

## 56.01

### **How to Describe a Position Trademark in an Application**

A position trademark consists of a mark (that must consist of characters, figures, signs, or three-dimensional shape, or any combination thereof, or any combination between any of such elements and a color or colors) and the specific position of the mark on the relevant goods. In the case of a position trademark, the applicant is required to show the trademark in the trademark representation section of an application (the "claimed trademark") by presenting one image or photograph or multiple different images or photographs. In each of such images and photographs, the applicant is required to define the mark and its position by using a solid line to draw the mark and using a dashed line to draw any other parts.<sup>1</sup>

In the case of a position trademark, the applicant may use lines, dots, etc. to define the mark and its position that comprise the trademark. In this case, the applicant is required to specify, in the section "Detailed explanation of the trademark," how those lines, dots, etc. define the mark and its position.<sup>2</sup>

Thus, a position trademark should be described in an application as follows.

#### 1. Presentation of a trademark

In the case of a position trademark, the applicant may use a solid line, a dashed line, colors, etc. to present a mark and its position. Regardless of the means of presenting the trademark, the claimed trademark would not be considered to satisfy the requirement specified in the main paragraph of Article 3(1) of the Trademark Act if the claimed trademark cannot be considered to be a position trademark based on the results of an examination of the trademark and the detailed explanation thereof presented in the application.

(1) The claimed trademark would not satisfy the requirement specified in the main paragraph of Article 3(1) of the Trademark Act if the information provided in the application is insufficient to define the shape, etc. of the mark of the trademark and, consequently, to also define the position of the mark on the relevant goods (e.g., the case where an image or photograph is unclear). However, even if the mark of the trademark is unclear, if the shape, etc. of the mark can be recognized, it would be

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<sup>1</sup> Please refer to "Article 4-6 of the Ordinance for Enforcement of the Trademark Act."

<sup>2</sup> Please refer to "Form 2, Note 7, 'Ne' of the Ordinance for Enforcement of the Trademark Act."

possible to define the position of the trademark on the goods. Thus, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would be satisfied.

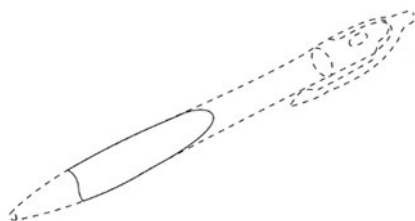
Furthermore, since the mark of a position trademark must consist of "characters, figures, signs, or three-dimensional shape, or any combination thereof, or any combination between any of such elements and a color or colors," if the mark consists of something else and cannot be considered to be a part of the position trademark, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied.

Such cases would include the cases (Examples 2-1 and 2-2) where the mark of the trademark itself cannot be defined, the cases (Examples 2-1 to 2-5) where the position of the mark on the goods cannot be defined, and the case (Example 2-6) where the trademark can be considered to be a color trademark based on the results of an examination of the claimed trademark and the detailed explanation of the trademark.

(2) Also, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied if the shape the goods (including the product package) or the article to be used for the provision of the service (the "goods, etc.") that the applicant presents in the application in order to define the position of the mark of a position trademark cannot be assumed to be the shape of the designated goods, etc. stated in the application (Example 2-7).

(Example 1) Cases where the trademark can be considered to be a position trademark

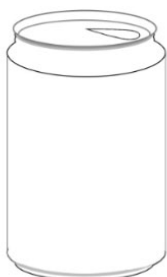
(Example 1-1) Case where the trademark is presented by use of a solid line and a dashed line



(Example 1-2) Case where the trademark is presented by use of colors



(Example 2) Cases where the trademark cannot be considered to be a position trademark  
 (Example 2-1) Case where the trademark is presented by use of only a solid line or only a dashed line



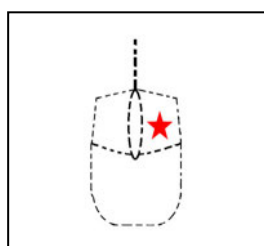
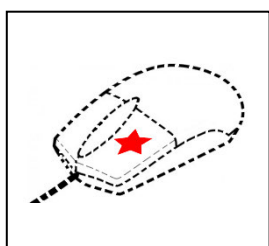
\* Any modification, deletion, etc. of the claimed trademark is not permitted since it would be regarded as a change in the substance of the trademark.

