

Part IV: Article 5 (Applications for trademark registration)

Article 5 (1) Any person who desires to register a trademark shall submit an application to the Commissioner of the Patent Office accompanied by the required documents. The application shall state the following matters:

- (i) the name and the domicile or residence of the applicant for trademark registration;
- (ii) the trademark for which registration is sought; and
- (iii) the designated goods or designated services and the class of goods or services provided by Cabinet Order as provided for in Article 6(2).

(2) Where a person desires to register a trademark listed in the following, the application shall contain a statement indicating thereof:

- (i) consists of any character(s), figure(s), sign(s) or three-dimensional shape(s) or colors, or any combination thereof, where the said character(s), figure(s), sign(s) or three-dimensional shape(s) or colors in connection with the said trademark change;
- (ii) consists of three-dimensional shape(s) (including the combination with any character(s), figure(s), sign(s) or three-dimensional shape(s) or colors, or any combination thereof) (excluding those listed in the preceding item);
- (iii) consists solely of colors (excluding those listed in item (i));
- (iv) consists solely of sounds; or
- (v) in addition to those listed in each of the preceding items, trademarks provided by Cabinet Order of the Ministry of Economy, Trade and Industry.

(3) Where a person desires to register a trademark consisting solely of characters designated by the Commissioner of the Patent Office (hereinafter referred to as "standard characters"), the application shall contain a statement indicating thereof.

(4) Where a person desires to register any trademark provided by Cabinet Order of the Ministry of Economy, Trade and Industry, the application shall state the detailed description of the trademark in the application pursuant to Ordinance of the Ministry of Economy, Trade and Industry, or affix materials provided by Ordinance of the Ministry of Economy, Trade and Industry to the application.

(5) The statement and materials in the preceding paragraph shall specify the trademark for which a registration is sought.

(6) Where a portion of the trademark for which a registration is sought is in the same color as that of the column in which a trademark for which a registration is sought is required to be stated, the said portion of the trademark shall be deemed not to be a part of the trademark;

provided, however, that this shall not apply to an area specified and identified as an area to be colored in the same color as that of the column.

Regulation for Enforcement of the Trademark Act

Article 4-7 The trademarks provided by Order of the Ministry of Economy, Trade and Industry as referred to in Article 5(2)(v) of the Trademark Act (including the case where applied mutatis mutandis pursuant to Article 68(1) of that Act) are position marks.

Article 4-8 (1) The trademarks provided by Order of the Ministry of Economy, Trade and Industry as referred to in Article 5(4) of the Trademark Act (including the case where applied mutatis mutandis pursuant to Article 68(1) of that Act; the same applies hereinafter) are as follows.

- (i) motion marks;
- (ii) hologram marks;
- (iii) color marks;
- (iv) sound marks; and
- (v) position marks

(2) The statement or affixing as referred to in Article 5(4) of the Trademark Act is to be made pursuant to the provisions of the following items according to the classification set forth in the respective item:

- (i) motion marks: statements of the detailed description of the trademark;
- (ii) hologram marks: statements of the detailed description of the trademark;
- (iii) color marks: statements of the detailed description of the trademark;
- (iv) sound marks: statements of the detailed description of the trademark (limited to the case where it is necessary to specify the trademark for which trademark registration is sought) and affixing of the materials provided by Order of the Ministry of Economy, Trade and Industry; and
- (v) position marks: statements of the detailed description of the trademark.

1. Regarding the "required documents"

The "required documents" as referred to in Article 5(1) are, for example, the following documents. All of the documents are not required to be submitted in every application but ought to be submitted when necessary.

(Example)

(a) A document concerning the use or intention of use of a trademark;

(b) A document describing the relevant portion in the case of coloring the portion in the same color as that of the column in which the trademark for which a registration is sought is required to be stated;

(c) A document describing the material, method of production, structure, method of use, intended purpose, etc. of the designated goods or the quality, efficacy, intended purpose, etc. of the designated services; and

(d) A document describing the three-dimensional trademark stated in the written application.

(Note) For a motion, hologram, color, sound or position mark, what is stated in the detailed description of the trademark provided for in Article 5(4) (hereinafter referred to as the "detailed description of the trademark") need not be duplicated and submitted in a "required document" provided for in this paragraph.

