

Registration of Regional Collective Trademarks in Japan – Requirements and Statistics

The registration of regional collective trademarks is a relatively new feature of the Japanese trademark system. Up until 2006, the Japanese Patent Office (JPO) had refused to accept geographical names as trademarks, due to the possibility that they might mislead consumers as to the origin of the branded products. The Japanese Trademark Law was amended to allow for the registration of regional collective trademarks denoting the geographical origin of products starting from April 1, 2006. However, only few foreign applicants are making use of this way of promoting the special features of their goods.

I. Background

Frequent media reports of foreign “counterfeit” products mislabeled as famous Japanese agricultural products led to an increasing demand from producers of local specialty food for a way to protect regional names. Local producers should be given a way to stop this mislabelling of food, in order to prevent confusion among consumers as to the true origin of the goods.

In the past, the JPO refused the registration of geographical designations as trademarks due to Art. 3 (1) (iii) of the Trademark Law, which specifically denied registrability to “marks indicating in a common way the origin of the goods”. A registration of such trademarks was regarded as inappropriate, since nobody should receive monopoly rights for geographical names. The only way to obtain a trademark with a geographical name was to demonstrate that the name had become famous enough to have a distinctive meaning of its own, apart from the purely geographical description of origin (Art. 3 (2) Trademark Law). Only very few trademark applications were able to climb that hurdle.

The legislation of 2006 changed that and gave business corporative associations and similar legal entities a new tool to protect regional brands.

II. Requirements

Geographical names can be registered as collective marks for certain goods after they have become well known through frequent use in such a way that the goods are commonly associated with the geographical region.

Any industrial business association and other associations established under Japanese law or corresponding foreign legal entities are entitled to file an application for a regional collective trademark.

The trademark name should consist of both the place and the product name, (as in Kôbe Beef), and there should be a close relationship between the geographical name in the trademark and the goods in question.

The trademark has to be well-known through use in Japan, which is a much lower standard than the “secondary meaning” required for geographical trademarks to be registrable under the former legislation. It is sufficient for the trademark to be well-known only in a certain regional area of Japan. The extent to which the trademark has to be well-known is also less critical than before.

In practical handling this means that for the registration of regional collective trademarks in Japan it is sufficient, if the trademark will be readily recognized in two or more prefectures or another definable area of considerable size. As a result, the registration of regional trademark names has become much easier.

III. Current application and registration practice

According to figures published in March 2009, 873 regional trademarks have been registered since the new legislation came into force on April 1, 2006. The system seems to be widely unknown among foreign applicants, as only four out of 873 trademarks belong to foreign applicants (“Canada Pork”, “Indian Darjeeling”,

“Jamaican Blue Mountain Coffee” and “Prosciutto di Parma”). Among the four applications, two have been accepted for registration since (“Prosciutto di Parma” and “Canada Pork”).

A Japanese regional collective mark of reknown is Kôbe Beef from the Hyôgo prefecture. Most applications were filed by the Kyôtô prefecture which is famous abroad for its temples. The prefecture filed 142 applications, 54 of which have been registered so far (ranging from Kyôtô Pickles to Uji Tea, just to name a few examples).

IV. Perspective

Considering the fact that Japanese consumers attach great importance to the quality and origin of products, there seems to be a lot of unused potential for marketing foreign regional specialty food in Japan through the tool of regionally based collective marks, which should not go unused.

Summary:

This article introduces the possibility of the registration of regional collective trademarks in Japan, which were implemented into Japanese Law on April 1, 2006. Recently, the Japanese Patent published current numbers of the use of the new trademarks. It showed that Japanese applicants took widely use of the application for regional collective trademarks, while the system seems to be unknown among foreign applicants.

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