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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Sixth Session
Geneva, November 24 to 28, 2008

CONTRIBUTION BY JAPAN

prepared by the International Bureau

1. In a communication dated October 15, 2008, the International Bureau received from Japan a text entitled Contribution by Japan on the Discussion of the Future Development of the Madrid System, for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its sixth session to be held in Geneva from November 24 to 28, 2008. Japan has requested that it be translated and circulated as part of the documents for that session.
2. The said Contribution text is annexed to this document.
3. *The Working Group is invited to note the contents of the attached Contribution by Japan.*

[Annex follows]

ANNEX

Japan Patent Office

The 6th Working Group for the Madrid System

Contribution by Japan

On the discussion of the Future Development of the Madrid System

October 15, 2008

[Outline of Contribution]

1. Background

1. In the Madrid System, it is required that the mark in an application for international registration be exactly the same as the original mark in the basic application or the basic registration (hereinafter referred to as “the requirement”).
2. According to “the requirement,” applicants who hold original marks consisting of Japanese language in Japan and wish to file an application for international registration for modified marks that fit the local language of the foreign country designated in an international (Madrid) application are first required to file with the JPO another basic application or registration for the modified mark. The applicants are unable to file a modified mark using the Madrid System (the Madrid Protocol) without first filing a basic application or registration for the modified mark due to the requirement.
3. Focusing its attention on the requirement while expressing concerns that today’s Madrid System does not support the linguistic diversity in the world, Japan has proposed that the requirement be made flexible to a certain extent to promote the utility of the Madrid System.
4. It has been decided that the aforementioned proposal is to be discussed at this Working Group meeting (held from the 24th to the 28th of November 2008 at WIPO Headquarters in Geneva).

2. Problems in terms of making the requirement flexible

5. Japan proposes that even if a modified mark consists of a language that differs from the original mark in the basic application or the basic registration, an applicant should be able to file an application for international registration as long as the meaning or the sound of the modified mark is the same as that of the original mark in the basic application or the basic registration.

6. The Office of Origin has to certify that the modified mark in the international application is the same as the original mark in the basic application or the basic registration (cf. Rule 9(5)(d)). Therefore the Office of Origin has to judge whether the modified mark in the international application has the same “meaning” or the same “sound” as the original mark in the basic application or the basic registration.
7. As about 60 different languages are used by Member States, it seems extremely difficult for each Office of Origin to certify the sameness of “meaning” or “sound” of the original marks in basic applications and the corresponding modified marks in international applications.
8. If the Office of Origin simply eliminates the system for certifying the sameness of an original mark and a modified mark, the Office of Origin should accept an international application for a mark without making a judgment about “the sameness of the marks in the basic application or registration and the international application.” This practice is not that different from eliminating the requirement of a basic application or registration, and when this practice is carried out by the Office of Origin, the proposal by Japan that the requirement for sameness should be made flexible to a certain extent becomes insignificant.
9. If the Office of Origin makes an applicant certify the sameness of the original mark in the basic application or registration and the modified mark in an international application, an applicant may, intentionally or negligently, file an application for the international registration of a modified mark which is not the same as the original mark in the basic application or registration. In this case, establishing a system for cancelling the trademark right, such as the “Central Attack System,” is not a realistic idea because each Designated Office will have to judge whether the modified mark in the international application is the same as the original mark in the basic application or registration.
10. On the other hand, according to a survey of Japan about the kinds of marks Japanese users were applying for in foreign countries, the largest percentage of applications was for modified marks totally different from the original marks used in Japan. It was also found that even if the flexibility of the requirement was increased to satisfy users, it would still be impossible to satisfy all of the requests of users regarding applying for marks in foreign countries.

3. Effects of deleting the requirement of a basic application or registration

11. As for the possible consequences of deleting the requirement of a basic application or registration, the unnecessary filing of basic applications for modified marks, which may never be used, can be eliminated, designation of his office of origin becomes possible, and integrated control of internationally registered marks can be practiced by applicants.
12. The Office of Origin does not need to judge whether designated goods and services in an international application and those in the basic application or registration are the same, and an applicant can freely adopt indications of goods and services which are acceptable in each designated country at the time of filing an international application.
13. There are some concerned voices that Central Attack could not be performed if the requirement of a basic application or registration were deleted. However, there have been very few Central-Attack cases by third parties. Additionally, under Article 9 quinquies of the Madrid Protocol, an international registration which was cancelled due to Central Attack can be transformed into a national application. Therefore, Central Attack should not be regarded to be a significant advantage of the Madrid System for a third party.
14. However, the requirement of a basic application or registration forms the foundation of the Madrid System. Deleting the requirement of a basic application or registration is equivalent to establishing a new registration system for marks, and thus careful consideration is required.

