

**Protection of Geographical Names  
(Regional Collective Trademark System/  
Protection of Geographical Indications)**

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## I Protection of Geographical Names

### 1. Protection of indications of places of origin and other geographical names under the Japanese Trademark Act

Article 3 of the Trademark Act stipulates requirements to be satisfied for registration of a trademark. Article 3 (1) (iii) stipulates that a trademark consisting solely of a mark indicating the origin of a good in a common manner cannot be registered as a trademark, as follows:

“Article 3

(1) Any trademark ...(snip) ... may be registered, unless the trademark:

...(snip) ...

(iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;”

The Japan Patent Office Interpretation of Clauses of Industrial Property Laws (17th Edition)<sup>1</sup> (hereinafter “JPO Interpretation”) issued by the Japan Patent Office explains the reason for the unregistrability; as follows:

“A trademark comprised solely of a mark indicating the place of origin of a product or any other geographical name in a common manner cannot be registered as a trademark because such indications are generally necessary for placing a product (or service) in the distribution or transaction process, and every person wishes to use them. Thus, it is not appropriate to allow exclusive use of these indications to certain private individuals. Moreover, in many cases, these indications have been used generally by unspecified persons or obviously will be used generally by unspecified persons in the future. Therefore, people do not recognize such trademark as something to discriminate one product (or service) from another.”

Article 4 of the same Act lists unregistrable trademarks. The Article stipulates that trademarks falling under paragraph (1) item (xvii), among others, are not allowed to be registered:

“Article 4 (1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

...(snip)...

(xvii) is comprised of a mark indicating a place of origin of wines or spirits of Japan which has been designated by the Commissioner of the Patent Office, or a mark indicating a place of origin of wines or spirits of a member of the World Trade Organization which is prohibited by the

said member from being used on wines or spirits not originating from the region of the said member, if such a trademark is used in connection with wines or spirits not originating from the region in Japan or of the said member;”

Similarly, the JPO Interpretation explains the reason for stipulating this provision as follows:

“The TRIPS Agreement includes no provision to obligate member countries to protect geographical indications of domestically-produced wines or spirits. However, if this provision (Article 4 paragraph 1 item (xvii)) is not provided in the Japanese Trademark Act, (i) places of origin in Japan are treated disadvantageously compared with places of origin in other member countries, and (ii) as stipulated in Article 24 paragraph 9 of the TRIPS Agreement, if geographical indications are not protected in the country of origin, other member countries have no obligation to protect them. To avoid disadvantageous treatment of places of origin in Japan in other member countries, the Act stipulates that trademarks indicating the origin places of domestically produced wines and spirits shall be protected.”

## 2. Protection of geographical indications

In addition to the protection under the Trademark Act described above, the Act on Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs (generally called the “Geographical Indications Act”) was enacted in June 2014 to protect geographical indications of agricultural, forestry and fishery products and foodstuffs.

## 3. Protection of other geographical indications

Articles 22 to 24 of the TRIPS Agreement impose an obligation to protect geographical indications on member countries. Article 22.1 of the TRIPS Agreement defines geographical indications as follows:

“... indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”

Japan fulfills its obligations regarding geographical indications under the TRIPS Agreement by protecting them through the Trademark Act and the Geographical Indications Act, and by applying the Unfair Competition Prevention Act and the Act against Unjustifiable Premiums and Misleading Representations. As for the geographical indications of wines and spirits, Japan fulfills its obligations under the TRIPS Agreement by applying the Act on Securing of Liquor Tax and on Liquor Business Associations.

## II Regional Collective Trademark System

### 1. Background of the introduction of the Regional Collective Trademark System

Products rooted in various regions now attract attention nationwide. There are many cases of regional products supporting the economic development projects of their respective regions, with such projects being actively been implemented in many regions throughout Japan.

Amidst such initiatives, the Intellectual Property Promotion Project 2004 was established in May 2004 by the Intellectual Property Strategy Headquarters<sup>2</sup> of the Cabinet Office. The project aimed to review the protection system for regional brands of agricultural, forestry and fishery products and foodstuffs in FY2004 from the viewpoint of strengthening the competitive power of local products, vitalizing regional communities, and protecting consumers—taking into account the impact on products whose names have already been generalized, or whose use has already become popular in other regions. Relevant public agencies have commenced reviews according to the announcement.

### 2. Protection of regional collective trademarks under the Trademark Act

Upon the commencement of the Intellectual Property Promotion Project 2004 described above, as well as a review conducted by the Patent Office in the Ministry of Economy, Trade and Industry regarding the protection of regional brands, the Act for Partially Revising the Trademark Act (Law No. 56, 2005) was promulgated on June 15, 2005, and enforced on April 1, 2006. It partially revised the Trademark Act, and introduced the Regional Collective Trademark System, stipulating that a regional business cooperative, agricultural cooperative or any other similar regional association may register a trademark comprising the name of a region and the name of a product (or service) as a regional collective trademark with the Japan Patent Office if such trademark has been known by consumers to some extent.

As explained in “1. Protection of geographical names, (1) Protection of indications of places of origin and other geographical names under the Japanese Trademark Act” above, trademarks comprising letters indicating the name of a region and the name of a product (or service) or trademarks comprising any other similar elements are trademarks that a wide range of business operators would want to use. Therefore, they do not fit the idea of exclusive ownership by a single business operator, and consumers do not recognize such trademarks as something through which to distinguish one product (or service) from another because they are used generally by the public. For these reasons, these trademarks were not registrable under the Trademark Act before the revision, as they did not satisfy the requirements stipulated in Article 3 (1) of the same Act. To be eligible for registration, such trademarks had to become recognizable by consumers as a result of their use by a specific business operator to satisfy the requirement in Article 3 (2) of the same Act. Article 3 (2) of the same Act did not stipulate to what extent a trademark must be recognizable by consumers, but in practice it was said that a trademark must be recognizable by consumers throughout Japan with a high degree of penetration. Therefore, a business operator could not remove me-too users until the trademark became recognizable by consumers throughout Japan to a considerable extent. Moreover, the

use of such trademarks by me-too users would have made it more difficult to be recognizable as a trademark of a specific business operator.

On the other hand, a trademark comprising the name of a region and the name of a product (or service) with an added distinctive graphic was regarded as recognizable by consumers as a trademark through which to distinguish a product (or service) of a business operator from other persons' products (or services) because of such a distinctive graphic. The provisions in Article 3 (1) of the same Act did not apply due to this recognizability, and it would be registrable if other requirements for registration were satisfied. This imposed another problem. A business operator could not effectively remove me-too users when their trademarks comprised letters that were identical with those used in the trademark of that business operator, but that had an added graphic that was not used in its trademark. These trademarks of me-too users were not regarded as having similarity to the trademark of the business operator due to these different graphics.

To address such problems, the Regional Collective Trademark System imposes more relaxed requirements for registration of trademarks comprising letters that indicate the name of a region and the name of a product (or service) than those stipulated in Article 3 (2) of the Trademark Act. Even if the extent of consumer recognition of the trademark is narrower or lower than that required in actual practice as stipulated in Article 3 (2) of the same Act, a trademark may be registered as a regional collective trademark. These requirements are explained in detail below.

### 3. Registration requirements for regional collective trademarks

To be registrable as a regional collective trademark, the application for registration must satisfy certain requirements:

#### (1) Eligibility of an applicant for registration of a regional collective trademark

The Trademark Act stipulates that an entity is eligible as an applicant for registration of a regional collective trademark if it satisfies the following requirements:

“Any association established by a special Act, including a business cooperative (those which do not have juridical personality are excluded, and limited to those which are established by a special Act providing, without a just cause, that the association shall not refuse the enrollment of any person who is eligible to become a member or that the association shall not impose on any of its prospective members any condition that is heavier than those imposed on its existing members) a commercial society, a chamber of commerce, a special non-profit cooperation..., or a foreign juridical person equivalent thereto...” (Article 7-2 (1), Trademark Act)

The applicant must be a business cooperative with a juridical personality, or an association incorporated under a special law. Such law underlying the incorporation must stipulate that the association shall not unfairly refuse the enrollment of any eligible person as a member without due cause.

The JPO Interpretation explains the reason for imposing requirements on an entity in protecting its regional collective trademark (entity requirement) as follows:

“Regional brands are basically intended for use by a wide range of product producers or service providers in the region who want to use them in connection with their products or services, and thus should not be exclusively owned by a single business operator. For this reason, among others, they were not registrable in accordance with Article 3 (1) of the Trademark Act before the revision. To address this issue, in the Regional Collective Trademark System established in the revised Act, the membership requirement for an association is set to guarantee to the greatest extent possible that any business operator who wants to use the regional collective trademark of the association is not refused from becoming a member of such association.” (JPO Interpretation)

For this reason, a strict eligibility requirement is set for an applicant as explained above.