2. In cases where the written application contains no statement to the effect that it has been filed for a trademark prescribed in the items of Article 5(2), such application is treated as a normal application.

3. Regarding "standard characters"

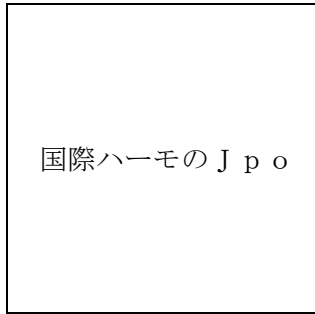
(1) A trademark with respect to which an application is recognized as that for a trademark composed of standard characters is considered as written with standard characters instead of being stated in the written application.

(2) A trademark for which an application is filed with a description stating that the trademark is composed of standard characters is treated as a normal trademark application in the case where the trademark is not recognized to be composed of standard characters from its composition described in the written application.

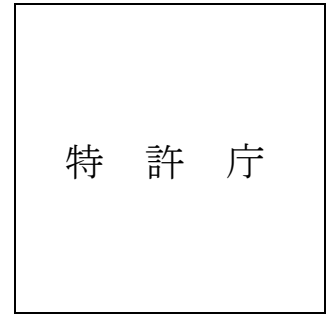
(a) Examples of descriptions of trademarks recognized to be composed of standard characters



Characters are different in size but characters representing geminated consonants and contracted sounds are the same in the number of points.



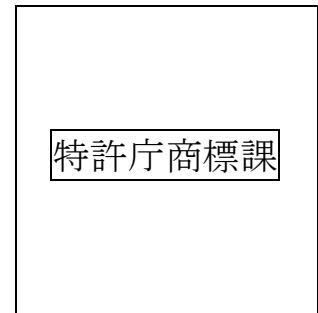
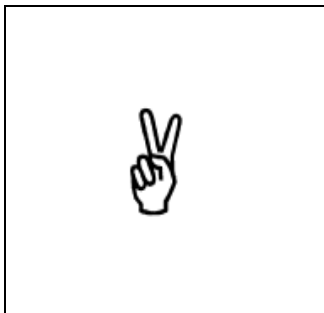
Chinese characters, kana, alphabetic characters, etc. can be used in combination. The capital letter and small letters are the same in the number of points.



Multiple spaces can be used unless continuously repeated.

(b) Examples of descriptions of trademarks not recognized to be composed of standard characters

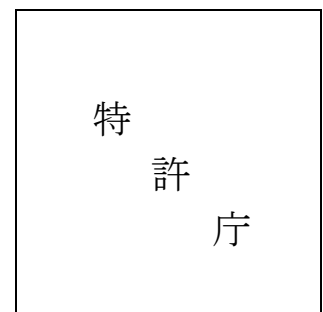
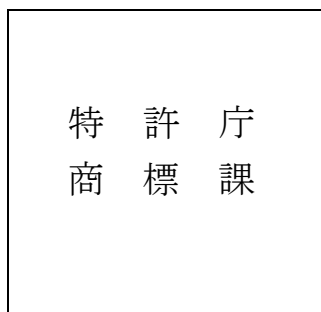
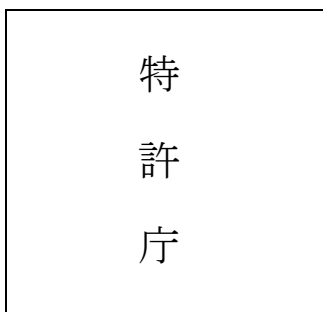
(i) Trademarks consisting solely of a figure and a figure and characters combined;



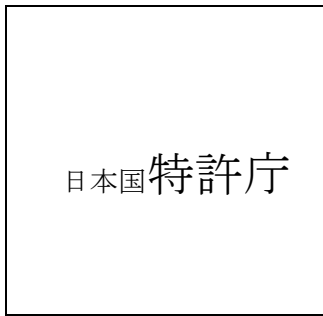
(ii) Trademarks including characters other than designated characters;

(iii) Trademarks exceeding the wordage limit of 30 characters (counting in spaces);

(iv) Vertically-written trademarks and trademarks composed of more than one row of characters

