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**JTA Position Paper regarding the Working Group
on the Legal Development of the Madrid System
for the International Registration of Marks
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The Japan Trademark Association (JTA) is an independent non-profit association in Japan, established on November 28, 1988. As of November 2022, JTA has 870 members consisting of 5 advisors, 486 individual members, 16 special members (academic experts), 238 companies, and 122 patent and trademark agencies or law firms. The corporations, attorneys-at-law, patent and trademark attorneys, and academic experts of JTA share a common interest in trademarks and related fields. They collaboratively engage in various activities such as research, studies, policy advocacy, information exchange, and mutual development.

JTA has reviewed the working documents for the Twentieth Session of the Working Group and would like to submit the following comments as a user organization of the Madrid System for the International Registration of Marks.

JTA Comments

1. Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ([MM/LD/WG/20/2](#)) - DIRECT FILING OF REQUESTS FOR THE RECORDING OF SUBSEQUENT DESIGNATIONS, CHANGES AND LICENSES

JTA would like to support the proposed amendments because the amendments would potentially contribute to the reduction of the workload of the International Bureau, the decrease in the irregularity rate, the shortening of processing time, and the simplification of the Madrid System.

Furthermore, JTA would like to strongly support the proposed exception to continue to allow the presentation of requests for the recording of change in ownership through the Office of the Contracting Party of the holder or of the Contracting Party of the transferee and hope that the exception will be retained in the future. This is because there are various forms of transfer of trademark rights based on relevant national laws in each country, and the recording process can be complicated, so JTA believes that it would be highly beneficial for users to be able to submit the request in consultation with the Offices of the Contracting Party of the holder or of the Contracting Party of the transferee.

In the meantime, considering that the number of online forms for various procedures is rapidly increasing and the order of entries in MM forms may differ from the order of entries of eMadrid online forms, JTA would like to request that the International Bureau should actively publish not only the notes on MM forms but also the explanation and notes on eMadrid online forms, such as explanations and notes on each input item, at the WIPO website. JTA would like to further request that consultation services about specific cases should be provided through the WIPO IP Portal or at the WIPO external offices, if necessary, before the holders of international registrations take the procedures.

2. Provisional Refusal ([MM/LD/WG/20/3](#))

JTA would like to support the proposed amendments indicated in the document MM/LD/WG/20/3, especially the amendment to introduce a minimum time limit of two months for the holder of an international registration to respond to a notification of a provisional refusal, as users have been struggling to deal with countries with extremely short response deadlines.

JTA also welcomes the introduction of the requirement to indicate in the notification the start and expiry dates of the time limit, where it starts on a date other than the date on which the International Bureau transmits the notification to the holder or on which the holder receives the notification.

Concerning the start date, to avoid users from being disadvantaged due to late notification of a provisional refusal, it would be preferable if the time limit would be calculated from the date on which the International Bureau transmits the notification to the holder or the date on which the holder receives the notification so that the holder can secure the sufficient time to consider the grounds of the provisional refusal and make an adequate response before the time limit. However, we understand that the Offices of several designated Contracting Parties

would have difficulty controlling the time limit and knowing the start date with such an approach. Taking all of these circumstances into consideration, JTA would like to express our appreciation to the International Bureau for the proposed amendment of this time, which has taken the aforementioned positions of both users and the Offices of designated Contracting Parties into consideration and balanced both.

On the other hand, given that the differences in the start date from country to country will remain even after the amendments take effect, JTA would like to suggest that a cover letter which the International Bureau transmits to the holder of an international registration with a notification of provisional refusal should clearly indicate from when the time limit would be calculated (i.e., the start date that the Office of a designated Contracting Party indicates in the notification of provisional refusal, or the date on which the International Bureau transmits the notification to the holder, or the date on which the holder receives the notification) and the response period if the expiry date is not indicated in the notification.

JTA would also like to suggest that the "information on the time limit to respond to notifications of provisional refusals and on the way to calculate them" (MM/LD/WG/20/INF/2) should be continuously updated in the future and published on the WIPO website, and sent to the holder of an international registration with the notification of the provisional refusal for reference.

Furthermore, JTA would like to request that some relief measures be provided if the time limit has already passed due to any reasons not attributable to the holder when the holder receives a notification of provisional refusal from the International Bureau.

3. 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")

Regarding the issue of the introduction of the Arabic, Chinese, and Russian languages into the Madrid System, JTA would like to continue to seek a careful discussion on this matter, considering the following points, as in the previous year.

- ✓ The designated goods and services are essential elements directly related to the interpretation of the scope of rights. Considering the significant impacts on both the holder and the third parties and legal stability of each trademark right,

any discrepancy in the scope of rights due to translation errors should be avoided. Therefore, in order to maintain confidence and legal stability in the Madrid System, the current situation where the number of working languages is limited should be maintained as much as possible, and the International Bureau should not bear an excessive burden of translation from the viewpoint that, given the role of the International Bureau, priority should be given to accurate and prompt processing.

- ✓ To ensure transparency in the application process of each case and to maintain confidence and reliability in the entire Madrid System, the International Bureau should ensure the quality of translation to languages other than those used in the Offices of designated Contracting Parties. It should be noted that ensuring the quality of translation may result in higher translation costs than currently anticipated and delays in the processing of the International Bureau.
- ✓ Regarding the quality of translation, the Secretariat states in the document MM/LD/WG/19/inf/3 that enriching the Terminology Database, securing the best-performing machine-translation tools, as well as the application of targeted post-editing under a differentiated practice, will ensure the quality of translation. If so, JTA believes that a certain number of samples should be taken and monitored to see if the accuracy of the translation is maintained and the Madrid System works without any problems before the introduction of the subject three languages.

4. **An Updated Road Map for the Evolution of the Madrid System** **[\(MM/LD/WG/20/7\)](#)**

JTA would like to express our appreciation to the Secretariat and the Working Group for the steady progress in resolving various issues based on the roadmap discussed at the 14th and 15th Sessions of the Madrid Working Group, aiming to improve the user-friendliness, reliability, and efficiency of the Madrid System. JTA hopes that further active discussions will be continued in the Working Groups based on the updated roadmap.

JTA looks forward to participating in the Madrid Working Group meeting and assisting the Working Group in considering a better Madrid System.