In Japan, juridical persons who are eligible to register a regional collective trademark include: a business cooperative, agricultural cooperative, fishery cooperative, marine product cooperative, forestry cooperative, liquor producer cooperative, liquor seller cooperative, commercial association, shopping district promotion association, commercial society, chamber of commerce, and special non-profit corporation.

Individual persons, local governments, corporate juridical persons, incorporated foundations, business corporations and the like are not eligible to register a regional collective trademark.

As for agricultural cooperatives, which are juridical persons eligible to register a regional collective trademark, Article 20 of the Agricultural Cooperatives Act<sup>3</sup> stipulates the right to become a member of an agricultural cooperative as follows:

“The cooperative shall not, without a due reason, refuse an eligible person from becoming a member of the cooperative, or impose heavier requirements on such person than those imposed on existing members when they joined the cooperative.”

The Trade Act stipulates that a foreign juridical person is also eligible to apply for registration of a regional collective trademark—not only associations in Japan—by referring to such person as “a foreign juridical person equivalent thereto,” as explained above. The JPO Interpretation states this to be “a foreign association having the status of a juridical person, comprising members who are business operators producing products or providing services as their business, which guarantees that membership is not unfairly refused to eligible persons.” If such foreign juridical person is equivalent to an association as defined in Japan, it is allowed to apply for registration of a regional collective trademark. In fact, some foreign associations have filed applications and are granted registration of their regional collective trademarks. I will discuss this topic later in this textbook.

If two or more associations jointly file an application for registration of a regional collective

trademark, all such associations must satisfy the entity requirement.

As explained above, when filing an application, the applicant must submit to the Commissioner of the Japan Patent Office a document certifying that it is:

“an association established by a special Act, including a business cooperative (those which do not have juridical personality are excluded, and limited to those which are established by a special Act providing, without a just cause, that the association shall not refuse the enrollment of any person who is eligible to become a member or that the association shall not impose on any of its prospective members any condition that is heavier than those imposed on its existing members) a commercial society, a chamber of commerce, a special non-profit cooperation..., or a foreign juridical person equivalent thereto.”

(entity requirement)

Article 7-2 (4) of the Trademark Act stipulates as follows:

“ Any person who desires to register a regional collective trademark .... shall, at the time of filing of an application for trademark registration.... submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is an Association, etc. ....”

It stipulates the formality requirement that an applicant for trademark registration must submit a document certifying its status as an eligible association. If an applicant fails to submit the certifying document, it is requested to correct the incompleteness of its application.

If two or more associations jointly file an application for registration of a regional collective trademark, all associations must individually submit documents certifying that they satisfy the entity requirement.

## (2) Use of regional collective trademarks

Article 7-2 (1) of the Trademark Act stipulates as follows regarding the use of regional collective trademarks:

“...provided that the trademark is used by its members...”

The JPO Interpretation explains the reason for stipulating the use of a regional collective trademark as follows:

“Regional collective trademarks are trademarks that an association allows its members who are business operators to use in order to indicate that a product or service having that trademark has originated from a member of that association. Therefore, a trademark to be registered as a regional collective trademark must be “a trademark that the association allows its members to use.” In addition to its members, the association itself may use the trademark.”

(JPO Interpretation)

For this reason, the Trademark Act stipulates the use of a regional collective trademark as explained above. To be registrable as a regional collective trademark, therefore, the association must allow its members to use the trademark. It is, additionally, required that the regional collective trademark be used by the members in accordance with the use conditions designated by the association.

A regional collective trademark intended to be used by the applicant (association) itself will also be granted registration if it is deemed that the association would allow its members to use it.

### (3) Trademarks registrable as regional collective trademarks

The Trademark Act stipulates that a trademark is registrable as a regional collective trademark if it satisfies the following requirements:

- “(i) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members; (Article 7-2 (1) (i))
- (ii) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the name customarily used as a name indicating the goods or services pertaining to the business of the applicant or its members; or (item (ii) of the same paragraph)
- (iii) a trademark consisting solely of characters indicating, in a common manner, the name of the region and the common name of the goods or services pertaining to the business of the applicant or its members, or the name customarily used as a name indicating thereof, and characters customarily added in indicating, in a common manner, the place of origin of the goods or the location of provision of the services. (item (iii) of the same paragraph)

The JPO Interpretation explains the reason for defining trademarks registrable as regional collective trademarks as follows:

“Because trademarks used as regional brands are often comprised of the name of the region and the name of the product (or service), the Act stipulates that a trademark satisfying this requirement is registrable as a regional collective trademark. The Act limits the registrability to a ‘trademark consisting solely of characters..., in a common manner’ because a trademark consisting of a combination of characters and a graphic or similar element, or a trademark that uses specially expressed characters, does not fall under the conditions stipulated in Article 3 (1) of the Trademark Act because it has discriminability by itself, and thus is registrable as a trademark under the Trademark Act before the revision. Therefore, the necessity that such trademark be registered under the Regional Collective Trademarks System is low.” (JPO

Interpretation)

Specifically, a trademark registrable as a regional collective trademark is:

(i) a trademark comprising the name of a region and the common name of a product (service) (paragraph (1) item (i))

It is a trademark comprising the combination of the name of a region and the common name of a product (service).

The “name of a region” refers to not only the name of a current administrative region but also the old name of a region or country, the name of a river, mountain or water area, and other geographical names.

Regarding the “common name,” the Trademark Examination Guidelines stipulate that the common name means: “a name that has been recognized as the common name of a product or service in trading circles, not indicating a product derived from a specific business operator or a service provided by a specific business operator. The common name of a product (service) also includes the abbreviated name or the nickname of such product or service.” (Trademark Examination Guidelines)<sup>4</sup>

(ii) a trademark comprising the name of a region and the customary name of a product (service) (paragraph (1) item (ii))

The customary name refers to a name that is not the common name of the product or service, but that is customarily used by consumers and traders to indicate the product or service. (JPO Interpretation)

The Trademark Examination Guidelines stipulate that “the name customarily used to indicate a product or service” includes, for example, the naming of “ori” (weave) or “tsumugi” (pongee) in relation to “silk fabric” or a “belt”; the naming of “yaki” (ware) in relation to “bowl” or “cup”; the naming of “buta” (pork) in relation to “pork meat”; and the naming of “onsen” (hot spring) in relation to the service of “provision of a bathing facility” or “provision of an accommodation facility.”

(iii) a trademark comprising the name of a region and the common name or customary name of a product (service), with added “characters customarily used as indicating the place of origin of the article or the location of provision of the service” (item (iii) of the same paragraph)

The “characters customarily used as indicating the place of origin of the article or the location of provision of the service” under the Act may include, for example, the characters “homba” (home), “tokusan” (local specialty), or “meisan” (local specialty) added to the name of the place of origin; or the characters “homba” (home) added to the name of the place of service. (Trademark Examination Guidelines)

The Act includes these trademarks in the range of trademarks registrable as regional collective trademarks, considering the actual situations where they have been used as “regional brands.” (JPO Interpretation)

A “trademark indicating in a common manner” means a mark that is comprised of characters presented in a common manner, including a mark indicating the common name of a product (service) by the Roman alphabet, hiragana or katakana, or standard characters (characters designated by the Commissioner of the Japan Patent Office, Article 5 (3) of the Act).

The Trademark Examination Guidelines present some examples of trademark that are not registrable as regional collective trademarks.

“5. The following are examples of trademarks that do not fall under any of the conditions stipulated in items (i) to (iii) :

(1) A trademark that comprises solely “the name of a region,” or a trademark that does not include “the name of a region”;

(2) A trademark that comprises solely “the common name of a product or service,” or a trademark that comprises solely “the name customarily used to indicate a product or service”;

(3) A trademark that comprises neither “the common name of a product or service” nor “the name customarily used to indicate a product or service”;

(4) A trademark that comprises any other characters than those designated in items (i) to (iii) (for example, characters that are not recognizable as those used when indicating the place of origin of a product or the place of provision of a service), a symbol or a graphic; or

(5) A trademark that comprises characters transformed into a design to a discriminable extent.”

For example, trademarks that are solely comprised of the name of a region; that include no regional name; that have an added graphic; or whose specially designed characters are ineligible are not registrable as regional collective trademarks.

