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Applying Article 4(1)(x), etc. of the Trademark Act to a Regular Application for Registering a Trademark containing a Regional Collective Trademark

Approach to analyze the application

A regional collective trademark is a trademark composed of characters “the name of the region + the common name, etc. of the goods.” When examiners analyze a regular application for trademark registration with characters in the constitution of the regional collective trademark (hereinafter called “the characters equivalent to the regional collective trademark”) and when the characters equivalent to the regional collective trademark represent another person’s trademark which is well known among consumers in at least one region as that indicating goods or services in connection with the person’s business, the examiners shall apply Article 4(1)(x) of the Trademark Act to the application while they cite the trademarks connected to the characters.

Examiners apply this provision only when the designated goods or designated services of the regular application are similar to the goods or services connected to the cited trademarks, but they may apply Article 4(1)(xv) of the Trademark Act when the designated goods or designated services of the regular application are not similar to the goods or services connected to the cited trademarks.

Details

1. Background of analyzing the application

It is a concern that an examination process for analyzing the regular application for trademark registration containing a regional collective trademark may ignore the purpose of the regional collective trademark system in some cases, such as where, when Applications A and B in Example 1 of the Appendix are both filed for registration, in which the characters connected to the regional collective trademark of Application B are not “customarily used” as stipulated in Article 3(2) of the Trademark Act and thus examiners decide to register Application A because of the lack of distinctiveness of Application B, the right holders of Application B, even those who are not members of the collective which is the applicant of Application B or are members of such collective but not defined as such, would have the right to use the trademark of Application A, which contains the characters connected to the regional collective trademark of Application B.

2. Applying Article 4(1)(x) of the Trademark Act to the application

The regional collective trademark system is a system which facilitates the registration of an application for a trademark composed of “the name of the region and the common name, etc. of the goods” which does not satisfy the requirement of Article 3(2) of the Trademark Act but is a trademark stipulated in Article 7-2(1) of the Trademark Act, which states that “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.” [The Examination Guidelines for Trademarks for Article 7-2\(1\) of the Trademark Act](#) define that

“well-known among consumers” ... means that “even if the trademark is not known among nationwide consumers, it requires to be known by a certain scope of consumers, for example, consumers in the neighboring prefectures.”

Meanwhile, when examiners reject a certain application while citing any unregistered trademark, such as rejecting Application A due to the presence of Application B in Example 1 of the Appendix, examiners would apply Article 4(1)(x) of the Trademark Act, as grounds for rejection, stipulating a cited trademark as “another person’s trademark which is well known among consumers as that indicating goods or services in connection with the person’s business.” Regarding being well-known among consumers, [the Guidelines for Article 4\(1\)\(x\) of the Trademark Act](#) stipulates that a “trademark which is well known among consumers’ includes not only a trademark which is widely recognized among end consumers but also a trademark which is widely recognized among traders in the industry and also includes not only a trademark which is known throughout the country but also a trademark which is widely recognized in a certain area.” This guideline allows examiners to apply Article 4(1)(x) of the Trademark Act to the application when the application is well-known among consumers, and hence, it nearly satisfies the requirement of “well-known” in Article 7-2(1) of the Trademark Act.

Although the application provides “well-known among consumers,” to which Article 7-2(1) and Article 4(1)(x) of the Trademark Act are applicable, “well-known among consumers” as provided in the application does not always meet the requirement stipulated in Article 3(2) of the Trademark Act since “well-known among consumers” as stipulated in Article 3(2) of the Trademark Act is interpreted as a situation in which “the consumers of the goods or services throughout the country are able to perceive the trademark” in [the Guidelines for Article 3\(2\) of the Trademark Act](#), which is grounds for unregistrability of the application. However, it is a concern that confusion as to the source of the goods and services may arise when the regional collective trademark has distinctiveness at least in the area where the trademark is well known and another person uses a trademark containing the regional collective trademark.

Therefore, to avoid this confusion regarding the source between an unregistered trademark and the regional collective trademark in question, examiners should apply Article 4(1)(x) of the Trademark Act to the trademark in question.

In addition, based on the fact that the requirements of “well-known among consumers” in Article 7-2(1) and Article 4(1)(x) of the Trademark Act are almost identical, this approach is expected to remove the concern that the examination process may ignore the purpose of the regional collective trademark system.

Furthermore, the regular application for trademark registration containing a regional collective trademark is analyzed through this approach, which does not change the conventional interpretation of Article 4(1)(x) of the Trademark Act.

3. Other approaches for applying Articles to the application

1) Applying Article 4(1)(xv) of the Trademark Act to the applications designating goods or services which are not similar

Applications A and B in Example 1 of the Appendix share the common name, etc. of the goods, and when examiners apply Article 4(1)(xvi), etc. of the Trademark Act, the designated goods or designated services of Applications A and B are limited to those equivalent to the common name, etc. of the goods or services. According to this approach, the designated goods or designated services are considered to be goods or services which are identical or similar to each other.

However, there are some applications whose goods or services are not similar, as shown in Example 2 of the Appendix, and examiners should consider applying Article 4(1)(xv) of the Trademark Act to these applications, taking the relationship between the goods or service into consideration.

2) Analyzing regional collective trademarks which are not filed yet

Item 1) mentions the example of pending applications filed for the regional collective trademark. Examiners should consider that the purpose of Article 4(1)(x) of the Trademark Act is to protect a well-known trademark which is not registered and apply Article 4(1)(x) of the Trademark Act to such application regardless of the fact that the application has already been filed.

It is not necessary to check if a business operator connected to the well-known trademark is an “Association, etc” stipulated in Article 7-2(1) of the Trademark Act when the application is not filed yet because Article 4(1)(x) of the Trademark Act does not require the owner of the well-known trademark to be a person entitled to register the regional collective trademark stipulated in Article 7-2(1) of the Trademark Act.

This viewpoint is also applied to the analysis of the application according to Article 4(1)(xv) of the Trademark Act.

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

Examination Guidelines for Trademarks:

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

[Article 4\(1\)\(x\) \(Well-Known Trademark of Another Person\)](#)

[Article 4\(1\)\(xv\) \(Confusion over the Source of Goods and Services\)](#)

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

Example 1:

A: Regular application for trademark registration

Designated goods: Shishamo smelt



鵜川ししやも (Translation: Mukawa shishamo smelt)

B: Regional collective trademark

Designated goods: Shishamo smelt from Hokkaido

“鵜川ししやも” (Translation: Mukawa shishamo smelt) (written in standard characters)

Example 2:

C: Regular application for trademark registration

Designated goods: Meat bun containing garlic from Takko, Aomori Pref.



田子にんにく肉まん (Translation: Takko Meat Bun)

D: Regular application for trademark registration

Designated services: Providing dishes containing garlic from Takko, Aomori Pref.



田子にんにく料理 (Translation: Takko garlic dishes)

E: Regional collective trademark

Designated goods: Garlic from Takko, Aomori Pref.

“たっこにんにく” (Translation: Takko garlic) (written in standard characters)