

**STANDING COMMITTEE ON GEOGRAPHICAL INDICATIONS  
QUESTIONNAIRE TO NATIONAL GROUPS**

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**National/Regional Group:** **Japanese Group**

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**Questions**

Your Group is invited to submit a Report addressing the questions below. If your Group considers that the answer to a question has already been given in its report on Question Q191, and that nothing has changed since then, a cross-reference to the specific paragraph in your Group's report on Q191 is sufficient.

***In each case please specify whether your answer differs:***

- (a) as between GIs and AOs; and
- (b) depending on whether the GI or AO is foreign or domestic.

**I. Analysis of current legislation and case law**

- 1) Are GIs and/or AOs protected under your Group's current law?

In Japan, GIs are protected under "the Act on Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs" (hereinafter "GI Protection Act"). According to this Act, a Geographical Indication is "an indication of the name of a Specific Agricultural, Forestry or Fishery Product or Foodstuff that can identify a specific place, region or country in which it is produced and to which its quality, reputation or other established characteristics are essentially attributable" (Article 2 (3) of the GI Protection Act).

A GI may also be protected as a Regional Collective Trademark if it meets certain requirements (Article 7-2 of the Trademark Act).

The Liquor Tax Act provides for protection of GIs for alcoholic beverages.

The use of an indication in a way that is likely to mislead the public as to the quality of the product, its place of origin, etc. is regulated as an act of unfair competition (Article 2 (1) (xiv) of the Unfair Competition Prevention Act).

- 2) If yes, please briefly describe the following:

- a) How AOs and GIs are defined and the prerequisites (in particular the type, nature and intensity of link with a territory).

In order to be protected as a GI, an indication of the name of an agricultural, forestry or fishery product must be able to identify its place of production. It is also necessary that the

product have quality or other established characteristics that are linked with its place of production.

In order to be protected as a Regional Collective Trademark, a trademark needs to comprise the name of a region and the name of a product or service. The name of a region shown in the trademark must be closely linked with that product or service, e.g. the product is made in the said region. It is also necessary that, as a result of its use, the trademark be well known among consumers as indicating the product or service pertaining to the business of the applicant's group or its members.

- b) Whether that protection is provided by sui generis laws; solely as aspects of other laws, such as by registration as collective or certification marks; or by other (and if so, what) means.

The protection is provided by the GI Protection Act and the Trademark Act.

- c) If GIs and/or AOs are protected by sui generis laws, whether your Group's laws provide for a system of registration. If so, what are the steps of this procedure including the content of the application and the possibility of opposition by third parties.

The GI Protection Act provides for a GI registration system.

Every application for registration accepted by the Ministry of Agriculture, Forestry and Fisheries (MAFF) is published on the ministry's website. During three months after its publication, anyone can submit an observation. After these three months for receiving third-party observation, there is a process of hearing expert opinions, then the MAFF performs examination.

The applicant has to submit the following types of documents and details:

- Application form
  - (1) The name of the producer's group, its address, and the name of its representative (a person who represents or manages the producer's group that does not have legal personality)
  - (2) The category of the agricultural, forestry or fishery product
  - (3) The name of the product
  - (4) The place where the product is made
  - (5) Characteristics of the product
  - (6) The method of making the product
  - (7) In addition to the details in 2) to 6), other information needed to identify the product
  - (8) Other items required by the ministerial ordinances
- Specification
- Work rules for management of production process

In order to be protected as a Regional Collective Trademark under the Trademark Act, it is necessary to file a trademark application for registration with the Japan Patent Office (JPO).

In the process of examination, the examiner notifies the applicant of, if any, reasons for refusal. In response to the notification of reasons for refusal, the applicant may submit an amendment or an argument in writing. If the amendment or argument cannot get rid of the reasons for refusal, the examiner will decide to refuse the application. If the applicant disagrees with the decision, they may appeal against the examiner's decision of refusal.

If there is no reason for refusal or the amendment/argument can get rid of the reasons for refusal, the examiner will decide to register the trademark.

