

November 12, 2021

Position Paper on Nineteen Session of Working Group on the Legal Development  
of the Madrid System for the International Registration of Marks

Japan Patent Attorneys Association (JPAA) was established under the Patent Attorneys Act in Japan in May of 1915, and it is the sole professional bar association of patent attorneys in Japan. At present, JPAA has more than 11,900 members practicing intellectual property law in Japan. Its members practice in all areas of intellectual property law, including patent, design and trademark law, as well as copyright and unfair competition.

Taking this opportunity, JPAA would like to submit the following comments on the meeting documents uploaded on the WIPO website.

**MM/LD/WG/19/3 and MM/LD/WG/19/INF/1—Provisional Refusal**

JPAA supports that the amendments proposed in this document will continue to be discussed

at this Working Group.

Seeing that in some cases, users find difficulty in responding to notifications of provisional refusal due to the extremely short time limit, we would like to request that each Contracting Party secure a sufficient time limit to respond to notifications of provisional refusal. As it may be better to give each Contracting Party a certain degree of discretion to decide the time limit, we consider that an appropriate approach would be to set the minimum time limit, such as "60 days or more."

In addition, from the perspectives of clarity and equitability, the starting day for calculating the time limit for response should be prescribed as the "date the International Bureau transmits the notification to the holder."

**MM/LD/WG/19/5—Dependency**

This document indicates three possible options for reduction of the dependency principle. JPAA's view on each option is as follows.

Reduction of the dependency period from five to three years

This option will be able to reduce trademark holders' concern that their international registrations might be cancelled due to central attacks to some extent. At the same time, it will also be able to secure a means for third parties to cancel defective registrations, such as those based on misappropriated applications, by one action. Thus, we find this option to be well-balanced.

Meanwhile, 20 years have passed since Japan joined the Madrid System, and we have come to see a central attack being used effectively, such as for the strategic purpose of having a third party's international registration cancelled on a global scale. Accordingly, not a

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few Japanese users hesitate to agree with the reduction of the current five-year dependency period.

Reduction of the grounds for cancellation of an international registration due to the ceasing of effect of the basic mark.

One possible approach for this second option is to cancel an international registration only where the ceasing of effect of the basic mark is pronounced on bad faith grounds. This approach should be carefully scrutinized, focusing on how to limit the grounds for the ceasing of effect of the basic mark, because there could be operational issues, for example: it may be difficult to establish a uniform view and a clear scope of "bad faith"; and, it is uncertain whether the basic mark can be regarded as the subject of a bad faith application even when it is refused or invalidated due to grounds other than bad faith.

Another possible approach is to cancel an international registration only where the basic mark ceases to be effective on the grounds of a third party action, such as opposition, cancellation or invalidation. We consider that this approach could also raise operational issues, for example: even where an earlier trademark holder wishes to have a later mark cancelled on whatever grounds, if the later mark is refused in the ex officio examination before being registered, the case may not be regarded as a central attack case because this refusal of the mark is not derived from a third party action.

**Elimination of the automatic effect of dependency**

The third option is the elimination of the automatic effect of dependency, which means, even if the basic application or basic registration ceases to have effect, the international registration would not be automatically rendered ineffective without a request from a third party. This option may raise an issue of legal stability of the international registration as it could put a trademark holder into an insecure position where a third party might file a request for cancellation at any time. It may be possible to solve this issue to some extent by limiting the period during which a third party is allowed to request cancellation. However, unless each Office operates this time limit strictly, a greater monitoring burden would be imposed on trademark holders.

Thus, each option involves various problems, including operational issues and detriment to users. JPAA hopes that deliberate discussion will further continue.

### **MM/LD/WG/19/6—Proposal by the Delegation of Switzerland**

JPAA supports the proposal to clearly state in Rule 9(5)(d)(vi) of the Common Regulations that it is the certification duty of the Office of Origin to ascertain that the limitation is covered by the main list, because it is important to ensure that the designated goods or services will be interpreted in the same manner as the applicant intends, and Japanese users, for example, consider that it would be reasonable to have a limitation be examined at the Office of Origin in Japan. We consider that this also applies to other Contracting Parties, if the Office of Origin examines a limitation to the goods, it may be less likely that the goods will be interpreted in a different way than the applicant intends.

We also support the proposal to clearly state in the Regulations that the International Bureau examines limitations in line with Rule 13 (accuracy), which is currently not required in the Regulations, in addition to examination of limitations concerning classification (Rule 12

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(8bis)).

On the other hand, we would like to request that deliberate discussion be held with regard to the following proposals: [1] amending Rule 13(1) of the Common Regulations in order to enable the International Bureau to issue an irregularity notification when it finds a limitation to be extensive, and also enable the International Bureau to make an annotation of "extensive term" if the applicant fails to respond to the irregularity notification; and [2] clearly stating in an interpretative declaration under Rule 17(2)(iv) of the Regulations that the notification of provisional refusal referred to in Proposal 1.3, Alternative 1 on the grounds that a limitation is extensive cannot be made.

The reasons for our opinion are as follows; First, the proposed amendments could increase the International Bureau's examination workload, which may result in requiring more time for the mark to be recorded in the International Register or causing a delay in making a notification to the Office of a designated Contracting Party. In addition, if both the Office of Origin and the International Bureau were each to conduct examination while the global harmonization regarding the generic concepts and specific concepts of designated goods and services has not yet been completed, there may be cases where the Office of Origin and the International Bureau reach different examination results, which could cause an unanticipated disadvantage to applicants. Furthermore, if the International Bureau were to make an annotation of "extensive term," whereas the Office of the designated Contracting Party is not allowed to issue a notification of provisional refusal on the grounds that the "limitation is extensive," it would be uncertain how the designated goods or services with such annotation would be treated in the designated Contracting Party, which could be disadvantageous to applicants.

## **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**

JPAA would like to request that deliberate discussion be held with regard to the introduction of Arabic, Chinese, and Russian languages into the Madrid System for the International Registration of Marks, from the following viewpoints.

- (1) In international applications, the designated goods or services are extremely important factors that are directly linked to the interpretation of the scope of rights. We have great concern that if a new language is introduced as a working language, accuracy of the translations of the descriptions of the designated goods or services might not be guaranteed. For example, there is a question as to whether it is possible to translate the descriptions of the goods or services accurately in line with the applicant's intention if translation is made between languages of different linguistic systems. If the accuracy of the translation is undermined, this could harm not only the interest of the applicant but also the interests of earlier trademark holders and later applicants. In addition, the introduction of any of the proposed new working languages could make it difficult to identify the scope of rights in the phase of dispute resolution, resulting in impairing the legal stability of related rights.

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(2) If inaccurate translations are frequently found, the number of requests for corrections will increase, which could lead to repetition of or delay in the examination at Offices of designated Contracting Parties, resulting in impairing the convenience of the Madrid System as a whole. This problem will emerge more clearly if the number of users increases as a result of the introduction of the proposed new languages.

(3) The introduction of a new language will increase costs for translation and system development. As the introduction of the proposed languages is not expected to increase the number of applications, we do not wish that this will lead to raising the official fees and result in increasing the burden on users. In addition, this document states that the International Bureau will provide translations of all decisions from the Offices of the designated Contracting Parties, including notifications of provisional refusal. This is expected to further increase the burden on users. Applications for international registration under the Madrid System are preferred to direct applications because of lower costs. Some Japanese users express that they will not choose applications for international registration under the Madrid System if the filing costs increase. Due consideration should be given to the impact of the introduction of new working languages on users.

End

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