country should accede to the Madrid Protocol in order to facilitate its industry especially the small and medium enterprises to expand their businesses around the world by the protection of their Marks in a more designated Contracting Party is of the view that the list of goods and services must be changed in order to register the Mark in that Contracting Party then the effect of this change in the list will only applicable to that particular designated Contracting party.</td>
</tr>
</tbody>
</table>
24. In Japan, people are still using the Paris Convention route more as compared to the Madrid Protocol as is indicated in the Annual Report, 2007 of the Japan Patent Office. Why?

This is mainly because of the provision of Central Attack in the Madrid Protocol in which the international registration is based on the basic application or basic registration for the first 5 years. The Japanese clients are very much concerned about the stability of their rights and the provision of Central Attack is not consistent with the demand of the Japanese clients.

25. Any other information that you want to share on the basis of your experience in practicing the Madrid Protocol in Japan?

There is no other information to share because we already have discussed many points in detail.

### 3.4.2.2 Interview with Mr. Hirohisa Suzuki;

The replies of Mr. Hirohisa Suzuki on the questions asked in the interview are elaborated as under:

<table>
<thead>
<tr>
<th>Q. No.</th>
<th>Question Asked</th>
<th>Reply Given</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Why Madrid Protocol is introduced in the presence of an already existed system of Madrid Agreement for the international registration of marks?</td>
<td>Madrid Protocol is introduced in the presence of an already existed system of Madrid Agreement in order to simplify the procedures and to reduce the cost and time for the international registration of Marks.</td>
</tr>
<tr>
<td>2.</td>
<td>Why Contracting Organizations are made eligible to file an international application under the Madrid Protocol along with the Contracting States?</td>
<td>The Contracting Organizations are made eligible to use Madrid Protocol in order to increase convenience. The most important example of the Contracting Organization is the Office for Harmonization in the Internal Market (OHIM) based in Spain that regulates the Community Trademark and Design system for the countries of the European Community. Therefore, if an applicant designates European Community in the international application then it means that he has designated all the 27 countries of the European Union. In other words, we can say that a kind of Madrid Protocol system exists within the Madrid Protocol.</td>
</tr>
<tr>
<td>3.</td>
<td>What are the disadvantages of the Madrid Protocol in the context of the interests of the In view of the Attorney, the major disadvantage of Madrid Protocol is that the burden of the Patent Office will</td>
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<td></td>
</tr>
<tr>
<td><strong>4. Why MM18 and MM17 form must be submitted along with the MM2 form, if the applicant designates United States and the European Community respectively?</strong></td>
<td><strong>MM18 form is submitted along with MM2 form when the applicant designates United States because it is necessary to declare the intention to use the mark under the US practice and MM17 form is submitted along with MM2 form, if the applicant has any claim of seniority in the countries of the European Union. Seniority is a mechanism which allows a trade mark owner to consolidate his existing national trade mark registrations in Member States under the umbrella of a CTM registration. Seniority can be claimed for a CTM application (Article 34 CTMR) or for a CTM registration (Article 35 CTMR). The effect of seniority is that if and when the existing national registrations are abandoned, the rights of the proprietor are deemed to continue in the Member States concerned through proper maintenance of the CTM [Article 34(2) and 35 (2) CTMR]. The advantage of seniority to the trade mark owner is, therefore, a significant saving in renewal fees and other administrative costs.</strong></td>
<td></td>
</tr>
<tr>
<td><strong>5. Why the applicant is under obligation to submit the aforesaid forms for the United States and the European Community as compared to other Contracting Parties of the Madrid Protocol? Is it will not effect the harmonization of the system and against the global trend of the world?</strong></td>
<td><strong>According to the Attorney, this is not a good trend to allow each country to have different requirements for the international registration of Marks. However, at this stage, since each country’s national law is different, we will have to accept requirements to some extent. Individual requirements will decrease, when laws of each country are harmonized.</strong></td>
<td></td>
</tr>
<tr>
<td><strong>6. If the applicant designate a Contracting Party that has its own Individual Fee then whether he also have to pay the supplementary and complementary fees to the International Bureau of WIPO or not?</strong></td>
<td><strong>If the Contracting party has fixed its own individual fee then there is no need to pay the supplementary and complementary fees to the International Bureau of WIPO. Vice versa, if the Contracting Party has not fixed its own individual fee then the applicant has to pay the supplementary and complementary fees to the International Bureau of WIPO. But, when the Contracting Party requires additional fee for additional classes, the</strong></td>
<td></td>
</tr>
<tr>
<td>Question</td>
<td>Answer</td>
<td></td>
</tr>
<tr>
<td>------------------------------------------------------------------------</td>
<td>------------------------------------------------------------------------</td>
<td></td>
</tr>
<tr>
<td>7. Where the applicant should submit the Individual Fee whether to the National Trade Marks Office of the designated Contracting Party or to the International Bureau of WIPO?</td>
<td>The applicant should submit the Individual Fee to the International Bureau of WIPO.</td>
<td></td>
</tr>
<tr>
<td>8. Where the applicant should submit the Supplementary and Complementary Fees whether to the Office of Origin or to the International Bureau of WIPO?</td>
<td>The applicant should submit the Supplementary and Complementary Fees to the International Bureau of WIPO.</td>
<td></td>
</tr>
<tr>
<td>9. What is the criterion for division of supplementary and complementary fees among the designated Contracting Parties?</td>
<td>This question may better be asked either to JPO or WIPO.</td>
<td></td>
</tr>
<tr>
<td>10. Is WIPO also divides the amount of Basic Fee that it receives from the applicant among the designated Contracting Parties?</td>
<td>This question may better be asked either to JPO or WIPO.</td>
<td></td>
</tr>
<tr>
<td>11. Is WIPO deducts some amount from the Individual Fee of a designated Contracting Party?</td>
<td>This question may better be asked either to JPO or WIPO.</td>
<td></td>
</tr>
<tr>
<td>12. What is the criterion for a Contracting Party to fix its own Individual Fee?</td>
<td>The Individual Fee would be the same as the official fee of the domestic applications of the Contracting Party.</td>
<td></td>
</tr>
<tr>
<td>13. What is your opinion whether a Contracting Party of the Madrid Protocol should fix its own Individual Fee or receive a share from the Supplementary and Complementary Fees from WIPO on annual basis?</td>
<td>If the official fee required for domestic applications is less than the complementary fee then the Contracting Party should not fix its own Individual Fee. However, if the official fee required for the domestic applications is more than the complementary fee then the contracting Party should fix its own Individual Fee.</td>
<td></td>
</tr>
<tr>
<td>14. If the Office of Origin is using French language and the applicant designate a Contracting Party that is using English language then what will be the scenario in this type of situation?</td>
<td>Even though the applications for Madrid Protocol are made in French, the designated Contracting Party will issue the office actions in English.</td>
<td></td>
</tr>
<tr>
<td>15. Why the International Registration is dependent on the basic application or registration for the first 5 years?</td>
<td>This provision is carried forward from the Madrid Agreement to the Madrid Protocol. The Attorney does not know exactly that why this provision was taken.</td>
<td></td>
</tr>
</tbody>
</table>
16. What kind of enquiries you receive from the applicant regarding the Madrid Protocol?

The applicant mostly asks about the cost and procedure of the Madrid Protocol required for the international registration of a Mark via Madrid Protocol. In particular, since the Japanese clients wish to avoid unnecessary office actions, they are concerned about descriptions of goods/services in each country.

17. What are the practices and processes of Trade Mark Attorneys to handle the international application via Madrid Protocol?

In case where Japan is the Office of Origin, the Attorney will file the international application on behalf of the applicant to the Japan Patent Office along with the official fee required by JPO. The fee for the International Bureau of WIPO will be submitted directly to WIPO and the Office of Origin (JPO) has no concern with it. The Japan Patent Office after formally examine the international application will forward it to the IB of WIPO for international registration. The IB of WIPO after formally examine the application, register the mark and notify each designated Contracting Party. With in the prescribed period of time, the designated Contracting Party will inform the IB of WIPO about the status of the Mark that informs JPO that in turns will inform the Attorney of the applicant.

18. What are the difficulties that are faced by the Attorneys to manage the Madrid Protocol applications?

The most frequent difficulty faced by the Attorneys is the description of goods and services in the international application because every country has its own criteria to describe the goods and services. Some countries used broad terms like Japan, European Community etc. in the classification whereas some countries use narrow terms like USA etc. in the classification of goods and services. Furthermore, criteria for classifying goods and services differ depending on countries.

19. What is the impact of Madrid Protocol on the attorneys that are practicing the Trade Marks Law?

The number of applications filed through Paris Convention route is decreased but there is no impact on the revenue of the SHIGA International Patent Office because most of the local clients are still using the Paris Convention route instead.
<table>
<thead>
<tr>
<th>Number</th>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>20.</td>
<td>What is the impact of Madrid Protocol on the Industries of a country party to the Madrid Protocol?</td>
<td>The Madrid Protocol is very cost effective system for the industries to register their Marks around the globe and it is a very easy system to manage their rights.</td>
</tr>
<tr>
<td>21.</td>
<td>Are the Industries especially small and medium enterprises of developing countries will benefit from the Madrid Protocol? If yes then how?</td>
<td>Yes, the industries especially SMEs will benefit from the Madrid Protocol although the number of classes of goods and services and number of designations will be less as compared to big companies.</td>
</tr>
<tr>
<td>22.</td>
<td>What are the implications that the Office of Origin will face after acceding to the Madrid Protocol?</td>
<td>The most important implication is the difference between domestic applications and the Madrid Protocol applications so it is necessary to improve the procedures in order to avoid confusion. Furthermore, the employees of the Office of Origin will have to work in English or French or Spanish language.</td>
</tr>
<tr>
<td>23.</td>
<td>What is your opinion about the Madrid Protocol? A country should accede to it or not? If yes then why?</td>
<td>Yes, a country should accede to the Madrid Protocol because it is a cost and time effective system and has the ability to boost the local industries by registering their Mark abroad.</td>
</tr>
</tbody>
</table>
| 24.    | In Japan, people are still using the Paris Convention route more as compared to the Madrid Protocol as is indicated in the Annual Report, 2007 of the Japan Patent Office. Why? | The citizens of Japan are still using the Paris Convention route as compared to Madrid Protocol route because of the following factors:  
- Most of the companies have already registered their important Marks (i.e., house marks) via Paris Convention route;  
- The companies know the rules and regulations of the foreign countries for the registration of a Mark; and  
- There is very less membership from the Asian countries in the Madrid Protocol and most of the companies of Japan have businesses in the Asian continent. |
| 25.    | Any other information that you Not in particular.                                           |                                                                                                                                                                                                                                                                             |
want to share on the basis of your experience in practicing the Madrid Protocol in Japan?

3.5 Distribution of Questionnaire to the Japan Patent Office and Interview of the Officials of JPO;

In order to study the operating system of Japan for managing Trade Mark applications filed via Madrid Protocol both as an Office of Origin and as a designated Contracting Party, it is very important to be acquainted with the national Trade Marks registration system of Japan.

3.5.1 Procedure of Registration of Trade Marks in Japan;

The details of the Trade Mark registration procedure in Japan can be elaborated as per the following heads:

3.5.1.1 Application for Trademark Registration;

An applicant shall file a written application, accompanying the designation of goods and/or services in either one or multiple classes together with a reproduction of Trade Marks to be registered. The Japanese Trade Mark Act adopts first-to-file application principle.

3.5.1.2 Examination of Formality;

A Trade Mark application filed with the Japan Patent Office (JPO) is checked by a formality examiner as to whether it fully complies with the statutory requirements of formality or not. If the application is not according to the statutory requirements of formality, an official notice is delivered to the applicant to fulfill the statutory requirements within a given period of time. If the applicant fails to comply within the given period of time, the application shall be treated as abandoned.

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3.5.1.3 Examination of Trade Mark Registrability;

A Trade Mark application shall subsequently be examined by a Trade Mark Examiner. The registrability examination is conducted with respect to whether the Trade Mark that has been applied for contains (a) any absolute grounds for rejection or (b) any relative grounds for rejection (a conflict with prior rights, including those of well-known Trade Marks). Both (a) and (b) are specifically stipulated in the Trademark Act of Japan.

If a Trade Mark Examiner considers that a Trade Mark application falls under (a) and/or (b), a preliminary notice of rejection shall be delivered to the applicant so as to give an opportunity to submit an argument or amendment within the prescribed period of time.

3.5.1.4 Decision to Grant or Refuse Trade Mark Registration;

After the examination relating to absolute and relative grounds for rejection is completed, the Trade Mark Examiner issues a decision to grant registration where no grounds for rejection are found. On the other hand, the Trade Mark Examiner issues a decision of rejection where any reason for refusal has been found.

In cases where a Trade Mark has been approved for registration, the applicant shall pay the registration fee within 30 days, after which the exclusive rights becomes effective for ten years (renewable) as of the date of its registration in the Trade Mark Register. Thereafter, the Trade Mark is published in the Official Gazette for inviting oppositions.

In cases where a Trade Mark application has been rejected, the applicant may appeal against the decision of rejection to the Appeal and Trial Board of the Japan Patent Office.

3.5.1.5 Post-Grant Opposition;

With in two months after the publication date, any party may file
an opposition to the published Trade Mark registration. The Board of Appeal and Trial will look after the opposition proceedings.

It must be pointed out that the current opposition system under Japanese Trademark Act is different from opposition systems in other countries. In other words, the present opposition system in Japan is not an Inter-Parties Procedure but is rather a kind of procedure that supports appeal and trial examiners by means of supplying relevant information and materials that prove the grounds why the Trade Mark should not be registered.

3.5.1.6 Actions before Board of Appeal and Trial;

(1) **Appeal against an Examiners Decision of Rejection;**

An applicant who receive an examiner’s decision of final rejection is allowed to file an appeal before the Board of Appeal and Trial within the Statutory period of 30 days (for overseas residents, an additional period is granted).

(2) **Invalidation Trial;**

In cases where a Trade Mark is not allowed to be registered from the beginning, an interested person may file an invalidation trial against the registration thereof with the Board of Appeal and Trial at any time within 5 years from the registration date. Once an affirmative ruling of the invalidation is rendered by the Appeal and Trial Board and becomes final, the registration is nullified and deemed to have been non-existent from the beginning.

(3) **Cancellation Trial for Non-Use;**

In cases where a registered Trade Mark has not been used for 3 consecutive years, any party may file a cancellation action (cancellation trial) with the Board of Appeal and Trial. Once an
affirmative ruling for the cancellation is rendered and becomes final, registration ceases to be effective when the decision is so recorded in the Trade Mark Register.

(4) Cancellation Trial for Misuse with Bad Faith;

In cases where the registered owner of a Trade Mark (or the exclusive licensee thereof) intentionally modifies the registered Trade Mark and uses it so as to make it confusing for an existing well-known Trade Mark of another party or so as to mislead the public as to the quality of goods or services, anyone may demand a trial for cancellation with in 5 years after the last occasion of such use.

(5) Invalidation Trial for Un-authorized Registration;

In cases where a sales agent or representative of a foreign Trade Mark owner registered the same Trade Mark without authorization, the foreign Trade Mark owner may file an invalidation trial against such an authorized registration with in 5 years from the registration date. This invalidation trial system corresponds to the Article 6septies of the Paris Convention for the Protection of Industrial Property.

Note: Decisions by the Board of Appeal and Trial for the above cases 1-5 may further be appealed to the Intellectual Property Court (High Court Level) and ultimately to the Supreme Court.

