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Handling of Application for Trademark Registration Consisting of Geographical Names in Japan and Overseas

With regard to the handling of trademarks consisting of geographical names both in Japan or overseas, a partial revision was made on the Examination Guidelines for Trademarks relating to Article 3(1)(iii) and (vi) of the Trademark Act. The partially revised Examination Guidelines for Trademarks (Revised 10th Edition) was issued and came into effect on November 1, 2012. Later, the Examination Guidelines for Trademarks was fully reviewed and the Examination Guidelines for Trademarks has been applied as follows since the application of the Revised 12 Edition of the Examination Guidelines for Trademarks on April 1, 2006.

1. Article 3(1)(iii) of the Trademark Act

Related article: Extracts

Article 3 Any trademark used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

(iii) consists 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 packaging; the same applies in Article 26 paragraph (1), items (ii) and (iii)), the method or features including time of production or use, quantity, price, or, in the case of services, the location of provision, quality, articles to be used in the provision, efficacy, intended purpose, modes, method or features including time, quantity or price of provision;

Part I, Chapter 5, Item 2. Of the Examination Guidelines for Trademarks

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, a province, 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."

(Explanation)

Chapter 5, Item 2(1) of the Examination Guidelines for Trademarks specifies how to handle the examination of a trademark consisting of a geographical name in Japan or overseas, to decide whether it corresponds to "the place of origin or place of sale of the goods, or location of provision of services" as prescribed in Article 3(1)(iii) of the Trademark Act.

In other words, it specifies that "the place of origin or place of sale of the goods, or location of provision of services" stipulated in Article 3(1)(iii) of that Act is also applicable to the following cases: (a) when the designated goods are actually produced or sold, or the designated services are provided in the place indicated by the geographical name, and (b) when it is found that the designated goods are generally recognized by consumers or traders as being produced and sold, or the designated services are generally recognized as being provided, in the place indicated by the geographical name.

The case mentioned in (a) above is obvious. Regarding the case mentioned in (b) above, a general recognition by consumers or traders is sufficient. This handling of an application for trademark registration was based on the intent that since the place of origin, place of sale of the goods, or the location of provision of services are indications that are necessary during the course of distribution or during the business processes, any person will need to use it and will want to use it. Therefore, it would not be appropriate to allow an individual to have its exclusive possession. Furthermore, these are already commonly used or will be commonly used in the future, and therefore cannot be recognized as being capable of distinguishing one's own goods or services from those of others (Kougyou Shoyuken Hou (Sangyou Zaisanken Hou) Chikujou Kaisetsu [Dai Niju Han] (Clause-by-clause commentary of the Industrial Property Act (Industrial Property Rights Act [20th Edition]) p. 1400).

Moreover, this handling of trademarks also takes into consideration the holding of the "Jo-jia" (Georgia in Japanese) Case (1985(Gyo-Tsu) 68, judgment of the Supreme Court of January 23, 1986). The holding states that in order for an application for trademark registration to be considered as "consisting solely of a mark indicating, in a common manner, the place of origin or place of sale of goods" described in Article 3(1)(iii) of the Trademark Act, "it is not necessarily required that the designated goods are actually produced or sold at the place indicated by said trademark and it would be sufficient that a consumer or a trader generally recognizes that the designated goods will be produced or sold at the place indicated by said

trademark".

In the past, actual determination on whether a trademark falls under the provision of Article 3(1)(iii) of the Trademark Act has been made by examining "the place of origin or place of sale of the goods, or location of provision of services" based on the aforementioned viewpoints. With the partial revision of the Examination Guidelines for Trademarks in November 2012, it was decided that the practice of examination should be clearly defined in the Examination Guidelines for Trademarks so as to thoroughly protect the use of geographical names in Japan and overseas within the frame of the current legislation.

Regarding the phrase "..... when it is found that the designated goods are generally recognized" mentioned in (b) above, if any cause is recognized by which the designated goods produced or sold or the designated service is provided in the place indicated by the geographical name, a trademark, in principle, is considered as satisfying the conditions of "..... when it is found that the designated goods are generally recognized" and is treated as such, even if the fact that the trademark is indicating "the place of origin or place of sale of the goods, or location of provision of services" is not directly written in a dictionary or any other literature.