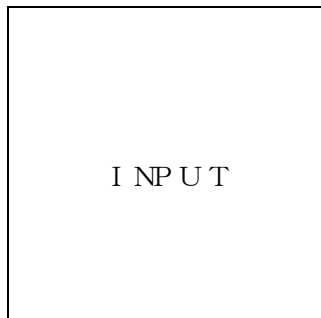
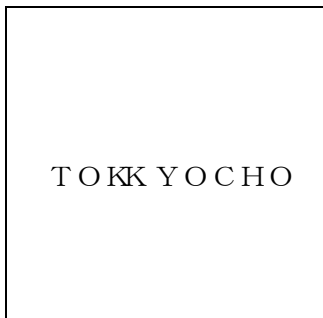


(v) Trademarks including characters different in the number of points;

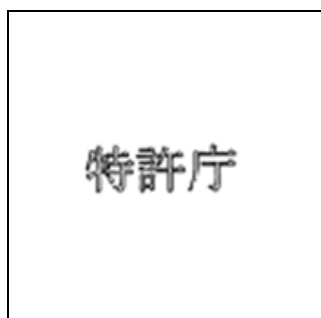


(vi) Colored trademarks;

(vii) Trademarks having a figure as their part or composed of characters written in different fonts;



(viii) Trademarks composed of ornate letters or characters written in the sosho (hand-written) or other special styles;



(ix) Trademarks composed of characters other than those listed in (i) to (viii) above, which can hardly be specified

4. Regarding the "detailed description of the trademark" and "materials"

In order to verify whether a detailed description of the trademark and materials provided for by the Order of the Ministry of Economy, Trade and Industry (hereinafter referred to as the "materials") can specify a trademark for which registration is sought, it is judged whether the detailed description of the trademark or the structure and mode of a trademark of the materials is identical with the trademark which is stated in the column where a trademark whose registration is sought as either of the motion, hologram, color, sound or position mark is stated (hereinafter referred to as the "trademark stated in an application").

If they are identical with each other, the detailed description of the trademark or the materials is regarded as specifying the trademark.

Even if they are not identical with each other, it is judged whether the detailed description of the trademark or the materials is covered by the structure and mode stated in the application, and if the detailed description of the trademark or the article is covered by the structure and mode, the detailed description of the trademark or the materials is regarded as specifying the trademark.

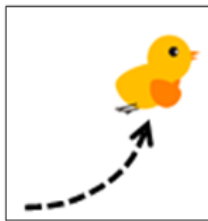
(1) Motion marks

(a) Example regarded as specifying a motion mark

A specific and clear statement is provided to explain a mark constituting a motion mark and how the mark changes its state as time passes (the sequence of its change, the time required for the whole change, etc.).

(Example 1) Example where a single figure is used to state a trademark (example where the mark moves without any change)

[Trademark for Which Registration Is Sought]



[Motion Mark]

[Detailed Description of Trademark]

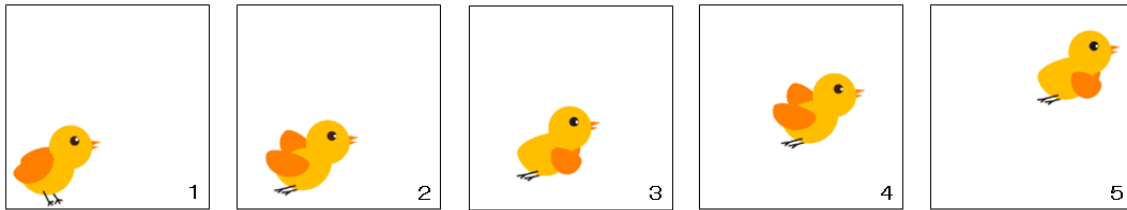
A trademark for which registration is sought (hereinafter referred to as the "trademark") is a motion mark.

The mark shows a bird gradually moving to the upper right from the lower left in accordance with the trajectory in dotted lines. This motion mark lasts for 3 seconds in total.

The arrow in the dotted lines is used for convenience to show the trajectory along which the bird moves and does not constitute the trademark.

(Example 2) Example where multiple figures are used to state a trademark

[Trademark for Which Registration Is Sought]



[Motion Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a motion mark.

This mark shows a bird gradually moving to the upper right by flapping its wings from figure 1 to 5. This motion mark lasts for 3 seconds in total.

Numbers at the lower right of each figure are provisionally provided to show the sequence of the pictures, and do not constitute a part of the trademark.

