

41.103.04**Handling Concerning Examinations on the Capability to Distinguish
Three-Dimensional Trademarks**

1. A three-dimensional trademark that is comprised of a shape that is acknowledged by the consumer as a shape that does not go beyond the scope of the shape of goods (including packaging) or goods used for providing services (hereinafter referred to as “goods, etc.”) itself

A three-dimensional trademark that is comprised of “a shape that is acknowledged by the consumer as a shape that does not go beyond the scope of the shape of goods, etc. itself,” is deemed as lacking the capability of being distinguished. The examination with respect to whether or not a trademark is comprised of “a shape that is acknowledged by the consumer as a shape that does not go beyond the scope of the shape of goods, etc. itself” will be conducted based on the following policies.

[Basic concept]

- (1) Where a three-dimensional shape is acknowledged as having been adopted for a purpose of contributing to a function or aesthetic appeal of goods, etc., unless there are special circumstances, the three-dimensional shape is deemed to not go beyond the scope of the shape of goods, etc. itself.
- (2) Even though a three-dimensional shape is characterized by having been uniquely changed or decorated, if the scope of change or decoration on the ground of function or aesthetic appeal of goods, etc. is within the consumers’ predictability, the three-dimensional shape is acknowledged as having been adopted for a purpose of contributing to a function or aesthetic appeal of goods, etc., and unless there are special circumstances, the three-dimensional shape is deemed to not go beyond the scope of the shape of goods, etc. itself.
- (3) When a three-dimensional shape that does not go beyond the scope of the shape of goods, etc. itself is attached with a mark using letters, figures, etc. that are distinguishable (including cases where letters, figures, etc. are attached in relief or openwork), the trademark as a whole will be also deemed to have the capability of being distinguished. However, where a mark using

letters, figures, etc. cannot be acknowledged as being used in a manner of use as a distinctive sign indicating a source of goods or services, the mark is deemed to fall under Article 3(1)(iii) or (vi).

[Explanation for basic concept]

(1) Where a three-dimensional shape is acknowledged as having been adopted for a purpose of contributing to a function or aesthetic appeal of goods, etc., unless there are special circumstances, the three-dimensional shape is deemed to not go beyond the scope of the shape of goods, etc. itself.

[Explanation]

A shape of goods, etc., in many cases, is adopted for a purpose of bringing out a function of goods, etc. more effectively, making its aesthetic appeal more superior and so on. It is rarely aimed to identify goods or services. (See Mini Maglite Case (Intellectual Property High Court: June 27, 2007, Case (Gyo Ke) No.10555 of 2006).)

Therefore, where a three-dimensional shape of a trademark is acknowledged as having been adopted for a purpose of contributing to a function or an aesthetic appeal of goods, etc., in principle, it is regarded that the three-dimensional shape falls under Article 3(1)(iii) as not going beyond the scope of the shape of goods, etc. itself.

[Specific examples] (The following are examples of trademarks that lack the capability of being distinguished.)



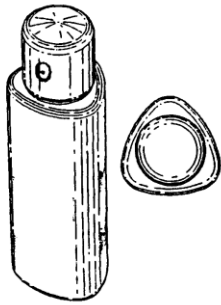
Class 9
camera



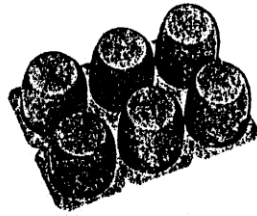
Class 14
wristwatch



Class 21
incense burner



Class 5
spray-type
pharmaceutical



Class 30
sweets



Class 30
sweets



Class 33
brandy

(2) Even though a three-dimensional shape is characterized by having been uniquely changed or decorated, if the scope of change or decoration on the ground of function or aesthetic appeal of goods, etc. is within the consumers' predictability, the three-dimensional shape is acknowledged as having been adopted for a purpose of contributing to a function or aesthetic appeal of goods, etc., and unless there are special circumstances, the three-dimensional shape is deemed to not go beyond the scope of the shape of goods, etc. itself.

