

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

Nihombashi 3-Chome Square Bldg.
6F, 9-1 Nihonbashi 3-chome,
Chuo-ku, Tokyo 103-0027, JAPAN



TEL:+81-3-6262-1570
FAX:+81-3-6262-5655
URL:<http://www.jipa.or.jp/>

May 13, 2024

Ms. Wang Binying
Deputy Director General
World Intellectual Property Organization,
34, chemin des Colombettes
CH-1211 Geneva 20, Switzerland

Re: Invitation to Contracting Parties of the Madrid System, other WIPO Member States and Observer Organizations to Submit Proposals Regarding Dependency

Dear Ms. Binying

We, the Japan Intellectual Property Association or “JIPA”, is a non-profit, non-governmental organization, which has 990 members (as of April 10, 2024). It represents industries and users of the intellectual property (IP) system and provides related institutions all around the world with well-timed, suitable opinions on the improvement of their IP systems and their utilization. For further information regarding JIPA is available at <http://www.jipa.or.jp/>.

Regarding the "Invitation to Contracting Parties of the Madrid System, other WIPO Member States and Observer Organizations to Submit Proposals Regarding Dependency" received in the letter dated February 12, 2024, we would like to submit the following statements.

Proposals Regarding Dependency

(1) Impact Assessment of Dependency Relaxation

We support the relaxation of dependency from 5 years to 3 years, but believe it is necessary to assess the impact of this relaxation.

As part of the impact assessment, we propose that WIPO take the lead for a certain period to investigate the increase in oppositions to international registrations in each designated country, and report the findings at a working group or other forum.

We also propose that WIPO set up a dedicated online suggestion box on websites it operates, such as the WIPO IP Portal, to directly collect cases affected by the relaxation of dependency from users and others, and report these cases at a working group or other forum.

(2) Remedies for Users

To maintain a deterrent against bad-faith applicants after the mitigation of dependency, we propose the establishment of new remedies in connection with the cancellation of International Registration.

As the first remedy, we propose the creation of a procedure to maintain international registration after a central attack.

The procedure to maintain international registration after a central attack involves the right holder paying a certain additional fee within a specific period to maintain their international registration. (This procedure is similar to subsequent designation but is a different procedure.)

The creation of this procedure gives the chance for the genuine right owners to maintain their rights with filing one Transformation form and less cost compared from conventional Transformation or direct applications to each Offices, while imposing the higher economical and mental pressure on the bad faith applicants to maintain IRs due to the additional fee for this new Transformation procedure. At the same time, this allows the International Bureau or the offices of each designated country to provide all the benefits of international registration to the right holder without compromising their revenue or incurring significant operational costs. The simple system also enables attorneys to explain the remedy more easily to their clients.

As a second remedy, we propose the introduction of a cancellation system for international registrations by WIPO.

The cancellation system for international registrations by WIPO allows genuine right holders who have been harmed by malicious international registrations to apply to WIPO for cancellation, and WIPO decides whether to maintain the international registration in each designated country.

The establishment of this system will make the relaxation of dependency a deterrent against malicious right holders, allowing genuine users to receive a uniform standard of judgment without being subject to the varying laws and regulations of each designated country. Therefore, the establishment of this system is beneficial for maintaining the order of the global economy in the 21st century.

To avoid confusion due to the change in the system of dependency relaxation, we believe it is best to introduce the relaxation of dependency and the enhancement of remedies for users simultaneously and to investigate and assess the impact of their introduction. However, we support WIPO even if the order is to first relax dependency, then investigate and assess its impact, and finally strengthen remedies for users.

(3) Suspension or Abolition of Dependency

Due to the potential increase in malicious trademark applications caused by the relaxation of dependency from 5 years to 3 years and the introduction of new languages, we propose not to consider the suspension or abolition of dependency as an agenda item until the results of the impact assessment proposed in (1) and the establishment of the remedy system and the plan for new language introduction proposed in (2) are confirmed.

We believe that all rules and systems under the Madrid Protocol should be simple and balanced, and it is not advisable to proceed with the relaxation of dependency alone hastily.

JIPA looks forward to participating in the Madrid Working Group meeting.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'Koji Saito'. The signature is stylized with a large 'K' and a long horizontal stroke at the end.

Koji SAITO
Managing Director of JIPA