

54.08

Transactional Practices Taken into Consideration in an Examination of a Color Trademark under Article 4(1)(xi)

In principle, in accordance with the Trademark Examination Guidelines, a color trademark may be considered to fall under Article 3(1)(ii), (iii), or (vi) and may be registered only if the trademark can be considered to have acquired distinctiveness through use (please refer to 54.06 of the Trademark Examination Manual). In light of such rules, from the perspective of public interest, i.e., the perspective that the right of freely using colors should not be restricted unreasonably, in the case where a prior color trademark exists, if a determination on similarity between the color trademark and the prior trademark in terms of goods or services is made in the course of an examination specified in Article 4(1)(xi) in accordance with the Examination Guidelines for Similar Goods and Services in an inflexible manner, there is a risk of providing excessive protection to the color trademark.

In the case of a color trademark, the trademark right would extend only to the goods or services that can be considered to have acquired distinctiveness through the use of the color(s). In accordance with the Examination Guidelines for Similar Goods and Services, the goods or services categorized under the same similar group code will be presumed to be similar to each other. Consequently, even some goods or services that are categorized under the same similar group code but cannot be considered to have acquired distinctiveness through the use of the color(s), in other words, some goods or services for which the color(s) cannot be considered to have become the source identifier of a certain person as a result of use, would be treated as goods or services similar to the designated goods or services of the color trademark. As a result, goods or services that would not cause confusion about the source even if the same or similar color(s) is/are used for those goods or services will be treated as similar goods or services. In this situation, the protection given to the color trademark might be considered to be excessive.

When an examiner examines similarity between the claimed trademark and a prior color trademark in terms of the designated goods or services, if the applicant makes an allegation with regard to transactional practices, such allegation should be treated as one of the various factors that should be taken into consideration in a comprehensive manner.

Similarly, when an examiner determines trademark similarity, if the

applicant makes an allegation with regard to transactional practices, such allegation should be treated as one of the various factors that should be taken into consideration in a comprehensive manner.