The flow sheet diagram of the procedure of domestic registration of a Trade Mark in Japan is as under:\(^{108}\):

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Flow Chart of Domestic Registration of Trade Mark in Japan

3.5.2 Procedure followed by JPO as an Office of Origin;

The applicant may file an International Application along with the requisite amount of fee to the Japan Patent Office (JPO) on the foundation of a basic application or basic registration that has been filed for a Trade Mark registration in Japan even on the same day or registered in Japan, as the case may be. It must be noted that in addition to the fee that the applicant has to pay to the JPO as an Office of Origin, he also has to pay the prescribed amount of fee to the International Bureau of WIPO directly for the International Registration of a Mark.

After submission of the International Application to the JPO, the International Trade Mark Application Office of JPO will perform the formality examination of the International Application in which the Office will check the following points:

I. Identity of the International Application with the basic application or basic registration;
II. Any deficiency in the International Application;
III. Any priority claim in the International Application; and
IV. Receipt of International Application Fee submitted to JPO.

If there is any discrepancy in the International Application on the basis of aforesaid criteria, the International Trade Mark Application Office of JPO will inform the applicant to rectify the discrepancy. If there is no discrepancy or after rectification of the discrepancy by the applicant or by the Office, as the case may be, in the International Application after the formality examination, the International Trade Mark Application Office will forward the International Application to the International Bureau of World Intellectual Property Organization (WIPO). The date of the International Registration will be the date on which the International Application is submitted to the JPO provided
that JPO has forwarded the International Application to the International Bureau of WIPO with in two months of the receiving of the International Application. Otherwise, the date of the International Registration will be the date on which the International Application is received by the International Bureau of WIPO from JPO.

After receiving the International Application from the International Trade Mark Application Office of JPO, the International Bureau of WIPO will also execute the formality examination of the International Application on the following grounds:

I. Any deficiency in the International Application;
II. Classification of Goods and Services; and
III. Receipt of International Application Fee submitted to WIPO.

If there is any irregularity is found in the International Application, the International Bureau of WIPO will send an irregularity notice to the International Trade Mark Application Office of JPO and to the applicant to rectify the irregularity. The JPO also informs the applicant about the irregularity notice of the International Bureau of WIPO. The applicant rectify the irregularity in the International Application in consultation with the JPO and after rectification, JPO will again forward the International Application to the International Bureau of WIPO for International Registration. This procedure must also be completed in the two months prescribed period so that the date of International Registration will be the date on which the International Application is submitted to the Japan Patent Office.

If there is no irregularity is found in the International Application by the International Bureau of WIPO on the aforesaid criteria or after rectification of the irregularity by the applicant or by the Office, as the case may be, then the Mark is registered and published in the WIPO Gazette of International Marks. At the same time, the International
Bureau of WIPO will inform the JPO about the International Registration and will also send a Certificate of Registration to the applicant either directly or through JPO, as the case may be.

After the Mark is registered and published in the Gazette, the International Bureau of WIPO forwards the International Application to the designated Contracting Parties that are mentioned in the International Application. The designated Contracting Parties will examine the International Application according to their own National Legislations and either register or refuse the Mark. The Offices that send notification of grant of protection to the applicant are the Offices of Armenia, Australia, European Community, Georgia, Hungary, Ireland, Japan, Norway, Republic of Korea, Singapore, Sweden, Syrian Arab Republic, Turkey and the United Kingdom (Total: 14 countries).

The list of the countries that receives an Individual Fee instead of receiving a share from the supplementary and complementary fees is available on the website of WIPO\(^\text{109}\) whereas there are only two countries, Cuba and Japan, that receive Individual Fee in two stages, one at the receiving of International Application from WIPO and second at the notification of grant of the Mark. The reason for this two-staged Individual Fee is to reduce the financial burden on users in cases where the Trade Mark was not registered. But many of the Contracting Parties of the Madrid Protocol collects a lump sum amount of Individual Fee at the time of application.

A detailed flow sheet diagram of the procedure that is followed by the Japan Patent Office as an Office of Origin is as under\(^\text{110}\):

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Basic Procedure Flow of JPO as an Office of Origin

![Diagram of the basic procedure flow of JPO as an office of origin.

**Note-1:** Countries that send notification of registration:
Armenia, Australia, European Community, Georgia, Hungary, Ireland, Japan, Norway, Republic of Korea, Singapore, Sweden, Syrian Arab Republic, Turkey and the United Kingdom (Total: 14 countries).

**Note-2:** Countries that embrace or will embrace the two-stage payment of individual fee (two-stage payment: fee charged upon registration in each country) are Cuba and Japan.

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*Tokyo, September 2008*
3.5.3 Procedure followed by JPO as a Designated Contracting Party;

After the Mark is registered and published in the WIPO Gazette of International Marks, the International Bureau of WIPO will forward the International Application to the designated Contracting Parties. If Japan is one of the designated Contracting Party then the applicant must have to submit an Individual Fee fixed by Japan instead of supplementary and complementary fees along with the basic fee to the International Bureau of WIPO.

The International Bureau of WIPO will send a notification of designation to the Japan Patent Office. The Japan Patent Office will do the formality check of the International Application and then publish the unexamined applications in the Official Gazette. After the formality check, the International Application is substantially examined by the Trade Mark Examiner. If the International Application fulfills the examination standards of the Trade Mark Division of JPO then the Trade Mark Examiner will issue a decision of grant of the Mark that is mentioned in the International Application. This decision of grant of the Mark is forwarded to the applicant of the International Application. Whereas a statement of grant of protection in Japan by the JPO is forwarded to the International Bureau of WIPO for international record along with the notice of payment of the second part of the Individual Fee. The International Bureau of WIPO will in turns forward a copy of the statement of grant of protection in Japan to the applicant accompanying with the copy of the payment notice of the second part of the Individual Fee. The applicant will pay the second part of the Individual Fee to the International Bureau of WIPO that in turn will inform the JPO through a notification of payment of second part of the Individual Fee. After receiving the confirmation of submission of the second part of the Individual Fee by the International Bureau of WIPO, JPO will register the Mark, publish it in the Trade Mark Gazette and
issue a certificate of Trade Mark registration either to the applicant or to the representative of the applicant, as the case may be.

On the contrary, if the Trade Mark Examiner, after the substantial examination, thinks that the Mark does not fulfills the criteria to be registered in Japan then he may issue a notification of provisional refusal to the International Bureau of WIPO for international record that in turns will inform the applicant by sending a copy of the notice of provisional refusal by JPO. It must be kept in mind that in case of Japan, the above mentioned procedure must be completed in 18 months period. If it is not completed in 18 months period then the Mark will automatically be protected in Japan. After the notice of provisional refusal, the role of International Bureau of WIPO is finished and the applicant now directly deals with the JPO for further procedures according to the National Trade Mark legislation of Japan for registering his Mark in Japan.

After receiving the decision of provisional refusal from the JPO via the International Bureau of WIPO, the applicant may hire the services of a Trade Mark Attorney in Japan and submits a written argument/amendment to JPO against the decision of the Trade Mark Examiner on the basis of which the Mark is provisionally refused. The Japan Patent Office will re-examine the International Application on the basis of the written argument/amendment submitted by the representative of the applicant to JPO. If the International Application is accepted for registration, JPO will issue a decision of grant of protection and send it to the representative of the applicant in Japan. The representative in turns may forward a copy of the decision of grant of protection to the applicant. At the same time, JPO will also inform the International Bureau of WIPO for the international record that the statement of provisional refusal is with drawn along with the notice of the payment of the second part of the Individual Fee. The International Bureau will inform the applicant about the withdrawal of
the statement of provisional refusal and advise the applicant to submit the second part of the Individual Fee. The applicant will pay the second part of the Individual Fee to the International Bureau of WIPO that in turns will inform JPO that the second part of the Individual Fee has been paid by the applicant. After receiving the confirmation of submission of the second part of the Individual Fee by the International Bureau of WIPO, JPO will register the Mark, publish it in the Trade Mark Gazette and issue a certificate of Trade Mark registration either to the applicant or to the representative of the applicant, as the case may be.

On the other hand, if the International Application is not accepted for registration by JPO, after the submission of the written argument/amendment by the representative of the applicant, JPO will issue a decision of refusal and send it to the representative of the applicant and if the applicant has no domestic representative the JPO will send the decision of refusal directly to the applicant. At this stage, if the applicant or the representative of the applicant does not demand for trial against the decision of the Trade Mark Examiner then JPO will issue a notification of statement of final decision of refusal and send it to the International Bureau of WIPO for the international record. The International Bureau of WIPO will in turns forward a copy of the notification of statement of final decision of refusal to the applicant.

But, the applicant or the representative of the applicant may lodge a demand for trial against the decision of the Trade Mark Examiner on the basis of re-examination after submitting the written argument/amendment in front of the Board of Appeal and Trial of JPO. After hearing, the Board may give a decision to grant of protection of the Mark and JPO will send a copy of the trial decision of grant of protection to the representative of the applicant that in turns forward it to the applicant. The Japan Patent Office will also inform the International Bureau of WIPO for the international record that the
statement of provisional refusal is withdrawn along with the notice of
the payment of the second part of the Individual Fee on the basis of
the decision of the Board of Appeal and Trial. The International Bureau
will inform the applicant about the withdrawal of the statement of
provisional refusal and advise the applicant to submit the second part
of the Individual Fee. The applicant will pay the second part of the
Individual Fee to the International Bureau of WIPO that in turns will
inform JPO that the second part of the Individual Fee has been paid by
the applicant. After receiving the confirmation of submission of the
second part of the Individual Fee by the International Bureau of WIPO,
JPO will register the Mark, publish it in the Trade Mark Gazette and
issue a certificate of Trade Mark registration either to the applicant or
to the representative of the applicant, as the case may be.

On the contrary, the Board may give a decision of refusal on the
basis of appeal and trial. In this situation, JPO will send a copy of the
trial decision of refusal to the representative of the applicant who in
turns will inform the applicant. At the same time, JPO will also send a
notification of statement of final decision of refusal to the International
Bureau of WIPO for international record. The International Bureau of
WIPO will in turns send a copy of this notification to the applicant. But,
it must be kept in mind that the applicant still has the opportunity to
take action against the decision of the Board of Appeal and Trial in the
Intellectual Property Court of Japan and ultimately to the Supreme
Court of Japan.

**Board of Appeal and Trial of JPO;**

The Board of Appeal and Trial of JPO consists of 3 or 5 appeal
examiners that form a Collegial Body. In most of the cases, the
Collegial Body is composed of 3 appeal examiners, one Chief Appeal
Examiner and two Appeal Examiners. The outlook of the Board of
Appeal and Trial located in JPO can better be understood from the
After all the aforesaid procedures are completed, the Mark is either registered or refused. If the Mark is registered, it is published in the Trade Mark Gazette of the Japan Patent Office for inviting oppositions within two months time from the date of publication of the Trade Mark Gazette. In case of any opposition filed within the prescribed period of time, the hearing will start in front of the Board of Appeal and Trial of JPO. If the Board decides to cancel the Mark on the basis of opposition, JPO will send a copy of decision of cancellation of the Mark to the International Bureau of WIPO for international record and to the representative of the applicant which in turns inform the applicant about the decision of cancellation. A similar proceeding will take place in case of trial for invalidation/cancellation. A detailed flow sheet diagram of the procedure that is followed by the Japan Patent Office as a designated Contracting Party is as under:\footnote{111 Book on the Procedure of International Trade Mark Application based on Madrid Protocol, Japan Patent Office, P-104, 2007}
Note-1: Solid line: Notification or procedure by the Patent Office or international bureau. Dashed line: communication between applicant/right holder and domestic representative

Note-2: Notification and payment of individual fee (annual fee) started with international applications for trademark registration, the international registration date of which is January 1, 2003.
3.5.4 Questionnaire to Japan Patent Office;

In order to study the operating system of the Japan Patent Office for implementing Madrid Protocol in terms of staff strength, workload analysis, capacity building requirements of the staff, awareness and support measures, automation requirements etc., a questionnaire is prepared and sent to the International Trade Mark Application Office of JPO (Annex-VI). The answer to each question given by the Japan Patent Office is as under:

<table>
<thead>
<tr>
<th>Q. No.</th>
<th>Questions</th>
<th>Answers</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>What are the implications faced by the Japan Patent Office after acceding to the Madrid Protocol?</td>
<td>No significant implications have been felt in JPO’s work, but active efforts have been made on our part to promote debate in various international conferences and bilateral consultations at every opportunity in an effort to revise the system in order to enhance the convenience for the benefit of Japanese users because growth in the number of applications filed by Japanese users remained sluggish compared with the increasing number of cases where Japan is specified as the designated state. We are also working on non-member Asian states to encourage their accession to the Protocol by taking advantage of every opportunity.</td>
</tr>
<tr>
<td>2.</td>
<td>What are the pre-requisites that a country should take before acceding to the Madrid Protocol?</td>
<td>It is necessary to grasp the users’ demands to improve by revamping the current system, including domestic laws and organizations, as required for accession to the Protocol.</td>
</tr>
<tr>
<td>3.</td>
<td>What are the drawbacks of the Madrid Protocol from the user point of view as well as from the perspective of the Office of Origin and designated Contracting Party?</td>
<td>One drawback is that considerable efforts are required of us to efficiently carry out liaison and communication activities with the relevant offices of WIPO and various document works in connection with all kinds of official services related to WIPO as we are not allowed to use our first language, Japanese, since we have chosen English for our official activities in this connection from among the three official languages of WIPO: English, Spanish, and French; this includes the preparation of</td>
</tr>
<tr>
<td></td>
<td>What are the ten drawbacks that the applicant in Japan faced while using the Madrid Protocol according to the survey of Japan Patent Office?</td>
<td>The following controversial issues were pointed out in a report prepared in March 2007:</td>
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<td>4.</td>
<td>(1) Concerns about central attacks; (2) Member states are scarce in Asia; (3) Users are not able to be assured of trademark protection before the expiry of the notification of provisional refusal in a number of countries; (4) The basic requirements of the basic application and the basic registration produces restraints; (5) It is not clear whether or not the alternative system is free of problems; (6) The money transfer system for the application fees is complicated; (7) The general lack of sufficient knowledge and experience with the system among the involved countries/users; (8) The long time it takes to acquire the necessary protection; (9) The small number of designated states makes the related expenses comparatively high. With regard to the problem of the time it takes to issue the statement of grant of protection, as stated in (3) above, this will be corrected by September of next year through revision of the rule.</td>
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<th></th>
<th>What is the time of examination or what is the time for acceptance or refusal for an international application where Japan is the designated Contracting Party?</th>
<th>The average period of the first action (Issuance of the first notice of the examination result to be given by the Examiner, mainly the decision of registration or refusal) is 8.4 months (2006).</th>
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<td>5.</td>
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<th></th>
<th>Why the international applications filed through Madrid Protocol are less than the international applications filed through the Paris Convention?</th>
<th>Reasons why Japanese users are not utilizing the Madrid Protocol are given in the answer to Question 4.</th>
</tr>
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<tr>
<td>6.</td>
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</table>

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<tr>
<th></th>
<th>Why the Japan Patent Office fix an Individual</th>
<th>This may be because it was necessary to maintain balance with the amount assessed on applications and other correspondence, the translation of domestic laws and regulations, system construction, the publication of instruction books and booklets, etc. unlike in the case of PCT.</th>
</tr>
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<tbody>
<tr>
<td>7.</td>
<td></td>
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</table>
Fee instead of receiving share from the supplementary and complementary fees from WIPO on annual basis? domestic applications. Incidentally, the Japanese Patent Office has chosen to follow Rule 34 (3) (a) of the Common Rule with respect to individual fees.

Questions of Administration

8. What is the total staff strength of the section dealing with the Madrid Protocol in the Japan Patent Office? May I have the Organogram of this section?

This section of JPO has 7 permanent staff, 1 non-permanent staff, and 4 temporary personnel: 12 total. Please refer to the attached organization chart for details.

Note: The organogram of the International Trade Mark Application Office of JPO is given at the end of this table.