[Explanation]

(a) Even though a shape of a three-dimensional trademark has been uniquely changed or decorated, when the consumer perceives those changes or decorations to be within the scope of the shape that is adopted by the industry involved in the transaction of the goods or services, it will be ruled that the three-dimensional shape does not go beyond the scope of the shape of the designated goods, even after observing the entire three-dimensional shape. Therefore, such a trademark will be deemed to lack the capability of being distinguished, in principle.

(Example) When the designated goods related to the trademark application are "automobiles", though the three-dimensional shape of the application has been uniquely changed or decorated in a manner that is different from the same type of goods, if the consumer perceives that change or decoration to have merely increased the aesthetic appeal of the goods, such a three-dimensional trademark will be acknowledged to fall within the scope of the shape of the automobile, which is the

designated goods. Thus, the trademark will be deemed to lack the capability to be distinguished.

(b) The phrase “the scope of change or decoration on the ground of function or aesthetic appeal of goods, etc. within the consumers’ predictability” may mean that, if the same type of goods, etc. whose shape has been changed or decorated identically may not exist in the market, and even though in relative terms that goods, etc. related to the trademark may be acknowledged to have an external appearance with a unique shape, it will be sufficient if the industry involved in the transaction of the goods or services acknowledges that the type of change or decoration can be adopted.

Therefore, whether or not it is within the consumers’ predictability is decided by taking comprehensively into consideration the actual condition of the transaction of the goods, etc. and the class of the consumers. It will be decided for each designated goods or each designated services.

For example, if it is in an area where the shape of the goods, etc. is not indispensable to securing the function or efficacy of the goods, and the unique appearance of the goods seriously impacts the purchasing psychology, the incentive to purchase and the purchasing behavior of the consumer, it must be acknowledged that in reality the goods and services will be changed and decorated in a unique manner in response to what is fashionable, what is the consumers’ use and preference in the market where the goods or services are sold.

In this case, such types of changes or decorations applied to a three-dimensional shape, even though they are acknowledged as being characteristic in external appearance compared to the shape of the same type of goods, etc., if the changes and decorations only enhance the aesthetic quality of the external appearance and the attractiveness of the shape in response to the consumers’ taste, they will be only acknowledged as being the shape of the goods.

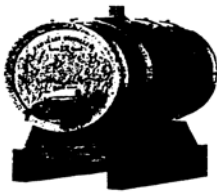
Therefore, since such change or decoration, etc. cannot be deemed to be functioning as an identification sign indicating the source of one’s own and a third party’s goods or services, from the observations of the entire of the shape of the three-dimensional trademark, the trademark cannot be deemed to be capable of being distinguished.

(Example) Taking sweets and western alcoholic beverages as an example, generally speaking in response to market trends and consumer preference, the

three-dimensional shapes that can be adopted for the same type of goods are not only decorated with various designs, but the dimensional shape itself is changed decoratively to depict various animals, plants and receptacles. Since this is the reality, the scope will be applied broadly.

(c) The above-mentioned concept also applies to three-dimensional trademarks consisting of a shape of package of goods, etc. Especially, where a designated good is a “perfume” or “western alcohol beverage” where the good is liquid, gas or powder, etc., it must be contained in a receptacle first and then traded. In this case, as long as the composition of the three-dimensional trademark on the whole is acknowledged to represent the shape of the receptacle that contains the good, it will be handled in the same manner.

[Specific examples] (The followings are examples of trademarks that are deemed to lack the capability of being distinguished.)



Class 33
whiskey



Class 33
whiskey



Class 14
wristwatch



Class 3
perfume



Class 3
aromatic goods



Class 30
sweets



Class 30
sweets



Class 30
sweets

(3) When a three-dimensional shape that does not go beyond the scope of the shape of goods, etc. itself is attached with a mark using letters, figures, etc. that are distinguishable (including cases where letters, figures, etc. are attached in relief or openwork), the trademark as a whole will be also deemed to have the capability of being distinguished. However, where a mark using letters, figures, etc. cannot be acknowledged as being used in a manner of use as a distinctive sign indicating a source of goods or services, the mark is deemed to fall under Article 3(1)(iii) or (vi).

