



### Madrid Protocol designating Japan – Frequently Asked Questions

Although Madrid Protocol applications designating Japan are examined for absolute grounds and relative grounds the same as national trademark applications in accordance with the Japanese examination guidelines, there are some differences in the procedures. Focusing on the differences, we will answer frequently asked questions and comment on situations we have experienced frequently. We use the term “Madrid Protocol application” to refer to International Registrations designating Japan, and “International Registration” to refer to entire “International Registration”.

#### **Q1 Which grounds are most often issued in the Office Actions? Why ?**

The most frequently issued grounds in the Office Actions are Japanese Trademark Law, Articles 6-1 and 2, which refer to “vague and broad” descriptions. This is because the JPO uses its own list of goods and services as provided in the examination standards. In addition, such grounds may be due to translations between English and Japanese. Therefore, the JPO often objects to descriptions of goods and services, even though they are acceptable under the Nice Classifications. Examples:

Class 9: Since the JPO considers that the description “scientific apparatus and instruments” is vague and broad, this description is rejected.

Class 37: “repair” – In Japan, it is necessary to indicate the object of repair such as “repair of automobiles” and “repair of toys or dolls”.

Class 40: “treatment of materials” – In Japan, it is necessary to indicate the object of treatment of materials such as “metalwork”, “ceramic processing” and “water treating”.

#### **Q2 How long is the term for responding to a Notification of Provisional Refusal? Is it possible to extend the deadline?**

The deadline for responding to a Notification of Provisional Refusal is three months from the date of pronouncement which is printed on the bottom of the first page. It is possible to extend the deadline once for one month by paying the official fee.

#### **Q3 Do we have to appoint Japanese attorneys in order to respond to a Notification of Provisional Refusal?**

If the ground of refusal can be overcome by amending the descriptions of the goods/services, the applicant or the local attorneys can directly submit a “Request for the Recording of a Limitation of the List of Goods and Services” (MM6) to the WIPO (without appointing Japanese attorneys). In this case, we recommend that you also send a copy of the MM6 by facsimile or email to the Examiner of the JPO mentioned in the Notification of Provisional Refusal.

Needless to say, it is possible to file amendments of the descriptions of the goods/services to the JPO through Japanese attorneys. In this case, it is absolutely necessary to file amendments on or before the deadline. After the deadline, the JPO will not accept the amendments filed by the Japanese attorneys.

If the applicant wishes to argue against the ground of refusal, it is necessary to appoint Japanese attorneys and file arguments through them.

#### **Q4 When requesting Japanese attorneys to respond to a Notification of Provisional Refusal, what documents are necessary?**

It is necessary to submit an original Power of Attorney to the JPO.

**Q5 When there is a ground regarding the descriptions of the goods/services in a Notification of Provisional Refusal, the Examiner often proposes acceptable descriptions in Part VI of the Notification. Is it possible to overcome the ground by amending the description of the goods /services in accordance with the Examiner's proposal?**

In principle, it is possible to overcome a ground for refusal by amending the description to those proposed by the Examiner. However, if the applicant wishes to further modify the descriptions proposed by the Examiner and confirm whether the descriptions of goods/services fully cover the applicant's goods/services, we recommend that you consult with us.

**Q6 After the response to a Notification of Provisional Refusal is submitted, is there another chance to respond to the Notification? If a Decision of Rejection is issued, what will be the next procedure?**

In principle, there is only one chance to respond to a Notification of Provisional Refusal issued to a Madrid Protocol application. Upon examining submitted Arguments and/or Amendments, the JPO will issue a Decision. If a Decision of Rejection is issued and the applicant is dissatisfied with the Decision, it is possible to proceed with an Appeal against the Decision of Rejection to the Board of Appeal of the JPO, just like other national applications.

**Q7 When a ground of refusal that the designated goods/services belong to a different class is issued, is it possible to amend the goods/services to an appropriate class?**

In principle, it is not allowed to amend the class because the WIPO determines classes for goods and services. However, under Japanese practice, amendment of the classes may be allowed within the original range of the Madrid Protocol application.

**Q8 Is it possible to divide a Madrid Protocol application?**

No. However, it is possible to divide a Madrid Protocol application if the division is caused by the assignment.

**Q9 Upon issuance of a Decision of Registration to a Madrid Protocol application, when should the second individual fee (the registration fee) be paid?**

The applicant of the International Registration must pay the second individual fee within three months from the date in the payment form. Please note that this deadline cannot be extended. The Japanese attorneys cannot pay the second individual fee to the JPO or the WIPO.

**Q10 When an International Registration is cancelled due to a central attack, is there any recovery measure?**

Yes. If the applicant satisfies the following conditions, it is possible to file and register the trademark in Japan. In this case, the filing date will be regarded to have the retroactive effect for the International Registration date (or subsequent designation date).

1. The national trademark application under the special exception clause must be filed within three months from the cancellation date of the International Registration.
2. The trademark of the national trademark application must be the same as that of the International Registration.
3. The range of goods/services of the national trademark application must not extend the range of goods/services of the International Registration.

**If you have any further questions, please contact to us: [tm-design@shigapatent.com](mailto:tm-design@shigapatent.com)**  
**For information regarding our firm, please visit our web site: [www.shigapatent.com](http://www.shigapatent.com)**