

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

ASAHI SEIMEI OTEMACHI BLDG.18F
6-1 Otemachi 2-chome
Chiyoda-ku Tokyo, 100-0004, JAPAN



TEL: 81 3 5205 3321
FAX: 81 3 5205 3391
URL: <http://www.jipa.or.jp/>

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Re: POSITION PAPER on EIGHTEENTH SESSION OF THE
MADRID WORKING GROUP, Geneva, October 12 to 16, 2020 (MM/LD/
WG/18)

We, the Japan Intellectual Property Association “JIPA”, is a non-profit, non-governmental organization, which has 966 members (as of October 1, 2020). It represents industries and users of the intellectual property (IP) system and provides related institutions all around the world with well-timed, suitable opinions on improvement of their IP systems and their utilization.

For further information regarding JIPA is available at <http://www.jipa.or.jp/>.

Although JIPA would not participate in the 18th Session of the Madrid Working Group meeting, we would like to make the following statements according to the agenda.

MM/LD/WG/18/3. New Means of Representation

JIPA welcomes that it is proposed that Rule 9(5)(d)(iv) be amended by requiring that the Office of origin certify that the mark in the international application corresponds to the mark in the basic application or basic registration, instead of requiring it to certify that it is the same. JIPA has mentioned at the Working Group meeting in 2015, 2016 and 2017 that the flexible correspondence, in particular between a composite mark of English and Japanese (Katakana or Hiragana) in the basic application or

registration and any part of such composite mark in the international application, shall be considered by all Offices. So, JIPA believes that this amendment can help Japanese applicants to use the Madrid System much more frequent and easier than before.

MM/LD/WG/18/5 and MM/LD/WG/18/5 Corr. Study of the Cost Implications and Technical Feasibility of the Gradual Introduction of the Arabic, Chinese and Russian Languages into the Madrid System

JIPA agrees that the International Bureau proposes the introduction of Arabic, Chinese and Russian as filing languages and that this introduction should be subject to a review following a period of no less than five years to assess its operational and financial impact and then there could be a decision on whether to progress to the processing or transmission language option. Meanwhile, JIPA has been very concerned about the cost and work increase for the introduction of these new languages and the risk of error in translation of languages, which can affect the scope of protection of our own trademark right.

MM/LD/WG/18/6. Provisional Refusal

JIPA supports the proposal that the time limit be calculated from the date on which the International Bureau transmits the notification to the holder. This could result in the holder having more time to respond to a refusal than the time limit calculated from the date of the decision by the Office.

MM/LD/WG/18/7. Dependency

JIPA remains in favor of reducing the dependency period from five to less than three years. The holders of the basic mark in Japan run the risk of cancellation due to non-use during a period of three years from the date of the registration of the basic mark. If the dependency period is reduced to less than three years, the risk of central attack will be partially reduced and such reduction of unstable period of the International Registration will be

exactly welcomed by many holders.

JIPA looks forward to participating again in the future Madrid Working Group meeting after moderating the various restrictions around COVID-19.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'K. Saito', with a stylized flourish at the end.

Koji SAITO
Managing Director of JIPA