(4) Close relationship between the name of a region and the product (service)

The Trademark Act defines the “name of a region” included in a trademark to be registrable as a regional collective trademark, as follows:

“2. The term “name of the region” as used in the preceding paragraph means, even prior to the filing of the said application, the name of the place of origin of the goods, the location of provision of services, or the name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent, for which the trademark pertaining to the said application has been used by the applicant or its members, or abbreviation thereof.”  
(Article 7-2 (2), Trademark Act)

As explained above, the Trademark Act stipulates that to be registrable as a regional collective trademark, the name of the region included in the trademark must have a close relationship with the product or service for which the trademark has been used before the application. The JPO Interpretation explains the reason for this requirement as follows:

“The Trademark Act stipulates that 'The term "name of the region" as used in the preceding paragraph means, even prior to the filing of the said application, the name of the place of origin of the goods, the location of provision of services, or the name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent, for which the trademark pertaining to the said application has been used by the applicant or its members, or abbreviation thereof. If an application for registration is filed for a trademark that exploits the impressions that would be evoked from the name of a region contained in such trademark, but, in fact, the trademark has been used for a product or service that has nothing to do with that region, such application for registration does not fit the purpose of the Regional Collective Trademark System. Accordingly, such trademark is not registrable as a regional collective trademark under the relaxed registration requirements. Generally, the name of a region used in a trademark is the name of the place of origin of a product or the place of provision of a service. However, business operators use the name of a region in a “regional brand” for various reasons. Therefore, the Act also includes “the name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent.” For example, the name or the abbreviated name of a region which is the origin place of the major raw material or the production method of a product is allowed to be used. Whether or not a regional name is closely related to a product or service is determined by considering whether the public in general considers it reasonable to use that regional name in the trademark in question based on the type of product or service, profiles of traders and customers, actual condition of trading and other factors. The “place of origin of a product,” the “place of provision of a service” and any “other regional name” are not limited to names of current administrative regions at the time of the filing of the application, but also include the old name of a region or country, the name of a river, mountain, pond or lake, the name of a water area, and other geographical names. Abbreviated names of regions are also permitted because trademarks often use abbreviated regional names.” (JPO Interpretation)

The “name of a region” included in a trademark must satisfy any of the following requirements in relation to the product or service for which the trademark has been used by the applicant or its members before the application is filed for that trademark:

(i) The place of origin of a product

According to the Trademark Examination Guidelines, the place of origin is, for example, the area where the agricultural product is produced, where the marine product is caught, or where the major production of the craft product took place.

(ii) The place of a service provision

According to the Trademark Examination Guidelines, the place of provision for the service of “providing a bathing facility for a hot spring” is, for example, the area where the hot spring exists.

(iii) The name of a region must have a close relationship with the product or service to the extent equivalent to (i) or (ii).

The “close relationship with the product or service to the extent equivalent to (i) or (ii)” referred to in (iii) may include, for example, cases wherein the production method of the product originates from that region, or wherein the product was made from a raw material produced in that region.

Specific examples are presented in VII Article 7-2 (Regional collective trademarks) item (iii), Article 7-2 (2) of the Trademark Examination Guidelines, as follows:

“4. The “name of the region which is considered to have a close relationship with the said goods or services to the equivalent extent” referred to in this paragraph includes, for example:

(1) A processed product whose place of origin of the raw material is important

If the origin place of the raw material for the processed product is important, the region where the main raw material was produced or otherwise originated falls under the definition above, including, for example:

(i) The region where buckwheat, which is the main raw material of buckwheat noodles, was produced; or

(ii) The region where the stone from which an ink slab is made of was quarried.

(2) A craft product whose place of origin of the production method is important

If the place of origin of the production method for a processed product is important, the region where such important production method of the craft product originated falls under the definition above, including, for example:

(i) The region where the traditional weaving method for a fabric originated

As explained above, the abbreviated name of the region may also be used.

The Trademark Act stipulates as follows:

“Any person who desires to register a regional collective trademark ...(snip)...shall, at the time of filing an application for trademark registration ...(snip), submit to the Commissioner of the Patent Office ...(snip)...documents necessary to prove that the trademark for which the registration is sought contains the name of a region.” (Article 7-2 (4), Trademark Act)

The JPO Interpretation explains the reason for requiring applicants to submit the above-mentioned documents as follows:

“You cannot determine for what product or service an association or its member has been using the trademark for which the application is filed and what relationship such product or service has with the region whose name is contained in the trademark unless the applicant submits documentary evidence. Accordingly, the Trademark Act clearly imposes on the applicant the obligation to submit documentary evidence.” (JPO Interpretation)

“When filing an application, the Act stipulates that the applicant must submit to the

Commissioner of the Patent Office necessary documents proving that the trademark for which the application is filed contains the “name of a region” stipulated in paragraph 2, namely, the name of the region contained in the trademark is the name or abbreviated name of the region that has a close relationship with the products or services for which the applicant association or its members have used the trademark before the application is filed. If an applicant fails to submit such documentary evidence, the applicant will be ordered to make the necessary correction and will be refused at the stage of the examination of the formality before it proceeds to a substantive examination.” (JPO Interpretation)

This provision stipulates the formality requirement that an applicant must submit necessary documents. If an applicant fails to submit the documents, it is requested to correct the incompleteness of the application. If an applicant fails to correct the incompleteness of the application after the order for correction, the application for registration of a regional collective trademark will be refused.

#### (5) Popularity of regional collective trademarks

The Trademark Act stipulates that a trademark is registrable as a regional collective trademark if it satisfies the following requirements with respect to its popularity:

“...as a result of the use of the said trademark, the said trademark is well known among consumers as indicating the goods or services pertaining to the business of the applicant or its members....” (Article 7-2 (1), Trademark Act)

To be registrable as a regional collective trademark, the trademark must have become well known among consumers and recognized as indicating the good or service related to the business of the applicant (i.e. an association) and its members as a result of its use. Namely, it must have become popular among consumers.

The JPO Interpretation explains the reason for requiring the popularity of a trademark to be registrable as a regional collective trademark as follows:

“The Regional Collective Trademark System allows registration of a trademark comprising a regional name and a product (service) name with less strict requirements than Article 3 (2) of the Act in order to allow its exclusive use to certain persons. However, to allow the registration, as a minimum requirement, the trademark must have accumulated a reputation to the extent it is considered appropriate to protect the trademark comprising a regional name and a product (service) name by restricting free use of that trademark by third parties. Moreover, one of the purposes of the Regional Collective Trademark System is prevention of third parties’ unfair exploitation of the reputation embodied in a trademark. Therefore, a trademark should be protected only when its reputation has been accumulated to the extent that unfair exploitation of that trademark by third parties may occur. The extent of popularity required, in respect of the

range of consumers and their recognition, is narrower or lower than that that is practically required for the registration under Article 3 (2). For example, it may be necessary that consumers in the neighboring prefectures must recognize the trademark. However, the range of consumers may vary depending on the type of product (service), the profile of traders and consumers, actual conditions of trading and other factors. It should be noted that the trademark must have become well known within Japan to be registrable as a regional collective trademark. Under the Act before the revision, trademarks satisfying the unique requirements for registration as regional collective trademarks have not been registrable since they fell under one or some of the conditions stipulated in items (iii) to (vi) of Article 3 (1). Considering this, the main body of paragraph 1 of this Article stipulates that these provisions do not apply to regional collective trademarks. On the other hand, trademarks falling under the conditions in Article 3 paragraph 1 item (i) (common name) or item (ii) (customary trademark) are not registrable as regional collective trademarks as their availability for free use by anyone is strongly necessary. Because trademarks satisfying the unique requirements for registration as regional collective trademarks need not be registered by applying Article 3 (2), the main body of paragraph 1 of this Article also excludes the application of Article 3 (2). The registration requirements stipulated in Article 4 are applicable to regional collective trademarks, as with general trademarks and collective trademarks.” (JPO Interpretation)

The Trademark Act stipulates that a trademark must have popularity to be registrable as a regional collective trademark, by stating “...trademark is well known among consumers.” Regarding this requirement, the Trademark Examination Guidelines describe in VII, Article 7-2 (Regional Collective Trademarks) 1, main body of Article 7-2 paragraph 1, as follows:

“6. (1) “Well-known among consumers” referred to in the main body of this paragraph means that a trademark must have been recognized by a certain range of consumers, for example, consumers in the neighboring prefectures, but not necessarily consumers throughout Japan, although this range may vary depending on the type of product or service, the profile of consumers, actual conditions of trading and other factors.”

So, a trademark must have been recognized by a certain range of consumers, but not necessarily by consumers throughout Japan, to satisfy the requirement of being “well-known among consumers.”

