

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Mr. Daren Tang
Director General
World Intellectual Property Organization,
34, chemin des Colombettes
CH-1211 Geneva 20, Switzerland

Re: POSITION PAPER on NINETEENTH SESSION OF THE MADRID
WORKING GROUP, Geneva, November 15 to 17, 2021 (MM/LD/WG/19)

Dear Mr. Tang,

We, the Japan Intellectual Property Association or “JIPA”, is a non-profit, non-governmental organization, which has 972 members (as of October 6, 2021). 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 the improvement of their IP systems and their utilization.

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

On the 19th Session of the Madrid Working Group meeting, we would like to make the following statements according to the agenda.

MM/LD/WG/19/3 Provisional Refusal

JIPA supports the proposal that the time limit should be calculated from the date on which the International Bureau transmits the notification to the holder and is in favor of having a minimum time limit of 2 months to respond to a provisional refusal. This proposal 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. In addition, if holders have more than 2 months to respond to a provisional refusal, it would be helpful to consider how to overcome the refusal with co-holders or to find and appoint a local

attorney without conflict issue. Considering that the severe time constraint which is less than 2 months in some countries prevents applicants from making well-considered responses, JIPA would appreciate that the proposal from the International Bureau would be established as the rule at the earliest timing so the contents of the proposal could be put into practice in all the Contracting Parties. Equal starting date and sufficient minimum time limit would give users more motivation to use the Madrid System.

MM/LD/WG/19/5 Dependency

JIPA's basic position is that the Madrid System should be a simple, balanced and user-friendly system for all users.

The "users" here includes not only the direct users of the Madrid System but also any corporations, individuals and attorneys who are related to trademarks through trademark clearance and so on.

International Bureau shows specific options for discussion, namely 1. Reduction of the dependency period, 2. Reduction of the grounds for cancellation of an international registration, 3. Elimination of the automatic effect of dependency and/or the combination of them.

After the agenda was released, various opinions from JIPA members were received, which can be summarized as below;

1. Reduction of the dependency period - The reduction of the dependency period apparently strengthens the certainty of international registrations and is welcomed by rightful owners. On the other hand, if the dependency period is reduced to three years from its international registration date, an international application registered during the examination of the basic application will be released from dependency before three years from the registration date of the basic mark. It means non-use cancellation of the basic mark has no influence on the international registration if the basic country adopts a three-year bar of non-use. In that case, users are required to file separate petitions in each country to cancel the international registration, which increases the burden on both the Office and the user, and reduces the deterrence of the central attack especially against applicants with a hidden unfair or run-out intent. In other words, a shorter dependency period might make international registrations a little too stable.
2. Reduction of the grounds for cancellation - Opinions of JIPA members

are mostly negative toward limiting the grounds of central attack only to bad faith. Rather, some members expressed they prefer the extended dependency period for the cancellation of the basic mark due to bad faith.

3. Elimination of the automatic effect of dependency - Most opinions JIPA received view this idea as worth considering. But as this idea creates some burden to the petitioners of cancellation, it is important to secure the accessibility to the information on the international registration, such as notification from the Office that the cancelled local mark is the basis of international registration, and/or simplicity of the cancellation procedure at International Bureau.
4. Other- JIPA received opinions that, to achieve the balanced relaxation of dependency, it is worth considering introducing the uniform evaluation standard of publicity toward the basic marks and international registrations. In particular, the publicity of international registrations and their basic applications/registrations should be examined under the international publicity at their examination, opposition and cancellation/invalidation stages in each Office. Currently, some member states only consider the domestic publicity of trademarks, but taking in mind that the core principle of the Madrid System is the extension of national registrations, there should be no member states where the bad-faith applicants can take advantage of the inward-looking national laws to outbreak the unfair registrations internationally.

Considering those opinions as well as the recent sharp increase of trademark applications worldwide, JIPA has a concern about whether the simple reduction or elimination of dependency in any manner can contribute to the better balance of the Madrid System. Thus we expect International Bureau and Offices to fully consider the balanced development of the Madrid System which encourages rightful users and discourages unfair users.

MM/LD/WG/19/7 Revised Study of the Cost Implications and Technical Feasibility of the Gradual Introduction of the Arabic, Chinese and Russian Languages into the Madrid System and Other Relevant Information

With regard to the proposal for the introduction of Arabic, Chinese and Russian languages into the Madrid System for the international registration

of Marks, JIPA proposes to have a further discussion as we are concerned.

1. The meaningful introduction of new languages

The Working Group provided the historic background that English and Spanish were added as working languages for the purpose of promoting the geographical expansion of the Madrid Union. We believe that the significance of the addition of new languages should be discussed again to form a consensus. We assume the meaning of the introduction of new languages should be discussed first to form the consensus among all the Offices and observers. The Delegations that had proposed the introduction of new languages allege that the United Nations uses these languages as their official languages. However, consideration should be given not only from the viewpoint of applicants, including new users, but also from the viewpoint of third parties who search and monitor the earlier applications on the Madrid Monitor. Further, if the official language of a country with a large number of applications is to be added, Japanese should also be added since the number of applications by Japanese companies is also large. However, the correctness of this approach should be examined considering the purpose of the new language addition.

2. The burden of translation cost for users

The International Bureau provides to translate communications such as notifications of provisional refusal from the Offices of the designated Contracting Parties into the existing languages. If the new languages are introduced into the Madrid System, it is not enough just to translate the current communications from the position of the third parties who use the Madrid Monitor for clearance searches and/or monitoring. To make up for the deficiency, users from non-speaking countries of new languages will have to bear an additional cost to translate other communications than provisional refusals into English. In view of the number of non-speakers of new languages in contracting parties, it is not a reality-based policy to introduce a differentiated translation practice. If this practice is introduced, the users from non-speaking countries of new languages will incur substantial costs to translate all communications they need into English by each clearance search and/or monitoring. Therefore, JIPA does not agree with this proposal of introducing a differentiated translation practice. Allowing that New

languages should be adopted, it needs to be achieved without the additional burden of translation cost for users. This would require that all communications including all notifications from the Offices of the designated Contracting Parties as well as all the responses from applicants and holders are translated into English and all the English translations shall be treated as authentic. The introduction of Arabic, Chinese and Russian into the Madrid System for the international registration of marks requires that all correspondence be provided in English and treated as authentic and that all authentic be disclosed in English on the Madrid Monitor, without delay and without an increase in the official fee to users.

3. The countermeasure against bad faith applications

In recent years, there has been a rapid increase in cross-border bad faith applications, and applicants with unfair purposes have filed large numbers of applications not only in their own countries but also in foreign countries. The Working Group seems to have been focusing on considering the quality and cost of translations so far, but considering the countermeasure against bad faith applications is the critical task as well. If the International Bureau expects the expansion of new users, it should be noted that such expansion could lead to the rapid increase of bad faith applications. It is necessary to thoroughly examine how to prevent bad faith applications from being made in the midst of a large number of genuine applications, as well as the effects of increasing numbers of bad faith applications.

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

Yours sincerely,



Koji SAITO
Managing Director of JIPA