



**JAPAN PATENT ATTORNEYS ASSOCIATION**  
3-4-2, Kasumigaseki Chiyoda-ku, Tokyo 100-0013, JAPAN  
Telephone: + 81-3-3581-1211 / Facsimile: +81-3-3581-9188  
<http://www.jpaa.or.jp>

October 12, 2020

JPAA's Comments on the Meeting Documents of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks Eighteenth Session

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 11,600 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.

JPAA greatly appreciates the efforts and dedication shown by the Secretariats in rescheduling the meeting in order to move forward the discussion on various important issues. Meanwhile, we deeply regret that the representatives of JPAA are unable to participate in the meeting remotely due to the time difference this time, though JPAA is very much looking forward to seeing the world overcome COVID-19 and attending in-person at the next session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks in 2021.

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

**MM/LD/WG/18/2 — Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks**

JPAA supports the amendment to Rule 3(2)(a) of the Regulations, as proposed under "REPRESENTATION BEFORE THE INTERNATIONAL BUREAU, (A) APPOINTMENT OF A REPRESENTATIVE" in this document. After the amendment, in the case of subsequent designation, for example, certainly, Form MM12 will have to be submitted separately in order to appoint a representative, which would impose an additional procedural burden on users. However, as Form MM12 can be easily submitted using the Contact Madrid support service even now, and if the International Bureau plans to build a web service system in the near future so that the appointment of a representative will be recorded in the



register more quickly, we consider that the proposed amendment will pose no problem.

We also support the other amendments to the Regulations proposed in this document.

### **MM/LD/WG/18/3—New Means of Representation**

JPAA supports the amendments to Rule 9(4)(a)(v) and Rule 9(5)(d)(iv) of the Common Regulations, as proposed in this document.

Since it would be beneficial to users if the marks they wish to register were protected properly in the forms they desire, we would like to support the addition of a new means of "representation."

Problems could arise if the type of mark which a user wishes to register is not acceptable in the designated Contracting Party or if acceptable means of representation vary among Contracting Parties. In this respect, we would like to request the disclosure of information concerning the types of marks that are acceptable under each Contracting Party's trademark system (it would be very helpful for users if WIPO published and frequently updated data in the view format regarding new marks accepted at each Office so that users could easily check whether their marks will be accepted when they consider a strategy for filing applications). We also hope that harmonization will be promoted in this area.

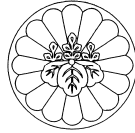
### **MM/LD/WG/18/4—Partial Replacement**

JPAA supports the proposed amendment to Rule 21 of the Common Regulations because this amendment will make it clear that partial replacement is possible, enabling users to easily switch from national registrations to international registrations.

### **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**

JPAA would like to request that deliberate discussion be held with regard to the introduction of Arabic, Chinese, and Russian languages as filing languages, from the following viewpoints.

- In international applications, the designated goods or services are very important factors that are directly linked to the interpretation of the scope of rights. We have concern that if a new language is introduced as a filing language, the accuracy of the translation 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, resulting in impairing the legal stability of related rights.



- If inaccurate translations are frequently found, the number of requests for corrections will increase, which could lead to the 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.
- If more languages are made available as filing languages, when the number of international applications increases rapidly, this could lead to the degradation of quality or prolongation of the processing of administrative work at the International Bureau.
- From users' viewpoint, there is concern about how the costs mentioned in this document, namely, initial investment, operating costs, and human resource costs, will be covered. We would like to request the International Bureau not to choose to cover these additional costs by raising filing fees.

#### **MM/LD/WG/18/6—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/18/7—Dependency**

JPAA is generally in favor of the first approach, described as "REDUCTION OF THE DEPENDENCY PERIOD FROM FIVE TO THREE YEARS," because this approach may serve to reduce trademark holders' concern that their international registrations might be cancelled due to central attacks to some extent. At the same time, this approach will still secure a means for third parties to initiate cancellation actions against defective registrations, irrespective of the grounds for cancellation. Thus, we find this approach to be well-balanced.

Meanwhile, 20 years have passed since Japan joined the Madrid System, and we have come to see this system being used effectively, such as when users try to use a central attack as a strategy to have an international registration cancelled on a global scale. Accordingly, there are not a few opinions even among Japanese users that the dependency principle be revised by limiting the grounds for central attacks, while maintaining the five-year dependency period.

In this respect, the second approach, described in this document as "CANCELLATION DUE TO THE CEASING OF EFFECT OF THE BASIC MARK ONLY ON BAD FAITH GROUNDS," which means limiting the scope of basic marks subject to central attacks to



those based on bad faith applications, should be carefully scrutinized, focusing on acceptable grounds for central attacks, because it may be difficult to establish a uniform definition of the term "bad faith" and demarcate the scope of "bad faith" grounds or applications, and also, there could be operational issues, such as whether the basic mark can be subject to central attack even when the basic mark based on a bad faith application is refused or invalidated due to grounds other than bad faith.

The third approach is to allow a central attack only in the case where the basic mark ceases to have effect due to a third party's 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 for 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.

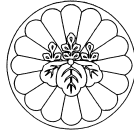
The fourth approach is the elimination of the automatic effect of dependency, which means, even if the basic application or basic registration ceased to have effect, the international application or registration would not be rendered automatically ineffective unless it is requested by a third party. JPAA thinks that the idea itself is reasonable, but this approach may raise an issue of legal stability of the international application or registration as it could put a trademark holder into an insecure position where there is a risk of facing a third party's 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 may request cancellation, but an excessive monitoring burden could be imposed on trademark holders unless each Office operates this time limit strictly. In addition, if this approach is introduced, the ex officio refusal would not lead to a central attack in any case, which is another operational issue.

As mentioned above, the second to the fourth possible approaches shown above still involve various possible problems, including operational issues and disadvantages for users, and thus, we hope that deliberate discussion will further continue, giving due consideration to these possible problems.

#### **MM/LD/WG/18/8 and MM/LD/WG/17/9—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 (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.

Sincerely,

Yoshihiro SHIMIZU  
President, JPAA