

27.71

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

1. Basic concept

(1) Specifying types of applications

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 collectively 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, and the type of the application must be confirmed by a written opinion, certificate, etc. submitted by the applicant.

(2) Relation to the system in Japan

- i. Under the Trademark Act of Japan, a collective trademark and a regional collective trademark fall under the category of “Collective mark” for international registration.
- ii. The Trademark Act of Japan provides that the definition of “trademark” includes “certification,” so a collective trademark, a regional collective trademark or a regular trademark includes “certification” and falls under the category of “certification mark” for international registration, respectively.
- * Whether or not a certification mark is registered is determined by the requirements for each type of mark.
- iii. The Trademark Act of Japan does not provide any provisions stipulating a “guarantee mark (guarantee trademark).”

2. Specific handling

- (1) When an applicant files for an international trademark registration whose constitution is protected as a regional collective trademark (, which satisfies the requirements in Article 7-2(1)(i) - (iii) of the Trademark Act), and when the applicant submits neither a certificate as stipulated in Article 7(3) of the Trademark Act (a document certifying that the applicant for trademark registration

is a juridical person that falls under Article 7(1) of the Trademark Act) nor certifying and necessary documents as stipulated in Article 7-2(4) of the Trademark Act.

The examiners send a notice of reasons for refusal to the applicant according to the following steps, requiring the applicant to specify whether the application is filed for a regional collective trademark, a collective trademark, or a “guarantee mark (guarantee trademark)”:

- i. 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 Trademark Act. In addition to the failure to submit the certificates and other documents stipulated in Article 7-2(4) of the Trademark Act, when the application does not meet any other requirement in Article 7-2(1) of the Trademark Act, the examiners also send a notice of reasons for refusal as per requirement to the applicant;
 - ii. 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), etc.; and
 - iii. When the applicant files the application for a “guarantee mark (guarantee trademark),” the examiners send a notice of reasons for refusal to the applicant according to the main paragraph of Article 3(1).
- (2) When an applicant files an application for an international trademark registration whose constitution is not protected as a regional collective trademark, (and hence, does not satisfy the requirement of Article 7-2(1) of the Trademark Act), and when the applicant does not submit a certificate as stipulated in Article 7(3) of the Trademark Act (a document certifying that the applicant for trademark registration is a juridical person that falls under Article 7(1) of the Trademark Act). 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 whether the application is filed for a collective trademark or a “guarantee mark (guarantee trademark).”

- (3) 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 handled as such trademark.

However, when an applicant does not submit certificates, or when the submitted documents do not satisfy the requirements, the application is handled according to the following steps i - v):

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

- ii. When an applicant submits only a document certifying that the applicant is an entitled juridical person stipulated in Article 7(3), the application is handled as an application filed as a collective trademark;
- iii. 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 the above steps i and ii;
- iv. When an applicant explicitly files an application for a “certification mark (certification mark)” in his written opinion (written statement), but it is not clear whether the application is filed for a regional collective trademark(, which is limited to a trademark that satisfies the requirements in Article 7-2(1)(i) - (iii) of the Trademark Act), a collective trademark, or a regular trademark, the applicant is asked to indicate the type of trademark for which the application is filed, and when the application is filed for a regional collective trademark or a collective trademark, the applicant is also asked to submit required certifying documents, etc. for each;
- v. 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's intention to protect the trademark mentioned in the written opinion (written statement) does not correspond to the details of the submitted certifying documents, etc., if these do not become appropriate within a certain period of time, the examiners decide to refuse the application; and

- vi. 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 other reasons for refusal if any).

(4) When an application is included in the processes 2. (1) and (2) above and examiners find other reasons for refusal than those mentioned in the preceding steps, the examiners send another notice of reasons for refusal to the applicant at the same time.

References

[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)