[Explanations]

(a) Where characters, letters, figures, etc. are attached to a shape of goods, etc., especially to a container (bottle), etc. (for example, where a company's name and a name of goods are indicated on a packaging container such as a bottle and a can), they are generally attached so as to attract the consumer's attention easily for a purpose of making them distinguish sources of goods or services. It is a rule of thumb in business transactions that characters, letters, figures, etc. displayed in marks are regarded as what display the source of the goods or the services. Therefore, in the examination with respect to overall capability of being distinguished of a three-dimensional trademark to which such characters, letters, figures, etc. are attached, in principle, the characters, the letters, the figures, etc. displayed in the marks attached to the three-dimensional shape are decided according to the examination method which would be used if the application of them are filed for a plane trademark.

Therefore, when the three-dimensional trademark mentioned above in basic concept 1. or 2. is attached with letters and figures that are deemed to be capable of being distinguished, in principle, the entire three-dimensional trademark is deemed to be capable of being distinguished.

[Specific example] (The following are examples each of which is deemed to have the capability of being distinguished.)



Class 32
beer



Class 21
hair brush



Class 3
soap



Class 3
cosmetics



Class 29
dairy products



Class 33
whiskey

(b) However, characters, letters, figures, etc. attached to a three-dimensional trademark function as the trademark of the designated goods or the designated services, only when the actual situation of the use of the designated goods or the designated services in actual trade is insistently considered and they are obviously used in a manner of use as distinctive signs indicating the source of the goods or the services.

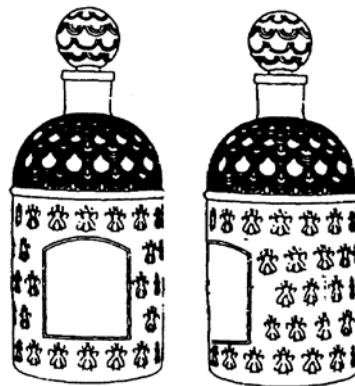
(c) Therefore, when sizes and ways of attaching of the characters, the letters, the figures, etc., and conditions of attached positions, etc. are considered; when it obviously cannot be recognized that they are used in a manner of use as distinctive signs indicating the source of the goods or the services, the entire three-dimensional trademark also cannot be recognized as having capability of being distinguished.

In other words, where characters, letters, figures, etc. in a three-dimensional trademark described in a request, for example, do not go beyond those that are

deemed to be decoration to improve an aesthetic impression, a function, etc. of the goods, etc., or decoration of a kind of mere base design, the entire three-dimensional trademark also is not deemed to have capability of being distinguished.

In addition, in this case, there would be a case where Article 3(1)(iii) is applied for the reason that mark parts of characters, letters or figures, etc. are deemed to be unified with a three-dimensional shape, and there would be another case where Article 3(1)(vi) is considered appropriate to be applied for the reason that the consumers, when observing the whole, cannot recognize goods or services as pertaining to someone's business. Which is appropriate is decided individually and specifically with observation of the entire structure of a relevant three-dimensional trademark, based on operations so far of examinations with respect to figure trademarks.

[Specific example] (The following case will be deemed to lack the capability of being distinguished.)



Class 3
perfume

(Note) This is recognized as a pattern.

2. Three-dimensional trademark consisting solely of a shape they can only be acknowledged as being within the scope of a very simple and common three-dimensional shapes

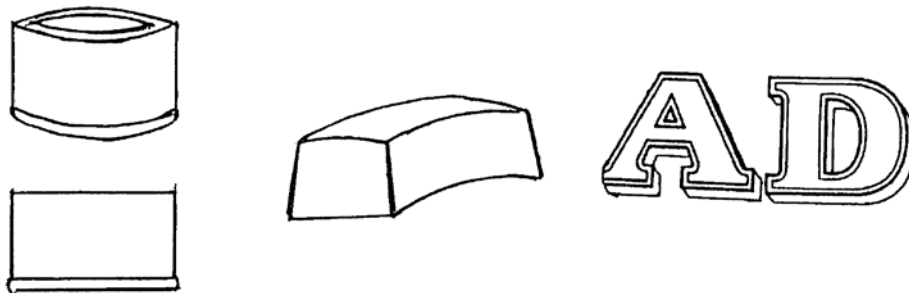
A three-dimensional trademark consisting solely of shapes “they can only be acknowledged as being within the scope of a very simple and common three-dimensional shapes” shall be deemed to not have capability of being distinguished.

