

November 4, 2022

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

MM/LD/WG/20/3—Provisional Refusal

JPAA agrees with the proposal of the International Bureau to introduce a minimum time limit of two months by the amendment to Rule 17(2)(vii) of the Regulations.

In some cases, users face a burden due to the extremely short time limit for responding to notifications of provisional refusal, and in order to reduce such burden, we consider that each Contracting Party should secure a sufficient time limit to respond. It is also necessary to give each Contracting Party a certain degree of discretion. Accordingly, to keep balance between these matters, we consider that this option of setting a minimum time limit of two months is appropriate.

In addition, from the perspectives of clarity and equitability, it would be user-friendly to calculate the time limit for response from the "date the International Bureau transmits the notification to the holder."

Report Following the Request in Paragraph 23(ii) and (iii) of Document MM/LD/WG/19/8 “Summary by the Chair” (Document: 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 continue to be held with regard to the introduction of Arabic, Chinese, and Russian languages as filing languages, 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 filing 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, introduction of any of the proposed new 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.

(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 for this to lead to raising the official fees and result in increasing the burden on users. In addition, if the International Bureau is to 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 chosen because they require lower costs than direct applications. 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 languages on users.

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