9. What are the responsibilities of each officer, mentioned in the Organogram, working in the section of Madrid Protocol?

Note: The responsibilities of each officer mentioned in the organogram of the International Trade Mark Application Office of JPO are elaborated at the end of this table.

10. What are the automation requirements necessary for handling the international applications filed through Madrid Protocol?

No particular automation is required in this respect in connection with the work of the office of origin or the designated offices as well as applications made by users.

Questions of Trademark Examiners

11. What is the total number of Trademark Examiners (both permanent and temporary) in the Japan Patent Office?

There are total 149 Trademark Examiners in the Trademark Division of JPO (as of 2006).

12. Is the Trademark Examiners for the Madrid Protocol applications are separate from the Trademark Examiners dealing with the national trademark applications of Japan and applications filed through Paris Convention?

The examination of applications based on the Madrid Protocol and national examination (those for application based on the Paris Convention or domestic application) are distinctly separated and the examiners who are engaged in applications based on the Madrid Protocol work only on applications filed there under.

13. If the answer on the above question is YES then what are the total number of Trademark Examiners (both permanent and temporary) that are dealing

There are 19 regular Madrid Protocol examiners (including 1Director and 1 Senior Examiner) plus 9 assistant examiners (as of April 2008): 28 Total.
14. What is the total number of trademark applications that a Trademark Examiner will examine in one year?
The number of First Actions (the first notice of examination results issued by the examiners mainly the notice on the decision of registration or refusal) in a year is 139,443 (in 2006). It is evident that the total number of trademark applications that an examiner will examine in one year is 936 approximately.

15. What is the total number of international trademark applications filed via Madrid Protocol that a Trademark Examiner will examine in one year?
The number of First Actions related to applications for the international registration of trademarks (the first notice of examination results issued by the examiners mainly the notice on the decision of registration or refusal) in a year is 8,198 (in 2006). It is evident that the total number of trademark applications file via Madrid Protocol that an examiner will examine in one year is 293 approximately.

Questions of Appeal Examiners

16. What is the total number of Appeal Examiners (both permanent and temporary) in the Japan Patent Office?
There are total 386 Appeal Examiners in the Japan Patent Office (all appeal examiners are permanent).

17. Is the Appeal Examiners for Trademarks are separate from the Appeal Examiners of Patents, Designs etc.?
Yes, the Appeals Department is divided into the 1st Board of Appeals to the 38th Board of Appeals. The trademark examinations are handled by the 35th Board through 38th Board of Appeals.

18. Is the Appeal Examiners for the Madrid Protocol applications are separate from the Appeal Examiners dealing with the national trademark applications of Japan and applications filed through Paris Convention?
Yes, they are. However, the appeal examiners handling applications based on the Madrid Protocol also handle applications filed under other domestic application systems.

19. If the answer on the above question is YES then what are the total number of Appeal Examiners (both permanent and temporary) that are dealing with the appeals of international applications filed through
Currently, 11 trademark examiners are appointed to the job (all of them are permanently employed officers.)
<table>
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<tr>
<th>Question</th>
<th>Answer</th>
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<tbody>
<tr>
<td>20. What is the total number of trademark appeals that an Appeal Examiner will handle in one year?</td>
<td>The total number of cases handled by these examiners per year is an average of 150 per examiner (for both appeals and inter-parties trials) as indicated in fiscal year 2007.</td>
</tr>
<tr>
<td>21. What is the total number of trademark appeals filed via Madrid Protocol that an Appeal Examiner will decide in one year?</td>
<td>The total number of cases handled by these examiners per year is an average of 14 per examiner (for both appeals and inter-parties trials) as indicated in fiscal year 2007.</td>
</tr>
</tbody>
</table>

**Questions of Capacity Building, Awareness and Support**

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
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<tbody>
<tr>
<td>22. What are the capacity building problems faced by the officers of the Japan Patent Office in order to handle the international applications filed by the route of Madrid Protocol both as Office of Origin and designated Contracting Party?</td>
<td>We try to line up officers who are proficient in English for this line of work as most of the documents related to the Madrid Protocol handled by the offices of origin and the designated offices are written in English. In addition, we encourage our officers to actively attend the English course run by INPIT in order to improve their proficiency in this area. Furthermore, officers newly assigned to this section regularly receive briefings on the summary of the Treaty and the rules of the Protocol as well as practical work related to the protocol from well-experienced officers.</td>
</tr>
<tr>
<td>23. What is the awareness strategy of the Japan Patent Office for disseminating the information of IP to the Small and Medium Enterprises of Japan?</td>
<td>With respect to the publicity of the Madrid Protocol system, we distribute related pamphlets through local intellectual property–related institutions and seminars held by us and actively co-operate with their requests to hold lectures for enlightenment.</td>
</tr>
<tr>
<td>24. What are the support measures that the Japan Patent Office had taken for facilitation of the small and medium enterprises?</td>
<td>No particular support measures such as subsidies are being taken concerning the Madrid Protocol System.</td>
</tr>
<tr>
<td>25. Is Japan Patent Office arranged seminars, workshops etc in order to disseminate the information among general public regarding the Madrid Protocol?</td>
<td>Seminars were held in four places across the country in fiscal year 2007.</td>
</tr>
<tr>
<td>26. Is Japan Patent Office had listened the views of the Japanese Industries particularly the small and medium enterprises before</td>
<td>JPO ran an opinion survey covering 760 domestic corporations about their opinions on controversial points prior to accession to the Madrid Protocol in 1997.</td>
</tr>
</tbody>
</table>
27. If the answer to the above question is YES then what are the views of the Japanese Industries particularly the small and medium enterprises for accession to the Madrid Protocol?

Responses were received from 410 of the subject corporations; 92.7% of respondents replied positively to the accession and 89.8% expressed their intentions to make use of the opportunity. However, 43% of respondents replied “negative” to the question of whether they have any knowledge about the summary of the protocol.

28. Any other information that you wish to share with me regarding the implications of Madrid Protocol based on your rich experience in handling the international applications via Madrid Protocol?

A reply received from the Trademark Section of JPO: The related laws, examination criteria, and the operation of the protocol may differ from one country to another, which makes it difficult to make some applicants understand the reason of provisional refusal for submitted applications. We believe that it would be useful to introduce the related laws and examination criteria on JPO’s web site in English in order to enhance the understanding of overseas applicants.

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**Organogram of the International Trade Mark Application Office of the Japan Patent Office**

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Tokyo, September 2008
## Responsibilities of Officers mentioned in the Organogram of the International Trade Mark Application Office of JPO

<table>
<thead>
<tr>
<th>Designation</th>
<th>Work Responsibility</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>④ Deputy Director:</strong> Administrative Affairs Section.</td>
<td>Planning and formulation of the administrative work systems for applications for international registration, etc. (of the office of origin and the designated offices)</td>
</tr>
<tr>
<td><strong>⑤ Assistant Director:</strong> Administrative Affairs Section. (Serving concurrently)</td>
<td>- Preparation, management, and distribution of required data for progress management in the administrative work for international applications for registration, etc. (by the office of origin and the designated offices).  - Liaison and coordination for the progress management in the administrative work (by the office of origin and the designated offices).  - Statistics related to applications for international registration, etc. (of the office of origin and the designated offices).  - Dispatch of documents related to applications for international registration, etc. (of the office of origin and the designated offices).</td>
</tr>
<tr>
<td><strong>③ Associate Managing Specialist for Electronic Data Management</strong></td>
<td>Administrative work related to the operation concerning the liaison and coordination concerning the paperless system.</td>
</tr>
<tr>
<td><strong>① Associate Managing Specialist for Formality Examination.</strong> (Person in charge in the office of origin)</td>
<td>- Acceptance of application related to applications for international registration, etc. (the office of origin).  - The formality examination of filing documents concerning applications for international registration, etc. (the office of origin).  - The processing of intermediate documents concerning applications for international registration, etc. (the office of origin).  - The correction and management of data concerning applications for international registration, etc. (the office of origin).</td>
</tr>
<tr>
<td><strong>② Specialist for Formality Examination.</strong> (Person in charge in the office of origin)</td>
<td></td>
</tr>
<tr>
<td><strong>① Associate Managing Specialist for Formality Examination.</strong> (Person in charge in the designated office) (Serving concurrently)</td>
<td>- Acceptance of application documents concerning applications for international registration, etc. (designated offices).  - Distribution and processing of intermediate documents concerning applications for international registration, etc. (designated offices).  - Withdrawal and abandonment of applications for international registration, etc. (designated office).  - The preparation, arrangement, dispatch, recovery and safekeeping of file wrapper relative to applications for international registration, etc. (designated office).  - The correction and management of data concerning applications for international registration, etc. (designated office).</td>
</tr>
<tr>
<td><strong>② Specialist for Formality Examination.</strong> (Person in charge in the designated office)</td>
<td></td>
</tr>
</tbody>
</table>
3.5.5 Follow-Up Questionnaire to Japan Patent Office;

On the basis of the questionnaire send to the Japan Patent Office, a follow-up questionnaire is prepared (Annex-VII) and forwarded to JPO for further clarification of Madrid Protocol. The answer to each question given by Japan Patent Office is as under:

<table>
<thead>
<tr>
<th>Q. No.</th>
<th>Questions</th>
<th>Answers</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Whether the Japanese applicant for the local registration of the Mark in Japan has to file one application in one class only or he can apply one application in more than one class?</td>
<td>The Japanese applicant can apply for more than one class in one application for the domestic registration of a Mark.</td>
</tr>
<tr>
<td>2.</td>
<td>If the Japanese applicant can apply one application in one class only then how JPO has remedied this irregularity before acceding to the Madrid Protocol where an applicant can file one application in more than one class?</td>
<td>The multi-class application system had already been introduced (in the 1996 revision) when Japan acceded to the Madrid Protocol in 2000. Therefore amendment in the law was not required for this problem.</td>
</tr>
<tr>
<td>3.</td>
<td>The number of applications in Japan as an Office of Origin is very less as compared to the number of applications where Japan is the designated Contracting Party. Why Japan acceded to Madrid Protocol? Is it does not affects the interests of the local businesses of Japan?</td>
<td>Japan acceded to the Madrid Protocol believing that it would also be beneficial to domestic users because the Madrid System allows them to receive protection for their trademarks in contracting states through simple, prompt, and inexpensive means. The question states: “The number of applications in Japan as an Office of Origin is significantly less than the number of applications where Japan is the designated Contracting Party.” However, such things can only be identified after accession to a treaty.</td>
</tr>
</tbody>
</table>
| 4.    | Why JPO receives Individual Fee in two parts?                             | Many of the contracting states of the Madrid Protocol that have chosen Individual Fee collect the portion for application and that for registration in one lump sum at the time of application. These countries, excluding the Office of Harmonization for the Internal Market (OHIM), do not give a partial refund of the Individual Fee even if the trademark
<p>| | | |</p>
<table>
<thead>
<tr>
<th></th>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>5.</strong> Is WIPO deducts some amount from the Individual Fee?</td>
<td>No, WIPO collects the basic fee independently and does not deduct any amount from the Individual Fee.</td>
<td></td>
</tr>
<tr>
<td><strong>6.</strong> If the answer to the above question is YES then what is the criteria of deduction from the Individual Fee?</td>
<td>Not Applicable.</td>
<td></td>
</tr>
<tr>
<td><strong>7.</strong> Is JPO has listened the views of the Attorneys in addition to the views of the Japanese Industries before acceding to the Madrid Protocol?</td>
<td>JPO requested the Industrial Property Council which consists of representatives from patent attorneys, enterprises, and other organizations to deliberate on joining the Madrid Protocol, etc.</td>
<td></td>
</tr>
</tbody>
</table>
| **8.** If answer to the above question is YES then what are the views of the Attorneys of Japan about accession of the Madrid Protocol? | The Madrid Protocol enables the protection of trademarks in contracting parties through simple, prompt, and inexpensive means, they had the following two opinions:  
➢ The system of the Madrid Protocol is beneficial for users for whom it is not easy to protect their trademark right overseas; and  
➢ Users can enjoy sufficient benefits by Japan’s acceding to the Madrid Protocol because it will allow the acquisition of trademark rights abroad through simple and prompt procedures. |
| **9.** Why no support measure is provided to small and medium enterprises of Japan regarding to Madrid Protocol? | JPO conducts PR activities (distribution of leaflets), holds briefing sessions on the system to spread knowledge of it and visits companies to listen to user needs regardless of the enterprise size. No support measure is provided to SMEs regarding Madrid Protocol because feedback from users does not include demand for support dedicated to small and medium enterprises. The focus of JPO is now on spreading the system among general users, including big companies. |
| **10.** Why there is a difference of workload between the Trade | This may be because the documents of international trademark application based |
Mark Examiners responsible for local applications and applications filed via Paris Convention route (936 applications/year) and Trade Mark Examiners responsible for international applications filed via Madrid Protocol route (293 applications/year)?

11. Is E-Filing is possible for the local Trade Mark applications and for the international applications filed via Madrid Protocol?

12. What are the means of communication between the Japan Patent Office and the International Bureau of WIPO related to Madrid Protocol?

13. Is paperless culture of JPO is also extended to the International Trade Mark Application Office of JPO?

14. Is JPO receives any amount of fee for the following actions that are related to Madrid Protocol? If YES then please give the amount of fee in the relevant box that is received by JPO?

<table>
<thead>
<tr>
<th>As an Office of Origin:</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>Actions</td>
<td>Fees received by JPO</td>
</tr>
<tr>
<td>Fees for the international registration of a mark from the applicant.</td>
<td>9,000 Yen</td>
</tr>
<tr>
<td>Fees for transformation of international registration in to national applications.</td>
<td>System does not exist.</td>
</tr>
<tr>
<td>Fees to record replacement of registered Trade Mark with international registration.</td>
<td>System does not exist.</td>
</tr>
</tbody>
</table>
**As a Designated Contracting Party:**

<table>
<thead>
<tr>
<th>Actions</th>
<th>Fees received by JPO</th>
</tr>
</thead>
<tbody>
<tr>
<td>Fees for the international registration of a mark from the applicant.</td>
<td>Only Individual Fee paid to IB [Article 8 (7) (a) of the Protocol].</td>
</tr>
<tr>
<td>Fees for transformation of international registration into national applications.</td>
<td>Charge free (Article 9.5 of the Protocol).</td>
</tr>
<tr>
<td>Fees to record replacement of registered Trade Mark with international registration.</td>
<td>Charge free (Article 4.2 of the Protocol).</td>
</tr>
<tr>
<td>Fees for filing of address for service/agent in Japan.</td>
<td>Charge free.</td>
</tr>
</tbody>
</table>

15. In the post-registration procedures of Madrid Protocol, the applicant can either approach the international bureau of WIPO directly or through the Office of Origin. I want to know that which of the following post-registration procedures are/are not (directly by the applicant to the IB of WIPO) routed through JPO to the IB of WIPO. Please give the answers in YES or NO in the relevant box.

<table>
<thead>
<tr>
<th>S. No.</th>
<th>Post-Registration Procedures</th>
<th>Routed through JPO</th>
<th>Directly by the applicant to the IB of WIPO</th>
<th>Amount of Fee received by JPO for Post-Registration Procedures</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Subsequent designation.</td>
<td>YES</td>
<td>NO</td>
<td>¥4,200</td>
</tr>
<tr>
<td>2.</td>
<td>Change of name or address of holder.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
<tr>
<td>3.</td>
<td>Change of name or address of representative.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
<tr>
<td>4.</td>
<td>Appointment of a representative at WIPO.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
<tr>
<td>5.</td>
<td>Limitation of the list of goods and services.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
<tr>
<td>6.</td>
<td>Recording of a Renunciation.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
<tr>
<td>7.</td>
<td>Cancellation of the international registration.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
<tr>
<td>8.</td>
<td>Change in ownership</td>
<td>YES</td>
<td>NO</td>
<td>¥4,200</td>
</tr>
<tr>
<td>9.</td>
<td>Renewal of international registration.</td>
<td>YES</td>
<td>NO</td>
<td>¥4,200</td>
</tr>
<tr>
<td>10.</td>
<td>Recording of a license.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
<tr>
<td>11.</td>
<td>Amendment for the recording of a license.</td>
<td>NO</td>
<td>YES</td>
<td>NIL</td>
</tr>
</tbody>
</table>
Note: In case of Recording of a License and Amendment of Recording of a License, if a country party to the Madrid Protocol has licensing provisions in its domestic legislation then there is no need to record the license at the International Bureau of WIPO but if a country party to the Madrid Protocol has no licensing provisions in its domestic legislation then the applicant has to record the license at the International Bureau of WIPO.