As explained above, the JPO Interpretation states that the degree of popularity required “in respect of the range of consumers and their recognition, is narrower or lower than that that is practically required for registration under Article 3 (2).” The Trademark Examination Guidelines clarify the criteria for determining the popularity in II. Article 3 paragraph 2 (Recognition by Use) regarding the phrase “that is practically required for registration under Article 3 (2)” as follows:

“3. (1) Whether a trademark has become recognizable by its use should be determined taking into consideration relevant factors comprehensively.

Specifically, the actual use conditions of the trademark should be identified quantitatively, in order to estimate the degree of recognition (large or small, high or low, or the like) of the trademark by consumers. The recognizability of the trademark is determined based on this estimation. The following are some examples of factors to be considered:

- (i) The trademark actually used, and goods and services for which the trademark has been used;
  - (ii) When the use of the trademark started, and how long and in which geographical areas it has been used;
  - (iii) Quantities of production, evidence and assignment, or the size of the business (numbers of stores and sales areas, sales revenues, etc.);
  - (iv) The methods, frequency and content of advertisements;
  - (v) Frequency and content of trademark coverage in general newspapers, trade newspapers, magazines, Internet postings and other media; and
  - (vi) Results of consumer surveys regarding the recognition of the trademark.
- (2) The factors listed in (1) should be evidenced, for example, by:
- (i) Printed materials on which the advertisements are published (newspapers, magazines, catalogs, fliers, etc.);
  - (ii) Itemized transaction statements, delivery slips, order sheets, invoices, receipts or accounting books;
  - (iii) Photos showing the actual use of the trademark;
  - (iv) Certificates issued by advertising agencies, broadcasters, publishers or printers;
  - (v) Certificates issued by other traders in the same industry, customers, suppliers, consumers and other interested parties;
  - (vi) Certificates issued by public agencies (national or local public organizations, foreign embassies in Japan, chambers of commerce, or other organizations);
  - (vii) Coverage of the trademark in general newspapers, trade newspapers, magazines, Internet postings and other media; and
  - (viii) Results of consumer surveys on the recognition of the trademark;
- The objectivity of the surveys should be carefully confirmed, with regard to the surveyors, the methods of surveying, the questionees chosen for the surveys and other factors.
- (3) Whether a trademark has become recognizable by use should be determined by confirming whether the trademark has been used by any other persons than the applicant (in the case of an application for a collective trademark, “any other persons than the applicant and its members”), and how such other persons have used the trademark.
- (4) When determining whether a collective trademark has become recognizable by its use, the factors listed in (1) related to the use by the members of the association are

especially important for consideration.

If materials related to members of the association are submitted as evidence listed in item (2) above, membership certificates of individual members should also be submitted.”

As explained above, the popularity of a regional collective trademark is determined by comprehensively taking into consideration relevant factors including how long and in which regions it has been used; the quantities of the goods (services) produced or sold, as well as sales areas; the methods, frequency and content of advertisements; and the frequency and content of coverage in general and trade-related newspapers.

The trademark for which the application is filed, and products (services) designated for such a trademark, should be identical with the trademark and the products (services) actually used.

The popularity of a trademark is determined as of the date of the examination.

Accordingly, if an application is filed for registration of a regional collective trademark and refused by the JPO as a result of the examination because its popularity cannot be confirmed, the applicant may overcome the reason for the refusal by submitting an additional document proving its popularity.

#### (6) Other registration requirements

To be registrable as a regional collective trademark, the trademark for which a registration application is filed should satisfy the general registration requirements imposed on general and collective trademarks (such as Articles 3 and 4 of the Trademark Act), in addition to the registration requirements that are unique to regional collective trademarks (Article 7-2 (1), Trademark Act). Such registration requirements are as follows:

(i) The trademark, as a whole, is not the common or customary name of the designated good or service (Article 3 (1) (i) and (ii), the Trademark Act)

Even if a trademark satisfies the registration requirements that are unique to regional collective trademarks, if such a trademark as a whole is the common or customary name of the designated good (service), it is not registrable.

If products grown or produced in various regions throughout Japan are called by the same name, that name as a whole is considered to be the common name of those products.

One typical example is “satsumaimo” used for the product “satsumaimo (sweet potatoes).” If a registration application is filed for the trademark “satsumaimo” for the designated product “satsumaimo (sweet potatoes) produced in Kagoshima Prefecture,” the trademark is not considered to be a combination of “satsuma,” which is the old regional name of Kagoshima Prefecture, and the common name “imo” (potatoes).

Article 7-2 (1) of the Act stipulates that a regional collective trademark is

“entitled to obtain a regional collective trademark registration....notwithstanding the provision of Article 3 (except a case falling under item (i) or (ii) of Article 3(1)).”

Accordingly, a registration application will not be refused for the reason stipulated in items (iii) to (vi) of Article 3 (1) if the trademark in question satisfies the registration requirements unique to regional collective trademarks.

(ii) The trademark must not be identical or similar to a well-known trademark of another person. (Article 4 (1) (x))

Article 4 of the same Act specifies unregistrable trademarks. Item (x) stipulates that a trademark is unregistrable if it

“is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto.”

The JPO Interpretation explains that this provision is intended to “prevent confusion on the origin of goods or services, and to protect the established interest of unregistered but famous trademarks that have accumulated a certain level of reputation.” (JPO Interpretation)

According to this provision, like common trademarks, a regional collective trademark is not registrable if there has already been an identical or similar well-known trademark of another person.

Accordingly, even if a trademark has not been registered, if such trademark has already become well known, an application for another trademark by another person that is identical with or similar to such already well-known trademark will be refused according to Article 4 (1) (x) of the Trademark Act.

If two or more associations have used the same trademark in the same region, and if such a trademark has been well known by consumers as indicating the product or service of such individual associations, the trademark is not registrable unless these associations jointly file an application, since this would confuse consumers as to the origin of the product or service.

(iii) The trademark must not be identical or similar to a registered trademark of another person. (Article 4 (1) (xi), Trademark Act)

If an application for registration of a regional collective trademark is filed for a trademark that is identical with or similar to a registered trademark of another person whose filing date of application was earlier than such application, the application will be refused according to Article 4 (1) (xi) of the Trademark Act.

However, the Trademark Examination Guidelines stipulate in IX. Article 4 (1) (xi) (Prior registered trademark of another person) with respect to a trademark registered as a regional collective trademark as follows:

“9. (1) Whether or not a trademark is similar to another trademark registered as a regional

collective trademark should be determined by regarding all elements in the trademark as an inseparable single element, considering the fact that the registered trademark has been widely recognized by consumers as an inseparable single element as a result of its use.

- (2) If an application for registration of a regional collective trademark is filed for a trademark that contains characters that are identical with or similar to those contained in a previously registered regional collective trademark of another person whose filing date of application was earlier than such application, such trademark in the later application is considered to have similarity to the previously registered regional collective trademark, in principle, considering the background of such registered regional collective trademark as explained in (1) above.”

As explained above, elements contained in a registered regional collective trademark are regarded as an inseparable single element when similarity of trademarks is determined.

Accordingly, if a person files an application for registration of a regional collective trademark, and there is a registered regional collective trademark whose filing date of application was earlier than such application and which is comprised of a combination of a distinctive graphic or distinctive characters and characters identical with or similar to the characters used in such person’s trademark, the later application for registration of a regional collective trademark will not be refused. This is because the graphic or distinctive characters included in the registered trademark whose filing date of application was earlier are regarded as constituting an indispensable part of the trademark, and are therefore regarded as not being similar to the regional collective trademark in the later application.

Assume a case where a regional collective trademark has been registered and an application for registration is filed by another person on a date that is later than the application date of such registered trademark. Additionally, the trademark pertaining to such subsequent application includes characters that are identical with or similar to those included in the registered regional collective trademark—the latter of which was registered because it had been well known by consumers. If consumers see the characters included in the trademark in the subsequent application, it is fairly likely that they might purchase the product upon recalling the registered trademark. Because of this, the registration of a trademark in the later application will, in principle, be refused.

- (iv) The trademark must not be identical with or similar to the name of a variety registered under the Plant Variety Protection and Seed Act. (Article 4 (1) (xvi), Trademark Act)

Article 4 (1) (xvi) of the Act stipulates that a trademark is not registrable if it “is identical with, or similar to, the name of a variety registered in accordance with ... the Plant Variety Protection and Seed Act<sup>5</sup> ..., if such a trademark is used in connection with seeds and seedlings of the variety or goods or services similar thereto.”

Therefore, a regional collective trademark that is identical with or similar to the name of a registered variety under the Plant Variety Protection and Seed Act cannot be registered for that registered variety or a product or service similar to that variety.

