

Approach to an International Trademark Registration Application Mentioning the Expression “Collective mark, certification mark, or guarantee mark”

1. When an international trademark application is registered on and before March 31, 2006, or the day the application subsequently designated if any, the application is analyzed according to the following process.

When an applicant files for an international trademark registration mentioning an expression “Collective mark, certification mark, or guarantee mark” and does not submit any “document certifying that the applicant for trademark registration is a juridical person that falls under Article 7(1) of the Trademark Act” prescribed in Article 7(3) of the Trademark Act, the application shall not be registered as a collective trademark according to the main paragraph of Article 3(1) of the Act applied by replacing the terms pursuant to Article 7(2) of the Act.

2. When an international trademark application is registered on and after April 1, 2006, or the day the application subsequently designated if any, the application is analyzed according to the following processes.

A. Outline of the analysis

i. Applications filed for collective trademarks

When an applicant does not submit “a document certifying that the applicant for trademark registration is a juridical person that falls under Article 7(1) of the Act” as prescribed in Article 7(3) of the Act, the application shall not be registered as a collective trademark according to the main paragraph of Article 3(1) of the Act applied by replacing the terms pursuant to Article 7(2) of the Act.

ii. Applications filed for regional collective trademarks

When an applicant does not submit either “a document certifying that the applicant for trademark registration is an Association, etc.” as stipulated in Article 7-2(4) of the Act or “documents necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in Article 7-2(2) of the Act,” the application shall not be registered as a regional collective trademark according to Article 7-2(1) of the Act.

iii. Applications filed for certification trademarks or guarantee trademarks

When an applicant files for a certification trademark or guarantee trademark, the application shall not be registered as a trademark according to the main paragraph of Article 3(1) of the Act since certification trademarks or guarantee trademarks are not covered by the Act in Japan.

B. Details of the analysis

i. When an applicant files for an international trademark registration with the expression “Collective mark, certification mark, or guarantee mark,” whose constitution is protected by the Act as a regional collective trademark, which satisfies the requirements in Article 7-2(1)(i) - (iii), and when the applicant does not submit either “a document certifying that the applicant for trademark registration is a juridical person that falls under Article 7(1)” as stipulated in Article 7(3) or “a certifying or proving document” as stipulated in Article 7-2(4) of the Act, the examiners send a notice of reasons for refusal to the applicant according to the following steps, requiring the applicant to specify if the application is filed for a regional collective trademark, collective trademark, certification trademark or guarantee trademark:

1) When the applicant files the application for a regional collective trademark, the examiners send a notice of reasons for refusal telling the applicant that the application does not satisfy the requirement in Article 7-2(1) of the Act. In addition to the failure to submit the certifying documents and other documents required for registration stipulated in Article 7-2(4), when the application does not meet the requirement in Article 7-2(1) of the Act, the examiners send a notice of reasons for refusal to the applicant, requiring the application to satisfy the respective requirements;

2) When the applicant files the application for a collective trademark, the examiners send a notice of reasons for refusal according to the main paragraph of Article 3(1) and also send another document that tells the applicant that the constitution of the filed trademark is covered by Article 3(1)(iii) of the Act; and

3) When the applicant files the application for a certification trademark or a guarantee trademark, the examiners send a notice of reasons for refusal to the applicant according to the main paragraph of Article 3(1) of the Act.

ii. When an applicant files an application for an international trademark registration with the expression “Collective mark, certification mark, or guarantee mark,” whose constitution is not protected by the Act as a regional collective trademark, and hence, does not satisfy the requirement of Article 7-2(1), and when the applicant does not submit “a document certifying that the applicant for trademark registration is a juridical person that falls under Article 7(1)” as stipulated in Article 7(3), the examiners send a notice of reasons for refusal to the applicant according to the main paragraph of Article 3(1), requiring the applicant to specify if the application is filed for a regional collective trademark, collective trademark, certification trademark, or guarantee trademark.

iii. When an applicant submits documents required for registering a trademark as a collective trademark or regional collective trademark, which specifies the filed trademark enough to be categorized in collective trademarks or regional collective trademarks, the application is analyzed as such trademark.