During a period of two months after the registered Regional Collective Trademark is published in the trademark gazette, a third party may file opposition.

The documents of a Regional Collective Trademark application need to include: written evidence to prove that the applicant (group) meets the requirements for an eligible entity; written evidence to prove that the product (service) is closely linked with the region; and written evidence to prove that the trademark is well known among consumers (but no need for being well known nationwide).

- 3) If your country does not protect GIs and/or AOs, was this a deliberate decision and, if so, why?
- 4) What are the grounds of invalidity/loss of rights for GIs and/or AOs under your Group's law (e.g. becoming generic, lack of use, not paying fees) and where can such be invoked (which court, office etc.)? Please specify the applicable test, how such is proven (e.g. consumer surveys, expert advice, dictionaries, etc.) and who bears the burden of proof.

According to Article 22 of the GI Protection Act, the grounds for revocation are:

- (1) When the group ceases to be a "Group of Producers,"
- (2) When an officer of the group was found guilty pursuant to any provisions of this Act, and a period of 2 years has not yet elapsed from the date on which the he/she served out his/her sentence or was released from the execution of the sentence,
- (3) When the group disobeys an order from the Minister to take necessary measures,
- (4) When the group had their GI or any change to its specification registered by wrongful means,
- (5) When the product is not a Specific Agricultural, Forestry or Fishery Product or Foodstuff, or when all or part of the product corresponds to any of the Specific Agricultural, Forestry and Fishery Products and Foodstuffs pertaining to the registered GIs.
- (6) When the name of the product has become a generic term; when the product is no longer a product made in a specific place, region or country; or when the quality, reputation or other established characteristics of the product are no longer essentially attributable to its place of production.
- (7) When the trademark holder or the exclusive licensee has withdrawn their approval.

Whether to revoke a GI is decided by the Minister of Agriculture, Forestry and Fisheries.

Under the Trademark Act, a request may be filed for invalidation trial of a registered Regional Collective Trademark on the grounds: (1) it does not meet the registrability requirements or (2) it ceases to meet the requirements (being well known, a close link with the region, etc.) after its registration. A non-use cancellation trial may be filed if the trademark has not been used for more than three years after its registration (Article 50).

When the applicant fails to pay the required fees, their application will be dismissed before entering into substantive examination.

A request for invalidation/non-use cancellation trial is filed with the JPO.

- 5) What is the scope of protection of GIs/AOs under your Group's current law?

The scope of protection under the GI Protection Act includes: (1) agricultural, forestry and fishery products (limited to those intended for human consumption); (2) foods and drinks

(excluding those set forth in (1)); (3) agricultural, forestry and fishery products (excluding those set forth in (1)); and (4) processed products (excluding those set forth in (2)).

The scope of protection under the Trademark Act includes all types of products and services. The scope of protection under the Liquor Tax Act includes alcoholic beverages.

- 6) Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.

The following types of conduct are against the GI Protection Act:

(1) When a member of a "Registered Group of Producer" affixes a GI to a product that does not meet the standards and puts it on the market,

(2) When a producer/processor who is not a member of a "Registered Group of Producer" affixes a GI to a product and puts it on the market,

When someone uses a mark identical or similar to a Regional Collective Trademark for an identical or similar designated product without any legitimate reason, such use will constitute an act of trademark infringement.

Under the Unfair Competition Prevention Act, the use of an indication in a way that is likely to mislead the public as to the quality of the product, its place of origin etc. will constitute an act of unfair competition.

- 7) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

Under the GI Protection Act, a group of producers and/or processors, a regional brand promotion group that does not have legal personality, etc.

Under the Trademark Act, industrial associations such as an agricultural co-operative and a fisheries co-operative, a commerce and industry association, a chamber of commerce, a specified non-profit organization, etc.

- 8) What remedies are available in the case of violation of rights in a GI/AO?