4. Conclusion

15. Japan proposed making the requirement sufficiently flexible to correspond to linguistic diversity, but this proposal would be difficult to achieve for lack of a concrete method of operation. Since deleting the requirement of a basic application or registration is equivalent to establishing a new registration system for marks, careful consideration on the deletion of the requirement of a basic application or registration is required. However corresponding to the linguistic diversity in the world is so crucial to making the Madrid System useful that we should discuss further including the deletion of the requirement of a basic application or registration.

【Contribution】

1. Problems on an operational level in making the requirement flexible

a. Concept of making the requirement flexible

16. In the Madrid system, it is impossible, because of the requirement, to enable users to apply for the international registration of a modified mark without first filing a basic application for the modified mark. This point is considered to be the reason why the Madrid system has not sufficiently supported linguistic diversity. In the Madrid system, if an applicant attempts to file an international application for a mark which has been modified to the language of a designated country, the applicant has to first apply for registration of the modified mark in his own country, even though the modified mark will never be used in his own country. As a result, an application for a non-use mark has to be filed in his home country, and the non-use mark also has to be registered in his home country.
17. Therefore, Japan has been proposing that the requirement be preserved but also be made more flexible to correspond to user desires (Ref. MM/LD/WG/4/5).

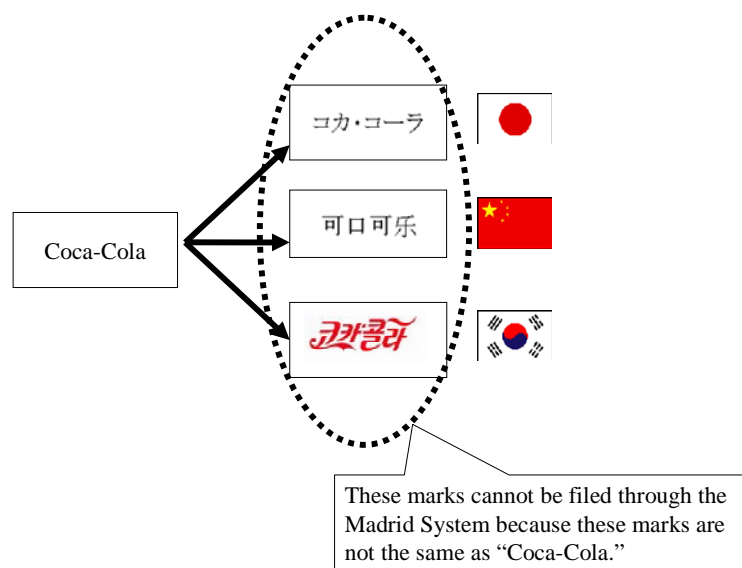


Fig. 1 The Madrid System does not support linguistic diversity.

18. Japan has introduced two ways to increase the flexibility of the requirement. One way is to identify the sameness of sound; i.e., when the sound of the original mark in the basic application or registration and the sound of the modified mark in the international application are the same, an applicant can file the international

application, and both marks will be acknowledged to be exactly the same. The other is to identify the sameness of meaning; i.e., when the meaning of the original mark in the basic application or registration and the meaning of the modified mark in the international application are the same, an applicant can file the international application, and both marks will be acknowledged to be exactly the same.

19. However, it is revealed from the following analysis that it is not a simple matter to put into practice under either method.