However, when an applicant does not submit the required documents, or when the

submitted documents do not satisfy the requirements, the application is analyzed according to the following steps 1) - 5):

1) When an applicant submits only a document certifying that the applicant is an entitled association stipulated in Article 7-2(4) of the Act, the application is analyzed as an application filed as a regional collective trademark.

In addition, when an applicant submits only “a document necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in Article 7-2(4) of the Act,” the application is analyzed as an application filed as a regional collective trademark;

2) When an applicant submits only a document certifying that the applicant is an entitled juridical person stipulated in Article 7(3) of the Act, the application is analyzed as an application filed as a collective trademark;

3) When an applicant explicitly mentions that the application is filed for a collective trademark or regional collective trademark in his written opinion (written statement), the written opinion is considered to show that the applicant intends to file the application for protecting the trademark, regardless of steps 1) and 2);

4) When an applicant mentions the preparation of required documents in a written opinion or written statement but does not fully satisfy the requirements, such as submitting certifying documents, even after a certain grace period, the examiners shall not send another notice of reasons for refusal but shall decide to refuse the application.

In addition, when the applicant mentions in the written opinion (written statement) an intention to protect the trademark that does not correspond to the details of the certifying documents, etc. he/she submits and he/she does not submit specific additional certifying documents, etc. within a certain period of time, the examiners decide to refuse the application; and

5) When the applicant does not contact the examiners, and the application remains unspecific for which type of trademark the application is filed, the examiners decide to refuse the application due to the violation of the main paragraph of Article 3(1), Article 3(1)(iii) (or (vi)) and Article 7-2(1), including the case when the applicant does not contact the examiners about another notice of reasons for refusal if any.

iv. When an application is included in the processes i and ii above and examiners find that another notice of reasons for refusal other than those mentioned in the preceding steps should be sent to the applicant, the examiners send another notice of reasons for refusal to the applicant at the same time.

3. Details of steps of application analysis

A. Specifying types of applications

i. When an applicant files an international trademark application for either a collective mark (collective trademark), a certification mark (certification trademark) or a guarantee mark

(guarantee trademark), the application is commonly indicated by the expression “Collective mark, certification mark, or guarantee mark,” which is reported to the designated states.

However, the indication is not specific enough for the designated states to determine which mark the applicant filed the application for.

ii. In Japan, the Trademark Act differentiates a collective trademark and regional collective trademark from a regular trademark registered on and after April 1, 2006, but it does not provide any provisions stipulating a certification trademark or guarantee trademark.

To cope with this situation, when the reported international trademark application for an international registration includes the expression “Collective mark, certification mark, or guarantee mark,” the JPO should ask the applicant about which trademark— a collective trademark or regional collective trademark—the registration application is filed for, since trademarks included in a “Collective mark” are protected as a collective trademark or regional collective trademark in Japan.

iii. When an applicant files an application for a collective trademark, the applicant should submit “a document certifying that the applicant for trademark registration is a juridical person that falls under Article 7(1) of the Act” as stipulated in Article 7(3) of the Act. When an applicant files an application for a regional collective trademark, the applicant should submit “a document certifying that the applicant for trademark registration is an Association, etc.” as stipulated in Article 7-2(4) of the Act.

iv. For this purpose, when an applicant submits the certifying documents and the application for international registration mentioning the expression “Collective mark, certification mark, or guarantee mark,” the application is considered to be and analyzed as an application filed for registering a collective trademark or regional collective trademark, based on the consideration that the certifying documents show the application is filed for a collective trademark or regional collective trademark.

