

42.118.01

Handling of a Three-dimensional Shape Essential to the Functions of Packaging of Goods (Article 4(1)(xviii) of the Trademark Act)

If a trademark application for a trademark consisting solely of a three-dimensional shape being indispensable to secure the functions of goods or their packaging were to be registered, the trademark owner would virtually be granted the right to monopolize the production and sales of the goods or their packaging almost indefinitely, which may hinder appropriate competition in the market. This resulted in the provision of Article 4(1)(xviii) of the Trademark Act in order to prevent such hindrance.

The “three-dimensional shape being indispensable to secure the functions of goods or their packaging” mentioned in this item is essentially a “shape of goods” or a “shape of their packaging,” so a trademark consisting of such three-dimensional shape is usually refused pursuant to Article 3(1)(iii) of the Trademark Act.

Therefore, the application of this item is considered to involve mostly those trademarks of which three-dimensional shape had already been in use, and as a result, acquired the capability to be distinguished, so in other words, those trademarks to which Article 3(2) of the Trademark Act is applicable.

In the actual examination concerning Article 4(1)(xviii) of the Trademark Act, the examiner refers to advertising documents or transaction documents submitted for the application of Article 3(2) of the Trademark Act, and determine the application of Article 4(1)(xviii) of the Trademark Act by looking at the functions realized by the shape of the goods or their packaging that is advertised as being the practical advantage of those goods or their packaging. The determination of whether the shape of those goods or their packaging is indispensable to secure the functions is made based on the purport of this item, and particularly taking the following points into consideration:

1. Whether there is another shape that can substitute the securing of the functions

If there is an alternative shape, the three-dimensional shape cannot be regarded as “indispensable,” so the trademark will not fall under this item. However, if there is no alternative shape, it would effectively suggest that the three-dimensional shape is an indispensable shape for securing the functions, so this item would be applicable.

2. Whether the cost of production will be at the same level (or lower) when the shape of the goods or their packaging is changed to the alternative shape

If the use of the alternative shape would significantly raise the production cost, the competitors would become extremely disadvantageous in the competition of commercial transactions, and as a result, the applicant may monopolize the market of the goods, etc. Thus, this item would be applicable.

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

[Article 3\(1\)\(iii\) \(Indication of Origin, Place of Sale and Quality of the Goods, or Indication of Location and Quality of Provision of the Services\)](#)

[Article 3\(2\) \(Distinctiveness Acquired Through Use\)](#)

[Article 4\(1\)\(xviii\) \(Three-Dimensional Shape Indispensable to Secure the Functions of the Goods or Their Packaging\)](#)