16. Is JPO receives any amount of fee (in addition to the fee submitted to WIPO by the applicant) for the post-registration procedures that are routed through JPO? If YES then please identify the fees for each post-registration procedure in the last column of the above table?
CONSIDERATION OF THE RESULTS

4.1 Consequence of the comparison of common provisions of Madrid Protocol in the National Trade Marks Legislations of Japan, Singapore and United States of America and Conflicts between the National Trade Marks Legislation of Pakistan and Madrid Protocol;

I have compared the common provisions of Madrid Protocol in the domestic legislations of the aforesaid countries. In case of Japanese and US legislations, they have incorporated many provisions in their Trade Marks Acts and also give details in the Rules for implementation of Madrid Protocol in Japan and USA respectively. But, in case of Singapore, it has given only one enabling provision in the Trade Marks Act and the whole detail is given in the Trade Mark (International Registration) Rules, 2000. One thing should be kept in mind that in Singapore, the Rules for the International Trade Mark Registration through Madrid Protocol are separate from the Rules of the National Trade Mark Registration.

In my point of view, there is no need of amendment in the existing National Trade Marks Legislation because each Contracting Party has to examine the international application according to its own national legislation. Rather, there is a need to include an additional chapter to the existing national legislation in order to give effect to the provisions of the Madrid Protocol just like the legislations of Japan, Singapore and United States of America.

In addition to the comparison, I also find some conflicts in the domestic Trade Marks legislation of Pakistan and the provisions of the Madrid Protocol. In my opinion, these conflicts can be remedied in the following two ways:

1. The domestic Trade Mark legislation may be amended in line
with the provisions of the Madrid Protocol; or

2. A new chapter may be incorporated in the domestic Trade Mark legislation to register the international applications filed through Madrid Protocol route in Pakistan.

4.2 Effect of the Awareness Strategy and Support for Small and Medium Enterprises in Japan;

I have studied the awareness strategy and support that is provided by the Government of Japan in general and Japan Patent Office in particular to the SMEs of Japan. As far as awareness strategy is concerned, Japan Patent Office (JPO) has implemented the following activities for the development of human resource in the field of Intellectual Property:

- Programs for elementary schools, junior high schools, high schools, universities, adults in general, researchers, entrepreneurs including SMEs and experts;
- Explanatory meetings to the persons who are involved in intellectual property matters;
- Seminars and Training for SMEs and Venture Companies;
- Training seminars for fostering Patent Licensing Experts;
- The Regional Headquarters for Intellectual Property Strategy in each region implement measures for raising the awareness level of SMEs and promotion of appropriate use of intellectual property;
- Patent Office is established in each Regional Bureau of Economy, Trade and Industry to provide information on IP and promoting utilization of Industrial Property rights; and
- Distribution of a Compendium of examples of Patent Utilization.
There is a range of support measures that are taken by the Japan Patent Office for the small and medium enterprises that sustain the industrial foundation in Japan and play a critical role as an energetic force of regional economies as well as to venture companies that are expected to create new industries. These support measures are elaborated as under:

- Consultation services on Industrial Property rights;
- Intellectual Property specialists to provide support to SMEs in terms of consultations, raising awareness and developing human resources in local areas;
- Free individual consultation services by experts;
- Support for Regional IP Advisory Counters established at Chambers of Commerce and Industry;
- Industrial Property Digital Library (IPDL);
- Patent Information Advisors;
- Support of Prior Art Searches;
- Reduction or exemption from Examination Request Fee;
- Accelerated examinations and accelerated appeal/trial;
- Refund system on Examination Request Fee;
- Reduction or exemption from the Patent Annual Fees;
- Project for supporting the formulation of Intellectual Property Strategies; and
- Project on Model Utilization of Intellectual Property Rights.

In addition to the Japan Patent Office, Small and Medium Enterprise Agency working under the Ministry of Economy, Trade and Industry (METI) is responsible for implementing different policies for facilitating the Small and Medium Enterprises of Japan. The Japan Patent Office has taken many initiatives in order to increase awareness among the SMEs and Venture Companies. At the same
time, a lot of support measures are also provided for SMEs and Venture Companies but these support measures mainly cover Patents. There is no support measure is provided to SMEs in the field of Marks in general and Madrid Protocol in particular.

4.3 Outcome of the Comparison of Fees;

The Small and Medium Enterprises in the developing countries are financially not so strong to pay the fees for the international registration of Marks through Madrid Protocol. In Pakistan, the fees required for the domestic registration of a Mark in one class is around PKR 5,000 (76 Swiss Francs) [1CHF = 66PKR]. Whereas in order to register a Mark through Madrid Protocol, the applicant has to pay a Basic Fee (653 or 903 Swiss Francs), a Supplementary Fee (73 Swiss Francs for each class beyond three classes) and a Complementary Fee (73 Swiss Francs) or if a Contracting Party has fixed its own Individual Fee then the applicant has to pay the Basic Fee and the Individual Fee fixed by that Contracting Party.

In the present situation, the fees of PKR 5,000 for domestic registration of a Mark in Pakistan does not predict the correct amount of fee and thus cannot be compared with the fee for the international registration of a Mark via Madrid Protocol. This is because of the following facts:

- In Pakistan, separate application must be filed for each class whereas in Madrid Protocol one application covers all the classes of goods and services; and
- In Pakistan, there is Pre-Grant Opposition System and one can never be sure whether an opposition or oppositions are going to be filed against the registration of a Mark or not. Therefore, PKR 5,000 is not a fixed amount of fee for the domestic registration of a Mark in Pakistan because against
each opposition, applicant has to file a counterstatement along with the prescribed amount of fee.

On the basis of aforesaid two facts, problem will arise if Pakistan is going to fix its own Individual Fee because the Individual Fee fixed by a Contracting Party may not be higher than the equivalent amount which the assumed Contracting Party will receive from an applicant for a ten year registration or from the holder of a registration for a ten year renewal of that registration.

Therefore, it is very difficult to point out the exact difference of amount of fees between the domestic registration of a Mark in Pakistan and the international registration of a Mark through Madrid Protocol. However, the amount of fee for the international registration of a Mark via Madrid Protocol will definitely be much higher than the amount of fee for the domestic registration of a Mark in Pakistan.

4.4 Upshot of the Questionnaire to Japanese Companies and Interviews of Trademark Attorneys;

4.4.1 Questionnaire to Japanese Companies;

The results of the questionnaire based on the replies of the Japanese Companies are elaborated as under:

I. Questions of IP Rights;
1. All the Japanese Companies are of the view that intellectual property rights are beneficial for a company;
2. 75% of the companies are right holders of 100-300 intellectual property rights;
3. Patents and Trade Marks are the most important IP rights for a small and medium enterprise to grow;
4. 91% of the companies have their own website; and
5. Despite of having their own website, only 17% of the companies have indicated their IP Profile on the website.
II. Questions of Trade Mark Portfolio;

1. 91% of the companies are of the view that Trade Marks are helpful in growing the business of their company;
2. 61% of the companies are right holders of 50-200 Trade Marks;
3. 83% of the companies thinks that the number of Trade Marks owned by their company will increase in future;
4. 78% of the companies register their Trade Marks abroad;
5. 70% of the companies have registered 25-75 Trade Marks in foreign countries;
6. 35% companies have registered their Trade Marks in less than 5 countries, 9% have registered their Trade Marks in less than 10 countries, 9% have registered their Trade Marks in less than 15 countries, 13% have registered their Trade Marks in less than 20 countries, 17% have registered their Trade Marks in more than 20 countries and 17% companies did not reply to the question;
7. 40% companies registered their Trade Marks through Paris Convention route, 30% have registered their Trade Marks via Madrid Protocol route, 13% have registered their Trade Marks by using both routes and 17% did not reply to the question;
8. The number of Trade Marks that are registered abroad by the Japanese Companies before and after the accession of Japan to Madrid Protocol is almost the same;
9. The number of countries in which the Trade Marks are registered by the Japanese Companies before and after the accession of Japan to Madrid Protocol is more or less the same; and
10. In the case of Paris Convention, 74% companies register their Trade Marks in foreign countries through a Trade Mark
Agent (remaining 26% did not reply) whereas in case of Madrid Protocol, 48% companies use the services of a Trade Mark Agent to register the Mark abroad (remaining 52% did not reply).
III. Questions of IP Department;

1. 96% of the companies are of the view that it is in the benefit of a small and medium enterprise to establish an IP department;

2. 70% companies have their own IP department whereas 30% companies don't have an IP department;

3. 57% companies have less than 5 employees in the IP department, 13% have less than 10 employees in the IP department and 30% don't have an IP department as mentioned in point 2; and
4. Most of the companies that have an IP department have the same role that is acquisition, management and maintenance of IP rights, handling of licensing agreements and disputes and search of IP rights of other companies.

IV. Questions of International Treaties;

1. 83% of the companies are familiar with the international treaties to which Japan is a signatory country whereas 17% are not familiar with the international treaties;

2. 66% companies are of the view that the international treaties are helpful to the company, 17% said that the international treaties are not helpful to their company and
17% did not reply to the question as indicated in point 1;

3. 87% companies considers that international treaties like Madrid Protocol, Patent Cooperation Treaty etc. are beneficial for their companies whereas 13% companies said that international treaties are not beneficial for them;

4. 61% companies used international treaties to register their IP rights, 26% did not use the international treaties to register their IP rights and 13% did not reply because they think that international treaties are not beneficial for them as indicated in point 3; and

V. Questions of Madrid Protocol;

1. 79% companies are familiar with the Madrid Protocol, 17% are not acquainted with Madrid Protocol and 4% did not reply to the question;

2. 39% companies used Madrid Protocol for the international registration of Marks, 48% did not used Madrid protocol and 13% did not replied to the question;

3. 39% companies thinks that Madrid Protocol is beneficial for their company, 52% believes that it is not beneficial for their company and 9% did not replied to the question;

4. 39% of the companies thinks that Madrid Protocol is beneficial for their company because of simple procedure, cost effectiveness and subsequent designation;

5. 87% companies said that Government of Japan did not take their viewpoint before acceding to the Madrid Protocol and remaining 13% did not reply to the question;

6. 87% companies said that they did not receive any kind of capacity building and awareness programs from the Government of Japan before or after acceding to the Madrid Protocol and remaining 13% did not reply to the question;

7. 39% companies used Madrid Protocol for the international registration of Marks, 52% did not used Madrid protocol and 9% did not replied to the question;

8. 39% of the companies that used Madrid Protocol for the international registration of Marks have the difficulties of understanding of the system, explanation of designated goods/services, submission of “record of use” and international application is based on domestic application/registration;

9. 57% companies are of the view that the fee structure of the Madrid Protocol is acceptable to their company, 26% said
that it is not acceptable to their company and 17% did not reply to the question;

10. 13% companies said that Paris Convention route is better than the Madrid Protocol route, 61% replied that Paris Convention route is not better than the Madrid Protocol route and 26% did not reply to the question;

11. 13% of the companies said that Paris Convention route is better than the Madrid Protocol route for small number of applications;

12. 17% companies have some know how about the “Central Attack” provision of the Madrid Protocol, 79% did not know about it and 4% did not reply to the question;

13. 14% of the companies said that the provision of “Central Attack” is acceptable to their company, 5% said that it is not acceptable to their company and 81% did not reply to the question; and

14. Companies think that the provision of “Central Attack” is not acceptable to their company due to the negative impression of having loss.

[Pie charts showing the distribution of responses to the questions related to the Paris Convention and Madrid Protocol routes.]

Tokyo, September 2008
4.4.2 Interviews of Trade Mark Attorneys;

Interviews of two Trade Mark Attorneys are conducted that are practicing Madrid Protocol in Japan in order to know their point of view about Madrid Protocol. The upshots of the Interviews of the two Trade Mark Attorneys are discussed as under:

1. Both the Attorneys are of the view that Madrid Protocol has more flexible provisions and more easy procedures as compared to the Madrid Agreement;
2. Both the Attorneys are of the view that Contracting Organizations are made eligible to file an international application in order to broaden the scope of the system;
3. In view of the first Attorney, the main disadvantage of Madrid Protocol is the provision of “Central Attack” whereas the second Attorney is of the view that the main disadvantage of Madrid Protocol is that the burden of the Patent Office will increase;
4. Both the Attorneys are of the view that MM18 form is submitted along with MM2 form when US is designated because it is the requirement of its national legislation and
MM17 form is submitted along with MM2 form, if the applicant has any “Claim of Seniority” in the countries of the European Community;

5. Both the Attorneys are of the view that the submission of different forms like MM18 form with MM2 form is against the harmonization of the system. However, at this stage each country’s national law is different and individual requirements will decrease, when laws of each country are harmonized;

6. Both the Attorneys are of the view that no supplementary and complementary fees are payable when the applicant designates a Contracting Party that fix its own Individual Fee. But, when the Contracting Party requires additional fee for additional classes, the supplementary fee fixed by that Contracting Party for each additional class must also be paid;

7. Both the Attorneys are of the view that the applicant will pay the Individual Fee directly to the International Bureau of WIPO;

8. Both the Attorneys are of the view that the applicant will pay the Supplementary and Complementary Fees directly to the International Bureau of WIPO;

9. Both the Attorneys are of the view that this question may better be asked to JPO or WIPO;

10. Both the Attorneys are of the view that this question may better be asked to JPO or WIPO;

11. Both the Attorneys are of the view that this question may better be asked to JPO or WIPO;

12. Both the Attorneys are of the view that the Individual Fee fixed by a Contracting Party may not be higher than the equivalent amount which the assumed Contracting Party will
receive from an applicant for a ten year registration or from the holder of a registration for a ten year renewal of that registration;

13. In view of the first Attorney, if the local fee for domestic Trade Mark filing is too expensive than the fees required for the international registration of a Mark then such kind of discrepancy can be remedied by fixing an Individual Fee whereas in view of the second Attorney, if the official fee is less than the complementary fee then the Contracting Party should not fix its own Individual Fee and vice versa;

14. Both the Attorneys are of the view that the application will be translated by the International Bureau of WIPO in case where the Office of Origin is using French language and the designated Contracting Party is using English or Spanish language, as the case may be;

15. In view of the first Attorney, the International Registration is dependent on the basic application or registration for the first 5 years probably due to the Article 6quinquies of the Paris Convention whereas in view of the second Attorney this provision comes forward from the Madrid Agreement but the Attorney does not know the reason that why this provision of “Central Attack” is carried forward in the Madrid Protocol;

16. Both the Attorneys are of the view that the Japanese clients enquire about the fees, time and procedure of international registration of a Mark filed through Madrid Protocol. In addition to this, the clients are very much concerned about the description of goods and services;

17. Both the Attorneys have described almost similar practices and processes to handle the international applications filed through Madrid Protocol;
18. Both the Attorneys are of the view that the description of goods and services in the international application is a difficult task for the Attorneys because every Contracting Party has its own interpretations of goods and services;

19. In view of the first Attorney, there is a reduction in the revenues of the Patent firms in Japan after acceding to the Madrid Protocol whereas in view of the second Attorney there is no impact of Madrid Protocol on the revenues of the Patent firms in Japan especially SHIGA International Patent Office;

20. Both the Attorneys are of the view that Madrid Protocol is a very effective system for the Industries because it provides an easy way to protect and manage their IP rights around the globe;

21. Both the Attorneys are of the view that the small and medium enterprises will benefit from the Madrid Protocol because the cost is low and the procedures are much simpler as compared to Paris Convention route;

22. The first Attorney is of the view that this question may better be asked to JPO but the second Attorney is of the view that the most important implication that an Office of Origin will face after accession to Madrid Protocol is the difference between domestic applications and the Madrid Protocol applications. In addition to it, the Office of Origin will have to work in English, French or Spanish language;

23. Both the Attorneys are of the view that a country should accede to Madrid Protocol because it will facilitate its industry especially SMEs to expand their businesses; and

24. In view of the first Attorney, Japanese are still using the Paris Convention route more as compared to the Madrid Protocol route due to the provision of “Central Attack”
whereas the second Attorney is of the view that this is because of the fact that there is very less membership from the Asian countries in the Madrid Protocol and the Japanese Companies have already registered their Marks via Paris Convention route.

