

## **Approach for Registering Collective Trademarks**

### 1. Introduction of the collective trademark system

A collective trademark is a trademark which members of a collective of business owners are allowed to use, and the source of the goods or services of which are connected to such members.

The mandatory protection of collective trademarks is stipulated in Article 7bis of the Paris Convention. In Japan, the protection of collective trademarks was first introduced and stipulated in the provisions of the Trademark Act of 1921 as the “collective mark system,” but this provision was deleted when a new licensing system, which was then considered to be a system to substantially protect collective trademarks, was introduced in 1959.

However, in 1996 the Trademark Act was revised and the collective trademark system was stipulated in the Trademark Act again since: [i] the characteristics of collective trademarks are different from those of other trademarks and [ii] the trademark system in Japan should be harmonized with other countries. Such characteristics of collective trademarks include the following facts: [a] applicants are collectives rather than individual business owners, but the collectives per se are not required to produce products or provide services and [b] filed trademarks are expected to be used not by the holder of the trademark right or a collective as a premise but by others or members of a collective, and the members should be allowed to use the trademarks as far as they belong to the collective.

Note: Shifting the title of the system from “collective mark system” to “collective trademark system”

The title of the “collective mark system” in the Trademark Act of 1921 was changed to the “collective trademark system” in the Trademark Act revised in 1996 to protect collective trademark rights, as in the past, since the revised Trademark Act clearly allows a collective to use the trademark taking such business circumstances into consideration as that a person who manufactures products as a business is still a user of the products and that a collective per se controls and manages products, such as manufacturing or selling products, and that the collective often uses the trademark in the management process.

### 2. Revising associations entitled to register collective trademarks

In the 1921 Trademark Act, an association entitled to obtain a collective trademark was stipulated as “[a]ny incorporated association established pursuant to Article 34 of the Civil Code or any other association established pursuant to a special Act including business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto.”

However, the 2006 Act for Partial Revision of the Design Act, etc. (Act No. 55 of

2006) newly stipulated “other association (except those which do not have juridical personality, and companies)” in addition to “[a]ny incorporated association established pursuant to Article 34 of the Civil Code,” which allows incorporated associations composed of certain members, such as the chambers of commerce and industry, the society of commerce and industry, and specified non-profit organizations, to be an association entitled to register a trademark as well as conventional associations, taking the following circumstances into consideration: [a] some incorporated associations which were composed of certain members, such as the chambers of commerce and industry, and had juridical personality did allow the members to use the trademark and [b] incorporated associations stipulated in Article 34 of the Civil Code cited in Article 7(1) of the Trademark Act were planned to be changed to general incorporated associations and these general incorporated associations were to include intermediate juridical persons which do not serve public interest as well as those which serve public interest (a revision based on the Act on General Incorporated Associations and General Incorporated Foundations (Act No. 48 of 2006)).

In addition, in accordance with the enforcement of the Act on General Incorporated Associations and General Incorporated Foundations in December 1, 2008, the “incorporated associations established pursuant to Article 34 of the Civil Code” in Article 7(1) of the Trademark Act was revised into “general incorporated associations” based on “the Act on the Revision, etc. of Related Acts that Accompany the Enforcement of the Act on General Incorporated Associations and General Incorporated Foundations, and the Act on the Authorization, etc. of Public-interest Incorporated Associations and Public-interest Incorporated Foundations (Act No. 50 of 2006),” which is the act for organizing related legislation.

#### Reference

Revised Acts	Effective Date	Details of associations to be entitled
Act for Partial Revision of the Trademark Act, etc. (Act No. 68 of 1996)	April 1, 1997	Any incorporated association established pursuant to Article 34 of the Civil Code or any other association established pursuant to a special Act including business cooperative (except those which do not have juridical personality) or a foreign juridical person equivalent thereto
Act for Partial Revision of the Design Act, etc. (Act No. 55 of 2006)	September 1, 2006	Any incorporated association established pursuant to Article 34 of the Civil Code (Act No. 89 of 1896) or other association (except those which do not have juridical personality, and companies), or any other association established pursuant to a special Act including a business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto
Act on the Revision, etc. of Related Acts that Accompany the Enforcement of the Act on General Incorporated	December 1, 2008	Any general incorporated association or other association (except those which do not have juridical personality, and companies), or any other association established pursuant to a

Associations and General Incorporated Foundations, and the Act on the Authorization, etc. of Public-interest Incorporated Associations and Public-interest Incorporated Foundations (Act No. 50 of 2006)		special Act including business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto
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### 3. Requirements for registering a collective trademark

#### A. Requirements for registering a collective trademark stipulated in the Trademark Act

Requirements for registering a collective trademark as stipulated in Article 7 of the Trademark Act are:

- 1) The applicant should be any general incorporated association or other association (except those which do not have juridical personality, and companies), or any other association established pursuant to a special Act including business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto;
- 2) The trademark for which the trademark application has been filed is the trademark used by the members; and
- 3) The applicant should submit documents to certify that the applicant is a juridical person that falls under Article 7(1) of the Trademark Act.