(b) Example not regarded as specifying a motion mark

(i) A trademark stated in an application is not identical with a mark stated in a detailed description of the trademark (including a case when a mark is not stated in the trademark stated in the application, but it is stated in a "detailed description of the trademark" column, and one when a mark is stated in an application, but it is not stated in a "detailed description of the trademark" column).

(ii) When the state of changes of a trademark stated in an application is not identical with the state of changes of a mark stated in a detailed description of the trademark; for, example, their sequences of change.

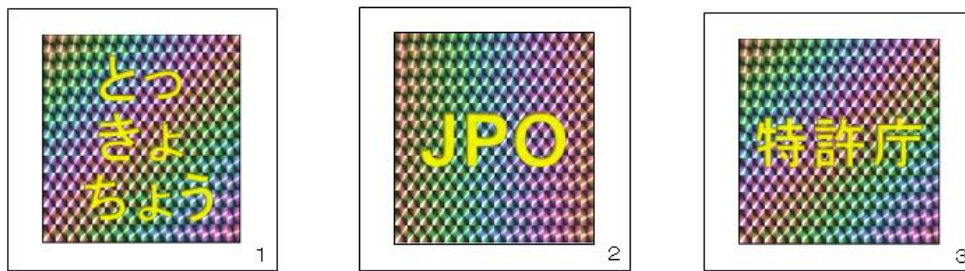
(2) Hologram marks

(a) Example regarded as specifying a hologram mark

A specific and clear statement is provided to explain a mark which constitutes a hologram mark and changes caused by visual effects based on holography and other means (such as those to show it as three-dimensional, as shiny by the reflection of light, and with different viewing angles; hereinafter referred to as "visual effects").

(Example)

[Trademark for Which Registration Is Sought]



[Hologram Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a hologram mark which displays different contents depending on viewing angles. Its displays seen from the left, the front and the right are shown in Figures 1, 2 and 3, respectively.

Numbers shown at the lower left are provisionally provided to indicate the sequence of the figures, and do not constitute a part of the trademark.

(b) Example not regarded as specifying a motion mark

(i) A trademark stated in an application is not identical with a mark stated in a "detailed description of the trademark" column (including the case where a mark is not stated in the trademark stated in the application, but it is stated in the "detailed description of the trademark" column, and one when a mark is stated in an application, but it is not stated in the "detailed description of the trademark" column).

(ii) The visual effects of a trademark stated in an application are not identical with those of a mark stated in the "detailed description of the trademark" column.

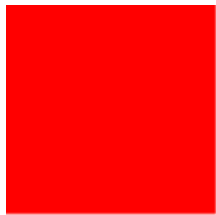
(3) Color marks

(a) Example regarded as specifying a color mark

A specific and clear statement is provided to explain color names, the combination ratio of the three primary colors (RGB), a number used to refer to a color sample book, how to combine colors (positions to which individual colors are paced and their ratios when the colors are combined), and other conditions to specify the colors constituting a color mark.

(Example 1) Single color

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought is one which consists of only red (RGB combination: R255, G0, B0).

(Example 2) Combination of colors

[Trademark for Which Registration Is Sought]



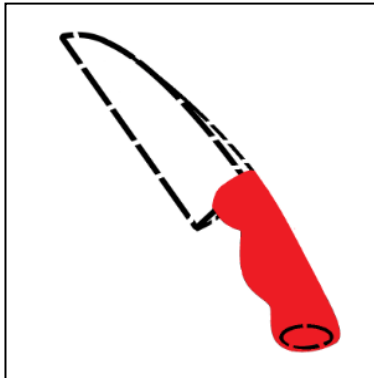
[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is one which consists of only combination of colors. The types of combination are red (RGB combination: R255, G0, B0), blue (RGB combination: R0, G0, B255), yellow (RGB combination: R255, G255, B0), and green (RGB combination: R255, G128, B0), and the percentage values of these colors from the first to the last are 50% for red, 25% for blue, 15% for yellow and 10% for green.

(Example 3) Trademark which specifies specific positions in goods, etc.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a color mark whose configuration is such that a kitchen knife's handle is colored in red (RGB combination: R255, G0 and B0).

It must be noted that dotted lines resembling a kitchen knife and a handle of the kitchen knife shown are for explanation purposes only, and do not constitute a part of the trademark.