4.5 Corollary of the Questionnaire to Japan Patent Office and Interview of the Officials of JPO;

On the basis of the replies given by the International Trade Mark Application Office of the Japan Patent Office, the following parameters are taken in to consideration that will play an important role in the implementation of the operating system of Madrid Protocol in a Trade Mark Office:

4.5.1 Staff Strength and Workload Analysis;

The total staff strength of the Japan Patent Office is 2900. Out of this, 1680 are the Patent Examiners (1190 are regular and 490 are on contract), 52 are Design Examiners, 149 are Trade Mark Examiners, 386 are Appeal Examiners and 633 are Clerical Staff. There are seven departments in the Japan Patent Office, out of which two of the following departments are involved in handling the international applications filed through Madrid Protocol:

1. Trademark, Design and Administrative Affairs Department; and
2. Appeal Department.

There are five divisions in the Trademark, Design and Administrative Affairs Department, out of which two of the following divisions are involved in handling the international applications filed through Madrid Protocol:
1. International Application Division; and
2. Trademark Division.

**International Trade Mark Application Office;**

The International Trade Mark Application Office of JPO is a part of the International Application Division that is responsible for receiving and formality examination of the International Applications both as an Office of Origin and as a designated Contracting Party. This section of JPO has a total staff strength of 12 out of which, 7 are permanent staff, 1 is non-permanent staff and 4 are temporary personnel. The organogram and responsibilities of each officer in the International Trade Mark Application Office of JPO is already given on pages 115-116 of Chapter No. 3.

**Trade Mark Examiners;**

The Trade Mark Examiners are part of the Trademark Division of the Japan Patent Office. The Trade Mark Examiners for Madrid Protocol are separated from the Trade Mark Examiners that deals with the local applications as well as with the international applications filed through the Paris Convention route. There are 19 regular Trade Mark Examiners (including 1 Director and 1 Senior Examiner) and 9 Assistant Trade Mark Examiners that deals only with the international applications filed through Madrid Protocol. So, the total working strength of Examiners for handling the international applications filed via Madrid Protocol is 28. There are 11,794 international applications that are filed through Madrid Protocol in the year 2006 and the number of first actions taken against these international applications by the Trade Mark Examiners is 8,198. Therefore, the number of applications that are examined by each Examiner for Madrid Protocol in the year 2006 is 293 approximately. Whereas, the number of domestic applications that are examined by each examiner in the year
2006 is 936 approximately. This difference in the workload of Mark applications per examiner is due to the fact that the applications filed through Madrid Protocol are in English language as compared to the domestic applications that are filed in Japanese language.

The detail of the international Trade Mark applications in which Japan is the designated Contracting party is given below:\(^{112}\):

<table>
<thead>
<tr>
<th>Year</th>
<th>Applications</th>
<th>First actions</th>
<th>Decisions of registration</th>
<th>Registrations</th>
</tr>
</thead>
<tbody>
<tr>
<td>2002</td>
<td>5,269</td>
<td>6,226</td>
<td>4,194</td>
<td>4,196</td>
</tr>
<tr>
<td>2003</td>
<td>5,334</td>
<td>5,833</td>
<td>4,335</td>
<td>3,708</td>
</tr>
<tr>
<td>2004</td>
<td>7,160</td>
<td>5,754</td>
<td>3,984</td>
<td>3,254</td>
</tr>
<tr>
<td>2005</td>
<td>9,889</td>
<td>7,116</td>
<td>5,386</td>
<td>3,991</td>
</tr>
<tr>
<td>2006</td>
<td>11,794</td>
<td>8,198</td>
<td>5,357</td>
<td>5,240</td>
</tr>
</tbody>
</table>

(Note) The number of first actions indicates the number of first notices of examination results made by examiners — mainly a decision of registration or notification of reasons for refusal — which were sent to International Bureau.


Appeal Examiners;

The Appeal Examiners are part of the Appeal Department of the Japan Patent Office. The Appeal Department in the Japan Patent Office is divided into the 1st Board of Appeals to the 38th Board of Appeals. The appeals against the Trade Mark examinations are handled by the 35th Board of Appeal to 38th Board of Appeal. The Appeal Examiners for Madrid Protocol are separated from the Appeal Examiners that deals with the appeals of local applications as well as with the appeals of the applications filed through the Paris Convention route. However, the Appeal Examiners handling the appeals against Trade Mark Examinations based on international applications filed via Madrid Protocol also handle the appeals against Trade Mark Examinations filed under other domestic application systems. There are 11 regular Appeal Examiners that deals with the appeals of Trade Mark applications filed through Madrid Protocol. The total number of appeals, in the fiscal year 2007, handled by the Appeal Examiners for Madrid Protocol is an average of 14 per examiner (for both appeals

and inter-parties trials). It is evident from the above data that 154 appeals are filed against the Trade Mark examinations based on international applications filed through Madrid Protocol in the year 2007.

4.5.2 Capacity Building Requirements of the Staff;

The most significant problem that is faced by the Japan Patent Office after accession to the Madrid Protocol in terms of capacity building of the staff is the language because there are only three official languages for Madrid Protocol that are English, French and Spanish and JPO has opted for the English language. The mother tongue in Japan is Japanese and it is very necessary for the officers of JPO that are dealing with the international applications filed through Madrid Protocol to have good knowledge about English language. In order to resolve this problem, JPO has tried to line-up those officers who are proficient in English for handling the international applications filed via Madrid Protocol. In addition, JPO encourage their officers to actively attend the English courses run by the National Centre for Industrial Property Information and Training (INPIT) in order to improve their proficiency in this area.

Furthermore, officers that are newly assigned to the section dealing with the Madrid Protocol regularly receives briefings on the summary and the rules of the Madrid Protocol as well as practical work related to the Madrid Protocol from well experienced officers.

4.5.3 Awareness and Support Measures;

The different awareness measures that are taken by the Japan Patent Office after accession to the Madrid Protocol are elaborated as under:
JPO distributes Madrid Protocol related pamphlets through local intellectual property related institutions;

JPO has organized four seminars at four different places of Japan in the fiscal year 2007 in order to create awareness among the public about Madrid Protocol; and

JPO also co-operates with the local intellectual property related institutions to hold lectures (on their request) for dissemination of IP related information;

However, it must be noted that no particular support measure has been provided by the Japan Patent Office to the small and medium enterprises to facilitate them in using the new system of international registration of Marks (Madrid Protocol) because the feedback from the users does not include demand for dedicated support to SMEs.

### 4.5.4 Automation Requirements;

No particular automation is required in connection with the work of the International Trade Mark Application Office both as an Office of Origin and as a designated Contracting Party as well as applications of the system used by the clients.

In Japan Patent Office, E-Filing is available for the domestic applications for Trade Mark registrations but there is no E-Filing is available for the international applications filed through Madrid Protocol. The operations at the International Trade Mark Application Office are currently based on paper. The paperless environment is not yet extended to the International Trade Mark Application Office. The means of communication between JPO and International Bureau of WIPO is through paper documents, facsimile, telephone and E-Mail. JPO also uses electronic dispatching by using an FTP server (File Transfer Protocol used to transfer data from one computer to another through a network such as the internet).
4.5.5 Views of the Stakeholders;

In 1997, Japan Patent Office has conducted an opinion survey covering 760 domestic corporations to know their point of view before acceding to the Madrid Protocol. Out of 760 domestic corporations, responses from 410 corporations have been received. The result of this opinion survey is as under:

- 92.7% of respondents replied positively to the accession;
- 89.8% of respondents expressed their intentions to the accession; and
- 43% of respondents do not have any knowledge about the Madrid Protocol.

In addition to the opinion survey of the domestic corporations, JPO has also requested the Industrial Property Council which consists of representatives from patent attorneys, enterprises and other organizations to deliberate on joining the Madrid Protocol. They have the following two opinions about the Madrid Protocol:

- The system of Madrid Protocol is beneficial for users to protect their trademark rights overseas; and
- Users can enjoy sufficient benefits by Japan’s acceding to Madrid Protocol because it will allow the acquisition of trademark rights in foreign countries through simple and prompt procedures.
RECOMMENDATIONS

I have the following recommendations on the basis of the results of the implemented methodology for the five hypotheses of my research theme:

5.1 First Hypothesis;
1. The domestic Trade Marks legislation must be amended in line with the provisions of the Madrid Protocol;
2. A new Chapter of Madrid Protocol may be added in the domestic Trade Marks law;
3. The rules for the international registration of Marks through Madrid Protocol may be incorporated in the existing rules or separate rules may be prepared; and
4. The legislation of Singapore is simpler as compared to the legislations of Japan and United States of America for giving effect to the provisions of Madrid Protocol in the respective countries.

5.2 Second Hypothesis;
1. Awareness and capacity building of small and medium enterprises is necessary for the maximum utilization of Madrid Protocol;
2. Seminars should be arranged in all the Chambers of Commerce and Industry to disseminate the information of Madrid Protocol;
3. Surveys should be conducted to know the point of view of the small and medium enterprises and other stakeholders before acceding to Madrid Protocol; and
4. There should be an Intellectual Property Training Centre at
the national level who has the capacity to educate all the persons that are related to the field of IP.

5.3 Third Hypothesis;
1. The Fees for the international registration of a Mark should be reduced for the developing countries to widen the scope of the system;
2. The Government of a developing country may provide some kind of financial assistance to the SMEs for facilitating them to register their Marks abroad; and
3. The country who wants to accede to Madrid Protocol may fix its own Individual Fee as most of the members of Madrid Protocol receive an Individual Fee instead of receiving a share from the supplementary and complementary fees from WIPO.

5.4 Fourth Hypothesis;
1. Acquisition of intellectual property rights is very important for a small and medium enterprise to grow;
2. The maintenance of IP Profile on the websites of the companies will help them to win the trust of the clients;
3. Patents, Trade Marks and Industrial Designs are the most important IP forms for the development of an SME;
4. The registration of Marks through Madrid Protocol is far more easier as compared to the Paris Convention;
5. Every company should establish a separate IP department for the management of its IP rights;
6. The staff of the IP department must be well conversant with the domestic registration procedures of different forms of IP as well as with the international treaties for the registration of IP rights in the world;
7. The international treaties can play an important role in the growth of the local industry provided that the local industry is well aware of the importance of their IP rights;

8. The fee structure of Madrid Protocol may be acceptable for the SMEs of a developed country but it is higher for the SMEs of a developing country;

9. The requirement of different countries for the registration of a Mark should be harmonized in order to facilitate the user of the system;

10. The description of goods and services in the international application is the most difficult task because every country has its own interpretation of the goods and services although they are following the Nice Classification of Goods and Services; and

11. The problem of description of goods and services is also becomes more significant due to difference in the language of Madrid Protocol (English, French or Spanish) with that of the national language of the Country.

5.5 Fifth Hypothesis.

1. There should be a separate section in the Trade Marks Registry that deals with the international applications filed through Madrid Protocol;

2. The Trade Mark Examiners for international applications filed through Madrid Protocol should be separated from the Trade Mark Examiners dealing with the domestic applications;

3. Capacity Building of the Trade Mark Examiners dealing with the international applications in terms of the rules and regulations of Madrid Protocol, language, computer literacy etc. is necessary before acceding to Madrid Protocol;
4. There should be no backlog in the Trade Marks Registry in order to reduce the chances of failure of the system;

5. E-Filing is not a pre-requisite for acceding to Madrid Protocol but it facilitates the applicants to use the system;

6. The Trade Marks Registry should have an effective system of electronic communication with the International Bureau of WIPO; and

7. Madrid Protocol will work more efficiently in Post-Registration Opposition system as compared to Pre-Registration Opposition system.
TRADEMARK LAW OF JAPAN

(Law No. 127 of April 13, 1959, as amended by Law No. 220 of December 22, 1999)

CHAPTER VIIbis

SPECIAL PROVISIONS UNDER THE PROTOCOL OF THE MADRID AGREEMENT

1. Application for International Registration

(Application for International Registration)

68bis.- (1) A Japanese national or an alien who is domiciled or resident (or, in the case of a legal entity, established) in Japan, who desires to seek an international registration (hereinafter referred to as "the international registration") as referred to in Article 2(1) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as adopted at Madrid on June 27, 1989 (hereinafter referred to as "the Protocol"), shall file with the Commissioner of the Patent Office an application (hereinafter referred to as "international application"), as referred to in Article 2(2) of the Protocol, based on either one of the following paragraphs. In such a case, where it complies with the requirement specified in an ordinance of the Ministry of Economy, Trade and Industry, two or more persons may make a joint international application:

(i) their application for trademark registration or for defensive mark registration pending with the Patent Office
(hereinafter referred to as "application for trademark registration, etc.");

(ii) their trademark registration or defensive mark registration (hereinafter referred to as "trademark registration, etc.").

(2) Any person desiring to file an international application shall submit the form prescribed by the Registrations under the Protocol (hereinafter in this Chapter referred to as "the request and necessary documents") prepared in a foreign language, as provided for in an ordinance of the Ministry of Economy, Trade and Industry.

(3) The following particulars shall be indicated in the request:

(i) the names of the Contracting States of the Protocol for which the protection of the trademarks relating to the international application is sought;

(ii) the goods or services in respect of which protection of the mark relating to the international application is sought, and the class or classes of the classification prescribed by Cabinet Order in Section 6(2).

(4) Any person desiring to seek the application of Article 3(3) of the Protocol for trademarks or marks relating to the international application shall indicate in the request a statement to that effect and a description of the color or the combination of colors affixed, and also shall append to the request copies in color of the trademarks or marks or of the registered trademarks or registered defensive marks relating to the application for trademark registration, etc.

68ter.- (1) The Commissioner of the Patent Office shall transmit the request of the international application and necessary documents to
the International Bureau as referred to in Article 2(1) of the Protocol (hereinafter referred to as "the International Bureau").

(2) In the case of the preceding subsection, the Commissioner of the Patent Office shall certify that the particulars appearing in the international application correspond to the particulars appearing in the basic application, etc. or in the basic registration, etc. and also indicate the date of the international application.

(3) In the case of Subsection (1), the Commissioner of the Patent Office shall transmit to the applicant for the said international application a copy of the request of the international application transmitted to the International Bureau.

(Later Designation)

68quater. As provided for in an ordinance of the Ministry of Economy, Trade and Industry, the holder of international registration may present a request for territorial extension to the Commissioner of the Patent Office under Article 3ter of the Protocol (hereinafter referred to as "the later designation").

