

Chapter 16: Article 4(1) (xviii) (Characteristics which goods, etc. must naturally have)

(xviii) A trademark consisting solely of characteristics which its goods, etc. (meaning its goods or packages, or services; the same shall apply in Article 26(1)(v)) must naturally have and which are specified by Cabinet Order; or

Order for Enforcement of the Trademark Act

Article 1 The characteristics specified by Cabinet Order as referred to in Article 4(1)(xviii) and Article 26(1)(v) of the Trademark Act are three-dimensional shapes, colors or shapes (in the case of services, the three-dimensional shape, color or sound of the article used for the provision of the service)

1. Case where this item applies

"Characteristics" which the trademark's goods or packages, or articles used for the provision of its services (hereinafter referred to as the "goods, etc.") "must naturally have" are in principle included in the characteristics of goods, etc. to which Article 3(1)(iii) is applicable. Therefore, a problem arises in the examination as to whether Article 4(1)(xviii) is applicable to a trademark that falls under Article 3(1)(iii), but in reality, the question is whether or not Article 3(2) is applicable.

2. Regarding the expression "characteristics" which goods, etc. "must naturally have"

With respect to "characteristics" which goods, etc. "must naturally have", the elements prescribed in (1), (2) or (3) below will be verified in determining whether Article 3(2) is applicable to a trademark, by the means of evidence submitted.

(1) Three-dimensional trademarks

(a) A trademark as applied consists solely of three-dimensional shapes spontaneously arising from the trademark's goods, etc.

(b) A trademark as applied consists solely of three-dimensional shapes which are essential to secure the functions of the trademark's goods, etc.

(2) Color Mark

The elements prescribed in (a) and (b) below will be verified.

(a) A trademark as applied consists solely of colors spontaneously arising from the trademark's goods, etc.

(b) A trademark as applied consists solely of colors which are essential to secure the functions of the trademark's goods, etc.

(3) Sound marks

The elements prescribed in (a) and (b) below will be verified.

(a) A trademark as applied consists solely of sounds spontaneously arising from the trademark's goods, etc.

(b) A trademark as applied consists solely of sounds which are essential to secure the functions of the trademark's goods, etc.

(4) When the elements prescribed in (1)(b), (2)(b) or (3)(b) above are verified, the elements prescribed in (a) and (b) below are taken into consideration.

(a) Whether alternative three-dimensional shapes, colors or sounds exist otherwise to secure the functions of a trademark's goods, etc.

(Example)

(i) Whether the relevant sounds are those inevitably generated because of structures or mechanics of a trademark's goods, etc.

(ii) Whether or not the relevant sounds are those artificially added.

(b) Even if alternative three-dimensional shapes, colors or sounds exist, whether a trademark's goods, etc. can be produced at the same (or lower) cost with these alternatives.