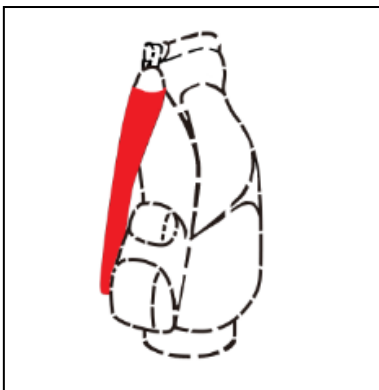
[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

(Example 4) Trademark which identifies positions in goods, etc.

[Trademark for Which Registration Is Sought]



[Color Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a color mark whose configuration is such that a golf club bag's belt is colored in red (RGB

combination: R255, G0 and B0).

It must be noted that the dotted lines resembling a golf club bag are only for purposes to explain how a golf club bag might look like, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 28]

[Designated Goods (Designated Services)] Golf Club Bag

(b) Example not regarded as specifying a color mark

(i) A trademark stated in an application is not identical with a mark stated in the detailed description of the trademark (including the case where a mark is not stated in the trademark stated in the application, but it is stated in the detailed description of the trademark, and one where a mark is stated in the application, but it is not stated in the detailed description of the trademark).

(ii) When color combinations are to be specified, the positions of colors, their ratios and other conditions of a trademark stated in the application are not identical with those of a mark stated in the detailed description of the trademark.

(iii) When positions to which colors are to be placed are specified, the positions to which colors are to be placed of a trademark stated in the application are not identical with those of a mark stated in the detailed description of the trademark.

(4) Sound marks

For a sound mark, if a matter is not stated in a trademark stated in an application (for example, the sound tones of an instrument played and the range of voice, etc., excluding lyrics and other linguistic elements), materials and the detailed description of the trademark (limited to the case where it is necessary to specify the trademark for which registration is sought) are used to identify the matter.

(a) Sound mark stated in a staff notation

(i) Example regarded as specifying a sound mark

[a] A piano is depicted in a trademark stated in an application as the musical instrument, and its material is a sound file recording sounds which seem to be generated by a piano.

[b] No musical instrument is depicted in a trademark stated in an application, but its materials are a sound file recording sounds which seem to be generated by a piano.

(ii) Example not regarded as specifying a sound mark

[a] A piano is depicted in a trademark stated in an application, and its material is a sound file

recording sounds which seem to be generated by a guitar.

[b] No instrument is depicted in a trademark stated in an application, but its material is a sound file recording sounds which seem to be generated by a guitar while its detailed description of the trademark states that the trademark is generated by a violin.

(b) Sound mark stated by characters (natural sounds, etc.)

(i) Example regarded as specifying a sound mark

A trademark stated in an application is a statement that "this trademark is structured such that a cat's meow call is heard after two clapping sounds are heard, and it lasts for 3 seconds," and its material is a sound file generating 2 clapping and then one meow sounds and lasts for 3 seconds.

(ii) Example not regarded as specifying a sound mark

A trademark stated in an application is the same as that in (i) above, but its material is a sound file generating 2 clapping sounds and lasts for 2 seconds.

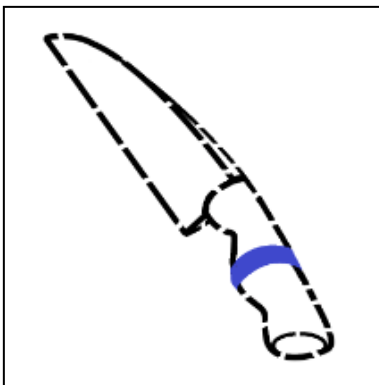
(5) Position marks

(a) Example regarded as specifying a position mark

A specific and clear statement is provided to explain a mark constituting a position mark and the position of its goods, etc. to which the mark is placed (the name, shape, characteristics and other information of a part).

(Example 1)

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter, referred to as the "trademark") is a position mark wherein the position to which the trademark is to be attached is identified and which consists of a figure attached to the periphery of the central part of a kitchen knife's handle.

It must be noted that the dotted lines are only provided to show an example of the trademark's goods, and do not constitute a part of the trademark.