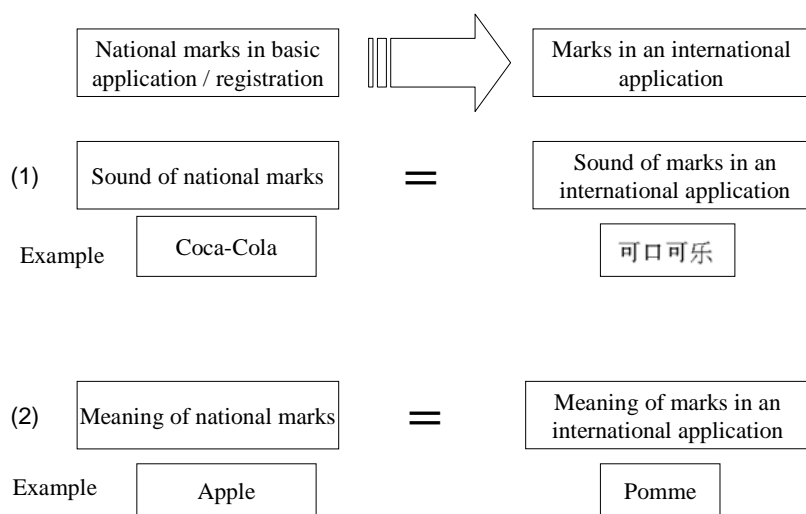


Fig. 2 Two ways to make the "requirement" flexible

b. Problems on an operational level

20. The Office of Origin shall prove that the original mark in the basic application or registration is exactly the same as the modified mark in the international application.

i. When maintaining the system of certifying sameness in the Office of Origin

21. An Office of Origin becomes responsible for acquiring expertise in linguistic diversity. However, it is extremely difficult for each Office of Origin to become well versed in all sorts of languages and acquire the expertise necessary to identify the sameness of the sound or the meaning of the original and modified marks.
22. Although the following solutions were considered for the aforementioned problems, the realization of these potential solutions has been recognized to be difficult.

1) Identify a mark by its transliteration

23. Where the original mark consists of or contains characters other than Latin characters, a transliteration of the original mark into Latin characters must be provided. The transliteration into Latin characters of the original mark must be the same as the phonetics of the language of the modified mark in the international application. Taking advantage of this transliteration, it seems possible to judge whether the “sound of the original mark and the sound of the modified mark are the same.”
24. However, even if a transliteration is provided, an Office of Origin may not be certain how the letters (i.e., Latin characters) are correctly pronounced in the language of the original mark (which indicates the true sound of the original mark). It is thus impossible to prove that the sound between the original mark and the modified mark are the same.

2) Request for applicant to submit dictionary, etc.

25. Concerning languages which are not supported in an Office of Origin, the Office of Origin has an applicant submit a dictionary, etc. in which the sound or the meaning of a mark can be identified; and thus, the Office of Origin is able to prove the sameness of a mark.
26. However, an Office of Origin is unable to respond to a coined word which is not listed in a dictionary.

ii. Eliminate the system for proving sameness in an Office of Origin

27. By having an applicant declare the sameness of a mark, etc., the system of requiring that sameness be proven in an Office of Origin is in effect eliminated. However, this is not significantly different from elimination of the requirement of a basic application or registration because an international application will be filed without being examined by the Office of Origin. Although the following potential solutions were considered, the realization of such solutions was deemed difficult.

1) Have an applicant declare the “sameness of a mark”

28. By having an applicant declare the “sameness of a mark,” an international application can be filed without an examination by an Office of Origin. However, when it is subsequently pointed out to a Designated Office by a third party that the modified mark in the international application is not exactly the same as the

original mark in the basic application, the applicant bears responsibility for defending his explanation of the modified mark, and when the applicant is unable to provide satisfactory defense, a procedure for cancelling an international application can be applied.

29. However, even if a third party claims to a Designated Office that a modified mark in an international application is not the same as the original mark in the basic application or registration and even if the Designated Office is entitled to cancel the said international application on the grounds of such a claim, it would be difficult for the Designated Office to arrive at a judgment, and the examination would be a burden to the Designated Office, unless the scope of sameness were specified in the Common Regulations, etc. of the Madrid System.

2) Establish specialized agencies

30. Although a method can be considered for establishing specialized agencies to prove the sameness of a modified mark and an original mark, this does not seem to be a realistic solution because the specialized agencies would merely have the same problems as those of the Office of Origin as considered in the aforementioned “i.”

c. Conclusion of making the requirement flexible

31. In the present Madrid System, an applicant is able to file an international application only for the same mark as the national mark, and the Madrid System is a clear and simple system in this regard. However, if the requirement is made flexible, it would create a discrepancy in views on the sameness of a mark between an Office of Origin and an applicant, and the Madrid System might thus become unclear and complicated.

