

## 49.02

### **Specific Handling Concerning Examination on Distinctiveness of a Three-Dimensional Trademark**

The specific handling concerning examination on distinctiveness of a three-dimensional trademark is to be as follows.

1. A three-dimensional trademark comprised of the shape of goods (including the shape of packaging of goods), articles to be used for the provision of services, etc. (Article 3(1)(iii) and (vi) of the Trademark Act)

If the trademark is a three-dimensional trademark solely comprised of a shape that is acknowledged by the consumer as a shape that does not go beyond the scope of the shape of the designated goods or articles to be used for the provision of the designated services (hereinafter referred to as "goods, etc.") itself, the trademark lacks distinctiveness (Article 3(1)(iii) of the Trademark Act). The examination as 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 basic concepts.

Also in the case of a three-dimensional trademark comprised of the shape (including the shape of the interior; the same shall apply hereinafter) of a store, office, place of business, or facility (hereinafter referred to as a "store, etc."), if the three-dimensional shape constituting the trademark could fall under Article 3(1)(iii) of the Trademark Act,<sup>1</sup> the judgment is made in the same manner as above.

Even in the case where a three-dimensional trademark comprised of the shape of a store, etc. does not fall under Article 3(1)(iii) of the Trademark Act, if the trademark is acknowledged by the consumer as merely being the shape of a store, etc., the trademark lacks distinctiveness on the basis of Article 3(1)(vi) of the Trademark Act. In this case, the basic concepts (1) and (2) below apply mutatis mutandis to the determination as to whether or not the trademark is comprised of a shape that is "acknowledged by the consumer as merely being the shape of a store, etc."

Meanwhile, in the case where a three-dimensional trademark comprised of the shape of a store, etc. is attached with a mark using characters, figures, etc. that have distinctiveness, the basic concept (3) below applies mutatis mutandis where the trademark falls under either Article 3(1)(iii) or Article 3(1)(vi) of the Trademark Act.

---

<sup>1</sup> Examples of such case include a three-dimensional shape of the outer appearance of the building subject to transaction for designated services "construction of a building," a three-dimensional shape of the interior of a railway vehicle for designated services "transportation," and a three-dimensional shape of a kitchen car for designated services "providing foods and beverages."

[Basic concept]

- (1) Where a three-dimensional shape is acknowledged as having been adopted for a purpose of contributing to a function or the 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 grounds of function or the 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 the 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 characters, figures, etc. that have distinctiveness (including cases where characters, figures, etc. are attached in relief or openwork), the trademark as a whole will be also deemed to have distinctiveness. However, where a mark using characters, 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) of the Trademark Act.

[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 the 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 judgment, June 27, 2007, 2006 (Gyo Ke) No.10555]).

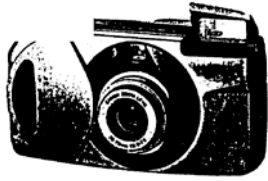
Therefore, where a three-dimensional shape of a trademark is acknowledged as having been adopted for a purpose of contributing to a function or the aesthetic appeal of goods, etc., in principle, it is regarded that the three-dimensional shape falls under Article 3(1)(iii) as not going beyond the scope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

A shape of a store, etc., in many cases, is also adopted for the purpose of contributing to a function or the aesthetic appeal of the store, etc.

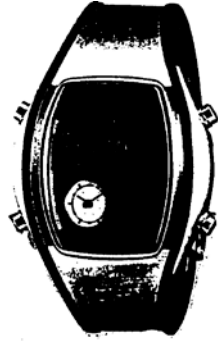
Therefore, also in the case of a three-dimensional trademark comprised of the shape of a store, etc., if the shape could fall under Article 3(1)(iii) of the Trademark Act (for example, if the shape of a store, etc. could fall under the category of "articles to be used for the provision of the designated services" in relation to the designated services), the applicability of Article 3(1)(iii) is judged in the same manner as above.

Even in the case where the shape of a store, etc. does not fall under Article 3(1)(iii) of the Trademark Act, if the three-dimensional trademark is acknowledged by the consumer as merely being the shape of a store, etc., it is judged to fall under Article 3(1)(vi) of the Trademark Act in principle, by applying the above concept *mutatis mutandis*, as the shape of a store, etc. generally does not make consumers recognize goods or services as pertaining to someone's business.