v. In a process for analyzing domestic applications in Japan, when an applicant files an application for registering a collective trademark without submitting a certifying document as stipulated in Article 7(3) of the Act, or an application for registering a regional collective trademark without submitting a certifying document as stipulated in Article 7-2(4) of the Act, the application is considered to be an application which should be amended, and the application for which the applicant does not submit any certifying document is considered to be an application to be rejected. In the process for analyzing international applications in Japan, however, this process is not adopted.

vi. As an approach to cope with these international applications, when an applicant does not submit any certifying document, examiners shall send a notice of provisional refusal to the

applicant (in the case of where the constitution of the filed trademark is covered by Article 7-2(1)(i) - (iii) of the Act), describing the reason that the application does not meet the requirement “[a]ny trademark to be used in connection with goods or services pertaining to the business of an applicant or its members,” which is applied by replacing the terms pursuant to Article 7(2) of the Act, stipulated in the main paragraph of Article 3(1) of the Act and also describing another reason that the application does not meet the requirement of associations, etc. stipulated in Article 7-2(1) of the Act.

On the other hand, when an applicant submits a certifying document stipulated in Article 7(3) of the Act, the application is considered to be an application filed for registering a collective trademark, and when an applicant submits a certifying document stipulated in Article 7-2(4) of the Act, the application is considered to be an application filed for registering a regional collective trademark, both of which becomes a basis for cancelling the notice of reasons for refusal sent to the applicant.

vii. Furthermore, when the constitution of the filed trademark is covered by Article 7-2(1)(i) - (iii) of the Act and when the applicant does not submit any “documents necessary to prove that the trademark for which the registration is sought contains the name of a region as provided in Article 7-2(2) of the Act” as stipulated in Article 7-2(4) of the Act, the examiners shall send a notice of provisional refusal to the applicant, describing the reason that the application does not satisfy the requirement stipulated in Article 7-2(1) of the Act.

B. Analyzing trademark applications based on the constitution

i. An application filed for a regional collective trademark is required to have a constitution stipulated in Article 7-2(1)(i) - (iii) of the Act. However, the trademark composed of such constitution is usually covered by Article 3(1)(iii), etc., and it is not registered as a collective trademark (regular trademark) unless it satisfies the requirement stipulated in Article 3(2) of the Act.

ii. Considering the situation above, when an applicant files an application for registering a collective trademark composed of the constitution stipulated in Article 7-2(1)(i) - (iii) of the Act, and when the applicant does not submit any document required for registering a collective trademark or regional collective trademark respectively, which means that the intention of the applicant in terms of the type of the trademarks—collective trademark or regional collective trademark—is not specified, the examiners would have to send a notice of provisional refusal, describing the reason that the application is covered by Article 3(1)(iii) of the Act.

iii. However, a constitution of a regional collective trademark is narrowly limited to those stipulated in Article 7-2(1)(i) - (iii) of the Act, and sending a notice of reasons for refusal even to an applicant whose application is not covered by a regional collective trademark but who is assumed to file the application for the trademark, due to the dissatisfaction of the requirements (entitled collectives, common names, constitutions, and names of regions

customarily used) in Article 7-2 of the Act would impose a heavy burden not only on the applicant who has to cope with the notice but also on examiners who have to examine such application, which seems contrary to the user-friendly and efficient examinations aimed at by the JPO.

Subsequently, when an applicant files an international application for a trademark with the expression “Collective mark, certification mark, or guarantee mark,” which is recognized not to be covered by Article 7-2(1)(i) - (iii) of the Act, the examiners do not send a notice of provisional refusal describing the reason that the application does not satisfy the requirement stipulated in Article 7-2(1).

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

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

[Article 3\(1\)\(iii\) \(Indication of Origin, Place of Sale and Quality of the Goods, or Indication of Location and Quality of Provision of the Services\)](#)

[Article 3\(2\) \(Distinctiveness Acquired Through Use\)](#)

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

[Article 7-2 \(Regionally based collective trademarks\)](#)