[Explanations]

(1) A very simple and common shape is, for example, a simple sphere, a cubicle, a rectangular parallelepiped, or cylinder, one or two Roman letters, or a number which has been made into a three-dimensional shapes to give thickness.

In addition, the determination of whether or not the three-dimensional shape claimed in a trademark application consists only of a simple and common shape should be made based on recognition of consumers of relevant goods or relevant services.

[Specific examples] (The followings are examples none of which are deemed to lack the capability of being distinguished.)



3. Handling of indication of characters, letters, figures, etc. where a three-dimensional shape is attached with such characters, letters, figures, etc., but the whole composition and mode which are considered to have to be indicated are not shown

Where, in spite of characters, letters, figures, etc. being attached to a three-dimensional shape, because parts of the characters, the letters, the figures, etc. are not shown, the whole composition and mode cannot be grasped; it is not recognized to be appropriate, in principle, to speculate from the name of the applicant about the composition and mode of the shape based on assumptions that the entire shape including the letters and figures are shown, and to determine the capability of being distinguished or the similarity of the trademark.

However, for example, though the whole composition and mode cannot be grasped from the manner in which the letters or figures were attached and depicted, if from the features of the external appearance of the visible portion, it is readily recognizable as part of a well-known or famous trademark, or when it is deemed that a certain appellation or concept comes easily to mind, the above stipulation does not apply.

[Specific examples]

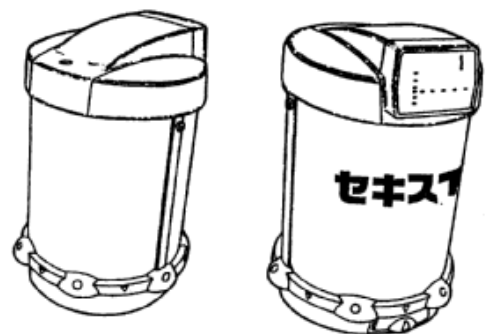
1. (Example where a certain appellation or concept is not brought to mind)

2. (Example where a specific appellation is brought to mind)

1.



2.



4. In relation to Article 3(2) of the Trademark Act

Handling of the issue of identicalness to the trademark claimed in the trademark application; when determining whether or not a three-dimensional trademark is capable of being distinguished in use, when the three dimensional trademark described in the trademark application is comprised solely of a three-dimensional shape, while the trademark shown in the goods used is attached with marks consisting of letters or figures (for example, labels)

- (1) When Article 3(2) of the Trademark Act is insisted on, it is the rule that, for a trademark to be deemed to have the capability of being distinguished in use, the trademark must be identical to the pertinent trademark, or to the same goods or services which use that trademark.
- (2) However, “some examples are found here and there in which multiple marks are attached to goods rather than only a single mark is always attached to each of goods, and sources of goods are tried to be identified or goods are tried to be distinguished. In addition, relevant traders and consumers also could identify sources of goods and distinguish goods with characteristics (including plane marks and three-dimensional shapes) of shapes of goods completely different from marks attached by relevant providers of goods” (Coca-Cola Bottle Case (Intellectual Property High Court Judgment May 29, 2008, Case (Gyo Ke) No.10215 of 2007)). Therefore, where a trademark applied for consists only of a three-dimensional shape, whereas a three-dimensional shape combined with plane marks of characters, letters, figures, etc. is used in a trademark pertaining to use in evidence submitted, adoption of Article 3(2) will not be denied immediately for the reason that the trademark applied for and the trademark pertaining to the use in the evidence are not the same, but
- (i) whether a three-dimensional shape part used out of goods, etc. and a three-dimensional shape pertaining to a trademark applied for are the same, and
 - (ii) whether it is recognized that a three-dimensional shape part used out of goods, etc. solely come to have a function of displaying a source to identify goods or services will be decided.