

November 29, 2023

Position Paper on Twelfth Session of Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs

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 11,900 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.

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

H/LD/WG/12/8 - REPORT ON CONSULTATIONS HELD CONCERNING THE POSSIBLE INTRODUCTION OF NEW LANGUAGES INTO THE HAGUE SYSTEM

Concerns and requests regarding the possibility of fees increase

We believe that one of the main reasons why Japanese users choose the Hague System is its cost effectiveness. Therefore, if the fees are additionally increased when additional languages are introduced as working languages under the Hague System, this would reduce the benefit to Japanese users for using the Hague System.

In particular, in light of the facts that the Hague System is in deficit and that the WIPO Secretariat reported in the document H/LD/WG/11/4 that it would be currently impossible to ensure the quality of translation under the Hague System, it is highly likely that the fees will be raised when additional languages are introduced at this stage.

Accordingly, we would express our concern over the introduction of additional languages and request that the Working Group engage in through discussions so that the introduction of additional languages will not result in fees increase.

Concerns and requests regarding the quality of translation

The JPAA would consider that it is still doubtful whether the *Product Indication* and the *Description* would be correctly translated, or the applicants can notice any mistranslation, when

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translation is done between languages of different linguistic systems under the present translation technology.

Most of the designated Contracting Parties use languages other than the existing working languages, and they translate the *Product Indication* and the *Description* into mother languages for examination. If there are grounds for refusal, the designated Contracting Party prepares a notification of provisional refusal and retranslate the *Product Indication* and the *Description* into the working language it selects. Under this practice, if the translation is done between languages of different linguistic systems, under the present translation technology, the applicant would not be able to believe that the translation is correct, and the applicant therefore must request a translation service provider to check the translation.

In addition, even if WIPO provides a machine translation, since it is an unofficial translation, the applicant will have to check whether the translation is correct if its reliability is questionable. This would give rise to additional workload and costs.

If the new languages are introduced, more applicants who have been able to receive notifications in the existing working languages will then receive notifications in languages that are different in linguistic systems, together with an unofficial translation. In such case, users of the Contracting Parties that use the existing working languages will not find it advantageous to file applications under the Hague System if they remain doubtful about the quality of translation and anxious about whether the scope of their rights is correct. As a result, when seeking to register designs in the designated Contracting Parties that use the new languages as their working languages, users would consider filing direct applications via local attorneys rather than filing applications under the Hague System.

From the user's standpoint, the JPAA requests that WIPO revise the Regulations before introducing the new languages to ensure that the Offices of the designated Contracting Parties will take responsibility for the translation of the official correspondences including notifications they issue in their working languages and include the English translation in these correspondences, so that applicants can trust the quality of the translation and confirm whether the scope of their rights is correct.

Requests regarding costs to be borne by the beneficiaries

As previously mentioned, even if multilingual machine translation is provided by WIPO, it will still be inconvenient and burdensome for users to receive notifications of refusal in languages they do not understand. On the other hand, the Offices of the Contracting Parties whose native

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languages are introduced as additional languages will be able to receive applications and issue notifications of refusal in their native languages. This will streamline their administrative workload compared to the current practice of using only the existing working languages.

In summary, the addition of new languages under the Hague System primarily benefits the Offices of the Contracting Parties and their nationals whose native languages are introduced. Therefore, if any additional costs are incurred due to the introduction of new languages, the principle of the beneficiary pays should be applied, and such costs should be covered by the Offices of the Contracting Parties whose native languages are introduced, rather than being imposed on users through fees. We kindly request that the Working Group consider the possibility of using contributions from these Offices of the Contracting Parties to cover any potential additional costs that may arise from the addition of new languages under the Hague System.

Concerns and requests regarding deficit balance of the Hague System

We would request the Working Group to request WIPO to provide a demonstration that the introduction of the new languages will realistically improve the deficit balance of the Hague system in future that we are currently facing, that is, an estimate of the balance *between* the revenue from expected increase in the number of Hague applications that the introduction of the new language will bring *and* the expenses necessary for the introduction of the new language. Suppose it is estimated that the increase in the number of applications will cover the necessary expense for introduction of the new languages and it is shown that there is no possibility of a fee increase, in that case, we believe that there remains only issue relating to the quality of translation.

Requests regarding selection and addition of new languages

We kindly request that WIPO ensure fair treatment that is acceptable to all Contracting Parties, such as selecting an additional language based on objective data, e.g., the current number and the potential number of applications, rather than introducing a language only based on the request of a specific Office of the Contracting Party. We request fair judgment considering that some Contracting Parties cannot agree to the introduction of additional languages at the present stage considering the financial situation of the Hague System and the possible burden on users.

Request for possible research concerning operation language in contracting parties

There are offices that process applications filed through the Hague System using a language that

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is not one of their native languages. It is not very clear what language is used to process the applications in such offices from the information currently available in public. Users would like to consider whether to use the Hague System while considering the possibility of mistranslation on various occasions. We propose WIPO to conduct a research to identify which language is used to examine applications and specify the scope of rights at the Office and the Court of each Contracting Party.

End

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