

Trademark Applications for Collective Trademarks

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I General Information

A collective trademark must be owned by a collective entity despite the use of the mark by members of the collective. Such use identifies its accuracy of membership, and therefore, consumers can distinguish the goods and services of members from those of non-members. What consumers can expect from the indication of a collective trademark is not only the geographical origin, but also the level of quality offered by membership regulation and characteristic features expected from the goods and services supplied under the membership.

The present Japanese registration system for collective trademarks was introduced in the revision of the Trademark Act in 1996, in the course of the participation of Japan to Madrid Protocol.

This system provides trademark registration for collectives in order to allow all their members to use the registered collective trademark under their responsibility and control, without assigning a trademark license to each member. Because a normal registered trademark is restricted to be used only by its registration owner and a third party who receives a trademark license from the owner, this is an exceptional treatment to the underlying principle of trademark protection; therefore, some special provisions are stipulated in the Law.

In Japan, there is another similar registration system for regional collective trademarks. The later section deals with how a collective trademark differs from a regional collective trademark.

II Tips for Successful Application

Applicants

The applicant (afterward, “collective”) must be a general incorporated association (including business cooperative), or a certain kind of association or cooperative established under the special Act. Juridical personality is necessary to be an applicant. Furthermore, the company is excluded from the collective. In this regard, in Japanese, the English word “company” means an incorporated association established under the Companies Act and is used normally for the association operating commercial activities exclusively for itself. Therefore, an applicant name using “company” in its collective’s name is likely to be rejected. Thus, it requires a careful handling to be accepted as an applicant in Japan.

The following are examples of collective that have been recognized as adequate applicants: Japan Agricultural Cooperatives, Commerce and Industry Association, Chamber of Commerce, Incorporated Non-Profit Organization and Intermediate Corporation. (These are all established under the particular laws in Japan.)

The foreign juridical entity equivalent thereto will also be able to be an applicant of a collective trademark.

Required documents

At the time of application, the applicant must submit documents to certify its qualification as an applicant. This particularly refers to the official certificate of juridical entity and documents certifying its establishment under the equivalent regulation of law in the applicant’s country.

Notes from examination standards

Regarding a practice on the main paragraph of Article 3(1) concerning “intention to use the mark,” it will be applied as a refusal reason when it appears that the applied trademark will be used only by the applicant and not by the members of the collective, or when it appears that the applied trademark will not be used by both of the collective and its members. Division of an application is possible, just as with an ordinary application. Conversion of application between a collective trademark, regional trademark and an ordinal trademark will be possible. However, if necessary for the converted application, the applicant should submit a document certifying its qualification as an applicant.

All other requirements for registration are the same as those of an ordinary trademark application.

III. Difference in Treatment of the Right

Basically, the scope and content of right relating to a registered collective trademark are the same as those of a normal trademark right. However, some different points exist pursuant to the exceptional treatment of a collective trademark.

The scope of the right for members of the collective

Members of the collective can use the registered collective trademark, but their right is not an exclusive right. Therefore, they have no right to file an infringement suit. For the benefit of all members, the collective holds the title of the exclusive right to use the registered collective trademark.

Users

The trademark registered under this system must be used by the member of collective. Naturally, the collective itself can use the trademark also. However, if the trademark is used only by the collective, the application will become a subject of rejection since it will be considered as a violation of Article 3, paragraph (1), item (iii).

Assignments

Assignments are, in itself, possible for a collective trademark as well. However, if a collective trademark is transferred to the person or entity who is not qualified to be the applicant of its registration, the nature of such an assigned trademark will be considered to be changed to a normal trademark. It is possible to assign a collective trademark as a collective trademark as well, if the assignee is also the incorporated body or association qualified to be the applicant of its registration.

IV. Application by International Registration of Marks through the Madrid System

It is possible to file a collective trademark through the Madrid system.

If you wish to designate the mark as a collective trademark in Japan, please check the box provided in Form MM2 and MM4. In this case, the required documents certifying the qualification as an applicant are not possible to file with IB of WIPO at the filing. Therefore, please file it afterwards, in response to the official action which informs the formal amendment request to file the same with JPO.

Further, it is also required that the trademark, sought to be registered, is also a collective trademark at basic registration or application for international registration.

Since the international registration system does not admit the conversion, the application through the Madrid system is not also possible with regard to conversion of the

application to a different type.

V. Distinction between a Collective Trademark and a Regional Collective Trademark

	Collective Trademark	Regional Collective Trademark
Qualification as an applicant	Any general incorporated association or other associations (except those which do not have juridical personality, and companies), or other associations established pursuant to a special Act including business cooperative (except those which do not have juridical personality), or a foreign juridical person equivalent thereto. Article 7 (1)	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) or a foreign juridical person equivalent thereto (hereinafter referred to as an "Association, etc.") Article 7-2 (1)
Conditions of open enrollment for new members	Not necessary	Necessary
Delineation of trademark	Any characters, figures, signs or three-dimensional shapes, or any combination thereof, or combination thereof with colors.	Combination of geographical name and the name of goods or services
Goods and services for designation	No limit	Restricted only for the goods and services used in the applied trademark

Acquired well-knownness or secondary meaning	Not necessary	Necessary
Connection to community of origin	Not necessary	Necessary