56.02

Application Showing a Position Trademark by Presenting Multiple Images or Photographs

If an applicant shows a position trademark by presenting multiple images or photographs, the application will be examined as follows.

1. Cases where multiple images or photographs are presented to define the position to which the trademark is affixed

In an application for a position trademark, the applicant is required to present goods, etc. to define the position of the trademark. In many cases, those goods, etc. are included in the designated goods or services (the "designated goods, etc.").

Since the exclusive right to use the registered trademark extends only to the designated goods, etc. (Article 25 of the Trademark Act), the goods, etc. presented to define the position of the trademark claimed in an application should be regarded as exhibiting an example of how to use the trademark for the designated goods, etc.
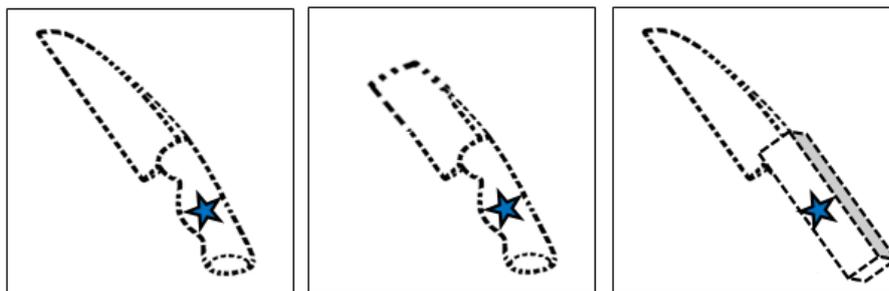
Therefore, if an application for a position trademark presents multiple images or photographs to define the position of the trademark on the relevant goods, etc., the application would be considered to satisfy the requirements specified in the main paragraph of Article 3(1) and Article 6(1) of the Trademark (a single trademark on each application) only if the images or photographs satisfy all of the requirements specified in [i] to [iii] below:

[i] The images or photographs must show goods, etc. included in the designated goods, etc.;

[ii] The images or photographs must show the same mark; and

[iii] The images or photographs must show the trademark affixed to the same position on the goods.

(Revised in April 2018)

(Examples)

2. Cases where the application shows the representation of a trademark to define the position of the mark on the goods, etc. and the separate representation of only the mark affixed to the position
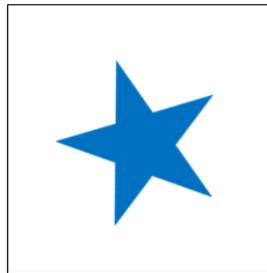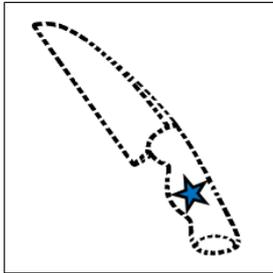
The exclusive right to use a position trademark would extend only to the trademark presented in the application if the trademark is affixed to the position on the goods, etc. defined in the section "Detailed explanation of the trademark." On the other hand, if an applicant separates the characters, figures, etc. that comprise the mark of a position trademark and files an application for a trademark consisting of only characters, figures, etc., the exclusive right to use such trademark would extend to the trademark regardless of its position on the goods, etc.

In this way, the manner of presenting a trademark in an application would affect the scope of the exclusive right to use the trademark. Thus, in the case where an application shows the representation of a position trademark as well as the separate representation of only the mark affixed to the position, if the applicant fails to explain, in the section "Detailed explanation of the trademark," why the mark affixed to the position is separately presented, the application would be deemed to claim two trademarks, i.e., a position trademark and a figure trademark, and to fail to present a position trademark and define its composition and style. Consequently, the requirements specified in the main paragraph of Article 3(1), Article 5(5), and Article 6(1) (a single trademark on each application) would not be satisfied.

However, the same would not apply if it is stated "The purpose of the separate representation of the mark affixed to the position is to clearly show the mark" in the "Detailed explanation of the trademark" since it is clear that the application is filed for a position trademark.

(Revised in April 2018)

(Example of how to fill out the section "Detailed explanation of the trademark")

[Trademark for which trademark registration is sought]
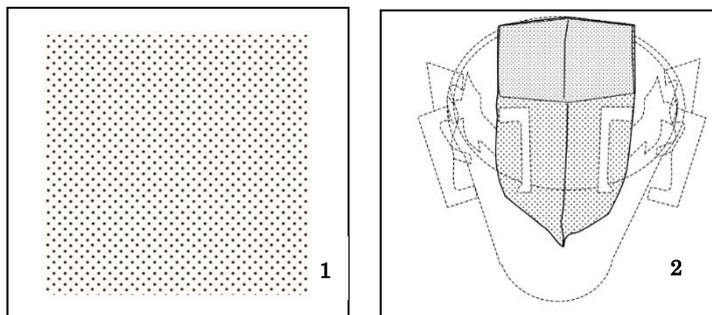

[Position trademark]

[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 left side of the central part of the handle of a kitchen knife. The purpose of the separate representation of only the star-shaped figure is to clearly show the mark affixed to the position. A dashed

　　On the other hand, if the enlarged image of the mark itself does not show the entire shape of the mark, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied since the mark cannot be defined based on the information presented in the section [Trademark for which trademark registration is sought].

(Revised in April 2018)

(Case where the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied)

[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 the shape of a part of a sheet placed in the central area of a coffee filter. Image 1 is an enlarged view of the sheet. The number indicated at the lower right corner of each image only shows the order of the images. A dashed line used in Image 2 merely shows an example of the shape of the goods and is not a part of the trademark.

In this case, even if the applicant deletes the enlarged view that shows a part of the separate representation of the mark affixed to the position, the deletion would not constitute a change in the substance of the trademark as long as the composition of the trademark after the deletion can be considered to be identical with that of the trademark initially presented in the application as of the time of the filing of the application. Thus, the amendment of deleting the enlarged view would be permissible.

(Note) Case where a single image shows the positions of multiple marks on goods, etc.

If different marks are affixed to multiple positions on certain goods, those marks as a whole would be considered to be a single trademark. Thus the requirement specified in Article 6(1) of the Trademark Act (a single trademark on each application) would be satisfied.

(Revised in April 2018)

(Example)