

Chapter II: Article 3(2)  
(Distinctiveness Acquired Through Use)

Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.

1. “The consumers are able to recognize the goods or services as those pertaining to a business of a particular person” in this paragraph means that the consumers of the goods or services throughout the country are able to perceive the trademark as an indication of trade source.

2. (1) Registration through the application of this paragraph is only acceptable when the trademark and the designated goods or designated services in an application are identical to those actually used.

(2) For example, a trademark is not recognized as a trademark which has gained its distinctiveness through use in case of the trademark in an application and the trademark indicated in an accompanying certificate are not identical.

(a) Whereas a trademark in an application is in Chinese characters of the cursive style, a trademark indicated in an accompanying certificate is in Chinese characters of either the square type or the semi-cursive style.

(b) Whereas a trademark in an application is in Japanese hiragana characters, a trademark indicated in an accompanying certificate is in Japanese katakana characters, Chinese characters or Roman characters.

(c) Whereas a trademark in an application uses Arabic numerals, a trademark indicated in an accompanying certificate uses Chinese numerals.

(d) Whereas a trademark in an application is indicated in such a form as ©, a trademark indicated in an accompanying certificate is indicated in such a form as P, △ and Ⓢ.

(e) Whereas a trademark in an application is indicated as a three-dimensional trademark, a trademark indicated in an accompanying certificate is a plain trademark, or vice versa.

(3) Even if the trademark in an application and the trademark indicated in an accompanying certificate are not strictly identical to each other, consideration will be given at the time of judgment if the difference is recognized as not affecting the identity of the trademark, for example, the difference between Mincho font and

Gothic font, or between vertical writing and horizontal writing.

3. (1) Judgment as to whether a trademark has come to gain its distinctiveness through use will be made, taking the following points into consideration. Specifically, the level of consumers' awareness, which will be estimated through a quantitative grasp of the use of a trademark, will be utilized to judge the distinctiveness of a trademark.

- (i) A trademark actually in use and goods or services for which it is used
- (ii) The start of its use, the length of its use, or the area where it is used
- (iii) The volume of production, certification or delivery and a scale of business (number of stores, an area of business, an amount of sales, etc.)
- (iv) The method, frequency and contents of advertising
- (v) The number of times of appearance in general newspapers, trade journals, magazines and the internet, and contents thereof
- (vi) The outcome of the questionnaire regarding consumers' awareness of the trademark

(2) The above facts need to be proved by a method using evidence, including:

- (i) Printed matter (newspaper clippings, magazines, catalogues, leaflets, etc.) carrying advertisements, public notices, etc.
- (ii) Invoices, delivery slips, order slips, bills, receipts, account books, pamphlets, etc.
- (iii) Photographs, etc. showing the use of a trademark
- (iv) A certificate by an advertisement agency, broadcasting agency, publisher or printer;
- (v) A certificate by a trade association, fellow traders or consumers
- (vi) A certificate by a public organization, etc. (the state, a local public entity, a foreign embassy in Japan, a Chamber of Commerce and Industry, etc.)
- (vii) Articles in general newspapers, trade journals, magazines and the internet
- (viii) Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark

However, due consideration will be given to the objectivity of the questionnaire with respect to the conductor, method, and respondents.

(3) Judgment as to whether a trademark has come to gain its distinctiveness through use will be made with consideration given to the frequency of use by people other than the applicant ("other than the applicant and the members" in the case of a collective trademark), and the status of use.

(4) Judgment as to whether a collective trademark has come to gain its distinctiveness through use will be made with due consideration given to the points stated in (1) above concerning the use by members of the owner of the collective trademark.

To prove the use of a collective trademark by a member of a collective trademark owner by means of evidence as specified in (2) above, documents need to be presented to prove the user's membership.

(5) In the case of proving that a trademark in relation to retail services has come to gain its distinctiveness through use, the applicant is required to submit a certificate under Item 3(3), Part 2: Principal Paragraph of Article 3(1), Chapter I of the Guidelines, proving that he is conducting business related to retail services.

(6) When examining the use of a trademark related to retail services, if a trademark is indicated on goods, their packaging, price lists, business documents and advertisements, judgment as to whether or not a trademark is used in respect of retail services shall be made by examining, according to the form of indication, whether the trademark identifies the source of goods or the source of retail services in connection with goods.