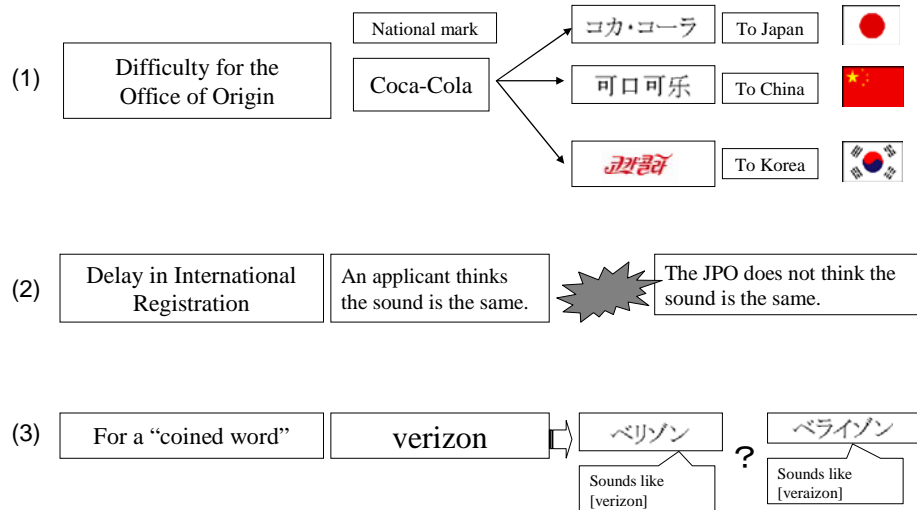
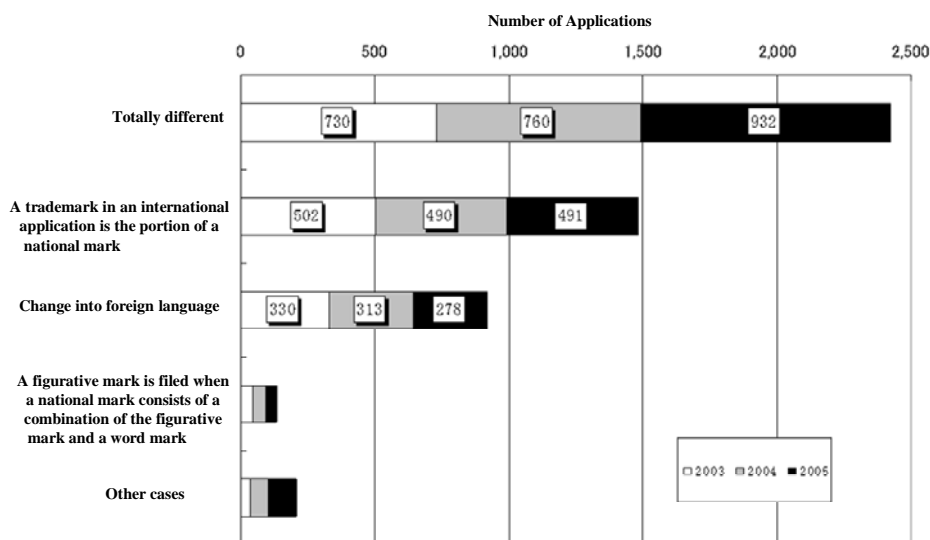


Fig. 3 Identify a mark by its sound

d. Analysis of domestic user needs

32. On the other hand, having asked users in Japan in 2007 how they modified an original mark when filing an international application, as figure 4 indicates, the largest number of applications was for a modified mark totally different from the original mark used in the home country in both meaning and sound.
33. It seems impossible for an Office of Origin to handle the differences between original and modified marks, no matter how flexible the requirement is made.
34. However, this problem could be solved by eliminating the requirement of a basic application or registration and thereby making it possible for applicants to file an application for marks modified to correspond to each designated country.



Source: User survey in 2007

Fig.4 How are the marks filed with other countries different from national marks?

2. Considerations about the elimination of the requirement of a basic application or registration

a. Effects of the elimination of the requirement of a basic application or registration

35. When an applicant modifies the form of a mark for each designated country, he has only to file an international application since there is no need to also file a basic application with his country for the mark which is not used in his country.
36. When the requirement of a basic application or registration is eliminated and self designation becomes possible, the convenience of the Madrid System for users will increase as users will be able to file simultaneously an application with many countries, including their own countries, and manage marks which are used in their countries and foreign countries on an international basis. (The Delegation of Norway also mentions this in the MM/LD/WG/2/9 Paragraph 10.)

