

54.06

Evidence to Prove That a Color Trademark Has Acquired Distinctiveness Through Use

1. Basic principle

In accordance with the Trademark Examination Guidelines, a color trademark can be considered to fall under Article 3(1)(ii), (iii), or (vi) of the Trademark Act in principle. Thus, a color trademark may be registered as long as the color(s) alone (separately from the figures, characters, etc. used together with the trademark) is/are recognized among the consumers of the goods or services as the source identifier of a certain party through the use of the color(s).

A determination as to whether a color trademark has acquired distinctiveness or not must be made in accordance with the Trademark Examination Guidelines related to Article 3(2) of the Trademark Act. Since a color trademark consists solely of a color or color(s), the following points should be noted.

If the trademark claimed in an application (the "claimed trademark") is a position-specific color trademark, its position should also be taken into consideration in making a determination as to whether the color trademark has acquired distinctiveness.

2. Determination on the identicalness between the claimed trademark and the trademark in use

In principle, only if the claimed trademark and its designated goods or services are identical with a trademark in use and the goods or services for which the trademark has been used, the trademark could be considered to have acquired distinctiveness through use. Since it is expected that the evidence for use of a color trademark tends to show that the color(s) has/have been used together with characters, figures, etc., a determination on the identicalness between the claimed trademark and a trademark in use should be made as follows.

(1) if the submitted evidence shows that the color(s) is/are used together with characters, figures, etc., such evidence alone cannot be found, in principle, to provide sufficient grounds to find that the color(s) has/have acquired distinctiveness through use;

(2) However, if the color(s) in use is/are identical with the color(s) of the claimed trademark, the allegation that the trademark has acquired distinctiveness through use should not be refused immediately on the grounds that the overall composition of the trademark is not identical with that of the color(s) in use as long as the following evidence is submitted. The submitted evidence should be taken into consideration in making a determination as to whether the color(s) in use alone has/have acquired the source-identifying function to distinguish one's goods or services from others:

- [i] Evidence that proves that the color(s) has/have clearly been used in a manner that give a strong impression to consumers such as a case where the color(s) take(s) up most of the space on the wrapping paper, signs, etc. or where the color(s) alone is/are used as the color(s) of the base pattern against the background of a neutral base color;
- [ii] Evidence that proves that the color(s) has/have always been used as an accent color(s), etc., even though the color(s) has/have been used in various styles (in combination with characters, figures, other colors, etc.); or
- [iii] Evidence that objectively proves that consumers have acquired the capability to associate the color(s) with the goods, etc. pertaining to the business of a certain person (such as the results of a questionnaire survey conducted on consumers*).

* Questionnaire survey conducted on consumers

In the case where the claimed (color) trademark is actually used together with characters, figures, etc., conducting a questionnaire survey of consumers is an effective way to prove that the claimed trademark has acquired distinctiveness. If the survey results conclude that the color(s) alone (independently from certain characters, figures, etc.) is/are associated with the goods or services pertaining to the business of a certain person, such survey results should be especially taken into consideration in making a determination as to whether the color(s) along is/are recognized as an identifier to distinguish one's goods or services from others. Whether the questionnaire survey was conducted properly or not should be evaluated based mostly on the following points:

- (A) whether the selection of survey targets and the number of targets were appropriate;
- (B) whether the questions asked in the survey were not arbitrary or loaded; and
- (C) whether the survey results were not artificially manipulated.

3. Trademark composition and transactional practices

The following points should also be taken into consideration when making a determination as to whether the trademark has acquired distinctiveness through use.

(1) Trademark composition

The composition of a color trademark should be taken into consideration (whether a color trademark consists of a single color, a combination of colors, or, in the case of a color combination trademark, whether the applicant designated the order of the colors included in the combination).

(2) Transactional practices

If the applicant alleged that the industry to which the designated goods or services belong has unique market characteristics, such characteristics should be taken into consideration. For example, factors such as the number of competing companies (whether the market is monopolized not) and the use of colors in the industry (whether it is common to use various colors for such goods or services) should be taken into

consideration.