

54.07

How to Prove That a Color Trademark Has Acquired Distinctiveness Through Use (Determination on the Identicalness between Colors)

When a determination is made as to whether a color trademark has acquired distinctiveness through use, an examination should be conducted as follows in order to determine whether the color(s) of the trademark claimed in an application (the "color(s) of the claimed trademark") is/are identical with the color(s) of the trademark presented in the evidence submitted to prove that the trademark has acquired distinctiveness through use (the "color(s) of the trademark in use").

If it can be found that, when the traders and consumers in the industry to which the designated goods or services belong come across the color(s) of the claimed trademark and the color(s) of the trademark in use, they recognize those colors to be the same, those colors may be considered to be identical.

When the applicant submits evidence in the form of a photograph taken under inappropriate conditions or evidence that has deteriorated with time, if the evidence is considered to be insufficient to accurately define the color(s) of the trademark in use and could be easily misinterpreted as showing that the color(s) of the trademark in use is/are so different from the color(s) of the claimed trademark that those colors cannot be considered to be identical, the applicant may, in order to allege that those color(s) is/are identical, submit additional evidence that accurately defines the color(s) of the trademark in use (hue, lightness, saturation, etc.) under a color specification system* or by a registration number in a color sample book. For example, if the applicant submits a product catalog, the applicant may additionally submit an order placement specification, etc. containing information about how the colors were designated when an order was placed for the printing of the catalog (For example, color specification values such as RGB values and the registration number in a color sample book).

When the applicant submits such evidence as an order placement specification, if such evidence explains, in detail, the trademark claimed in an application by using color specification values such as RGB values, the color specification values stated in the application and those stated in the evidence should be identical in principle. If those values are not identical, the degree of difference between the colors defined by those values should be taken into consideration. Only if the traders and consumers in the industry to which the designated goods or services belong can recognize those colors as identical despite the difference, those colors can be found identical.

* Color specification system: A system to specify a color quantitatively in accordance with certain rules and definitions such as RGB, CMYK, and HSB.