

A2.04

Handling Concerning the Identicalness of a Trademark which Has Color as a Constituent Element

1. When the trademark of a basic registration or basic application has color as a constituent element, the trademark claimed in an international trademark application must be of an identical constitution and form, and the color of the trademarks must be combined identically.

2. When the basic registration or basic application claims color as a characteristic of the trademark, the corresponding international trademark application must make the same claim.

In addition, when color is not claimed in the basic registration or basic application, but is claimed in the corresponding international application, the trademark of the basic registration or basic application must be in the colors claimed or consist of a combination of the colors claimed.

[Explanation]

The concept that it must be severely determined whether or not the trademark claimed in an international trademark application and the trademark of a basic registration or basic application are identical and also that the trademarks must be identical in constitution and form also applies to colors (see the Trademark Examination Manual A2.01).

Therefore, when the trademark of the basic registration or basic application consists of a combination of colors, the trademark of the corresponding international trademark application must be identical in constitution and form, and the colors must be combined identically.

According to the same concept, when said basic registration or basic application claims colors as a characteristic of the trademark, the corresponding international trademark application must claim the same.

Also, when the basic registration or basic application does not claim colors but the corresponding international application does, said basic registration or basic application must be in the colors claimed or consist of a combination of the colors claimed.

(Note) Regarding the relation between identicalness of a trademark and colors, Article 70 of the Trademark Act provides that, in certain cases, the term "registered trademark" as used in the articles includes trademarks similar to the registered

trademark that would be regarded as being identical with the registered trademark if they were in the same colors as the registered trademark. However, a case where the trademark of an international trademark application is different from the trademark claimed in the basic registration or basic application only in respect to colors is not regarded as being the certain case of Article 70, and the provision shall not be applied.

[Notes]

<When a trademark is based on a registered trademark with "limitation of color" under the Trademark Act of 1909 or 1921>

For example, Article 1(3) of the Trademark Act of 1921 provides that "A trademark can be registered with a limitation of color to be applied" (hereinafter referred to as a "limitation of color"), and the provision is still effective at present according to the provision of Article 3(3) of the Enforcement Order of the Trademark Act.

For filing an international application of a registered trademark that claims "limitation of color" in its written application under the above Trademark Act, the following procedure shall apply.

- i) State the trademark described in the written application of the basic registration in column (a) of item 7 "THE MARK" (trademark)" of the written application for an international trademark application.
- ii) Place a check mark in the box in item 8 "COLOR(S) CLAIMED" of the written application.
- iii) State only the names of the colors described in the written application in the column "Color or combination of colors claimed."

Example 1 [Description of "limitation of color" of the basic registration]
"gold metallic color, a gold medal and an outline of maple, green, ground, ..."
[Example of description in the request]
"gold metallic color, green, ..."

Example 2 [Description of "limitation of color" of the basic registration]
"as indicated in the sample of the trademark"
[Example of description in the request]
List colors applied to the trademark following Example 1.

When a trademark is described only in black, claiming "limitation of color," describe it in the same way.

- iv) It is not necessary to fill out the column "Indication, for each color, of the principal parts of the mark that are in that color (as may be required by certain designated Contracting Parties)."