37. However, the requirement of a basic application or registration forms the foundation of the Madrid System. Eliminating the requirement of a basic application or registration is equivalent to establishing a new registration system for marks and thus, further detailed consideration is required, including research about the effects on users and operations caused by the elimination of the requirement of a basic application or registration.

b. Free adoption of designated goods and services when filing an international application

38. An Office of Origin makes a judgment whether designated goods and services in an international application are the same as those in a basic application or registration. However, this judgment will no longer be needed due to the elimination of the requirement of a basic application or registration, and thus an Office of Origin's workload will be reduced. (The Delegation of Norway also mentions this in the MM/LD/WG/2/9, Paragraph 16.)

39. Indications of designated goods and services in an international application will not be restricted by those in a basic application or registration as a result of the elimination of the requirement of a basic application or registration. For example, by using indications in the Nice Classification or indications of designated goods and services which the JPO, the OHIM, and the USPTO have been proceeding with and releasing as acceptable items among the Trilateral Offices, each Designated Office is freely able to adopt indications of its acceptable designated goods and services respectively.¹

c. Considerations about Central Attack

40. The Central Attack system can be considered to be automatically eliminated due to the elimination of the requirement of a basic application or registration.

¹ The JPO, the USPTO, and the OHIM are proceeding with the joint creation of the Trilateral goods and services indication manual and releasing adoptable indications of goods and services (the Trilateral Offices list) for the purpose of reducing the filing burden of users and the burden of examination of the Trilateral Offices.

41. According to the results of a survey by Japan (as of September 2008), regarding 4,559 international applications filed through the JPO from 2000 to 2007, there were only four cases in which an international registration was totally canceled as a result of a basic registration being canceled through oppositions or demands for trial for invalidation by a third party. In addition, there were 83 cases in which an application for international registration was filed on the basis of a national application filed with Japan, and the international registration was canceled as a result of the refusal of the said basic application. Out of the 83 cases, there were 29 in which a national application was refused for not having distinctiveness; and in the remainder of the cases, the national applications were refused for reasons such as the existence of a prior registration.
42. That is, the number of Central Attacks and the demands for trial for invalidation by a third party account for only 0.15% of the 4,559 international applications filed through the JPO. Most of the other refusals resulted from domestic conditions, etc. These results seem to indicate that an applicant who seeks international registration tends to regard the Central Attack system as one of the demerits of the Madrid System.
43. On the other hand, under Article 9 quinquies of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, the holder of an international registration that was cancelled by the Central Attack is able to file a national application in each Designated Office with the same filing date as the filing date for the international registration which was cancelled by the Central Attack. Accordingly, a third party who has implemented the Central Attack must again perform procedures such as oppositions or trials for invalidation in each Designated Office where the said national application was filed.
44. In addition, in the case that the original mark in a basic application or registration is canceled based on a previously registered mark of a third party due to circumstances in the country of origin, it could be considered rather unkind to the applicant that the corresponding modified mark is also canceled in a foreign country where the previously registered original mark of the aforementioned third party does not necessarily exist in modified form. Moreover, even in the case that a basic application or registration for the original mark is canceled for not having distinctiveness in the applicant's home country, it cannot always be said that the modified mark would lack distinctiveness in other countries.

45. Therefore, it seems that the Central Attack System does not significantly benefit either a third party or an applicant who files an international application in the Madrid System.

3 Conclusions

46. After raising the issue that the Madrid System does not correspond to the linguistic diversity in the world, Japan proposed making the requirement flexible to a certain extent, but making the requirement flexible is difficult to achieve because we could not find any concrete method of operation.
47. Since deleting the requirement of a basic application or registration is equivalent to establishing a new registration system for marks, careful consideration on the deletion of the requirement of a basic application or registration is required. However corresponding to the linguistic diversity in the world is so crucial to make the Madrid System useful that we should discuss further including the deletion of the requirement. of a basic application or registration
48. Initially, in respect of the Madrid System, Japan thought it would be possible, without revising the Protocol, for the Madrid System to correspond to linguistic diversity through a more flexible requirement. However, suggestions and opinions about the operation of the Madrid System were provided by several countries since the JPO submitted ideas of making the requirement flexible to the Working Group. In light of these suggestions and opinions, the JPO has contributed the aforementioned considerations. We would sincerely like to express our gratitude to each country for participating in the Working Group which provided valuable suggestions and opinions.

[End of Annex and of document]