

## Appeal decision

Appeal No. 2018-2128

Tokyo, Japan

Appellant

# Olympus Corporation

Patent Attorney

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The case of appeal against the examiner's decision of refusal of Trademark Application No. 2015-30713 has resulted in the following appeal decision:

## Conclusion

The appeal of the case was groundless.

## Reason

### No. 1 The trademark in the Application

The trademark in the application is configured as indicated in Attachment 1. The application for its registration was filed on April 1, 2015 as a color mark with designated goods of Class 10 as stated in the application. Thereafter, the designated goods of the trademark in the application were amended as Class 10 "Light source device for an endoscope, video processor for an endoscope, light source integrated processor for an endoscope, and video printer for an endoscope." by the written amendment dated on October 6, 2016 in the original examination.

No. 2 Gist of reasons for refusal stated in the examiner's decision

The examiner's decision acknowledged and determined that "The color used for a product includes a combination of various colors and is selected to enhance the appeal of the product in many cases and cannot be recognized as a mark that indicates the source of goods and distinguishes relevant products from others. Therefore, even if

the trademark in the application is used for the designated goods, traders and consumers coming into contact with the trademark only recognize that the trademark indicates a color that is normally used or may be used for the goods. Therefore, since the trademark in the application simply indicates the feature of the goods by a method normally used, the trademark in the application falls under Article 3(1)(iii) of the Trademark Act. Furthermore, according to the evidences submitted by the applicant, it cannot be acknowledged that the trademark in the application becomes a trademark by which consumers are able to recognize the goods as those pertaining to a business of a particular person as a result of the use of the trademark in the application. Therefore, it cannot be said that the trademark in the application meets the requirement stipulated in Article 3(2) of the Trademark Act". The application was rejected.

### No. 3 Judgment by the body

#### 1 Handling of evidences by the body

In the original examination the appellant submitted Evidence A No. 1 to A No. 46 (abstracted and referred from the written amendment dated on October 6, 2016 regarding Trademark Application No. 2015-30675 by the appellant). Moreover, the appellant submitted Evidence A No. 1 to A No. 5 to the body.

However, in this case, evidence numbers of Evidence A No. 1 to A No. 5 are overlapped. Therefore, Evidence A No. 1 to A No. 5 submitted in the body are respectively replaced with Evidence A No. 47 to A No. 51.

Furthermore, in the body, Evidence A No. 21 and A No. 22 submitted by the written amendment dated on October 6, 2016 regarding Trademark Application No. 2015-30675 are also employed as information for making a decision and are respectively replaced with Evidence A No. 52 and A No. 53.

#### 2 Applicability of Article 3(1)(iii) of the Trademark Act

(1) The trademark in the application is a color mark as described in No. 1 above and has a configuration in which a blue (PANTONE 287C) horizontally long band-like shape is arranged in the upper portion (referred to as "upper blue portion" below), white (PANTONE Cool Gray 1C) is arranged in about half on the left side of the front surface, and gray (PANTONE 7540C) is arranged in about half on the right side of the front surface on a front surface portion of a housing of a medical apparatus and instruments. Class 10 "Light source device for an endoscope, video processor for an endoscope, light source integrated processor for an endoscope, and video printer for an endoscope." are set as the designated goods.

(2) The colors of the goods (including a combination of these) are understood such that the colors do not originally indicate the source of goods, unlike trademarks configured of characters, shapes, and the like. In actuality, the colors (including a combination of these) are widely used in general for the purpose of enhancing the aesthetic impression or the function of the goods.

Then, in the industry handling the medical apparatus and instruments including "light source device for an endoscope and video processor for an endoscope" and the like that are the designated goods of the trademark in the application, for example, as indicated in the following A to C, a person other than the appellant applies colors of white, gray close to black, or blue (including a combination of these) on the front surface portion of the medical apparatus and instruments having a housing in order to enhance the aesthetic impression or the function of the goods in general.