[Specific examples] Examples that are found to lack distinctiveness



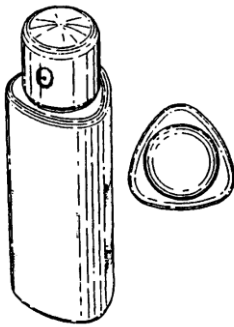
Class 9  
Camera



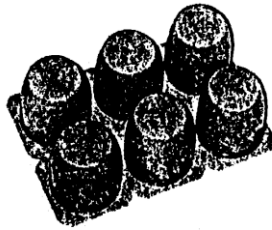
Class 14  
Wristwatch



Class 21  
Incense burner



Class 5  
Spray-type pharmaceutical



Class 30  
Chocolate



Class 30  
Chocolate



Class 33  
Brandy



Class 37  
Construction of housing



Class 43  
Providing foods and beverages

(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 grounds of function or the 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 the 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 is judged that the three-dimensional shape falls under Article 3(1)(iii) as not going beyond the scope of the shape of the goods, etc. pertaining to the designated goods or services even after observing the entire three-dimensional shape.

Also in the case of a three-dimensional trademark comprised of the shape of a store, etc., if the shape could fall under Article 3(1)(iii) of the Trademark Act, the applicability of Article 3(1)(iii) is judged in the same manner as above.

Even in the case where the shape of a store, etc. does not fall under Article 3(1)(iii) of the Trademark Act, if the three-dimensional trademark is acknowledged by the consumer as merely being the shape of a store, etc., it is judged to fall under Article 3(1)(vi) of the Trademark Act in principle, by applying the above concept *mutatis mutandis*.

Hereinafter, (b) and (c) of this explanation also apply *mutatis mutandis* to examination of a three-dimensional trademark comprised of the shape of a store, etc.

(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 distinctiveness.

(b) The phrase "the scope of change or decoration on the grounds of function or the aesthetic appeal of goods, etc. within the consumers' predictability" means that, even if the same type of goods, etc. whose shape has been changed or decorated identically do not actually exist in the market, and the goods, etc. related to the trademark are acknowledged to have an outer appearance with a unique shape, it is sufficient as long as it is acknowledged in the industry involved in the transaction of the goods or services that such

type of change or decoration could be adopted.

Therefore, whether or not it is within the consumers' predictability is determined by taking comprehensively into consideration the actual state of the transaction of the goods, etc. and the class of the consumers, and is determined for each category of designated goods or 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, etc. and the unique appearance of the goods, etc. 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 and what is the consumers' use and preference in the market where the goods or services are sold.

In this case, even though such types of changes or decorations applied to a three-dimensional shape are acknowledged as being characteristic in outer appearance compared to the shape of the same type of goods, etc., if the changes and decorations only enhance the aesthetic quality of the outer 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, etc.

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 entirety of the shape of the three-dimensional trademark, the trademark cannot be deemed to have distinctiveness.

(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, etc. are not only decorated with various designs, but the three-dimensional shape itself is changed or decorated 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 packaging of goods. 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] Examples that are found to lack distinctiveness



Class 33  
Whiskey



Class 33  
Whiskey



Class 14  
Wristwatch



Class 3  
Perfume



Class 3  
Aromatic goods



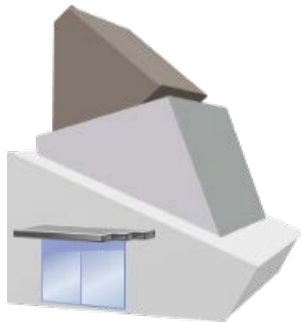
Class 30  
Biscuit



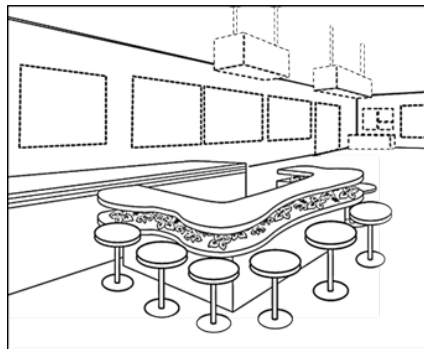
Class 30  
Candy



Class 30  
Chocolate



Class 43  
Providing temporary accommodation



Class 43  
Providing foods and beverages

(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 characters, figures, etc. that have distinctiveness (including cases where characters, figures, etc. are attached in relief or openwork), the trademark as a whole will be also deemed to have distinctiveness. However, where a mark using characters, 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]