(Example 1) Trademark "屋久島" Designated Goods : Class 29 "Fresh, chilled or frozen edible aquatic animals"

When an application for trademark registration is filed for a trademark indicating the letters "屋久島" designating the goods, "fresh, chilled or frozen edible aquatic animals," the trademark is generally recognized as indicating the geographical name of a sightseeing area (including its location and surrounding areas) and would be recognized as indicating the place of origin or sale of the goods in relation to the designated goods, and thus Article 3(1)(iii) of the Trademark Act will be applied.

(Example 2) Trademark: Figures and characters indicating "レマン湖", Designated goods: Class 30 "Confectionery"

When an application for trademark registration is filed for a trademark composed of figures and characters indicating "レマン湖" designating the goods "confectionery," the trademark is generally recognized as indicating the geographical name of a sightseeing area (including its location and surrounding areas) and would be recognized as indicating the place of origin or sale of the goods in relation to the designated goods, and thus Article 3(1)(iii) of the Trademark Act will be applied.

(Example 3) Trademark "アルベロベッロ", Designated services: Class 43 "Providing temporary accommodation"

When an application is filed for a trademark indicating "アルベロベッロ" designating the service "providing temporary accommodation," the trademark is

generally recognized as indicating the geographical name of a sightseeing area (including its location and surrounding areas) and would be recognized as indicating the place of origin or sale of the goods in relation to the designated services, and thus Article 3(1)(iii) of the Trademark Act will be applied.

2. Article 3(1)(vi) of the Trademark Act

Related article Extracts

Article 3 Any trademark used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

(vi) is beyond 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.

Part I, Chapter 8, Item 5. of the Examination Guidelines for Trademarks

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 shipment place and the temporary storage place of the designated goods, or the stop-off place when the designated service is provided (a harbor and an airport, etc.) or the like shall fall under the provision of Article 3(1)(vi).

(Explanation)

This Guidelines stipulates that when a trademark consisting of a geographical name in Japan or overseas is recognized as consisting of a geographical name in Japan or overseas indicating the foundation place of a business operator or the stop-off place when the designated service is provided, it falls under Article 3(1)(vi).

In light of the provisions of that item and the outline of the judgment concerning that item (see Annex), Article 3(1)(vi) of the Trademark Act is applicable to trademarks that are presumed to be incapable of fulfilling the function as a trademark due to lack of capacity to distinguish one's own goods or services from those of others based on the composition of the trademark per se, even if item (iii) of that paragraph is not.

In light of the abovementioned viewpoint, in the case where a geographical name in Japan and overseas that constitutes the trademark indicates (or is recognized as) "the place of origin or place of sale of the goods, or location of provision of services", the provision of Article 3(1)(iii) of the Trademark Act will be applied. However, as in the following examples, when a geographical name is not considered as an indication (or is not recognized as) "the place of origin or place of sale of the goods, or location of provision of services", it may be difficult to apply Article 3(1)(iii) of the Trademark Act to a trademark indicating such geographical name.

(Example 4) Trademark "スワンナプーム"¹ Designated services: Class 36 "Theatre production"

When an application for trademark registration is filed for a trademark indicating the letters "スワンナプーム" designating "theatre production" as the service, since the trademark is hardly recognized in general as indicating the location of the provision of service, it is difficult to apply Article 3(1)(iii) of the Trademark Act.

However, in light of the fact that letters "スワンナプーム" may be recognized as a geographical name overseas indicating the stop-off place when the service is provided (airport), the mark consisting of the letters cannot be found to fulfill the function to distinguish its own services from those of others.

(Example 5) Trademark "ジュネーブ" Designated goods: Class 8 "Japanese swords"

When an application for trademark registration is filed for a trademark indicating the letters "ジュネーブ" designating "Japanese swords" as the goods, since the trademark is hardly recognized in general as indicating the place of origin or sales of the goods, it is difficult to apply Article 3(1)(iii) of the Trademark Act.