A There are a large number of housings, to which white is applied, of medical apparatus and instruments, including housings used by health workers in hospitals (Evidence A No. 41 to A No. 43, A No. 46, and A No. 49 to A No. 51).

B A lamp and a display indicating an operation and a button, a switch, and the like to set and operate various functions (referred to as "operation lamp and the like" below) are often collectively disposed on the front surface portion of the housing of the medical apparatus and instruments, and a dark color such as gray close to black or black that improves visibility of the operation lamp and the like is used in the background portion of the operation lamp and the like (Evidence A No. 42, A No. 43, A No. 45, and A No. 46).

C In general, blue is disposed as a kind of design, or a color that is used together with a corporate logo and characters indicating the source in a portion of the housing of the medical apparatus and instruments (Evidence A No. 43, A No. 48, A No. 49, and A No. 51).

(3) Regarding the medical apparatus and instruments including the housing handled by the appellant

As described in (1) above, the trademark in the application is configured by colors including , in the front surface portion of the medical apparatus and instruments, white arranged in about half on the left side of the front surface, gray arranged in about half on the right side, and the blue horizontally long band-like shape arranged in the upper portion. However as described in (2) above, it is reasonable that, even when the color trademark in the application is used for the designated goods, traders and consumers coming into contact with the trademark only recognize that the trademark

indicates the color, which is the feature of the goods, that may be normally used for the goods in order to enhance the aesthetic impression and the function of the goods.

Therefore, the trademark in the application consists of only a mark indicating the feature (the color) of the goods by a method that is usually used and falls under Article 3(1)(iii) of the Trademark Act.

### 3 Applicability of Article 3(2) of the Trademark Act

The appellant alleges that "even in a case where the trademark in the application falls under Article 3(1)(iii) of the Trademark Act, the trademark in the application functions as a mark for distinguishing relevant products from others according to the use for the designated goods by the appellant" and submitted Evidence A No. 1 to A No. 51 as evidences.

Therefore, in consideration of the evidences submitted by the appellant, the evidences employed in the body, and the allegation by the appellant, whether or not the trademark in the application has become a trademark by which consumers are able to recognize the goods as those pertaining to a business of a particular person as a result of the use of the trademark in the application will be examined below.

According to the evidences and the allegation of the appellant, the following facts are acknowledged.

#### (1) The appellant and a use region of the trademark in the application

The appellant was established in 1919, and a main business of the appellant is manufacture and sale of precision instruments (Evidence A No. 3 and A No. 4).

The appellant achieved practical use of a gastroscope in 1950 for the first time in the world, introduced a gastroscope with a fiberscope in 1964, and launched a videoscope in 1985 (Evidence A No. 15).

In addition to 15 branches and offices or business offices across Japan including Tokyo, the appellant has 120 subsidiary companies and four associated companies across Japan and overseas (at the end of March in 2016). The appellant sells goods using the trademark in the application to hospital facilities in Japan from the offices and the like (Evidence A No. 12 to A No. 14).

#### (2) Record of sales and market share of the goods

A The sales amount of the appellant is 804.6 billion yen in 2016, and 608.9 billion yen, which is 75.7% of the sales amount, is a sales amount of the medical service (Evidence A No. 4 and A No. 7).

The sales amount of the medical service of the appellant has been increased from 2012 to 2016 for five consecutive years (Evidence A No. 5).

Furthermore, according to "Market share and ranking in medical instrument industry (2013 to 2014)"(industry trends search), the sales amount is 492.2 billion yen, and the sales amount share is 22.3% (Evidence A No. 9). According to "Medical instrument manufacturer ranking" (MT bank), the appellant gained the top position in sales amount (2013 to 2014 in Japan) (Evidence A No. 10).

B The sales amount of the endoscope manufactured by the appellant was 313.3 billion yen in 2015 and 341.6 billion yen in 2016, and the market share of the appellant is 56% of the whole medical service industry (Evidence A No. 7).