(a) Where characters, figures, etc. are attached to the 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, 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 distinctiveness of a three-dimensional trademark to which such characters, figures, etc. are attached, in principle, the characters, the figures, etc. displayed in the marks attached to the three-dimensional shape are determined 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 in (1) or (2) above is attached with characters, figures, etc. that have distinctiveness, in principle, the entire three-dimensional trademark is deemed to have distinctiveness.

Also, when the shape of a store, etc. has characters, figures, etc. that have distinctiveness attached to it, in principle, the entire three-dimensional trademark is deemed to have distinctiveness, by applying the above concept *mutatis mutandis*.

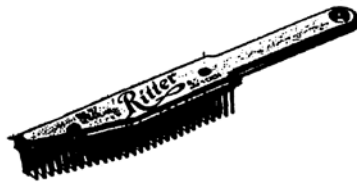
Hereinafter, (b) and (c) of this explanation also apply *mutatis mutandis* to examination of a three-dimensional trademark comprised of the shape of a store, etc.

[Specific examples] Examples that are found to have distinctiveness





Class 32  
Beer



Class 21  
Hair brush



Class 3  
Soap



Class 3  
Cosmetics



Class 29  
Dairy product



Class 33  
Whiskey

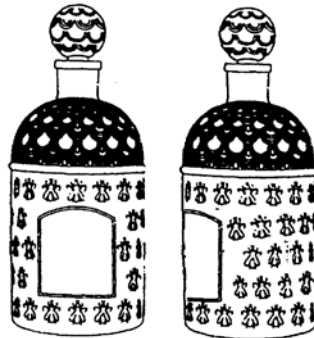
(b) However, characters, figures, etc. attached to a three-dimensional trademark function as the trademark of the designated goods or the designated services, only when the actual situation of the use of the designated goods or the designated services in actual trade is considered and they are obviously 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, figures, etc., and conditions of attached positions, etc. are considered, if 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 distinctiveness.

In other words, where characters, figures, etc. in a three-dimensional trademark stated in an application, 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 distinctiveness.

In addition, in this case, there would be a case where Article 3(1)(iii) is applied, 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 the Examination Guidelines for Trademarks and operations so far of examinations with respect to figure trademarks.

[Specific example] Example that is found to lack distinctiveness



Class 3  
Perfume

(Note) This is recognized as a pattern.

2. Three-dimensional trademark consisting solely of a shape that can only be acknowledged as being within the scope of very simple and common three-dimensional shapes (Article 3(1)(v) of the Trademark Act)

A three-dimensional trademark consisting solely of shapes “that can only be acknowledged as being within the scope of very simple and common three-dimensional shapes” lacks distinctiveness.

[Explanation]

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

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

[Specific examples] Examples that are found to lack distinctiveness



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

Where, in spite of characters, figures, etc. being attached to a three-dimensional shape, because parts of the characters, 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 characters, figures, etc. are shown, and to determine the distinctiveness or the similarity of the trademark.

However, for example, though the whole composition and mode cannot be grasped from the manner in which the characters, figures, etc. were attached and depicted, if from the features of the outer 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]

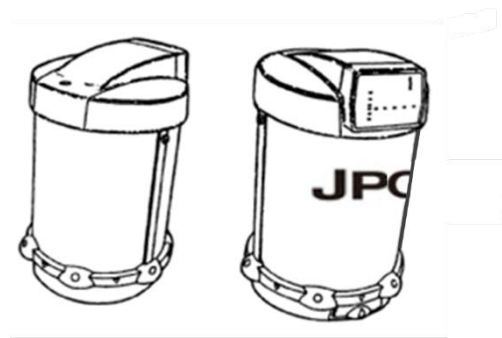
Example where a certain appellation or concept is not brought to mind



(Note 1) In the above example, it cannot be identified whether the left-end character attached at the front of the three-dimensional shape is either "J" or "U," and it cannot be recognized from the characters that are visible that they constitute a part of a well-known or famous trademark.