(v) The trademark is not likely to cause confusion in connection with the goods or services pertaining to a business of another person. (Article 4 (1) (xv), Trademark Act)

Article 4 (1) (xv) of the Act stipulates that a trademark is not registrable if it

“is likely to cause confusion in connection with the goods or services pertaining to a business of another person.”

Therefore, if it is likely that consumers may confuse a regional collective trademark with another person’s mark of origin, the regional collective trademark cannot be registered.

(vi) The trademark is not likely to mislead as to the quality of the goods or services. (Article 4 (1) (xvi), Trademark Act)

Regarding Article 4 (1) (xvi) of the Trademark Act, the Trademark Examination Guidelines stipulate in XIV. Article 4 (1) (xvi) (Mislead as to the quality of the goods or services) as follows:

“6. The provision stipulated in this item should be applied to a regional collective trademark if it is used in connection with a product or service which is not closely related to the name of the region contained in that trademark because it may mislead consumers as to the quality of the product or service.

However, this provision should not apply if the designated products or services are properly presented so as not to mislead consumers as to the quality of the products or services, for example, as follows:

(i) “XX (product name) produced in YY (name of the region)” to indicate the origin place of the product;

(ii) “XX (service name) provided in YY (name of the region)” to indicate the place of provision of the service;

(iii) “XX (product name) containing ZZ (name of the raw material) produced in YY (name of the region) as a major raw material” to indicate the origin place of the major raw material;  
or

(iv) “XX (product name) produced by the production method originated in YY (name of the region)” to indicate the origin place of the production method. However, names that have become recognizable by consumers as indicating general production methods because their relationship with the indicated region has become weak, such as “Indian curry” or “Edomae sushi,” are excluded.”

Therefore, as explained above, if the application for registration of a regional collective trademark properly designates the products (services) for which the trademark is used, the application will not be refused because it does not mislead customers as to the quality of the products or services under Article 4 (1) (xvi) of the Trademark Act.

The Trademark Examination Guidelines also explain as follows:

“1. The phrase “is likely to mislead as to the quality of the goods or services” refers to a situation where consumers may misunderstand that the trademark indicates the quality of the product or service, regardless of whether or not such quality of such product or service actually exists.”

Suppose that an application for registration of a regional collective trademark is filed for a trademark that includes the characters for “mikan” (mandarin orange). If the application designates “fruits” produced in the region whose name is contained in that regional collective trademark, and if the trademark is used in connection with any fruit that is not “mikan,” it is likely to mislead consumers as to the quality of the goods. Accordingly, such application will be refused in accordance with Article 4 (1) (xvi) of the Act.

If the application designates “mikan” produced in the region whose name is included in that regional collective trademark, the application will not be refused in accordance with Article 4 (1) (xvi) of the Act.

Similarly, a regional collective trademark that comprises the name of a region and the name of a product (service) is easily recognizable as indicating that the product was produced or the service is provided in the place matching the name of the region included in the trademark. If it is used in connection with a product produced or a service provided in a region that is not included in the trademark, it will mislead consumers as to the quality of the product or service. Therefore, the application for registration of a regional collective trademark should designate the proper products (services) to clearly define the relationship between the name of the region and the products (services).

(7) Submission of necessary documents for application for registration of a regional collective trademark

The Trademark Act stipulates that an applicant for registration of a regional collective trademark must submit necessary documents for the application as follows:

“4. Any person who desires to register a regional collective trademark pursuant to paragraph (1) shall, at the time of filing an application for trademark registration pursuant to Article 5 (1), submit to the Commissioner of the Patent Office a document certifying that the applicant for trademark registration is an Association, etc., and that documents necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in

paragraph (2).” (Article 7-2 (4), Trademark Act)

The JPO Interpretation explains the reason for stipulating necessary documents when applying for registration of a regional collective trademark as follows:

“When filing an application, the Act stipulates that the applicant must submit to the Commissioner of the Patent Office a document proving that the applicant satisfies the entity requirements stipulated in paragraph (1) and necessary documents proving that the trademark for which the application is filed contains the “name of a region” stipulated in paragraph (2), namely, the name of the region contained in the trademark is the name or abbreviated name of the region that has a close relationship with the products or services for which the applicant association or its members have used the trademark before the application is filed. If an applicant fails to submit such documentary evidence, the applicant will be ordered to make the necessary correction, and will be refused at the stage of the examination of the formality before it proceeds to a substantive examination. You cannot determine for what product or service an association or its member has been using the trademark for which the application is filed, nor what relationship such product or service has with the region whose name is contained in the trademark, unless the applicant submits documentary evidence. Accordingly, the Trademark Act clearly imposes on the applicant the obligation to submit such documentary evidence.” (JPO Interpretation)

Therefore, when a person files an application for registration of its regional collective trademark, the person must also submit necessary documents to the Commissioner of the Patent Office.

#### 4. Effect of registration of regional collective trademarks and effect of trademark rights

##### (1) Registration of a regional collective trademark and its effect

(i) When no reasons for refusal are found in an application for registration of a regional collective trademark, a decision to register the trademark will be rendered. (Article 16, Trademark Act)

A trademark right will take effect when the designated registration fee is paid within the designated period and the establishment of the trademark right is registered. (Article 18, Trademark Act)

(ii) The duration of the registered trademark right will expire after ten years from the date of registration of establishment of such right, and may be renewed by the holder of the trademark right (such as the association that holds the trademark right in the regional collective trademark) by filing an application for registration of renewal. (Article 19, Trademark Act)

(iii) The holder of the trademark right (as specified above) has an exclusive right to use the registered trademark in connection with the designated goods or services. (Article 25,

Trademark Act) Members of the association that holds the trademark right pertaining to the regional collective trademark have the right to use the registered regional collective trademark for the designated goods or services as provided by the said association that is the holder of the trademark right. (Article 31-2 (1), Trademark Act)

(iv) If a person uses a trademark identical with or similar to the registered regional collective trademark in connection with goods or services similar to those designated for that registered trademark, such use constitutes infringement of the trademark right. (Article 37, Trademark Act)

(v) The holder of the trademark right (as specified above) may demand a person who is infringing or is likely to infringe the trademark right to stop or prevent such infringement. (Article 36 (1), Trademark Act) In making such a demand, the holder of the trademark right may demand the infringing person to destroy the articles that constitute the act of infringement, remove the equipment used for or contributing to the act of infringement, and/or take other necessary measures to eliminate the infringement. (Article 36 (2), Trademark Act)

## (2) Effect of trademark rights

### (i) Use by third parties

The Trademark Act stipulates that a person who has been using a trademark identical with or similar to a registered regional collective trademark from earlier than the filing date of the application for the registered regional collective trademark may continue to use such a trademark, as follows:

“Any person who has been using in Japan a trademark identical with, or similar to, a regionally-based collective trademark for which an application for registration is filed by another person in connection with the designated goods or services for which the application for trademark registration is filed, or in connection with goods or services similar thereto, without any intention to be engaged in unfair competition, prior to the filing of such other person's application for trademark registration of the said regionally based collective trademark, shall have the right to use the trademark in connection with such goods or services as far as the said person continuously uses the trademark in connection with such goods or services. The same shall apply to those by whom such business is succeeded. (Article 32-2 (1), Trademark Act)

The JPO Interpretation explains that this provision is stipulated to protect the interest of third parties who have used such trademarks before the application for registration was filed for the regional collective trademark, as follows:

“A trademark comprising the name of a region and the name of a product (service) registrable as a regional collective trademark was a trademark originally permitted to be

used by anyone. In particular, it is anticipated that persons who are producing or selling similar products or providing similar services within the same region have used an identical or similar trademark for such similar products or services before the registration application was filed for the regional collective trademark. Article 32 stipulates the prior user's right to a registered trademark. But a prior user is not protected under this Article if the prior user's trademark has not become well known by consumers at the time when another person files a registration application for an identical or similar trademark. Suppose an association files a registration application for a regional collective trademark, and a business operator that is not a member of the association has been using a trademark that is identical with or similar to such regional collective trademark. If the prior user's right is refused because its trademark has not been well known by consumers, such business operator cannot continue to conduct its business by using its trademark. Such situation is considered to cause an imbalance of interests between the interest holder and third parties." (JPO Interpretation)

Unlike general trademarks, the prior user's right to a regional collective trademark is granted regardless of whether the trademark has been well known.