However, in light of the fact that letters "ジュネーブ" may be recognized as a geographical name in overseas indicating the shipment place of the goods, the mark consisting of the letters "ジュネーブ" cannot be found to fulfill the function to distinguish its own goods from those of others.

While Article 3(1)(iii) of the Trademark Act is not applicable to the marks indicating the stop-off place or shipment place mentioned in Examples 4 and 5 above, in many cases, the marks are already used in general or will certainly be used in general in the future in advertisements or transaction documents.

Even if a trademark consisting of a geographical name in Japan and overseas does not fall under Article 3(1)(iii) of the Trademark Act, when that trademark indicates (or is recognized to indicate) the foundation place of a business operator, the address of the business place, or the shipment place of the designated goods, the trademark is deemed as not capable of distinguishing one's own goods or services from those of others. In order to clarify that such trademark falls under Article 3(1)(vi) of the Trademark Act, a new rule was introduced in the partial revision of the Trademark Examination Guidelines issued in November 2012.

In the practice of examination, when an application for trademark registration is filed for a trademark consisting of a geographical name in Japan and overseas, the

¹ An international airport of Thailand which was newly opened as a substitute for Don Mueang International Airport which had become too small. Suvarnabhumi means "the land of gold" and was named by King Bhumibol. (Nippon Daihyakka Zensho (Nipponica) (The Compendium of Encyclopedia of Japan))

examiner will first consider the applicability of Article 3(1)(iii) of the Trademark Act in relation to the designated goods or designated services and then consider the applicability of item (vi) of that paragraph with respect to the designated goods or designated services to which item (iii) of that paragraph is not applicable.

Accordingly, note that, when two or more goods or services are designated, the examiner may apply Article 3(1)(iii) of the Trademark Act to one designated goods or services and item (vi) to the other designated goods or designated services.

Part I, Chapter 8, Item 12 of the Examination Guidelines for Trademarks

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.

(Explanation)

Even if the trademarks fall under Items 1. to 11. of the Examination Guidelines for Trademarks related to Article 3(1)(vi) of the Trademark Act, if they are recognized by consumers as indicating the goods or services pertaining to the business of a particular person as a result of use, they do not fall under that item. While Article 3(2) of the Trademark Act stipulates that only "a trademark that falls under any of items (iii) through (v) of the preceding paragraph" is covered, this Guidelines have definitively stipulated the perspective of applying Article 3(1)(vi) of the Trademark Act by partially revising the Examination Guidelines for Trademarks in November 2012.

The statement "If a trademark is listed in 1. to 11. above" in the Guidelines clarifies that in the examination of the applicability of Article 3(1)(vi) of the Trademark Act, in addition to the trademarks that fall under Items 1. to 11. of the Examination Guidelines for Trademarks concerning that item, trademarks for which there are questions concerning whether they are subject to that item for reasons other than the above would not be subject to that item if they are found to have acquired the capacity to distinguish one's own goods from those of others as a result of use.

Annex

Judgment Concerning Article 3(1)(vi) of the Trademark Act

"UVmini" case

(March 9, 2006, Intellectual Property High Court, 2005(Gyo-Ke) 10651)

<Judgment (summary)>

It can be said that "trademarks by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person" as prescribed in Article 3(1)(vi) of the Trademark Act will include not only ones whose composition do not take the form of a trademark so that they are not capable of distinguishing one's own goods or services from those of others from the very first, but also trademarks that do not fall under Article 3(1)(i) to (v) of that Act but are presumed not to function as a trademark since the composition itself is not capable of distinguishing one's own goods or services from those of others and trademarks that are not presumed to be incapable of distinguishing one's own goods or services from those of others in terms of the compositions themselves and thus failing to function as a trademarks, but may possibly be regarded as being incapable of distinguishing one's own goods or services from those of others and failing to function as a trademark if the actual state of transaction is taken into consideration.

Examination Guidelines for Trademarks:

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)

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