

Chapter 8: Article 3(1)(vi) (Trademarks lacking distinctiveness in addition to those mentioned in each of the preceding items)

(vi) In addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.

1. If a trademark does not fall under any of the items (i) to (v) of this Paragraph but can be commonly use and lacks distinctiveness, it is judged to be applicable to this item. For example, trademarks listed in 2. to 11. below are judged to fall under this item.

2. For trademarks composed of only marks indicating advertisement of the designated goods or designated services or corporate philosophy or management policy which have little connection with the designated goods or designated services;

(1) Where a filed trademark is recognized to indicate advertisement of the goods or services or corporate philosophy or management policy in a commonly-used method, this item is judged to be applicable.

Where a filed trademark can be recognized not only as advertisement of the goods or services or corporate philosophy or management policy but also as a coined word, this item is judged not to be applicable.

(2) Whether a filed trademark is recognized only as advertisement of the goods or services is judged by taking a concept generated from the entire goods or services, connection with the designated goods or designated services, the actual state of its transaction, the trademark's constitution and mode, etc. into consideration.

(a) Circumstances in which a trademark is recognized to indicate only advertisement of goods or services

(Examples)

(i) The trademark indicates the explanations of the designated goods or designated services;

(ii) The trademark indicates the characteristics and superiority of the designated goods or designated services;

(iii) The trademark briefly indicates the quality and characteristics of the designated goods or designated services;

(iv) The trademark consists of words commonly used for advertisement of goods or services

(However, it is not required that there is an example of actual use of the designated goods or designated services for advertisement).

(b) Circumstances in which a trademark recognizes something other than advertisement of goods or services

(Examples)

(i) The trademark is not recognized to have a direct or specific meaning in relation to the designated goods or designated services.

(ii) Whereas the applicant uses the filed trademark for a certain period of time as a mark which distinguishes its goods or services from those of others, a third party does not use the words identical with or similar to the filed trademark as advertisement.

(3) Whether the filed trademark is recognized only as corporate philosophy or management policy is judged by comprehensively taking a concept generated from the entire goods or services, connection with the designated goods or designated services, the actual state of its transaction, the trademark's constitution and mode, etc. into consideration

(a) Circumstances in which the trademark is recognized only as corporate philosophy or management policy

(Examples)

(i) The trademark describes the characteristics and superiority of a company;

(ii) The trademark is described with words commonly used to indicate corporate philosophy or management policy.

(b) Circumstances in which the trademark recognizes something other than corporate philosophy or management policy

(Examples)

(i) Whereas the applicant uses the filed trademark for a certain period of time as a mark which distinguishes its goods or services from those of others, a third party does not use the words identical with or similar to the filed trademark as corporate philosophy or management policy.

3. Trademarks indicating the unit, etc.

A trademark recognized as indicating the quantity in relation to goods or services in any ordinary commercial practice such as, for example, "Meter," "Gram," "Net" and "Gross," falls under the provision of this item.

4. Trademarks indicating Japanese era names

A trademark recognized as indicating nothing more than a Japanese era name (e.g., “平成” [Heisei]) falls under the provision of this item.

Whether or not a trademark is recognized as indicating nothing more than a Japanese era name is determined based on whether the Japanese era name is generally used as something that indicates, for example, the year of foundation of a company, the year of production of goods, or the year of provision of services.

5. Trademarks indicating a geographical name in Japan and overseas

A trademark indicating the geographical name in Japan and overseas of the foundation place of a business operator and the address of a business place, the delivered place and the temporary storage place of designated goods, or the stop-off place when a designated service is provided (a harbor and an airport, etc.) or the like shall fall under the provision of Article 3(1)(vi).

6. Trademarks indicating the place of origin, etc. of the traded goods

(1) In the case of retail services, trademarks which are recognized as indicating the place of origin, quality, raw materials, efficacy, intended purpose, shape (including shape of packages), the method or time of production or use, other characteristics, or quantity or price of the traded goods fall under this item.

(2) 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.

7. Trademarks consisting solely of a pattern

Where a trademark is recognized as a mere base pattern, since it consists of continuously repeated figures in pattern, it is judged to fall under this item.