However, to avoid confusion between the trademark of the prior user and the registered regional collective trademark, the Act stipulates that the holder of trademark rights to the regional collective trademark may demand such prior user to affix an indication to prevent confusion, as follows:

"The holder of a trademark right may request the person who has the right to use the trademark pursuant to the preceding paragraph to affix an indication that may sufficiently prevent any confusion between the goods or services pertaining to the business of the said person and those of its own or its members" (Article 32-2 (2), Trademark Act)

(ii) Limitations of trademark right effects

Article 26 of the Trademark Act stipulates trademarks on which trademark rights have no effect. The provisions in this Article also apply to trademark rights for regional collective trademarks. It stipulates as follows:

"A trademark right shall have no effect on any of the following trademarks (including those which constitute part of other trademarks):

- (i) a trademark indicating, in a common manner, one's own portrait, name, famous pseudonym, professional name, pen name or famous abbreviation thereof;
- (ii) a trademark indicating, in a common manner, the common name, place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages; the same shall apply in the following item), price, the method or time of production or use of the designated goods or goods similar thereto, or the

common name, location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision of services similar to the designated goods;

- (iii) a trademark indicating, in a common manner, the common name, location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision of the designated services or services similar thereto, or the common name, place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape, price, method or time of production, or use of goods similar to the designated services;
- (iv) a trademark customarily used for the designated goods or designated services or goods or services similar thereto; or
- (v) a trademark consisting solely of a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function.” (Article 26 (1), Trademark Act)

Therefore, where a third person uses a trademark that is identical with or similar to a registered regional collective trademark, if such third party’s trademark indicates the common name, place of origin, quality, etc. of the product, or the common name, place of provision, quality, etc. of the service, the trademark rights have no effect on such third party’s trademark.

Paragraph (3) was added to Article 26 in response to the enforcement of the Geographical Indications Act. It adds acts on which the trademark rights have no effect: acts to present a geographical indication on goods or product packages in accordance with the provision in Article 3 (1) of the Geographical Indications Act (item (i)); acts to assign, transfer, display for assignment or transfer, import or export goods attached with geographical indications (item (ii)); or acts to display goods attached with geographical indications on their invoices (item (iii)).

### (3) Transfer of trademark rights and establishment of the right to use

The Trademark Act stipulates a restriction on the assignment of a regional collective trademark as follows:

“A trademark right in connection with a regionally-based collective trademark may not be assigned.” (Article 24-2 (4), Trademark Act)

The Act also stipulates a restriction on the exclusive right of use as follows:

“The holder of a trademark right may establish an exclusive right to use for the trademark to which he/she holds the right; provided, however, that this provision shall not apply to ....(snip)....a regionally based collective trademark (Article 30 (1), Trademark Act)

## 5. Opposition to registration, and trial for invalidation or rescission of a regional collective

trademark

(1) Filing of an opposition to registration of a regional collective trademark

The Trademark Act stipulates that any person may file with the Commissioner of the Patent Office an opposition to registration on the grounds that a regional collective trademark was erroneously registered despite the fact that it did not satisfy the registration requirements. (Article 43-2, Trademark Act)

This provision pertaining to regional collective trademarks was added to the existing provisions in response to the establishment of the Regional Collective Trademark System.

(2) Trial for invalidation of a registered regional collective trademark

As in the case of an opposition to registration, the Act stipulates that any person may request a trial for invalidation of a registered regional collective trademark on the grounds that it was erroneously registered despite the fact that it did not satisfy the registration requirements. (Article 46, Trademark Act)

This provision pertaining to regional collective trademarks was also added to the existing provisions in response to the establishment of the Regional Collective Trademark System.

(3) Trial for rescission of a registered regional collective trademark

As in the case of general trademarks, the Trademark Act stipulates that anyone may request a trial to rescind a registered regional collective trademark that has not been used for three consecutive years or longer (Article 50, the Trademark Act), or which misleads as to the quality of the goods or services or causes confusion in connection with the goods or services pertaining to a business of another person (Article 51, the Trademark Act).

This provision pertaining to regional collective trademarks was also added to the existing provisions in response to the establishment of the Regional Collective Trademark System.

6. Procedures to apply for registration of a regional collective trademark

(1) Application

An application for registration of a regional collective trademark should be filed by following the same procedures as stipulated for registration of general trademarks. (Article 6, Trademark Act)

The Ordinance for Enforcement of the Trademark Act stipulates that the application for registration of a regional collective trademark should be created by using Form 3-2 (Article 2 (3), Ordinance for Enforcement of the Trademark Act).

The document title of Form 3-2 is "Request for Registration of Regional Collective Trademark." Necessary documents are described in the "List of materials to be submitted."

(2) Materials to be submitted

Documents necessary for the registration of a regional collective trademark should be attached to the Request for Registration of Regional Collective Trademark. Such documents

include the following:

(i) Documents proving that the applicant is an association as defined in Article 7-2 (1) of the Trademark Act

The [Notes] section of Form 3-2 notes that such documents should be “a Certificate of Registered Matters and a copy of the law underlying the establishment of the association as defined in Article 7-2 (1) of the Act.”

(ii) Document proving that the trademark includes the name of a region as defined in Article 7-2 (2) of the Trademark Act

The [Notes] section of Form 3-2 notes that such documents should be “materials indicating a close relationship between the name of the region contained in the trademark pertaining to the registration application and the products (services) for which such trademark has been used, including articles posted in newspapers, magazines, books and other publications, or pamphlets, catalogs, advertisements, or documents describing the rules for using the trademarks in connection with the products (services).”

(iii) Others

The [Note] section of Form 3-2 notes that “if it is necessary to prove that the trademark for which registration is sought in accordance with Article 7-2 (1) of the Trademark Act has been well-known by consumers and recognized as indicating the goods or services related to the business of the association or its members as a result of the use of such trademark, the applicant must add to Form 3-2 the header “Documents proving wide recognition by consumers as a trademark under Article 7-2 (1) of the Trademark Act” and attach such documents to the form.”

## 7. Status of implementation

After the revision of the Trademark Act and introduction of the Regional Collective Trademark System in Japan, filing of applications for registration began on April 1, 2006.

The statuses of filing applications for registration of regional collective trademarks are published and updated regularly by the Trademark Division, Japan Patent Office, on the website of the Japan Patent Office<sup>6</sup>.

According to the information on the website, a total of 1,156 applications for registration of regional collective trademarks had been filed as of December 31, 2016.

These included nine applications from foreign countries (Jamaica, Canada, Italy, India, China, South Korea and Sri Lanka). Such applications for registration of regional collective trademarks have been examined by examiners, and as of January 11, 2017, approval for registration had been given to a total of 608 regional collective trademarks as a result of such examinations.

### III Geographical Indications

#### 1. Background for the introduction of geographical indications

Currently, more than 100 countries provide independent protection to geographical indications.

In order to establish a system to protect geographical indications in line with this international trend, the Act on Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs (hereinafter referred to as the “Geographical Indications Act”) was enacted in Japan in June 2014, and enforced beginning on June 1, 2015.

The Geographical Indications Act stipulates its purpose as follows:

“The purpose of this Act is to secure the profits of Producers of Specific Agricultural, Forestry and Fishery Products and Foodstuffs by establishing a system concerning the protection of the names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs based on the Annex 1C (Agreement on Trade-Related Aspects of Intellectual Property Rights) of the Marrakesh Agreement Establishing the World Trade Organization, and thereby to contribute to the development of agricultural, forestry and fishery industries and relevant industries as well as to protect the interests of customers.”(Article 1, Geographical Indications Act)

#### 2. Definition of geographical indications

(1) “Geographical indications” are defined as follows:

“The indication of the names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs (limited to what can identify the matters set forth in the respective items of the preceding paragraph by said names).”

(Article 2 (3), Geographical Indications Act)

The Geographical Indications Act defines “Agricultural, Forestry and Fishery Products and Foodstuffs” (Article 2 (1)) and “Specific Agricultural, Forestry and Fishery Products and Foodstuffs” (Article 2 (2)).

“Agricultural, Forestry and Fishery Products and Foodstuffs” are defined in Article 2 (1) as follows:

“(i) agricultural, forestry and fishery products (limited to those intended for human consumption);

(ii) foods and drinks (excluding those set forth in the preceding item);

(iii) agricultural, forestry and fishery products (excluding those set forth in item (i)), and as provided by Cabinet Order; and

(iv) products manufactured or processed by using agricultural, forestry and fishery products as raw materials or ingredients (excluding those set forth in item (ii)), and as provided by Cabinet Order.” It also stipulate that:

“...those falling under any liquors prescribed in Article 2, paragraph (1) of the Liquor Tax Act..., and medicines prescribed in Article 2, paragraph (1) of the Act on Securing Quality, Efficacy and Safety of Pharmaceuticals, Medical Devices, Regenerative and Cellular Therapy Products, Gene Therapy Products, and Cosmetics ....., quasi-pharmaceutical products prescribed in paragraph (2) of said Article, cosmetics prescribed in paragraph (3) of said Article, and regenerative medical product prescribed in paragraph (9) of said Article are excluded:”

Article 2 defines “Specific Agricultural, Forestry and Fishery Products and Foodstuffs” as follows:

“...those falling under the following items:

- (i) products produced in a specific place, region or country; and
- (ii) products whose quality, reputation or other established characteristic.....is essentially attributable to the place of production specified in the preceding item.”