Example where a specific appellation is brought to mind

\* "JPO" is assumed to be a well-known or famous trademark



(Note 2) In the above example, it can be recognized from the characters that are visible that the characters attached to the three-dimensional shape constitute a part of a well-known or famous trademark, "JPO," and that the appellation "JPO" comes easily to mind.

4. Examination on distinctiveness acquired through use (in relation to Article 3(2) of the Trademark Act)

Handling in the case where, in determination as to whether or not a three-dimensional trademark has distinctiveness acquired through use, the trademark relating to an application for trademark registration is solely comprised of a three-dimensional trademark while the trademark shown in the goods, etc. used is attached with marks consisting of characters, figures, etc. (for example, labels)

(1) When application of Article 3(2) of the Trademark Act is asserted, it is the rule that, for a trademark to be deemed to have acquired distinctiveness through use, the trademark must be identical to the trademark, and the goods or services must be identical to the goods or services for which that trademark had been used.

(2) However, “some examples are found here and there in which multiple marks are attached to goods rather than only a single mark being always attached to each of the 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, etc.) 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, 2007 (Gyo Ke) No.10215]). Therefore, where a trademark relating to an application for trademark registration (hereinafter referred to as the "trademark in an application") consists only of a three-dimensional shape, whereas a three-dimensional shape combined with plane marks of characters, figures, etc. is used in a trademark pertaining to use (hereinafter referred to as the "trademark as used") in evidence submitted, application of Article 3(2) will not be denied immediately for the reason that the trademark in the application and the trademark as used are not the same, but will be determined based on the following:

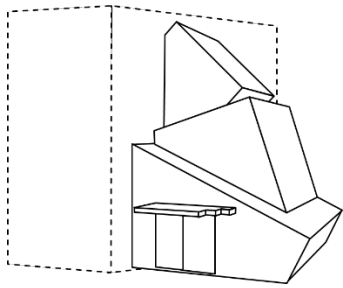
- (i) whether the three-dimensional shape part of the trademark as used, etc. and the three-dimensional shape pertaining to the trademark in the application are the same, and
- (ii) whether it is recognized that the three-dimensional shape part of the trademark as used, etc. has independently acquired a function of indicating a source to identify goods or services.

Handling in the case where, in determining the identity of a trademark in an application and a trademark as used, the trademark in the application has broken lines, etc. indicating a part that does not constitute the trademark

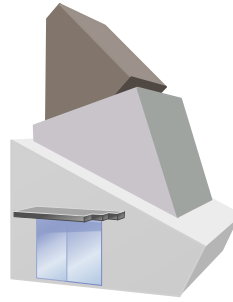
As mentioned in the Examination Guidelines for Trademarks, when determining the identity of a trademark in an application, which is stated by a method such as drawing the mark in connection with the trademark with solid lines and other parts with broken lines (hereinafter referred to as “(having) parts drawn differently with solid lines/broken lines, etc.”), and a trademark as used, the other parts pertaining to the trademark in the application are not taken into consideration (Part II, Item 3(2) [Article 3(2) (note)] of the Examination Guidelines for Trademarks).

Therefore, if the trademark in an application has parts drawn differently with solid lines/broken lines, etc., the part that does not constitute the trademark (broken lines, etc.) is not taken into consideration, and a comparison is made between the mark part (solid lines, etc.) of the trademark in the application and the trademark as used.

[Specific example] Example in which identity of the trademark in an application and the trademark as used can be recognized



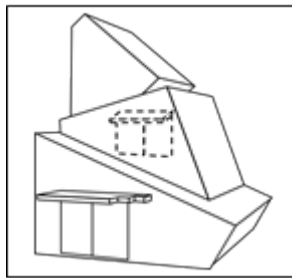
Trademark in an application



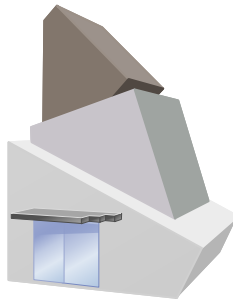
Trademark as used

Even where the three-dimensional shapes of the trademark as used and the trademark in an application partially differ, such as where an element that does not constitute the trademark in the application is added to the trademark as used, the two trademarks are judged to be identical if the characteristic parts of three-dimensional shapes of the trademark in the application and the trademark as used are identical and differences in other parts are minor.