(Request for Renewal of International Registration)

68quinquies. As provided for in an ordinance of the Ministry of Economy, Trade and Industry, the holder of international registration may present a request for renewal of his international registration to the Commissioner of the Patent Office under Article 7(1) of the Protocol (hereinafter referred to as "the renewal of the international registration").
(Request for Recordal of Change in the Ownership of International Registration)

68sexies.- (1) As provided for in an ordinance of the Ministry of Economy, Trade and Industry, the holder of international registration or his assignee may present a request for the recordal of change in the ownership of the international registration to the Commissioner of the Patent Office under Article 9 of the Protocol (hereinafter referred to as "the change in the ownership of the international registration").

(2) The request as referred to in the preceding subsection may be made in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods or services listed in the registration.

(Application mutatis mutandis of Provisions on Application for Trademark Registration)

68septies. Sections 17(3) (limited to the proportion relating to Paragraph (iii)) and 18(1) of the Patent Law as applied under Section 77(2) of this Law shall apply mutandis to the international application, the later designation, the request for the renewal of international registration and the request for the recordal of change in the ownership of international registration.

(Delegation to Ordinance of the Ministry of Economy, Trade and Industry)

68octies. In addition to the matters provided for in Sections 68bis to 68septies, necessary details for implementing the Protocol and the Regulations there under shall be provided for in an ordinance of the Ministry of Economy, Trade and Industry, relating to the international application, the later designation, the request for the renewal of international registration and the request for the recordal of change in the ownership of international registration.
2. **Special Provisions Relating to Application for International Registration**

*(Trademark Application Based on Request for Territorial Extension)*

**68movies.- (1)** A request for territorial extension with respect to Japan shall be considered to be an application for trademark registration having been filed on the date of international registration made in accordance with Article 3(4) of the Protocol (hereinafter referred to as "the date of international registration"). However, in the case of later designation, under Article 3 ter (2) of the Protocol, the application for trademark registration shall be considered to be the application having been filed on the date (hereinafter referred to as "the date of later designation") on which later designation is recorded in the register of the International Register defined in Article 2(1).

**2** The matters specified in the left-hand column of the following table contained in the International Register of the international registration with respect to Japan shall be considered to be the matters specified in the right-hand column of the following table stated in the request of application for trademark registration filed under Section 5(1):

<table>
<thead>
<tr>
<th>The name and the domicile of the holder of the international registration</th>
<th>The name and the domicile or residence of the applicant for a trademark registration</th>
</tr>
</thead>
<tbody>
<tr>
<td>The mark registered in the International Register</td>
<td>The mark for which registration is sought</td>
</tr>
<tr>
<td>The goods or services listed in the international registration and the class of the classification of goods or services</td>
<td>The designated goods or designated services and the class of the classification of goods or services as prescribed by Cabinet Order referred to in Section 6(2)</td>
</tr>
</tbody>
</table>
(Special Provisions for Time of Filing of Application for International Trademark Registration)

68decies-(1) Where a registered trademark (hereinafter in this Section referred to as "the registered trademark based on international registration") relating to the request for territorial extension considered to be an application for trademark registration under 68novies(1) (hereinafter in this Chapter referred to as "the application for international trademark registration") is identical with a trademark prior to the trademark registration (excluding trademarks based on international registration; hereinafter in this Section referred to as "the registered trademark based on national registration"), and the designated goods or designated services relating to the registered trademark based on international registration are the same as the designated goods or designated services relating to the registered trademark based on the national registration, and also where the trademark holder of the registered trademark based on the international registration and the trademark holder of registered trademark based on the national registration are identical, the application for international trademark registration shall be deemed to have been made to the extent that such scope has overlapped on the date of the application for trademark registration relating to the registered trademark based on the national registration.

(2) Section 68duotrices (3) and (4) shall apply mutatis mutandis to the application for international trademark registration in the preceding subsection.

(Special Provisions for Time of Filing of Application)

68undecies. For the purpose of Section 9(2) for the application international trademark registration, "simultaneously with the
trademark application" in Section 9(2) shall read "within 30 days from the date of filing of the application for international trademark registration".

(Special Provisions for Division of Applications)

68duodecies. Section 10 shall not apply to applications for international trademark registration.

(Special Provisions for Conversion of Applications)

68terdecies. Sections 11 and 65 shall not apply to applications for international trademark registration.

(Special Provisions for Matters Published in Trademark Gazette Relating to Publication of Applications)

68quater decies. For the purpose of Section 12bis(2) for to applications for international trademark registration, "the number and date of application for trademark registration" in Section 12bis(2) (ii) shall read "the number of the international registration and the date of the international registration (in the case of international trademark registration relating to late designation, the date of later designation)".

(Special Provisions for Proceedings for Priority Claim under the Paris Convention, etc.)

68quindecies.- (1) Section 43(1) to (4) of the Patent Law, as applied under Section 13(1) of this Law shall not apply to the applications for international trademark registration.

(2) For the purpose of Section 43(1) of the Patent Law, as applied under Section 43bis (3) of the said Law as applied under Section 13(1) of this Law for applications for international trademark registration,
"simultaneously with the patent application" in the said Section 43(1) shall read "within 30 days from the date of filing of the application for international trademark registration".

(Special Provisions for Rights Resulting from Applications for Trademark Registration)

68sedecies.- (1) For the purpose of Section 34(4) of the Patent Law, as applied under Section 13(2) of this Law for applications for international trademark registration, "the Commissioner of the Patent Office except in the case of inheritance or other general succession" in Section 34(4) of the Patent Law shall read "the International Bureau".

(2) Section 34(5) to (7) of the Patent Law as applied under Section 13(2) of this Law shall not apply to the applications for international trademark registration.

(Dealing with Applications for International Trademark Registration Resulting from Change in the Ownership of an International Registration)

68septies decies. Where all or some goods or services listed in the international registration has been divided and assigned resulting from change in the ownership of an international trademark registration, the application for international trademark registration shall be considered to have become applications for trademark registration with respect to each of holder after the change.

(Special Provisions for New Application for Trademark as Amended)

68duodevicies.- (1) Section 17(3) of the Design Law as applied under Section 17bis (1) or Section 55bis(3) (including its application under Section 60bis(2)) of this Law shall not apply to the applications for international trademark registration.
(2) Section 17(4) of the Design Law, as applied under Section 17bis(2) of this Law shall not apply to the applications for international trademark registration.

(Special Provisions for Registration of Establishment of Trademark Right)

68undevicies.- (1) For the purpose of Section 18(2) for applications for international trademark registration, "when the registration fee under Section 40(1) or the registration fee due to be paid within 30 days from the date of the transmittal of the examiner's decision or the trial decision that the trademark is to be registered under Section 41bis(1) has been paid" in Section 18(2) shall read "when the examiner's decision or the trial decision that the trademark is to be registered has been rendered".

(2) For the purpose of Section 18(3) for applications for international trademark registration, "the number and date of the application for trademark registration" in Section 18(3)(ii) shall read "the number of the international registration and the date of the international registration (the date of later designation in the case of the application for international trademark registration with respect to the later designation," and "the registration number and date of the registration of the establishment" in Section 18(3)(v) shall read "the number of the international registration and the date of the registration of the establishment".

(Effects of Extinguishment of International Registration)

68vicies.- (1) Where all or some of the international registration on which it is based has been extinguished, application for international trademark registration shall be deemed to have been withdrawn to
the extent all or some of the designated goods or designated services has been extinguished.

(2) Where all or some of the international registration on which it is based has been extinguished, the trademark right which has been granted the registration of the establishment under Section 18(2) as applied under Section 68undevicies (1) (hereinafter referred to as "the trademark right based on the international registration") shall be deemed to have been extinguished to the extent that all or some of the designated goods or designated services has been extinguished.

(3) The effects under the preceding two subsections shall come into force from the date on which the international registration in the International Register has been extinguished.

(Term of Trademark Right Based on International Registration)

68undevicies.- (1) The term of a trademark right based on the international registration shall be ten years from the date (the date of its latest renewal, if the term of international registration has been renewed prior to the registration of the establishment of the trademark right) of the international registration.

(2) The term of the trademark right based on the international registration may be renewed on the renewal of the term of the international registration.

(3) When the term of the international registration has been renewed, the term of the trademark right based on international registration shall be deemed to have been renewed upon expiration of the term.

(4) When the term of the international registration has not been renewed, the trademark right based on international registration shall
be deemed to have been extinguished retroactively from the time of
the expiration of the term.

(Special Provisions for Registration of Renewal of Term)

68duovicies-(1) Sections 19 to 22 and 23(1) and (2) shall not apply
to the trademark rights based on the international registration.

(2) For the purpose of Section 23(3) for the trademark rights based
on the international registration, "registration in the preceding two
subsections" in Section 23(3) shall read "the renewal of the term of
international registration," and "the number of registration and the
date of the registration of renewal" in Section 23(3)(ii) shall read "the
number of international registration and the date of renewal of the
term of international registration".

(Special Provisions for Division of Trademark Rights)

68tervicies. Section 24 shall not apply to the trademark rights based
on the international registration.

(Special Provisions for Transfer of
Collective Trademark Right)

68quater vicies-(1) The collective trademark right trademark
rights based on the international registration may not be transferred,
except in the case where the documents prescribed in Section 7(3)
are submitted.

(2) Section 24(3) shall not apply to the trademark rights based on
international registration.
(Special Provisions for Surrender of Trademark Rights)

68quinvicies.- (1) The owner of the trademark rights based on the international registration may surrender his trademark rights.

(2) Section 97(1) of the Patent Law as applied under Section 35 of this Law shall not apply to the trademark rights based on the international registration.

(Special Provisions for Effects of Registration of Trademark Rights)

68sevicies.- (1) The transfer, extinguishment by surrender or restriction on disposal of the trademark rights based on the international registration shall be of no effect unless it is registered.

(2) Section 98(1)(i) and (2) of the Patent Law as applied under Section 35 of this Law shall not apply to the trademark rights based on the international registration.

(Special Provisions for Registration in Trademark Register)

68septies vicies.- (1) For the purpose of Section 71(1)(i) for the trademark rights based on the international registration, "the establishment, renewal of term, division, transfer, change, extinguishment, restoration or restriction on the disposal of trademark rights" in Section 71(1)(i) shall read "the establishment or the restriction on disposal of trademark rights".

(2) With respect to the renewal, transfer, change or extinguishment of the trademark rights based on the international registration, the entry in the International Register shall prevail.
(Special Provisions for Amendments of Proceedings)

**68duodetricies**-(1) For the purpose of applications for the international trademark registration, amendments for the designated goods or designated services stated in the request or for the trademark for which trademark registration is sought, can be made, only within a designated time limit, in accordance with Section 15bis [including its application under Section 55bis(1) (including its application under Section 60bis(2))] or of Section 15ter [including its application under Section 55bis(1) (including its application under Section 60bis(2))].

(2) Section 68quadragies shall not apply to the applications for the international trademark registration.

(Special Provisions for Exceptional Provisions on Trademark with Two or More Designated Goods or Designated Services)

**68undetricies.** For the purpose of Section 69 for the trademark rights based on the international registration, "Sections 97(1) or 98(1)(i) of the Patent Law as applied under Sections 20(4), 33(1) and 35 of this Law" in Section 69 shall read "Sections 33(1), 68quinvicies(1) or 68sevicies(1)" and "Section 71(1)(i)" in Section 69 shall read "Sections 71(1)(i), 68septies vicies (2) as applied under Section 68septies vicies (1)".

(Individual fee for Trademark Rights Based on International Registration)

**68tricies.**-(1) Any person desiring the registration of the establishment of trademark rights based on the international registration shall pay, in advance of the international registration, to the International Bureau an individual fee, as prescribed in Article 8(7)(a) of the Protocol (hereinafter referred to as "the individual fee"),
in the sum amounting to ¥4,800 per case plus 81,000 yen for each 
class of the classification of goods and services.

(2) Any person desiring to renew the term of the trademark rights 
based on the international registration shall pay to the International 
Bureau the individual fee in the sum amounting to ¥151,000 per case 
multiplied by the number of the classification.

(3) Sections 40 to 43 and 76(2) (limited to the proportion specified in 
the Attached Table 1) shall not apply to the applications for the 
international trademark registration and to the trademark rights 
based on the international registration.

(Delegation to Ordinance of the Ministry 
of Economy, Trade and Industry)

68untricies. In addition to the matters provided for in Sections 
68novies to 68tricies, necessary details for implementing the Protocol 
and the Regulations there under shall be provided for in an ordinance 
of the Ministry of Economy, Trade and Industry.

3. Special Provisions for Applications for Trademark 
Registration, etc. Special Provisions 
for Trademark Registration

(Subsequent to Cancellation of International Registration)

68duotricies.- (1) Where the international registration is cancelled 
under Article 6(4) of the Protocol in respect of all or some of the goods 
and services listed in the said registration, the person who was the 
holder of international registration, may file an application for the 
registration of the same mark which was registered in the
International Register with respect to Japan in respect of all or some of the said goods or services.

(2) The application for the trademark registration under the preceding subsection shall be deemed to have been filed on the date of international registration as referred to in the said subsection (in the case of the international registration as referred to in the said subsection in respect of subsequent designation, the date of said subsequent designation) provided that the said application falls under any one of the following paragraphs:

(i) such application in the preceding subsection is filed within three months from the date on which the international registration as referred to in the preceding subsection was cancelled;

(ii) the trademark of which registration is sought is identical with the trademark in respect of such international registration in the preceding subsection;

(iii) the designated goods or the designated services in respect of such application are in fact covered by the list of goods and services contained in such international registration in the preceding subsection.

(3) Where the international registration as referred to in Subsection (1) enjoyed the right of priority provided for by Article 4 of the Paris Convention, that application under Subsection (1) shall enjoy the same right of priority.

(4) The preceding subsection shall also apply, where the priority was enjoyed under Section 43bis(2) of the Patent Law as applied under Section 9ter or 13(1) of this Law for the application for international
trademark registration in respect of the international registration as referred to in Subsection (1).

(5) For the purpose of Section 10(1) with respect to the application for trademark registration under Subsection (1), "a part of his application for trademark registration" in Section 10(1) shall read "a part of his application for trademark registration (limited to the goods and services covered by the list of goods and services contained in the international registration as referred to in Section 68duotrices(1))."

(Special Provisions for Application for Trademark Registration Subsequent to Denunciation of Protocol)

68tertricies.(1) Where the holder of the international registration having effect in Japan at the date on which the denounciation under Article 15(5)(b) of the Protocol becomes effective, who, because of the denounciation, is no longer entitled to file the international application under Article 2(1) of the Protocol, may file an application for trademark registration for the goods or services listed in the said international registration.

(2) Section 68duotrices(2) to (5) shall apply mutatis mutandis to the application for trademark registration under the preceding subsection. In such a case, "within three months from the date on which the international registration in the preceding subsection was cancelled" in Section 68duotrices(2)(i) shall read "within two years from the date on which the denounciation under Article 15(3) of the Protocol took effect".

(Special Provisions for Reasons for Refusal)

68quater tricies.(1) For the purpose of Section 15 for the application for trademark registration under Section 68duotrices(1),
"where it falls under any of the following paragraphs" in Section 15 shall read "where it falls under any of the following paragraphs, or where the application for trademark registration under Section 68duotricies(1) or 68tertricies(1) dose not comply with the requirements of Section 68duotricies(1) or 68tertricies(2) (including its application as applied under Section 68tertricies(2))".

(2) Section 15 (limited to the proportion for Paragraphs (i) and (ii)) shall not apply to the application for trademark registration under Section 68duotricies(1) or 68tertricies(1) relating to the trademark right based on the international registration (referred to as "re-filing of trademark right relating to former international registration" in Sections 68septies tricies and 68undequadragies).