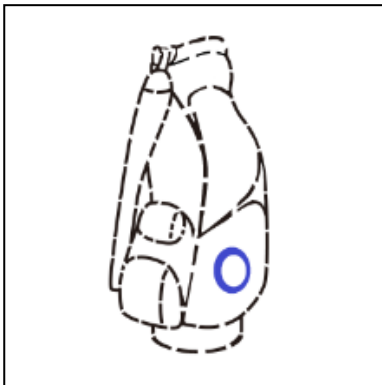
[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 8]

[Designated Goods (Designated Services)] Kitchen Knife

(Example 2)

[Trademark for Which Registration Is Sought]



[Position Mark]

[Detailed Description of Trademark]

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a color mark wherein the position to which the trademark is to be attached is identified and which consists of a figure attached to the lower part of the lateral side of the golf club bag's belt.

It must be noted that the dotted lines are only provided to show an example of the trademark's goods, and do not constitute a part of the trademark.

[Designated Goods or Designated Services and Classification of Goods and Services]

[Class 28]

[Designated Goods (Designated Services)] Golf Club Bag

(b) Example not regarded as specifying a position mark

(i) A trademark stated in the application is not identical with a mark stated in the detailed description of the trademark (including the case where a mark is not stated in the trademark stated in the application, but it is stated in the detailed description of the trademark, and one where a mark is stated in the application, but it is not stated in the detailed description of the trademark).

(ii) What is stated in the application as the position to which a trademark is attached is not identical with what is stated in its detailed description of the trademark.

5. Treatment of a declaration to the effect that the characters are "standard characters" in relation to the international application for trademark registration

Though the characters are declared to be "standard characters" in relation to the international application for trademark registration, the characters will not fall under the standard characters as stated in Article 5(3).

6. Treatment of the statements of the type of trademarks in an international application for trademark registration

Whether a trademark for which an international application for trademark registration is filed is either a "motion mark," "hologram mark," "three-dimensional trademark," "color mark," "sound mark" or "position mark" is judged as follows in principle.

(1) If the statement "Indication relating to the nature or kind of marks" is stated in territorial extension which designates Japan (hereinafter referred to as a "designation notification"), it is judged in principle as follows based on what is stated there.

(i) If a statement "three-dimensional mark" is written in the statement "Indication relating to the nature or kind of marks," the trademark is judged as a "three-dimensional trademark."

(ii) If a statement "mark consisting exclusively of one or several colors" is written in the statement "Indication relating to the nature or kind of marks," the trademark is judged as a "color mark."

(iii) If a statement "sound mark" is written in the statement "Indication relating to the nature or kind of marks," the trademark is judged as a "sound mark."

(2) Depending on what is stated in the column "Description of the mark" of the designation notification, it is judged as follows in principle.

(i) If a statement "moving," etc. is written in the column "Description of the mark," the trademark is judged as a "motion mark."

(ii) If a statement "hologram," etc. is written in the column "Description of the mark," the trademark is judged as a "hologram mark."

(iii) If a statement "positioning of the mark," "position mark" or other relevant statement is written in the column "Description of the mark," the trademark is judged as a "position mark."

(3) If there is no description as specified in (1) above, or if it is not possible to make a judgment

based on what is written in accordance with (2) above, judgment is to be made based on what is stated in the trademark for which registration is sought.

For example, if a staff notation is stated in a column where a trademark for which registration is sought must be stated, but if a statement "sound mark" is not written in the statement "Indication relating to the nature or kind of marks" and statements such as "moving," "hologram," "positioning of the mark" or "position mark" are not stated in the column "Description of the mark," then it is treated as a figure trademark where the staff notation is the trademark for which registration is sought.

7. Treatment of the column "Detailed description of the trademark" in an international application for trademark registration

For a trademark for which an international application for trademark registration is filed, the detailed description of the trademark for which registration is sought is to be as follows.

(1) For a "color mark," entries to the columns "Colours claimed" and "Description of the mark" in its designation notification will be the detailed description of the trademark.

(2) For a "sound mark," "motion mark," "hologram mark" or "position mark," an entry to the column "Description of the mark" in its designation notification will be the detailed description of the trademark.

8. Treatment of "materials" in an international application for trademark registration

For a trademark for which an international application for trademark registration is filed, because no procedure exists to attach its material to the International Register, the material is not attached when its territorial extension designates Japan. Therefore, Article 5(5) is applied so that the submission of the article will be facilitated.