(Example 2-2) Case where an image or a photograph is extremely unclear



\* An amendment of making the image of photograph clear enough to clearly define the position trademark as a whole is not permitted since it would be regarded as a change in the substance of the trademark.

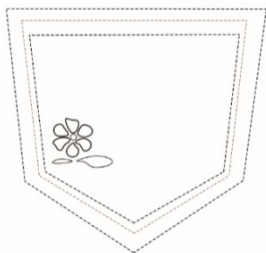
(Example 2-3) Case where the position of the mark cannot be defined because the provision of the mark differs from one image or photograph to another (Part 1, Chapter 2, 11 (1) (A) of the Trademark Examination Guidelines)



\* Any modification, deletion, etc. of the claimed trademark is not permitted since it would be regarded as a change in the substance of the trademark.

(Example 2-4) Case where the position of the mark cannot be defined since only the enlarged image of a part of the goods is presented without showing the entire shape of the goods, which consequently makes it impossible to define the position of the mark relative to the entire shape of the goods, etc.

[Trademark for which trademark registration is sought]



[Position trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. It should be noted that the pocket presented by use of a dashed line is a mere example of the shape of the goods and should not be considered to be a part of the trademark.

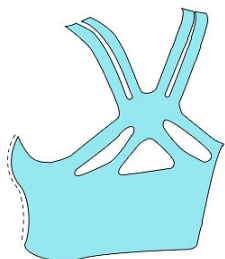
[Designated goods]

Clothing

\* Any modification, deletion, etc. of the claimed trademark is not permitted since it would be regarded as a change in the substance of the trademark.

(Example 2-5) Case where the position of the mark relative to the entire shape of the goods, etc. cannot be defined since only a part of the shape of the goods, etc. is presented

[Trademark for which trademark registration is sought]



[Position trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The trademark has the shape of a non-wire type brassiere viewed from the back side consisting of the X-shaped strap parts and the part that covers the upper part of the back. A dashed line merely shows an example of the shape of the goods and is not a part of the trademark.

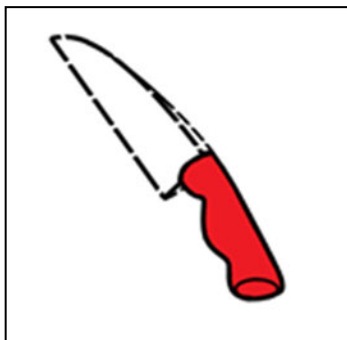
[Designated goods]

Brassieres, underwear, camisoles, clothing

\* Any modification, deletion, etc. of the claimed trademark is not permitted since it would be regarded as a change in the substance of the trademark.

(Example 2-6) Case where the claimed trademark and the detailed explanation of the trademark suggest that the mark consists solely of a color (Part I, Chapter 2, 11 (1) (B))

[Trademark for which trademark registration is sought]



[Position trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") consists of a red color affixed to the handle of a kitchen knife.

A dashed line merely shows an example of the shape of the goods and is not a part of the trademark.

[Designated goods or services and the classification of the goods and services]

[Class 8]

[Designated goods (designated services)] Kitchen knives

- \* The applicant may amend the detailed explanation of the trademark in order to clarify that the mark consists of a combination of a three-dimensional shape and a color. For example, the detailed explanation of the trademark may be amended to "The Trademark consists of a three-dimensional shape of the handle of a kitchen knife colored in red."

