

Chapter 5: Article 3(1)(iii) (Indication of origin, place of sale, quality and other characteristics of the goods, or indication of location, quality and other characteristics of provision of the services)

(iii) A trademark consisting solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packages; the same shall apply in Article 26 (1)(ii) and (iii)), the method or time of production or use, or other characteristics, or quantity or price, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, modes, method or time of provision, or other characteristics, or quantity or price;

Part I Chapter 5: Article 3(1)(iii)

1. “In the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packages), the method or time of production or use, or other characteristics, or quantity or price, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, modes, method or time of provision, or other characteristics, or quantity or price” (hereinafter referred to as “the characteristics, etc. of goods or services”)

- If a trademark, when used for its designated goods or services, is generally recognized among consumers or traders as indicating the characteristics, etc. of the goods or services, it is judged to fall under the provision of this item.

- In order to be “generally recognized,” a trademark is not required to be actually used as something that indicates the characteristics, etc. of the goods or services.

(1) Trademarks indicated with prolonged sound symbols such as “コクナール,” “スグレータ,” “とーくべつ,” “うまーい,” and “早ーい” which, when examined with their prolonged sound symbols excluded, are recognized as indicating the characteristics, etc. of goods or services are determined to indicate the characteristics of the goods or services in principle.

(2) Trademarks indirectly indicating the characteristics, etc. of goods or services are determined not to indicate the characteristics, etc. of goods or services.

(3) Trademarks indicating the characteristics, etc. of goods or services by means of figures or three-dimensional shapes are determined to indicate the characteristics, etc. of goods or services.

2. “Origin or Place” and of “Place of Sale” of goods and “Location of Provision” of services

(1) Where trademarks are composed of a geographical name in Japan and overseas (a name or a

map indicating a nation, an old nation, a capital, a province, an administrative area (a prefecture, a municipality, a special city ward, etc.), a state, the capital of a state, a county, the capital of a province, an old country, an old area, a busy downtown street, a sightseeing area (including its location and surrounding areas), a lake, a mountain, a river, or a park, etc.), they are considered as “the place of origin” of goods or “the place of their sale” or “the location of provision of services,” where a consumer or a trader generally recognizes that the designated goods will be produced or sold or the designated services will be provided at the place indicated by the geographical name.

(2) Where trademarks are composed of a state name (including abbreviations of state names and former state names of existing countries) or famous geographical names in Japan and overseas, they are considered as “the place of origin” of goods or “the place of their sale” or “the location of provision of services.”

3. “Quality” of Goods and Services

(1) Contents of articles to be used for the provision of goods or services

In any of the following cases, a trademark which recognizes the content of goods is judged to indicate the quality of goods or services.

Whether a trademark indicates a content of an article to be used for the provision of goods or services or not is determined based on the following criteria.

(a) Where a trademark is recognized to clearly indicate specific contents of works such as their classification and type in respect of such goods as “books,” electronic publication,” “film” recording images, “sound recorded magnetic tapes,” “sound recorded compact disks,” “phonograph records,” etc., it is judged to indicate “the quality” of goods.

(Examples) Trademark “The Trademark Act,” “Novel Collection” in respect of goods “Books”

Trademark “Classic Music” in respect of goods “Sound Recorded Compact Disk”

(b) Where a trademark is recognized to clearly indicate specific contents of broadcast program which is a service to be used for the provision of services, such as their classification and type in respect of such services as “production of broadcast programs” and “distribution of broadcast programs,” etc. it is judged to indicate “the quality” of services.

(Examples) Trademarks “News,” “Music Program” and “Variety Show” in respect of services “Production of broadcast programs”

(c) Where a trademark is recognized to clearly indicate specific contents of articles provided for use by a person to which the service is provided (“cine films,” “image recorded magnetic tapes,”

“sound recorded magnetic tapes,” “recorded compact disks,” “phonograph records,” etc.) such as their classifications and types in respect of such services as the rental of “cine films” “image recorded magnetic tapes” “sound recorded magnetic tapes,” “recorded compact disks,” “phonograph records,” etc., is judged to indicate the quality of a service.

(Examples) Trademark “Japan Folksong Collection” in respect of a service “Rental of sound recorded compact disks”

Trademark “Suspense” in respect of a service “Rental of cine films”

(d) Where a trademark is recognized by consumers as a title of a name of broadcast program (hereinafter referred to as “the title, etc.”) in respect of such goods or services as “books,” “production of broadcast programs,” etc. and the title, etc. is found to recognize specific contents, it is judged to indicate the quality of goods or services, since it recognizes the contents of such goods.

Whether a trademark is recognized as the title, etc. is determined by whether it is widely recognized by consumers as the title, etc. Whether the title, etc. recognizes specific contents is determined by taking the actual state of its transaction into consideration.

For example, the following circumstances are used as the elements to determine that the trademark does not indicate the quality of goods or services.

1) A work including different contents is produced regularly for a certain period of time;

2) A mark used for the title, etc. is also used as a distinctive mark of origin.

(e) Goods belonging to “regular publication” such as a newspaper, magazine, etc., are determined not to fall under the provision of this item, because the title does not recognize specific contents, although the trademark is widely recognized by consumers as the title.