However, even if a trademark is recognized as a base pattern, whether it falls under the provision of this item is determined based on if there is any characteristic mode in its composition.

8. Trademarks consisting of the shapes of stores, offices or facilities (hereinafter referred to as “stores, etc.”)

Three-dimensional trademarks judged as nothing more than the shapes (including the shapes of the interior; the same shall apply hereinafter) of stores, etc. (including those that do not fall under

the category of buildings; for example, mobile vending vehicles, sightseeing vehicles, passenger airplanes, and passenger ships) which deal with designated goods or designated services (excluding a case that falls under Article 3(1)(iii)) fall under the provision of this item.

Part I, Chapter 5, Item 4(1)(a) and (b) (Article 3(1)(iii)) of the Guidelines apply *mutatis mutandis* to judgments as to whether trademarks are judged as nothing more than the shapes of stores, etc. which deal with designated goods or designated services.

#### 9. Trademarks used in a great number as the name of a shop

Where a trademark is clearly used as the name of a shop in a great number in respect with the designated service (including those having the name of business such as “snack” (restaurant), “coffee shop” combined therewith or removed therefrom)

(Examples of trademarks falling under this provision)

(i) In respect of designated services, providing of foods and beverages mainly with alcoholic beverages served: Trademarks such as “さくら” (cherry blossom), “愛” (love), “純” (pure), “ゆき” (snow), “ひまわり” (sunflower), and “蘭” (orchid)

(ii) In respect of designated services, providing of foods and beverages mainly with tea, coffee, etc. serviced: Trademarks such as “オリーブ” (olive), “フレンド” (friend), “ひまわり” (sunflower), and “たんぽぽ” (dandelion)

#### 10. Trademarks consisting of Color marks only

This item shall be applicable to color marks in principle, excluding those to which Article 3(1)(ii) and (iii) is applicable.

(Applicable Example)

Colors articles used for the provision of services generally have

#### 11. Sound marks

(1) Sound elements (musical elements, natural sounds, etc.) as well as linguistic elements (lyrics, etc.) of which a sound mark is composed shall be examined together so that the trademark is examined as a whole.

(2) If this item is not applicable to the linguistic elements of a sound mark, it shall be regarded that this item is also not applicable to the sound mark as a whole.

(3) If this item is not applicable to the sound elements of a sound mark, it shall be regarded that this item is also not applicable to the sound mark as a whole.

For example, if a sound mark consists solely of the following sound elements, consumers are not able to recognize the trademark as a mark which can distinguish its goods and services from those of others, and therefore, this item shall be applicable to it in principle.

(a) Sounds which consumers recognize as natural sounds

When natural sounds are mentioned, they mean not only sounds existing in nature such as those of blowing wind and thunder, but also those mimicking natural sounds as well as those which are artificial but imitate natural sounds so that they may be recognized as if they existed in nature.

(b) Sounds which consumers recognize only as classical music, popular songs, original tunes and other musical compositions.

(Examples of trademarks falling under this provision) Musical compositions played as the BGM in commercial or other advertisements.

(c) Sounds which may not be generally used or indispensable to secure their goods' functions or furnish their services, but merely enhance their goods' or services' attractiveness

(Examples of trademarks falling under this provision) Squeaking sounds every footstep generates for the goods of "children's shoes"

(d) Sounds used to attract consumers' attention, give certain impressions to them or generate sound effects for advertisements and other purposes

(Examples of trademarks falling under this provision)

Sound effects of "kopokopo" generated when beer is poured for the goods of "sauce for barbecued meat."

"Sounds of 'boink' generated at the end of a TV CM to attract consumers' attention"

(e) Sounds generated by the articles to be used for the provision of the Services

(Examples of trademarks falling under this provision)

Engine sounds of vehicles for the services of "car transport"

Sounds of grinding coffee beans for the services of "providing coffee beverages"

12. If a trademark is listed in 1. to 11. above, but if it has become popular so that consumers are able to recognize its goods or services as those pertaining to a business of a particular person as a result of its usage, this item shall not be applicable to it.