(Example 2-7) Case where the shape of the goods presented to define the position of the trademark cannot be assumed to be the shape of the designated goods, etc. (Part I, Chapter 2, 11 (1) (C))

[Trademark for which trademark registration is sought]



[Position trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The Trademark consists of a star-shaped figure affixed to the central part of the side of the handle of a kitchen knife. A dashed line merely shows an example of the shape of the goods and is not a part of the trademark.

[Designated goods or services and the classification of goods and services]

[Class 8]

[Designated goods (designated services)] Scissors and the like, kitchen knives and the like, swords, carpenters' inkpots and their accessories

\* The applicant may amend the designated goods to only "kitchen knives and the like, swords."

## 2. How to fill out the section "Detailed explanation of the trademark"<sup>3</sup>

### (1) Description of the mark

Since the information presented in the section "Detailed explanation of the trademark" must define the claimed trademark, if the mark of a position trademark is inconsistent with the type of the mark (characters, figures, three-dimensional shape,

<sup>3</sup> Please refer to Part IV (Article 5) of the Trademark Examination Guidelines.

etc.) described in the section "Detailed explanation of the trademark," the requirement specified in Article 5(5) of the Trademark Act would not be satisfied.

Even if it is determined that they are consistent, the trademark would not be considered to be defined unless the mark of the position trademark, which must consist of "characters, figures, signs, or three-dimensional shape, or any combination thereof, or any combination between any of such elements and a color or colors," is defined to be made of any of the abovementioned items in the section "Detailed explanation of the trademark" or could be interpreted to be made of any of them.

If the applicant uses a solid line, a dashed line, colors, etc. to present a position trademark in an application, the applicant is required to specify, in the section "Detailed explanation of the trademark," what element (e.g., solid line) expresses the mark and what element (e.g., dashed line) expresses any parts other than the mark (the entire shape of the goods, etc.). If the applicant fails to appropriately state what element (e.g., dashed line) is not a part of the trademark for which trademark registration is sought, the requirement specified in Article 5(5) of the Trademark Act would not be satisfied since the information provided in the section "Detailed explanation of the trademark" cannot be considered to define the claimed trademark.

## (2) Description of the petition

Since the information provided in the section "Detailed explanation of the trademark" must define the claimed trademark, if the section fails to provide specific and clear information about the position of the mark on the goods, etc., the requirement specified in Article 5(5) of the Trademark Act would not be satisfied.

The claimed trademark merely shows an example of how the position trademark is used. The position of the mark might slightly change depending on the shape, etc. of the goods.

Thus, if the position of the mark on the goods, etc. described in the application is the position to which the claimed trademark can be reasonably interpreted to be affixed in consideration of various factors such as the size of the mark, the goods, etc. to which the mark is affixed, and transactional practices, the position of the mark can be considered to be defined.

The factor "the goods, etc. to which the mark is affixed" means the type, size, shape, etc. of the goods, or the size, shape, etc. of the relevant part of the goods, etc. The factor "transactional practices" means, for example, the level of awareness of the consumers in



the industry to which the goods, etc. belong (e.g., the level of attention paid by consumers to the marked area of a shirt).

(3) Case where the claimed trademark does not satisfy the requirement specified in the main paragraph of Article 3(1) of the Trademark Act

In the case where the claimed trademark fails to provide sufficient information to define the mark of the position trademark (e.g., in the case where the image or photograph is unclear) and does not satisfy the requirement specified in the main paragraph of Article 3(1) of the Trademark Act, even if a clear explanation of the mark is provided (e.g., "the trademark consists of a figure of XX"), the requirement specified in Article 5(5) of the Trademark Act would not be satisfied since the explanation cannot be considered to be consistent with the claimed trademark.