(2) Eligible persons for presenting geographical indications

Article 3 of the Geographical Indications Act stipulates as follows:

“A Producer as a Member of a Group of Producers which has received a registration ... (snip)...may affix a Geographical Indication on the Specific Agricultural, Forestry and Fishery Products and Foodstuffs or their package, container or invoice ..... if the Agricultural, Forestry and Fishery Products and Foodstuffs produced by the Producer are Specific Agricultural, Forestry and Fishery Products and Foodstuffs ...” (Article 3, Geographical Indications Act)

Article 3 (3) stipulates that persons engaged in the import of Agricultural, Forestry and Fishery Products and Foodstuffs should not assign such imported Agricultural, Forestry and Fishery Products and Foodstuffs unless they fall under the conditions specified in the proviso of the same paragraph.

3. Registration requirements for geographical indications

(1) Registrable names

A name is registrable if it identifies a product whose characteristics have a relationship with the place of production. Therefore, in addition to a name including the name of a region, the old name of a country, city or town, or a name that does not contain the name of a region but that has a relationship with a region is also registrable.

However, even if a name includes the name of a region, if it is a name (common name) of a product produced in various places throughout Japan, and thus has a weak relationship with that region, such a name is not registrable.

When an application for registration is filed for a processed product, the raw material of the

processed product may not necessarily be made in the place where the processed product is produced.

If the place of production of the raw material is different from the place of production of the processed product, the relationship of the characteristic of the processed product, such as quality, with the place of production (processing) must be clarified by the production method, etc.

#### (2) Registration requirements for geographical indications

The product must have been produced for a consecutive period while having a relationship with the place of production. The examination guidelines for the registration of geographical indications designate that this period should be around 25 years.

#### 4. Consultation with academic experts

The Geographical Indications Act stipulates that the Minister of Agriculture, Forestry and Fisheries must consult with academic experts as to whether an application falls under a case to be refused. (Article 11 (1), Geographical Indications Act)

It also stipulates that when written opinions are submitted, the Minister of Agriculture, Forestry and Fisheries must present the contents of such written opinions to the academic experts. (Article 11 (2), Geographical Indications Act)

Additionally, it stipulates that academic experts, if they find it to be necessary, may hear opinions of the Group of Producers that filed the application for registration, or other relevant persons including those who submitted written opinions. (Article 11 (3), Geographical Indications Act)

#### 5. Refusal of registration

Article 13 of the Geographical Indications Act stipulates that the Minister of Agriculture, Forestry and Fisheries must refuse registration if an application falls under any of the conditions stipulated in the same Article.

Item (i) in Article 13 (1) stipulates refusal conditions for a Group of Producers, item (ii) stipulates refusal conditions for Production Process Management, item (iii) stipulates refusal conditions for Agricultural, Forestry and Fishery Products and Foodstuffs pertaining to the application, and item (iv) stipulates refusal conditions for names.

An application for a common name or a name that is identical with or similar to a registered trademark will be refused.

However, if an application is filed for a name that is identical with or similar to a registered trademark, and the applicant is the holder of the trademark right to that registered trademark or an exclusive licensee of the exclusive right to use that registered trademark, the application will not be refused. (Article 13 (2), Geographical Indications Act)

It is stipulated that when the Minister of Agriculture, Forestry and Fisheries has refused registration, the Minister must give notice in writing of the same, along with the reason, to the

Group of Producers that filed the application for registration. (Article 13 (3), Geographical Indications Act)

#### 6. Public notice of an application for registration

Article 8 (1) stipulates that when the Minister of Agriculture, Forestry and Fisheries has received an application for registration, the Minister must issue a public notice of the application and other necessary information, except when registration is refused. (Article 8 (1), Geographical Indications Act)

Paragraph (2) of the same Article stipulates that the Minister of Agriculture, Forestry and Fisheries must make the written application and attached documents available for public inspection for 2 months from the date of the public notice. (Article 8 (2), Geographical Indications Act)

It is stipulated that the public notice is to be issued through the Internet (Article 23, Geographical Indications Act). The public notice is posted on a special page within the website of the Ministry of Agriculture, Forestry and Fisheries of Japan.

#### 7. Submission of a written opinion

Article 9 (1) stipulates that when a public notice is posted, any person may submit a written opinion about the application for registration within 3 months from the date of the public notice. (Article 9 (1), Geographical Indications Act)

When the Minister of Agriculture, Forestry and Fisheries has received a written opinion, the Minister must send a copy of said written opinion to the Group of Producers that has made the application for registration. (Article 9 (2), Geographical Indications Act)

#### 8. Registration of geographical indications and effect of registration

##### (1) Effect of registration of geographical indications

A Producer that is a Member of a Group of Producers that has registered geographical indications may affix the geographical indications on its Specific Agricultural, Forestry and Fishery Products and Foodstuffs, their packages, their containers or the like. (Article 3 (1), Geographical Indications Act)

The same Article stipulates that any person other than the Producer specified above must not affix geographical indications or any similar indications except for the following cases: (Article 3 (2), Geographical Indications Act)

(i) when a person affixes a Geographical Indication or an indication similar thereto on Agricultural, Forestry and Fishery Products and Foodstuffs manufactured or processed using said Specific Agricultural, Forestry and Fishery Products and Foodstuffs pertaining to the registration as a main raw material or ingredient, on its packages, etc. (Article 3 (2) (i), Geographical Indications Act), or

(ii) when a registered trademark, for which the application was made earlier than the

registration date of the geographical indication, is used by a person who has the right to use that registered trademark (Article 3 (2) (ii), Geographical Indications Act)

Therefore, any trademark right holder and any person who has the right to use a registered trademark under the Trademark Act, who has a status stipulated in this paragraph, may continue to use the registered trademark after the registration of the geographical indications. (Article 3 (2) (iii), Geographical Indications Act)

A person who has been using a name that is identical with or similar to a geographical indication for no wrongful purpose before the registration of the geographical indication (and a successor who has succeeded to the business pertaining to such name from that person) may continue to use such name after the registration of the geographical indication. (Article 3 (2) (iv), Geographical Indications Act)

## (2) Use of registration symbol

Article 4 of the Geographical Indications Act stipulates that when a Producer Member of a Registered Group of Producers affixes a geographical indication on the products, packages and the like, the Producer must attach the registration symbol to the geographical indication. (Article 4, Geographical Indications Act)

The same Article stipulates that the registration symbol is a symbol created under the Ordinance of the Ministry of Agriculture, Forestry and Fisheries to indicate that the geographical indication is the name of the Specific Agricultural, Forestry and Fishery Products and Foodstuffs in connection with which the geographical indication is registered.

The image below is the registration symbol.



An application for trademark registration was filed for this symbol, and it was registered as a trademark on April 10, 2015 (Registration No. 5756405).

Applications for trademark registration were also filed in other countries. Currently, the symbol is registered in South Korea, Taiwan, Cambodia, the Philippines, Malaysia, Myanmar, Laos, the EU, Australia, and New Zealand.

## 9. Minister's order to take measures

Article 5 of the Geographical Indication Act stipulates as follows:

“The Minister of Agriculture, Forestry and Fisheries may order a person who has violated the provisions set forth in the following items to take measures set forth in said respective items....”

(Article 5, Geographical Indication Act)

Item (i) of the same Article stipulates removal or erasure of the geographical indication as defined in Article 3 (2) or an indication similar thereto; item (ii) stipulates attachment of the registration symbol as stipulated in Article 4 (1); and item (iii) stipulates removal or erasure of the registration symbol as stipulated in Article 4 (2) or any symbol similar thereto.

#### 10. Completion of registration

Article 12 (1) of the Geographical Indications Act stipulates that when the Minister of Agriculture, Forestry and Fisheries has finished the procedures stipulated in Article 8 through Article 11, the Minister must register the geographical indication, except when registration is refused. (Article 12 (1), Geographical Indications Act)

The registration is recorded in the register of specific agricultural, forestry and fishery products and foodstuffs. (Article 12 (2), Geographical Indications Act)

The registration number, the registration date, the name and address of the Group of Producers and other information included in the application for the registration (as specified in Article 7 of the Geographical Indications Act) are recorded in the register.