When a producer or processor wrongfully uses a GI, the Minister (MAFF) will order them to remove or erase it, pursuant to the GI Protection Act. If an imported product bearing a GI is counterfeit, the assignment of such a product is prohibited. A penalty may be imposed in case of disobedience to an order from the Minister.

Under the Trademark Act, injunctions and damages are available as civil remedies in the case of trademark infringement. An infringer may also receive a penalty under the Criminal Code.

- 9) How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?

Under the GI Protection Act, if there is a prior trademark that is identical or similar to the name of a specific agricultural, forestry and fishery product for which the GI application is filed, the applicant will be required to obtain approval from the trademark holder or the exclusive licensee, or alternatively, the trademark holder may file a GI application.

Under the Trademark Act, a Regional Collective Trademark will not be registered if it is identical or similar to a prior trademark or a well-known trademark. To accommodate the newly established GI system, the Trademark Act has a new provision Article 26 (3), stating that a trademark right shall have no effect on the use of a GI (except when used for the purpose of unfair competition).

10) Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?

No.

11) Is there anybody that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with product specifications is verified before such goods are put on the market and/or the subsequent market controls on such goods?

The body that manages the registration of GIs for their protection is the MAFF. After the registration, the producer's group needs to verify the compliance of products bearing the GI by themselves and report to the Minister pursuant to the GI Protection Act.

Such a body or system does not exist under the Trademark Act.

12) Please describe any other developments in your country in relation to GIs or AOs which you consider relevant, including any proposals for reform. For example, to the extent that your country has been involved in any negotiations or discussions regarding the protection of GIs and AOs in any fora, such as multilateral, regional or bilateral agreements, please specify whether your country is negotiating or has signed any agreement with other countries that includes provisions on AOs/GIs and whether it was necessary to amend domestic legislation as a result of such agreements.

None.

## II. Proposals for improvements and for harmonisation

13) Should there be harmonised definitions of AOs and GIs? If so, please propose appropriate definitions and prerequisites.

If any harmonization becomes a reality, we are in favor of establishing such definitions. In this case, we would propose the following prerequisites:

- Names to be protected are the names of specific agricultural, forestry and fishery products etc.
- Each of such products is made in a specific place, region or country.
- The quality, reputation or other established characteristics of the product are essentially attributable to its place of production, and
- The product has actually been made in that region for at least a predetermined number of years.

14) Should there be a registration procedure for AOs and GIs? If so, what should its key features be? For example, content of the application; examination by competent bodies; possibility of opposition by third parties.

Yes.

- Requirements for an eligible applicant should be eased.
- The content of the application needs to be clear enough for the examiner to understand the characteristics of a product objectively to a certain degree.

- A third party should be allowed to file opposition.

- 15) What should the grounds of invalidity/loss of rights for GIs and/or AOs be? For example, becoming generic, lack of use, not paying fees. Please specify what the applicable test should be, how such should be proven and who should bear the burden of proof.

Non-use, non-payment of fees.

When the quality is not maintained or not properly controlled.

- 16) How should conflicts between GIs/AOs and prior trademark rights be regulated?

There should a provision for coordination of conflicting rights.

- 17) What scope of protection should GIs/AOs have and should it matter if these are domestic or foreign? Against which conduct by third parties should they be protected?

When registered, domestic and foreign GIs/AOs should be treated in the same manner.

However, before the registration, it is necessary to judge whether to give the same level of protection.

- 18) Who should have legal standing to protect a GI/AO and which remedies are appropriate?

Groups of producers should have legal standing to protect a GI/AO. As remedies, injunctions or damages should also be available.

- 19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?

We are basically in favor of introducing such a provision or practice. However, it will be necessary to secure a means to cancel any wrongful domain name in which a GI is included.

### **Responses to this Questionnaire**

Groups are requested to submit responses to this questionnaire by May 29, 2017.

Responses should be sent by email to [StandingCommittees@aippi.org](mailto:StandingCommittees@aippi.org) and should clearly indicate that they are responses to this questionnaire.