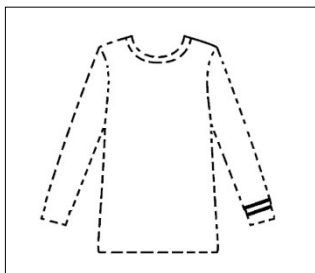
(4) Case where a mark is clearly recognized only as a three-dimensional mark

In the case where a mark is clearly recognized as a three-dimensional mark, if the information provided in the section "Detailed explanation of the trademark" suggests that the mark is a two-dimensional mark (e.g., "a mark consists of a two-dimensional figure (*zukei*)"), the requirement specified in Article 5(5) of the Trademark Act would not be satisfied.

(Example 3) Cases where the requirement specified in Article 5(5) of the Trademark Act would be satisfied

(Example 3-1) Example of a detailed explanation of the trademark that can be considered to define the mark and its position

[Trademark for which trademark registration is sought]



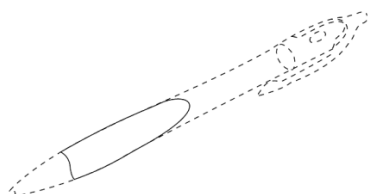
[Position trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The Trademark consists of two black stripes affixed around the lower edge of the left sleeve of a long-sleeved shirt. A dashed line merely shows an example of the shape of the goods and is not a part of the trademark.

(Example 3-2) Case where the applicant expresses the claimed trademark with a solid line and a dashed line and appropriately states, in the section "Detailed explanation of the trademark," what element (e.g., dashed line) is not a part of the trademark for which trademark registration is sought

[Trademark for which trademark registration is sought]



[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The Trademark consists of a figure affixed to the lower part of the penholder of a ballpoint pen. A dashed line merely shows an example of the shape of the goods and is not a part of the trademark.

(Example 3-3) Case where the applicant expresses the claimed trademark with colors and appropriately states, in the section "Detailed explanation of the trademark," what element (e.g., dashed line) is not a part of the trademark for which trademark registration is sought

[Trademark for which trademark registration is sought]



[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The Trademark consists of two figures affixed to the main sole (the side of the sole that touches the ground). More specifically, one figure is affixed to the area between the toe and the arch, while the other figure is affixed to the heel area. The pale purple part of the main sole merely shows an example of the shape of the goods and is not a part of the trademark.

(Example 4) Cases where the requirement specified in Article 5(5) of the Trademark Act would not be satisfied

(Example 4-1) Case where the detailed explanation of the trademark cannot be considered to define the mark

[Trademark for which trademark registration is sought]



[Position trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The Trademark consists of a mark as shown in the image above affixed around the lower edge of the left sleeve of a long-sleeved shirt. A dashed line merely shows an example of the shape of the goods and is not a part of the trademark.

(Example 4-2) Case where the detailed explanation of the trademark cannot be considered to define the mark

[Trademark for which trademark registration is sought]



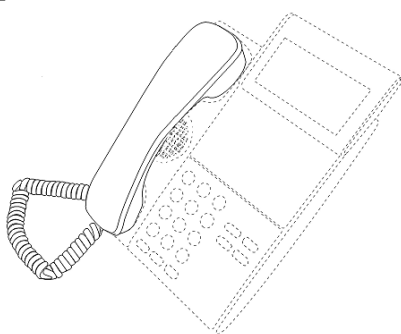
[Position trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The Trademark consists of two black stripes affixed around the left sleeve of a long-sleeved shirt. A dashed line merely shows an example of the shape of the goods and is not a part of the trademark.

(Example 4-3) Case where the mark can be clearly recognized to have a three-dimensional shape, while the mark is stated as a two-dimensional figure (*zukei*) in the detailed explanation of the trademark

[Trademark for which trademark registration is sought]



[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a position trademark, which is affixed to a certain position on the goods, etc. The Trademark consists of two-dimensional figure (*zukei*) showing a phone receiver on the left part of a telephone set and a code connecting the main body of the telephone set and the receiver. A dashed line merely shows an example of the shape of the goods

and is not a part of the trademark.