All other requirements for registration are the same as those of a regular trademark registration.

#### B. Practical application of the main paragraph of Article 3(1) of the Trademark Act

The expression “a trademark claimed in a collective trademark application is not for ‘use by the members’” in the main paragraph of Article 3(1) of the Trademark Act (as restated according to Article 7(2) of the Trademark Act) applies not only to a case in which the trademark will not be used by both the collective and its members. It also applies to a case where the collective trademark is used by the collective for designated goods or services, but the members of the collective do not use the trademark. Thus, in this case, the applicant will not be entitled to register a collective trademark.

### 4. Conversion of application

An applicant for trademark registration may convert an application for trademark registration of a collective trademark into a regular application for trademark registration or an application for trademark registration of a regional collective trademark, and vice versa (Article 11 of the Trademark Act).

When the applicant converts an application for a collective trademark into an application for a regional collective trademark pursuant to the provision of Article 11(1) of the Trademark Act, the applicant should submit “a document certifying that the applicant for

trademark registration is an Association, etc” and “documents necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in paragraph (2)” as stipulated in Article 7-2(4) of the Trademark Act. When the applicant converts an application for a regular trademark into an application for a collective trademark pursuant to the provision of Article 11(3) of the Trademark Act, the applicant should submit “a document certifying that the applicant for trademark registration is a juridical person that falls under paragraph (1)” stipulated in Article 7(3) of the Trademark Act.

However, such applicant is not allowed to convert an international trademark application into a collective trademark application (Article 68-13 of the Trademark Act).

#### 5. Approach for understanding trademark rights relating to collective trademarks

The details and scope of a trademark right relating to a collective trademark are basically the same as those of a regular trademark right. However, because of the unique characteristics of a collective trademark (see the requirements for entitled associations as stipulated in Article 7 of the Trademark Act), the trademark right relating to a collective trademark is approached from a different angle to a regular trademark right on some points, such as transfer of the right (Article 24-3 of the Trademark Act) or allowing the members of the collective to use the trademark, in which the applicant does not have an exclusive right to use the trademark. (Article 31-2 of the Trademark Act.)

In addition, Article 68-24 of the Trademark Act provides a special provision of a transfer of a collective trademark right based on international registration.

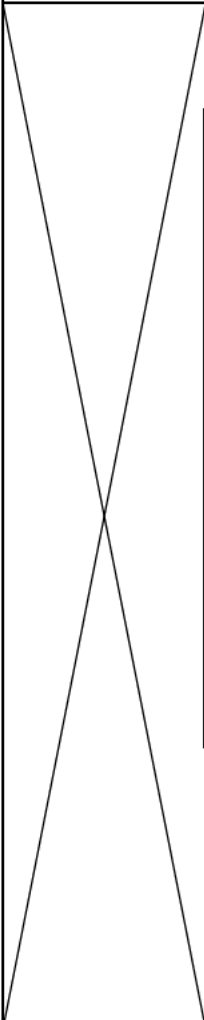
(Note) Click below to see the Trademark Examination Guidelines

Trademark Examination Guidelines:

[Principal Paragraph of Article 3\(1\)](#)

[Article 7 \(Collective Trademarks\)](#)

Reference: Outline of corporations in Japan (bordered by a bold line) entitled to register collective trademarks

Collectives not to be entitled	Corporations which have juridical personality		
	Incorporated associations	Cooperatives	Incorporated foundations, etc.
	General incorporated associations (including public interest incorporated associations)	Business cooperatives Any other association established pursuant to a special Act Examples: agricultural cooperatives, commercial and industrial association	General incorporated foundations (including public interest incorporated foundations)
	Any other associations (excluding companies) Examples: chambers of commerce and industry, incorporated nonprofit organizations		Foundations, etc. established pursuant to a special Act Examples: medical corporations (incorporated foundations), vocational training corporations, school corporations, religious corporations
Stock companies, limited partnership companies, etc.			

Note: According to Article 7(1) of the Trademark Act, school corporations, etc. are not entitled to register a trademark since they are not included in either general incorporated associations or any other associations (except those which do not have juridical personality, and companies) or any other association established pursuant to a special Act including a business cooperative (except those which do not have juridical personality).