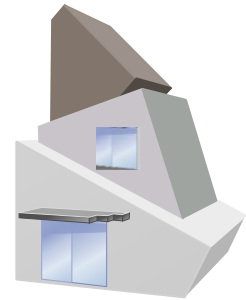
[Specific example] Example in which identity of the trademark in an application and the trademark as used can be recognized



Trademark in an application

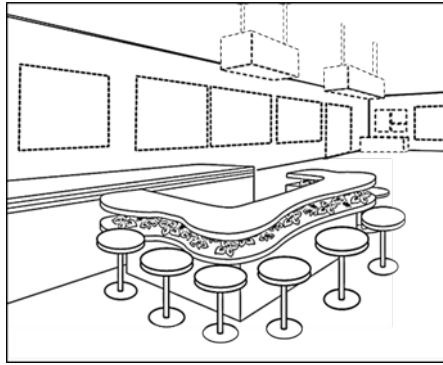


Trademark as used 1

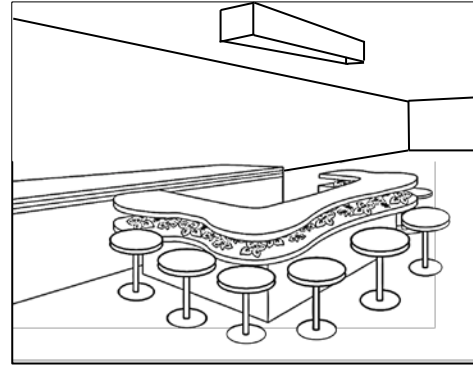


Trademark as used 2

(Note) Trademark as used 2 has a "window," which is drawn as an element that does not constitute the trademark in the trademark in an application, but the characteristic parts of the trademark in the application and the trademark as used are both considered to be three-dimensional shapes comprised of polyhedrons, and the presence or absence of a window is only a minor difference.



Trademark in an application



Trademark as used

(Note) The trademark as used has a "lighting apparatus," which is drawn as elements that do not constitute the trademark in the trademark in an application, but the characteristic parts of the trademark in the application and the trademark as used are considered to be the decorated "U-shaped counter" at the central part, and the presence or absence of lighting apparatuses is only a minor difference.

Consideration of the actual state of the transaction in determining the identity of a trademark in an application relating to a three-dimensional shape of the outer appearance or the interior of a store, etc. and a trademark as used

In determining the identity of a trademark in an application relating to a three-dimensional shape of the outer appearance or the interior of a store, etc. and a trademark as used, due consideration is given to the actual state of the transaction with regard to the trademark as used.

However, if the identity of the trademark is found to be lost due to the degree of differences between the trademark in the application and the trademark as used, the two trademarks are judged not to be identical.

[Explanation]

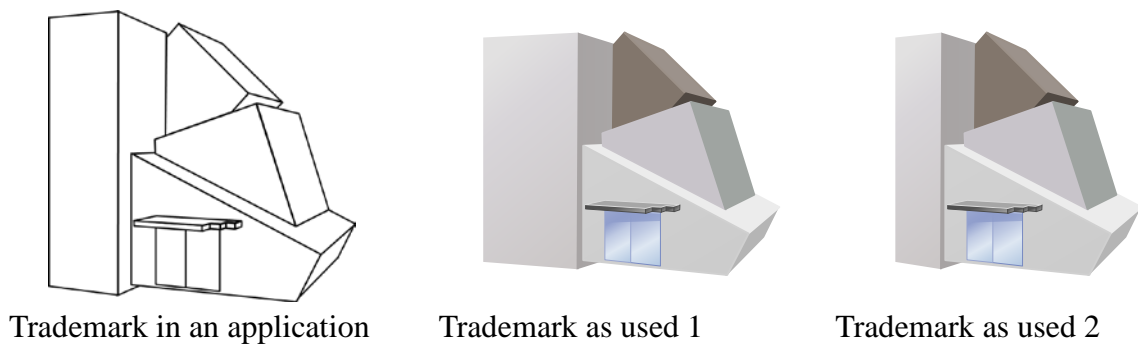
Determination of the identity of a trademark in an application relating to a three-dimensional shape of the outer appearance or the interior of a store, etc. and a trademark as used does not differ from determination of identity of a trademark in an application relating to a three-dimensional trademark of the shape of goods (including the shape of packaging of goods) and a trademark as used, in principle.