(Special Provisions for Registration of Establishment of Trademark Right)

68quintricies. Notwithstanding Section 18(2), the establishment of trademark right shall be registered for the application for trademark registration under Section 68duotricies(1) or 68tertricies(1), where the examiner's decision or trial decision has been made to the effect that the trademark is to be registered within ten years from the date of international registration relating to the said application (the date of its latest renewal, where the renewal of the term of said international registration has been made).

(Special Provisions for Term)

68setricies.-(1) The term of trademark right as referred to in Section 68quintricies shall be ten years from the date of international registration relating to the said application (the date of its latest renewal, where the renewal of said international registration has been made).
(2) Section 19(1) shall not apply to the term of trademark right referred to in Section 68setricies.

(Special Provisions for Opposition to Registration)

68septies tricies. For the purpose of Section 43bis for the trademark registration made in consequence of the re-filling of the application for trademark right from the former international registration, "trademark registration" in Section 43bis shall read "trademark registration (excluding the trademark registration made in consequence of the re-filling of the application for trademark right from the former international registration for which the term prescribed under this Section has expired without having any opposition raised to the trademark registration relying on the former international registration)".

(Special Provisions for Trial for Invalidation of Trademark Registration)

68duodequadragies. For the purpose of the trial in Section 46(1) for the trademark registration relating to the application for trademark registration under Section 68duotricies(1) or 68tertricies(1), "In the following cases" in Section 46(1) shall read "In the following cases, or in the case where the trademark registration has been effected contrary to Section 68duotricies(1), 68tertricies(1) or each paragraph of Section 68duotricies(2) (including its application under Section 68tertricies(2))".

68undequadragies. For the purpose of Section 47 for the trademark registration for the re-filing of the application for the registration of trademark right based on any former international registration "may not be demanded". In Section 47 shall read "may not be demanded. The same shall apply prior to the expiration of five years from the date

Tokyo, September 2008
of registration of the establishment of the trademark right, with respect to the trademark registration relating to re-filing of the application for trademark right relating to former international registration, when it has become impossible to make a demand for trial under Section 46(1) with respect to the trademark registration from the former international registration".
PART VII of TRADE MARKS ACT 1998 of SINGAPORE

INTERNATIONAL MATTERS
The Madrid Protocol etc.

Power to Make Provision Giving Effect to Madrid Protocol, etc.

54.- (1) The Minister may make rules to give effect in Singapore to the provisions of the Madrid Protocol or of any treaty, convention, arrangement or engagement relating to trade marks to which Singapore is a party.

(2) Rules may, in particular, be made to provide for-

(a) The making of applications for international registrations by way of the Registry as office of origin;

(b) The procedures to be followed where the basic Singapore application or registration fails or ceases to be in force;

(c) The procedures to be followed where the Registry receives from the International Bureau or any body specified in the rules a request for extension of protection to Singapore;

(d) The effects of a successful request for extension of protection to Singapore;

(e) The transformation of an application for an international registration, or an international registration, into a national application for registration;
(f) The communication of information to the International Bureau; and

(g) The payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.

(3) Provision may also be made in the rules to apply in relation to an international trade mark (Singapore) the provisions of section 35 and Parts VI and X.

(4) For the purposes of this section-

"International Bureau" has the meaning given by Article 2 (1) of the Madrid Protocol;

"International trade mark (Singapore)" means a trade mark which is entitled to protection in Singapore under the Madrid Protocol or a trade mark prescribed by the Minister as an international trade mark (Singapore);

"Madrid Protocol" means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989, as revised or amended from time to time.
TITLE 15 OF THE UNITED STATES CODE

Title 15 of the United States Code outlines the role of the commerce and trade in the United States Code. There are total 103 chapters in the Title 15 of the United States Code and chapter 22 is the Trade Marks Act (Lanham Act). There are 4 sub-chapters of the Trade Marks Act and sub-chapter-IV deals with the Madrid Protocol.

THE MADRID PROTOCOL

§ 1141. Definitions

In this subchapter:

(1) **Basic application**

The term “basic application” means the application for the registration of a mark that has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

(2) **Basic registration**

The term “basic registration” means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

(3) **Contracting Party**

The term “Contracting Party” means any country or inter-governmental organization that is a party to the Madrid Protocol.
(4) **Date of recordal**

The term “date of recordal” means the date on which a request for extension of protection, filed after an international registration is granted is recorded on the International Register.

(5) **Declaration of bona fide intention to use the mark in commerce**

The term “declaration of bona fide intention to use the mark in commerce” means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that—

(A) the applicant or holder has a bona fide intention to use the mark in commerce;

(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and

(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

(6) **Extension of protection**

The term “extension of protection” means the protection resulting from an international registration that extends to the United States at the request of the holder of the international registration, in accordance with the Madrid Protocol.
(7) **Holder of an international registration**

A “holder” of an international registration is the natural or juristic person in whose name the international registration is recorded on the International Register.

(8) **International application**

The term “international application” means an application for international registration that is filed under the Madrid Protocol.

(9) **International Bureau**


(10) **International Register**

The term “International Register” means the official collection of data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded.

(11) **International registration**

The term “international registration” means the registration of a mark granted under the Madrid Protocol.

(12) **International registration date**

The term “international registration date” means the date assigned to the international registration by the International Bureau.

(13) **Madrid Protocol**

The term “Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, Spain, on June 27, 1989.
(14) **Notification of refusal**

The term “notification of refusal” means the notice sent by the United States Patent and Trademark Office to the International Bureau declaring that an extension of protection cannot be granted.

(15) **Office of a Contracting Party**

The term “Office of a Contracting Party” means—

(A) the office, or governmental entity, of a Contracting Party that is responsible for the registration of marks; or

(B) the common office, or governmental entity, of more than 1 Contracting Party that is responsible for the registration of marks and is so recognized by the International Bureau.

(16) **Office of origin**

The term “office of origin” means the Office of a Contracting Party with which a basic application was filed or by which a basic registration was granted.

(17) **Opposition period**

The term “opposition period” means the time allowed for filing an opposition in the United States Patent and Trademark Office, including any extension of time granted under section 1063 of this title.

**§ 1141a. International applications based on United States applications or registrations**

(a) **In general**

The owner of a basic application pending before the United States Patent and Trademark Office, or the owner of a basic...
registration granted by the United States Patent and Trademark Office may file an international application by submitting to the United States Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Director.

(b) Qualified owners

A qualified owner, under subsection (a) of this section, shall—

(1) be a national of the United States;
(2) be domiciled in the United States; or
(3) have a real and effective industrial or commercial establishment in the United States.

§ 1141b. Certification of the international application

(a) Certification procedure

Upon the filing of an application for international registration and payment of the prescribed fees, the Director shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification.

(b) Transmittal

Upon examination and certification of the international application, the Director shall transmit the international application to the International Bureau.
§ 1141c. Restriction, abandonment, cancellation, or expiration of a basic application or basic registration

With respect to an international application transmitted to the International Bureau under section 1141b of this title, the Director shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration—

(1) within 5 years after the international registration date; or
(2) more than 5 years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.

§ 1141d. Request for extension of protection subsequent to international registration

The holder of an international registration that is based upon a basic application filed with the United States Patent and Trademark Office or a basic registration granted by the Patent and Trademark Office may request an extension of protection of its international registration by filing such a request—

(1) directly with the International Bureau; or
(2) with the United States Patent and Trademark Office for transmittal to the International Bureau, if the request is in such form, and contains such transmittal fee, as may be prescribed by the Director.
§ 1141e. Extension of protection of an international registration to the United States under the Madrid Protocol

(a) In general

Subject to the provisions of section 1141h of this title, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.

(b) If the United States is office of origin

Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.

§ 1141f. Effect of filing a request for extension of protection of an international registration to the United States

(a) Requirement for request for extension of protection

A request for extension of protection of an international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.

(b) Effect of proper filing

Unless extension of protection is refused under section 1141h of this title, the proper filing of the request for extension of protection under subsection (a) of this section shall constitute constructive use
of the mark, conferring the same rights as those specified in section 1057 (c) of this title, as of the earliest of the following:

(1) The international registration date, if the request for extension of protection was filed in the international application.

(2) The date of recordal of the request for extension of protection, if the request for extension of protection was made after the international registration date.

(3) The date of priority claimed pursuant to section 1141g of this title.

§ 1141g. Right of priority for request for extension of protection to the United States

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if—

(1) the request for extension of protection contains a claim of priority; and

(2) the date of international registration or the date of the recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).
§ 1141h. Examination of and opposition to request for extension of protection; notification of refusal

(a) Examination and opposition

(1) A request for extension of protection described in section 1141f (a) of this title shall be examined as an application for registration on the Principal Register under this chapter, and if on such examination it appears that the applicant is entitled to extension of protection under this subchapter, the Director shall cause the mark to be published in the Official Gazette of the United States Patent and Trademark Office.

(2) Subject to the provisions of subsection (c) of this section, a request for extension of protection under this subchapter shall be subject to opposition under section 1063 of this title.

(3) Extension of protection shall not be refused on the ground that the mark has not been used in commerce.

(4) Extension of protection shall be refused to any mark not registrable on the Principal Register.

(b) Notification of refusal

If a request for extension of protection is refused under subsection (a) of this section, the Director shall declare in a notification of refusal (as provided in subsection (c) of this section) that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal was based.

(c) Notice to International Bureau

(1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the
Director shall transmit to the International Bureau any of the following that applies to such request:

(A) A notification of refusal based on an examination of the request for extension of protection.

(B) A notification of refusal based on the filing of an opposition to the request.

(C) A notification of the possibility that an opposition to the request may be filed after the end of that 18-month period.

(2) If the Director has sent a notification of the possibility of opposition under paragraph (1)(C), the Director shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.

(3) If a notification of refusal of a request for extension of protection is transmitted under paragraph (1) or (2), no grounds for refusal of such request other than those set forth in such notification may be transmitted to the International Bureau by the Director after the expiration of the time periods set forth in paragraph (1) or (2), as the case may be.

(4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not
be refused and the Director shall issue a certificate of extension of protection pursuant to the request.

(d) **Designation of agent for service of process**

In responding to a notification of refusal with respect to a mark, the holder of the international registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation filed. If the person designated cannot be found at the address given in the last designation, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.

§ 1141i. **Effect of extension of protection**

(a) **Issuance of extension of protection**

Unless a request for extension of protection is refused under section 1141h of this title, the Director shall issue a certificate of extension of protection pursuant to the request and shall cause notice of such certificate of extension of protection to be published in the Official Gazette of the United States Patent and Trademark Office.

(b) **Effect of extension of protection**

From the date on which a certificate of extension of protection is issued under subsection (a) of this section—
(1) such extension of protection shall have the same effect and validity as a registration on the Principal Register; and

(2) the holder of the international registration shall have the same rights and remedies as the owner of a registration on the Principal Register.

§ 1141j. Dependence of extension of protection to the United States on the underlying international registration

(a) Effect of cancellation of international registration

If the International Bureau notifies the United States Patent and Trademark Office of the cancellation of an international registration with respect to some or all of the goods and services listed in the international registration, the Director shall cancel any extension of protection to the United States with respect to such goods and services as of the date on which the international registration was canceled.

(b) Effect of failure to renew international registration

If the International Bureau does not renew an international registration, the corresponding extension of protection to the United States shall cease to be valid as of the date of the expiration of the international registration.

(c) Transformation of an extension of protection into a United States application

The holder of an international registration canceled in whole or in part by the International Bureau at the request of the office of origin, under article 6(4) of the Madrid Protocol, may file an application, under section 1051 or 1126 of this title, for the registration of the same mark for any of the goods and services to which the cancellation applies that were covered by an extension of protection to the United
States based on that international registration. Such an application shall be treated as if it had been filed on the international registration date or the date of recordal of the request for extension of protection with the International Bureau, whichever date applies, and, if the extension of protection enjoyed priority under section 1141g of this title, shall enjoy the same priority. Such an application shall be entitled to the benefits conferred by this subsection only if the application is filed not later than 3 months after the date on which the international registration was canceled, in whole or in part, and only if the application complies with all the requirements of this chapter which apply to any application filed pursuant to section 1051 or 1126 of this title.

§ 1141k. Affidavits and fees

(a) Required affidavits and fees

An extension of protection for which a certificate of extension of protection has been issued under section 1141i of this title shall remain in force for the term of the international registration upon which it is based, except that the extension of protection of any mark shall be canceled by the Director—

(1) at the end of the 6-year period beginning on the date on which the certificate of extension of protection was issued by the Director, unless within the 1-year period preceding the expiration of that 6-year period the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) of this section together with a fee prescribed by the Director; and
(2) at the end of the 10-year period beginning on the date on which the certificate of extension of protection was issued by the Director, and at the end of each 10-year period thereafter, unless—

(A) within the 6-month period preceding the expiration of such 10-year period the holder of the international registration files in the United States Patent and Trademark Office an affidavit under subsection (b) of this section together with a fee prescribed by the Director; or

(B) within 3 months after the expiration of such 10-year period, the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) of this section together with the fee described in subparagraph (A) and the surcharge prescribed by the Director.

(b) Contents of affidavit

The affidavit referred to in subsection (a) of this section shall set forth those goods or services recited in the extension of protection on or in connection with which the mark is in use in commerce and the holder of the international registration shall attach to the affidavit a specimen or facsimile showing the current use of the mark in commerce, or shall set forth that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.
(c) **Notification**

The Director shall notify the holder of the international registration who files 1 of the affidavits of the Director’s acceptance or refusal thereof and, in case of a refusal, the reasons therefore.

(d) **Service of notice or process**

The holder of the international registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person so designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation so filed. If the person designated cannot be found at the address given in the last designation, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.

§ 1141l. **Assignment of an extension of protection**

An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.

§ 1141m. **Incontestability**

The period of continuous use prescribed under section 1065 of this title for a mark covered by an extension of protection issued
under this subchapter may begin no earlier than the date on which the Director issues the certificate of the extension of protection under section 1141i of this title, except as provided in section 1141n of this title.

