

56.03

Distinctiveness of a Position Trademark

1. Basic principle

Since the mark of a position trademark consists 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, a determination as to whether a position trademark falls under any item of Article 3(1) of the Trademark Act should be made based on a comprehensive evaluation of the trademark as a whole, more specifically, in consideration of both the mark such as characters and figures comprising the position trademark and the position of the mark on the relevant goods (please refer to Part. I, Chapter 1, 7 (1) of the Trademark Examination Guidelines).

2. Position trademark that falls under the items of Article 3(1) of the Trademark Act

If the entire part of the mark such as characters and figures is considered to fall under any item of Article 3(1) of the Trademark Act, the trademark as a whole may be considered to fall under said item of Article 3(1) of said Act in principle (please refer to Part. I, Chapter 1, 7 (3) of the Trademark Examination Guidelines).

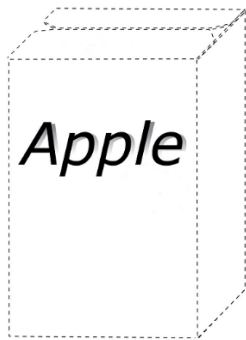
Furthermore, when making a determination as to whether a position trademark falls under any item of Article 3(1) of the Trademark Act, based on the basic principle mentioned above, not only the mark of a position trademark but also the position of the mark should be taken into consideration in a comprehensive manner so that the trademark can be evaluated as a whole.

Based on the interpretation presented above, the following cases are examples that fall under the items of Article 3(1) of the Trademark Act.

(1) Article 3(1)(iii) of the Trademark Act

(A) Case where the characters comprising a position trademark are merely considered to indicate the place of origin, the place of sale, quality, etc. of goods in a common manner even in consideration of the positions of those characters on the designated goods, etc.

(Example)



Designated goods: Apple juice

(B) Case where the figure or three-dimensional shape comprising a position trademark is merely considered to be a part of the shape of the goods, etc. in light of the position of the figure or three-dimensional shape

(Example)



Designated goods: Bicycles

* The red part indicates the figure comprising the position trademark

[Explanation]

In many cases, it becomes clear, based on the information provided in the section "Detailed explanation of the trademark," that the entire shape of a trademark is the same as the shape of goods, etc. In such cases, if the trademark is examined in consideration of the characteristics of the appearance that the goods, etc. usually have and the information provided in the section "Detailed explanation of the trademark," the figure or three-dimensional shape comprising the position trademark sometimes cannot be regarded as the source identifier to distinguish one's goods or services from others, but should be merely regarded as a part of the shape of the goods, etc.

Thus, even if the figure or three-dimensional shape comprising a position trademark can be considered to be distinctive enough if it were not claimed in a position trademark application, but rather in an ordinary trademark application, the position trademark

would be considered to fall under Article 3(1)(iii) of the Trademark Act as long as the mark is merely considered to be a part of the shape of the goods, etc. from the perspective of the composition of the trademark as a whole.¹

An examination as to whether the mark is "merely considered to be a part of the shape of the goods, etc." should be conducted in accordance with the examination rule concerning the distinctiveness of a three-dimensional trademark (please refer to 49.02 "Specific Handling Concerning Examination on Distinctiveness of a Three-Dimensional Trademark" of the Trademark Examination Manual), which is applied when determining whether a three-dimensional trademark is "merely considered to fall within the scope of the "shape of goods"

(2) Article 3(1)(v) of the Trademark Act

Case where the mark of a position trademark consists solely of a very simple and common mark or such mark that is merely increased in thickness.

(3) Article 3(1)(vi) of the Trademark Act

Case where the figures comprising a position trademark could be associated with a repetitive base pattern or could be adoptable as a package design for goods similar to the designated goods (a decoration covering the entire surface of the package), or a design for clothing, in other words, could be merely recognized by consumers as a decoration or pattern

[Explanation]

Even in the case where the figures comprising a position trademark can be considered to be distinctive enough if they were not claimed in a position trademark application, but rather in an ordinary trademark application, if it is possible for consumers to take into consideration the manner of using the trademark, i.e., the position on the goods, etc. to which the figures are affixed, and to presume that the figures are used as a decoration, pattern, etc. solely for the purpose of adding an aesthetic quality to the goods, the figures can be considered to have been adopted for the purpose of enhancing the function or aesthetic quality of the goods, etc. In this case, unless there are special circumstances, consumers would be unable to recognize the trademark as a source identifier of goods or services pertaining to the business of a certain person.

¹ A part of the shape of goods, etc. falls under Article 3(1)(iii) of the Trademark Act in accordance with Part I. Chapter 5, 4 (1) of the Trademark Examination Guidelines.

3. Marks that do not fall under any item of Article 3(1) of the Trademark Act

If the mark such as characters, figures, etc. comprising a position trademark does not fall under any item of Article 3(1) of the Trademark Act, it can be considered, in principle, that the trademark as a whole does not fall under any item of Article 3(1) of the Trademark Act (please refer to Part. I, Chapter 1, 7 (2) of the Trademark Examination Guidelines).

Therefore, the following cases are examples that do not fall under any item of Article 3(1) of the Trademark Act:

(A) Case where it can be found that the mark of a position trademark consists of distinctive characters or figures and that those characters or figures are used in such way that they function as a source identifier of goods or services;

(B) Case where it can be found that the mark of a position trademark consists of a combination of non-distinctive figures or a three-dimensional shape and distinctive characters and that those characters are used in such way that they function as a source identifier of goods or services; and

(C) Case where the figure or three-dimensional shape comprising a position trademark cannot be presumed to have been designed simply for the purpose of enhancing the function or aesthetic function of goods, etc.

4. Article 3(2) of the Trademark Act

In an examination as to whether a position trademark has acquired distinctiveness through use, even if the trademark in use can be considered to contain a mark other than the trademark claimed in the trademark application, the trademark in use could be considered to have acquired distinctiveness through use as long as the part identical to the trademark claimed in the application can be independently recognized as a source identifier to distinguish one's goods or services from others (Part II, 7 of the Trademark Examination Guidelines).