The Minister must notify the completion of the registration to the Group of Producers that made the application for registration, and also issue a public notice regarding the registration. (Article 12 (3), Geographical Indications Act)

#### 11. Refusal, expiration or revocation of registration

##### (1) Refusal of registration

Article 13 of the Geographical Indications Act stipulates that the Minister of Agriculture, Forestry and Fisheries must refuse registration in the following cases (Article 13, Geographical Indications Act):

(i) a geographic indication of the Group of Producers was revoked, and 2 years have not yet elapsed from the date of the revocation (Article 13 stipulates other cases in addition to this case);

(ii) matters relating to Production Process Management stipulated in the specification attached to the written application are different from the matters specified in said written application (Article 13 stipulates other cases in addition to this case);

(iii) the Agricultural, Forestry and Fishery Products and Foodstuffs pertaining to application for registration are not Specific Agricultural, Forestry and Fishery Products and Foodstuffs; or

(iv) the names of the Agricultural, Forestry and Fishery Products and Foodstuffs applied for are common names of the products (Article 13 stipulates other cases in addition to this case).

##### (2) Expiration of registration

Article 20 of the Geographical Indications Act stipulates that a registration will cease to be effective if either of the following conditions occurs (Article 20, Geographical Indications Act):

(i) the Registered Group of Producers has been dissolved and liquidation has been

completed; or

(ii) the Registered Group of Producers has discontinued its Production Process Management.

Paragraph 2 of the same Article stipulates that when the registration has ceased to be effective in accordance with paragraph 1, the Registered Group of Producers pertaining to said registration must notify the Minister of Agriculture, Forestry and Fisheries of the reason and the date of its invalidation without delay (Article 20 (2), Geographical Indications Act). It is further stipulated that the Minister of Agriculture, Forestry and Fisheries must delete the registration and issue a public notice about the deletion. (Article 20 (3) and (4), Geographical Indications Act)

### (3) Revocation of registration

Article 22 of the Geographical Indications Act stipulates that the Minister of Agriculture, Forestry and Fisheries may revoke all or part of a registration in the following cases (Article 22, Geographical Indications Act):

(1) (i) a Registered Group of Producers no longer falls under the definition of a Group of Producers (Article 22 stipulates other cases in addition to this case);

(1) (ii) the Specific Agricultural, Forestry and Fishery Products and Foodstuffs pertaining to the registration are no longer Specific Agricultural, Forestry and Fishery Products and Foodstuffs;

(1) (iii) the names of the Specific Agricultural, Forestry and Fishery Products and Foodstuffs pertaining to the registration are common names of the product, etc.; or

(1) (iv) a holder of the trademark right or an exclusive licensee has withdrawn its approval for the registration application.

The same Article stipulates that when the Minister of Agriculture, Forestry and Fisheries revokes all or part of a registration, the Minister must delete all or the corresponding part of the records in the register, notify the revocation to the Registered Group of Producers, and issue a public notice about the revocation. (Article 22 (3) and (4), Geographical Indications Act)

## 12. Procedures for registration application

A Group of Producers that intends to register its Specific Agricultural, Forestry and Fishery Products and Foodstuffs must submit a written application to the Minister of Agriculture, Forestry and Fisheries, pursuant to the Ordinance of the Ministry of Agriculture, Forestry and Fisheries. (Article 7, Geographical Indications Act)

The application must be created by using Form 1 “Application for Registration of Specific Agricultural, Forestry and Fishery Products and Foodstuffs” as designated by the Ordinance of the Ministry of Agriculture, Forestry and Fisheries (“Ordinance for Enforcement of the Geographical Indications Act”) and submitted to the Minister of Agriculture, Forestry and Fisheries.

The application must include (i) the name of the Group of Producers, (ii) the classification of

the Agricultural, Forestry and Fishery Products and Foodstuffs, (iii) their names, (iv) their places of production, (v) their characteristics, (vi) their production methods, (vii) other information necessary to identify said Agricultural, Forestry and Fishery Products and Foodstuffs, and other relevant information.

Article 2 stipulates that the term “Group of Producers” means a group that comprises producers (as defined in Article 2 (4)) as direct or indirect members, and that is provided for by the Ordinance of the Ministry of Agriculture, Forestry and Fisheries. (Article 2 (5), Geographical Indications Act) The same paragraph limits the qualification of a Group of Producers, stipulating that if a group is an organization without legal personality, it must have a representative or administrator appointed; it must be stipulated in the law or in the articles of incorporation and any other basic contract of such group that it must not deny enrollment of any person eligible to become a member without a justifiable cause, or that it must not impose any conditions of enrollment heavier than those imposed on its existing members.

Article 7 also stipulates that the application should be attached with a specification (item (i)), the Production Process Management Rules (item (ii)), and documents designated by the Ordinance of the Ministry of Agriculture, Forestry and Fisheries (item (iii)). (Article 7 (2), Geographical Indications Act)

The “Production Process Management Rules” is a document that describes the rules regarding quality control operations established by a group. It is stipulated that “Production Process Management” includes: (i) creating or changing a specification with regard to Agricultural, Forestry and Fishery Products and Foodstuffs; (ii) providing guidance, examination and other operations that are necessary to ensure that the Producer as a Member of said Group of Producers performed the production of such Agricultural, Forestry and Fishery Products and Foodstuffs in accordance with the specification created for such goods; and (iii) conducting operations incidental to the operations set forth in the preceding two items. (Article 2 (6), Geographical Indications Act)

If two or more Groups of Producers conduct Production Process Management, they may apply for registration jointly. (Article 7 (3), Geographical Indications Act)

### 13. Special provision for Specific Agricultural, Forestry and Fishery Products and Foodstuffs produced in foreign countries

Some provisions were added to the Geographical Indications Act on December 26, 2016, to stipulate that the Minister of Agriculture, Forestry and Fisheries may designate some products produced in a foreign country as Specific Agricultural, Forestry and Fishery Products and Foodstuffs if such foreign country has a protection system equivalent to the protection system established under this Act, and if Japan has concluded a treaty or an international agreement with such foreign country or region having an equivalent system, in order to protect these names from each other. (Article 23 and others)

### 14. Status of implementation

Upon the enforcement of the Geographical Indications Act, filing of applications started on June 1, 2015.

The statuses of applications for registration of geographical indications are published and updated from time to time on the website of the Ministry of Agriculture, Forestry and Fisheries.

A total of 24 geographical indications were registered as of December 7, 2016.

#### IV. Summary

In Japan, geographical names are protected under the Trademark Act, the Act on Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs, the Act on Securing of Liquor Tax and on Liquor Business Associations, the Unfair Competition Prevention Act, and the Act against Unjustifiable Premiums and Misleading Representations.

Since projects to promote regional development are actively carried out in various regions throughout Japan on a continuous basis, it is expected that effective utilization of these protection systems will further promote regional development.

It is also expected that regional names and regional brands will be protected in foreign countries.

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<sup>1</sup> Patent Office Interpretation of Clauses of Industrial Property Laws (17th Edition) (Japan Institute of Invention and Innovation, May 30, 2008, 17th edition)

<sup>2</sup> The Intellectual Property Strategy Headquarters was established within the Cabinet Office with the objective of extensively and systematically promoting activities to create, protect and utilize intellectual properties based on Article 24 of the Intellectual Property Basic Act, enforced beginning on March 1, 2003.

This organization, comprising the Prime Minister as the chief director, the Chief Cabinet Secretary, the minister in charge of science and technology policies, the Minister of Education, Culture, Sports, Science and Technology, and the Minister of Economy, Trade and Industry as deputy directors, and all other ministers of states and ten experts from the private sector who have outstanding knowledge on intellectual property policies, plays a central role in promoting intellectual property strategies through united and comprehensively coordinated efforts of the government and related agencies.

(excerpted from the website of the administrative office of the Intellectual Property Strategy Headquarters)

Intellectual Property Strategy Headquarters website URL: <http://www.kantei.go.jp/jp/singi/titeki2/>

<sup>3</sup> Agricultural Cooperatives Act (Law No. 132, November 19, 1947)

<sup>4</sup> Trademark Examination Guidelines 9th Edition, April 2007, Japan Patent Office website. These guidelines were created for patent examination by the Japan Patent Office to ensure smooth enforcement of the Trademark Act and fair and quick processing of patent examinations.

<sup>5</sup> Plant Variety Protection and Seed Act (Law No. 83, 1998)

<sup>6</sup> Japan Patent Office website URL <http://www.jpo.go.jp/indexj.htm>

<sup>7</sup> Ministry of Agriculture, Forestry and Fisheries of Japan website URL <http://www.maff.go.jp/index.html>