However, in the case of the shape of the outer appearance or the interior of a store, etc., there is a circumstance that it is difficult to make the shape in each trademark as used completely the same as the shape in the trademark in an application, as compared to the case of the shape of goods, so it is assumed that the shapes in the trademark in an application and the trademark as used are often not strictly identical to each other in appearance.

It is mentioned in the Examination Guidelines for Trademarks that, even if the trademark in an application and the trademark as used are not strictly identical to each other in appearance, the trademark in the application is recognized as being used if the difference is recognized as not affecting the identity of the trademark by considering the degree of differences in appearance and the actual state of transaction of the designated goods or designated services (Part II, Item 1(1) [Article 3(2)] of the Examination Guidelines for Trademarks). Therefore, in examining the identity of a trademark in an application relating to a three-dimensional shape of the outer appearance or the interior of a store, etc. and a trademark as used, due consideration is given to the state of transaction as mentioned above.

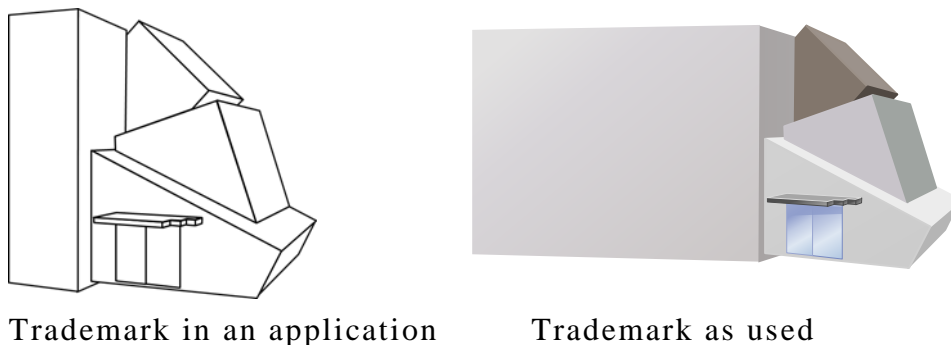
However, if the identity of the trademark is found to be lost, such as where the degree of differences between the trademark in an application and the trademark as used is large, the two trademarks are judged not to be identical.

[Specific example] Example in which identity of the trademark in an application and the trademark as used can be recognized



(Note) In trademark as used 1 and trademark as used 2, the width of the cuboid at the left part of the building is different from that of the trademark in an application, but the degree of difference is not large, and the characteristic part comprised of multiple polyhedrons at the right part is identical, so the identity of the trademark is not lost.

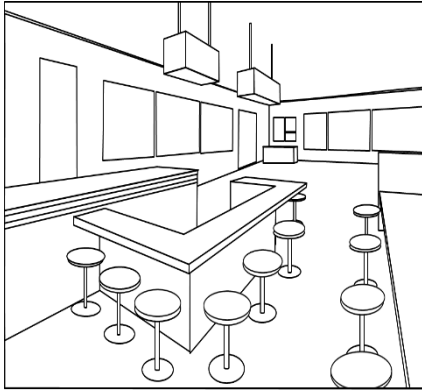
[Specific examples] Examples in which identity of the trademark in an application and the trademark as used cannot be recognized



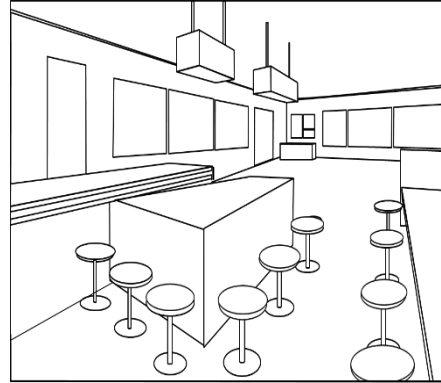
(Established in April 2020)



(Note) As the width of the cuboid at the left part of the building is considerably different, the degree of difference between the trademark in an application and the trademark as used is large, and the identity of the trademark is lost.



Trademark in an application



Trademark as used

(Note) As the shape of the table at the central part is considerably different, the identity of the trademark is lost.