(2) Personal names

For example, a trademark is recognized to indicate a personal name, etc., in the following cases;

(a) Where a trademark is widely recognized by consumers as a name of a singer or of a music group in respect of goods “sound recorded magnetic tapes,” “sound recorded compact disks,” or “phonograph records,” it is judged to indicate the quality of the goods.

(3) Where a trademark is a state name or another geographical name and recognized to indicate a specific cooking style (such as French, Italian, Beijing, etc.) in connection with a service relating to the “providing of foods and beverages,” it is judged to indicate the quality of the service.

(4) Name of a registered variety which falls under this item

Refer to Part III, Chapter 12, Items 2 and 3 (Article 4(1)(xiv)) of the Guidelines for the name of registered varieties.

4. “Shape” of “Goods and “Articles for Use for the Provision” of Services

(1) A trademark that is comprised of a shape that is acknowledged by the consumer as a shape that does not go beyond the scope of the shape of designated goods (including the shape of packaging of designated goods) or articles for use for the provision of designated services itself is judged to indicate the “shape” of the goods or “articles for use for the provision” of the services.

Moreover, the same principle shall apply to cases where a trademark is recognized as part of the shapes per se of articles for use for the provision of designated goods (including their packages) or the designated services.

When examining whether or not a trademark is comprised of “a shape that is acknowledged by the consumer as a shape that does not go beyond the scope of the shape of goods, etc. itself,” the determination is made based on the following criteria.

(a) Where a three-dimensional shape is acknowledged as having been adopted for a purpose of contributing to a function or the aesthetic appeal of goods, etc., unless there are special circumstances, the three-dimensional shape is deemed to not go beyond the scope of the shape of goods, etc. itself.

(b) Even though a three-dimensional shape is characterized by having been uniquely changed or decorated, if the scope of change or decoration on the grounds of function or the aesthetic appeal of goods, etc. is within the consumers’ predictability, the three-dimensional shape is acknowledged as having been adopted for a purpose of contributing to a function or the aesthetic appeal of goods, etc., and unless there are special circumstances, the three-dimensional shape is deemed to not go beyond the scope of the shape of goods, etc. itself.

(2) A three-dimensional trademark designating a service to handle buildings, etc. such as construction industry, real estate industry, etc. and simply indicating the shape of the building (including the shape of the interior) in a common manner without surpassing it in scope, is judged to indicate “articles for use in such a provision” in a common manner.

(3) In the case of retail services, trademarks which are recognized as marks indicating traded goods

are considered those indicating “articles for use in such a provision.”

5. Trademark “indicated in common manner”

If a font or the entire composition of an indication of a mark is determined to be special beyond the generally-used scope by traders taking into account the actual state of transaction of goods or services, the trademark is not judged to be “indicated in common manner.”

(Example 1) Cases where the trademark is judged to be indicated in common manner

The trademark is indicated by a font or composition generally used by traders.

(Example 2) Cases where the trademark is not judged to be indicated in common manner

The trademark is indicated by applying special lettering or by a special composition beyond the generally-used scope by traders.

6. Expression “consist of only---”

A trademark composed of more than a single mark indicating the characteristics, etc. of goods or services is judged to fall under the provision of this item, in principle.

7. Color mark corresponding to characteristics of goods or services

If a color mark only consists of colors which the goods generally have, this item shall be applicable to the trademark in principle.

(1) Colors which goods generally have

(a) Natural colors of goods because of their properties

(Example) “Black color” for the goods of “coals”

(b) Colors generally used or required to secure goods’ functions

(Example) “Black color” for the goods of “automobile tires”

(c) Colors generally used to make goods more attractive in their markets

(Example) “Silver color” for the goods of “mobile phones”

(d) Colors which are not generally used for goods but may be used

(Example) “Yellow color” for the goods of “refrigerators”

(e) Colors used in color patterns and backgrounds

(Example) “Vertical stripes of yellow, green and red colors” for the goods of “cups”

8. Sound mark relating to characteristics of its goods or services

If the trademark only consists of marks which indicate sounds the goods usually generate, or

generate when providing the services in a common manner, this item shall be applicable to the trademark in principle.

(1) Sounds which goods commonly generate

(a) Sounds which goods naturally generate

(Example) “Fizzling” sounds generated when bubbles burst for the goods of “carbonated drinks”

(b) Sounds generally used or required to secure goods’ functions

(Example) “Beeping’ alarm sounds” for the goods of “alarm clocks”

Furthermore, as far as alarm sounds of alarm clocks, which are electronically generated to secure their functions of waking up people, regardless of whether they are either very common beeping sounds or flowing melodies, are used as standard alarm sounds, this item shall be applicable to such sounds.

(2) Sounds generally generated when providing services

(a) Sounds generated naturally because of services’ properties

(Example) “Sizzling’ sounds generated when meat is barbequed” for the services of “supplying barbecued meat”

(b) Sounds generally used or required when providing services

(Example) “Clang’ sounds generated when gongs are struck” for the services of “holding boxing matches”