§ 1141n. Rights of extension of protection

When a United States registration and a subsequently issued certificate of extension of protection to the United States are owned by the same person, identify the same mark, and list the same goods or services, the extension of protection shall have the same rights that accrued to the registration prior to issuance of the certificate of extension of protection.
ANNEX-IV

QUESTIONNAIRE
(Japanese Companies particularly SMEs)

By:
Asfand Ali
Assistant Director
IPO-Pakistan
(asfandch27@gmail.com)

Respondent’s Information:
Full Name:
Position:
Department:

Company’s Profile:
Name of the Company:
Industrial Field:
Annual Turnover:
Number of Employees:

1. Questions of IP Rights:

1. What do you think that intellectual property rights are beneficial for your company?
   ○ Yes ○ No

2. If the answer to the above question is YES then how many intellectual property rights are owned by your company?
   ○ Less than 5 ○ Less than 10
   ○ Less than 15 ○ Less than 20
   ○ Any other answer: _________________________________________

3. What do you think which is the most important intellectual property right for a small and medium enterprise to grow? You can select more than one option.
   ○ Patents ○ Utility Models ○ Trademarks

Tokyo, September 2008
WIPO Six Months Study-cum-Research Fellowship
(April – September, 2008)

O Copyrights O Industrial Designs O Geographical Indications
O Lay-out Designs of Integrated Circuits O All of the above

4. Is your company has its own website?
   O Yes O No

5. If the answer to the above question is YES then whether the company has given it’s IP Profile (the number of IP rights that is owned by the company) on the website or not?
   O Yes O No

II. Questions of Trademark Portfolio:

1. What do you think whether Trademarks are playing a key role in growing the business of your company or not?
   O Yes O No

2. What are the numbers of Trademarks that are owned by your company?
   O Less than 5 O Less than 10
   O Less than 15 O Less than 20
   O Any other answer: ________________________________

3. What do you think that the number of Trademarks that are owned by your company will increase in future?
   O Yes O No

4. Is your company registering its Trademarks in the foreign countries?
   O Yes O No

5. If the answer to the above question is YES then what are the number of Trademarks that are registered abroad by your company?
   O Less than 5 O Less than 10
   O Less than 15 O Less than 20
   O Any other answer: ________________________________

6. What is the number of countries in which your company has registered its Trademarks?
   O Less than 5 O Less than 10
7. Is Trademarks are registered abroad by Paris Convention route or by Madrid Protocol?
   - Paris Convention
   - Madrid Protocol

8. What are the numbers of Trademarks that are registered abroad by your company before and after the accession of Japan to Madrid Protocol?
   - Before accession to Madrid Protocol (Paris Convention Route)
     - Less than 5
     - Less than 10
     - Less than 15
     - Less than 20
     - Any other answer: ______________________________
   - After accession to Madrid Protocol
     - Less than 5
     - Less than 10
     - Less than 15
     - Less than 20
     - Any other answer: ______________________________

9. What is the number of countries in which your company has registered its Trademarks before and after the accession of Japan to Madrid Protocol?
   - Before accession to Madrid Protocol (Paris Convention Route)
     - Less than 5
     - Less than 10
     - Less than 15
     - Less than 20
     - Any other answer: ______________________________
   - After accession to Madrid Protocol
     - Less than 5
     - Less than 10
     - Less than 15
     - Less than 20
     - Any other answer: ______________________________

10. How your company files an application for Trademark registration in foreign countries in the following two cases:
III. Questions of IP Department:

1. What do you think whether it is in the benefit of a Company especially a small and medium enterprise to establish an IP Department?
   - Yes
   - No

2. Is there an IP Department in your company?
   - Yes
   - No

3. If the answer to the above question is YES then what is the number of employees of the IP Department?
   - Less than 5
   - Less than 10
   - Less than 15
   - Less than 20
   - Any other answer: _________________________________________

4. What is the role of the IP Department in your company?

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IV. Questions of International Treaties:

1. Do you have some knowledge about the international treaties to which Japan is a signatory state?
   - Yes
   - No

2. If the answer to the above question is YES then whether these international treaties are helpful for your company or not?
   - Yes
   - No

3. What do you think whether it is in the benefit of the industries to use the international treaties like Madrid Protocol, Patent Cooperation Treaty etc.?
   - Yes
   - No
4. If the answer to the above question is YES then is your company used any of the international treaty for registering its IP right?

   O Yes   O No

5. If the answer to the above question is YES then may I know the names of the international treaties that your company used to register its IP rights?

   Adamantium

V. Questions of Madrid Protocol:

1. Do you know that what is Madrid Protocol for the International Registration of Marks?

   O Yes   O No

2. Is your company used Madrid Protocol for the international registration of its marks?

   O Yes   O No

3. What do you think that Madrid Protocol is beneficial for your company?

   O Yes   O No

4. If the answer to the above question is YES then what are the benefits that your company has by using the Madrid Protocol?

   Adamantium

5. Is the Government of Japan received your company views before acceding to the Madrid Protocol?

   O Yes   O No

6. Did your company receive any kind of capacity building and awareness programs from the Government of Japan before or after acceding to the Madrid Protocol?

   O Yes   O No

7. Is your company ever used the route of Madrid Protocol for registering its marks to the countries that are party to the Madrid protocol?

   O Yes   O No

8. If the answer to the above question is YES then what are the difficulties that are
faced by your company in using the Madrid Protocol?

9. Is the fee structure including the fees of the Attorney, the Office of Origin, the International Bureau of WIPO and the designated Contracting Party (if any) Individual Fee is fixed by the designated Contracting Party) for the international registration of a Mark via Madrid Protocol is acceptable to your company?

   ○ Yes ○ No

10. Is the conventional way of registering the Marks internationally by Paris Convention is better than the Madrid Protocol?

   ○ Yes ○ No

11. If the answer to the above question is YES then why the Paris Convention route is better than the Madrid Protocol?

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12. Do you have some know how about the provision of “Central Attack” in the Madrid Protocol?

   ○ Yes ○ No

13. If the answer to the above question is YES then what do you think whether the provision of “Central Attack” is acceptable to your company or not?

   ○ Yes ○ No

14. If the answer to the above question is NO then why this provision of “Central Attack” is not acceptable to your company?

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THANK YOU FOR YOUR COOPERATION
ANNEX-V

QUESTIONNAIRE
(Japanese Trade Mark Attorneys)

By:

Asfand Ali
Assistant Director
IPO-Pakistan
(asfandch27@gmail.com)

Respondent’s Information:

Full Name:

Position:

Company:

Interview Questions:

1. Why Madrid Protocol is introduced in the presence of an already existed system of Madrid Agreement for the international registration of marks?

2. Why Contracting Organizations are made eligible to file an international application under the Madrid Protocol along with the Contracting States?

3. What are the disadvantages of the Madrid Protocol in the context of the interests of the developing countries?

4. Why MM18 and MM17 form must be submitted along with the MM2 form, if the applicant designates United States and the European Community respectively?

5. Why the applicant is under obligation to submit the aforesaid forms for the United States and the European Community as compared to other Contracting Parties of the Madrid Protocol? Is it will not effect the harmonization of the system and against the global trend of the world?

6. If the applicant designate a Contracting Party that has its own Individual Fee then whether he also have to pay the supplementary and complementary fees to the International
Bureau of WIPO or not?

7. Where the applicant should submit the Individual Fee whether to the National Trade Marks Office of the designated Contracting Party or to the International Bureau of WIPO?

8. Where the applicant should submit the Supplementary and Complementary Fees whether to the Office of Origin or to the International Bureau of WIPO?

9. What is the criterion for division of supplementary and complementary fees among the designated Contracting Parties?

10. Is WIPO also divides the amount of Basic Fee that it receives from the applicant among the designated Contracting Parties?

11. Is WIPO deducts some amount from the Individual Fee of a designated Contracting Party?

12. What is the criterion for a Contracting Party to fix its own Individual Fee?

13. What is your opinion whether a Contracting Party of the Madrid Protocol should fix its own Individual Fee or receive a share from the Supplementary and Complementary Fees from WIPO on annual basis?

14. If the Office of Origin is using French language and the applicant designate a Contracting Party that is using English language then what will be the scenario in this type of situation?

15. Why the International Registration is dependent on the basic application or registration for the first 5 years?

16. What kind of enquiries you receive from the applicant regarding the Madrid Protocol?

17. What are the practices and processes of Trade Mark Attorneys to handle the international application via Madrid Protocol?

18. What are the difficulties that are faced by the Attorneys to manage the Madrid Protocol applications?

19. What is the impact of Madrid Protocol on the attorneys that are practicing the Trade Marks Law?
20. What is the impact of Madrid Protocol on the Industries of a country party to the Madrid Protocol?

21. Are the Industries especially small and medium enterprises of developing countries will benefit from the Madrid Protocol? If yes then how?

22. What are the implications that the Office of Origin will face after acceding to the Madrid Protocol?

23. What is your opinion about the Madrid Protocol? A country should accede to it or not? If yes then why?

24. In Japan, people are still using the Paris Convention route more as compared to the Madrid Protocol as is indicated in the Annual Report, 2007 of the Japan Patent Office. Why?

25. Any other information that you want to share on the basis of your experience in practicing the Madrid Protocol in Japan?

THANK YOU FOR YOUR COOPERATION
QUESTIONNAIRE
(Japan Patent Office)

By:
Asfand Ali
Assistant Director
IPO-Pakistan
(asfandch27@gmail.com)

General Questions:

1. What are the implications faced by the Japan Patent Office after acceding to the Madrid Protocol?

2. What are the pre-requisites that a country should take before acceding to the Madrid Protocol?

3. What are the drawbacks of the Madrid Protocol from the user point of view as well as from the perspective of the Office of Origin and designated Contracting Party?

4. What are the ten drawbacks that the applicant in Japan faced while using the Madrid Protocol according to the survey of Japan Patent Office?

5. What is the time of examination or what is the time for acceptance or refusal for an international application where Japan is the designated Contracting Party?

6. Why the international applications filed through Madrid Protocol are less than the international applications filed through the Paris Convention?

7. Why the Japan Patent Office fix an Individual Fee instead of receiving share from the supplementary and complementary fees from WIPO on annual basis?

Questions of Administration:

8. What is the total staff strength of the section dealing with the Madrid Protocol in the Japan Patent Office? May I have the Organogram of this section?
9. What are the responsibilities of each officer, mentioned in the Organogram, working in the section of Madrid Protocol?

10. What are the automation requirements necessary for handling the international applications filed through Madrid Protocol?

Questions of Trademark Examiners:

11. What is the total number of Trademark Examiners (both permanent and temporary) in the Japan Patent Office?

12. Is the Trademark Examiners for the Madrid Protocol applications are separate from the Trademark Examiners dealing with the national trademark applications of Japan and applications filed through Paris Convention?

13. If the answer on the above question is YES then what are the total number of Trademark Examiners (both permanent and temporary) that are dealing with the applications filed via Madrid Protocol?

14. What is the total number of trademark applications that a Trademark Examiner will examine in one year?

15. What is the total number of international trademark applications filed via Madrid Protocol that a Trademark Examiner will examine in one year?

Questions of Appeal Examiners:

16. What is the total number of Appeal Examiners (both permanent and temporary) in the Japan Patent Office?

17. Is the Appeal Examiners for Trademarks are separate from the Appeal Examiners of Patents, Designs etc.

18. Is the Appeal Examiners for the Madrid Protocol applications are separate from the Appeal Examiners dealing with the national trademark applications of Japan and applications filed through Paris Convention?

19. If the answer on the above question is YES then what are the total number of Appeal Examiners (both permanent and temporary) that are dealing with the appeals of international applications filed through Madrid Protocol?
20. What is the total number of trademark appeals that an Appeal Examiner will handle in one year?

21. What is the total number of trademark appeals filed via Madrid Protocol that an Appeal Examiner will decide in one year?

Questions of Capacity Building, Awareness and Support:

22. What are the capacity building problems faced by the officers of the Japan Patent Office in order to handle the international applications filed by the route of Madrid Protocol both as Office of Origin and designated Contracting Party?

23. What is the awareness strategy of the Japan Patent Office for disseminating the information of IP to the Small and Medium Enterprises of Japan?

24. What are the support measures that the Japan Patent Office had taken for facilitation of the small and medium enterprises?

25. Is Japan Patent Office arranged seminars, workshops etc in order to disseminate the information among general public regarding the Madrid Protocol?

26. Is Japan Patent Office had listened the views of the Japanese Industries particularly the small and medium enterprises before accession to the Madrid Protocol?

27. If the answer to the above question is YES then what are the views of the Japanese Industries particularly the small and medium enterprises for accession to the Madrid Protocol?

28. Any other information that you wish to share with me regarding the implications of Madrid Protocol based on your rich experience in handling the international applications via Madrid Protocol?

THANK YOU FOR YOUR COOPERATION
Follow-Up Questions:

1. Whether the Japanese applicant for the local registration of the Mark in Japan has to file one application in one class only or he can apply one application in more than one class?

2. If the Japanese applicant can apply one application in one class only then how JPO has remedied this irregularity before acceding to the Madrid Protocol where an applicant can file one application in more than one class?

3. The number of applications in Japan as an Office of Origin is very less as compared to the number of applications where Japan is the designated Contracting Party. Why Japan acceded to Madrid Protocol? Is it does not affects the interests of the local businesses of Japan?

4. Why JPO receives Individual Fee in two parts?

5. Is WIPO deducts some amount from the Individual Fee?

6. If the answer to the above question is YES then what is the criteria of deduction from the Individual Fee?

7. Is JPO has listened the views of the Attorneys in addition to the views of the Japanese Industries before acceding to the Madrid Protocol?

8. If answer to the above question is YES then what are the views of the Attorneys of Japan about accession of the Madrid Protocol?

9. Why no support measure is provided to small and medium enterprises of Japan regarding to Madrid Protocol?
10. Why there is a difference of workload between the Trade Mark Examiners responsible for local applications and applications filed via Paris Convention route (936 applications/year) and Trade Mark Examiners responsible for international applications filed via Madrid Protocol route (293 applications/year)?

11. Is E-Filing is possible for the local Trade Mark applications and for the international applications filed via Madrid Protocol?

12. What are the means of communication between the Japan Patent Office and the International Bureau of WIPO related to Madrid Protocol?

13. Is paperless culture of JPO is also extended to the International Trade Mark Application Office of JPO?

14. Is JPO receives any amount of fee for the following actions that are related to Madrid Protocol? If YES then please give the amount of fee in the relevant box that is received by JPO?

<table>
<thead>
<tr>
<th>Actions</th>
<th>Fees received by JPO</th>
</tr>
</thead>
<tbody>
<tr>
<td>Fees for the international registration of a mark from the applicant.</td>
<td></td>
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<tr>
<td>Fees for transformation of international registration in to national applications.</td>
<td></td>
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<tr>
<td>Fees to record replacement of registered Trade Mark with international registration.</td>
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<tr>
<td>Fees for filing of address for service/agent in Japan.</td>
<td></td>
</tr>
</tbody>
</table>

15. In the post-registration procedures of Madrid Protocol, the applicant can either approach the international bureau of WIPO directly or through the Office of Origin. I want to know that which of the following post-registration procedures are/are not (directly by the applicant to the IB of WIPO) routed through JPO to the IB of WIPO. Please give the answers in YES or NO in the relevant box.
**WIPO Six Months Study-cum-Research Fellowship**

(April – September, 2008)

<table>
<thead>
<tr>
<th>S. No.</th>
<th>Post-Registration Procedures</th>
<th>Routed through JPO</th>
<th>Do not Routed through JPO (Directly by the applicant to the IB of WIPO)</th>
<th>Amount of Fee received by JPO for Post-Registration Procedures</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Subsequent designation.</td>
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<td>2.</td>
<td>Change of name or address of holder.</td>
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<tr>
<td>3.</td>
<td>Change of name or address of representative.</td>
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<td>4.</td>
<td>Appointment of a representative at WIPO.</td>
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<td>5.</td>
<td>Limitation of the list of goods and services.</td>
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<tr>
<td>6.</td>
<td>Recording of a Renunciation.</td>
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<tr>
<td>7.</td>
<td>Cancellation of the international registration.</td>
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<tr>
<td>8.</td>
<td>Change in ownership</td>
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<tr>
<td>9.</td>
<td>Renewal of international registration.</td>
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<tr>
<td>10.</td>
<td>Recording of a license.</td>
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<tr>
<td>11.</td>
<td>Amendment for the recording of a license.</td>
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</tbody>
</table>

16. Is JPO receives any amount of fee (in addition to the fee submitted to WIPO by the applicant) for the post-registration procedures that are routed through JPO? If YES then please identify the fees for each post-registration procedure in the last column of the above table?

**THANK YOU FOR YOUR COOPERATION**
REFERENCES

1. Articles of the Paris Convention for the Protection of Industrial Property;

2. Articles and Common Regulations of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;


11. Annual Report, Japan Patent Office, 2007; and

**Websites Searched:**

5. The Organization for Small & Medium Enterprises and Regional Innovation Japan (SMRJ) at [http://www.smrj.go.jp](http://www.smrj.go.jp)
ACKNOWLEDGEMENT

All praises are for Allah Almighty Who is the Lord of whole universe, Who is gracious, merciful and Who helps us in all difficulties. Allah is the entire source of knowledge, guidance and wisdom awarded to mankind. Almighty Allah never spoils our efforts. Every piece of work is rewarded according to nature and degree of devotion put in. I thanks to Allah, Who blessed me with the courage and power to complete this report. All the respects and love for the Holy Prophet, Muhammad (P.B.U.H) Who is for ever a torch of guidance and light of knowledge for all mankind.

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Tokyo, September 2008