Then, according to an article on the Internet (July 2, 2013), in the market of the endoscope used for examination and treatment of the stomach and large intestine, the appellant has an about 70% market share in the world (Evidence A No. 17) and had a 43% market share in Japan in 2012 (Evidence A No. 18).

(3) Use start period and use method of the trademark in the application

The appellant has started to sell a product "endoscope integrated video system", in which the same colors as in the trademark in the application are applied on the front surface portion of the housing, since October 2011 (Evidence A No. 11).

A Use of the trademark in the application for the designated goods

(A) "High-luminance light source device CLV-290SL/CLV-290" (Evidence A No. 19)(attachment 2(1)), "High-luminance light source device CLV-S190" (Evidence A No. 22 and A No. 24), and "High-luminance light source device CLV-S400" (Evidence A No. 23) that are acknowledged to be included in the category of the "light source device for an endoscope" have a configuration in which a blue horizontally-long band-like shape is arranged in the upper portion, white is arranged in about half on the left side of the front surface, and gray is arranged in about half of the right side of the front surface on the front surface portion of the housing the above products. Therefore, it is acknowledged that the same colors as those of the trademark in the application are arranged. Furthermore, in the upper blue portion, outlined characters of "OLYMPUS" are displayed on the left end.

(B) "Video system center CV-290" (Evidence A No. 19), "Video system center OTV-S190" (Evidence A No. 22), "Video system center CV-190" (Evidence A No. 24), and "3D video processor 3DV-190" (Evidence A No. 24) (Attachment 2 (2)) that are acknowledged to be included in the category of the "video processor for an endoscope" have a configuration in which a blue horizontally-long band-like shape is arranged in the upper portion, white is arranged in about half on the left side of the front surface, and gray is arranged in about half of the right side of the front surface on the front surface portion of the housing the above products. Therefore, it is acknowledged that

the same colors as those of the trademark in the application are arranged. Furthermore, in the upper blue portion, outlined characters of "OLYMPUS" are displayed on the left end.

(C) "Video system center CV-170"(Evidence A No. 52) described as a "light source integrated processor" as a product that is acknowledged to be included in the category of the "light source integrated processor for an endoscope" has a front surface portion of a housing on which a white portion is arranged in a substantially L-like shape and a gray portion is applied only in a rectangle that occupies three-quarters to a half of the housing of the product on the right side in the vertical direction. Therefore, it cannot be acknowledged that the same colors as those of the trademark in the application are arranged. Furthermore, although a blue horizontally-long band-like shape is arranged in the upper portion on the front surface portion of the housing, outlined characters of "OLYMPUS" are displayed on the left end.

(D) The product "color video printer OEP-5" (Evidence A No. 19 and A No. 22) that is acknowledged to be included in the category of the "video printer for an endoscope" has a configuration in which a gray portion, having the same width as the upper blue portion, is arranged in a band-like shape as having a vertical width about twice a vertical width of the upper blue portion, and the remaining lower portion is white, on a housing front surface portion. Furthermore, the color of almost the entire housing of the product "color video printer YP-25MD"(Evidence A No. 52) is white. Therefore, they cannot be acknowledged that the same colors as those of the trademark in the application are arranged. Furthermore, on the front surface portion of the housing of the product "color video printer OEP-5", the blue horizontally-long band-like shape is arranged in the upper portion, and outlined characters of "OLYMPUS" are displayed on the left side.

B Use of the trademark in the application for goods other than the designated goods

In the product catalog of the appellant, regarding medical apparatus and instruments having a housing other than the designated goods of the trademark in the application, products having a combination of colors largely different from that of the trademark in the application are described, such as a product having different color arrangement and giving a completely different impression from the configuration of the trademark in the application (for example, "Ultrasonic observation device for an endoscope EU-ME2" (Evidence A No. 53)), a product which is white other than the upper blue portion on the front surface portion (for example, "Wireless video transmission device UWIT-TX/UWIT-RX" (Evidence A No. 22) and "Surgical environment integrated system ENDOALPHA" (Evidence A No. 22, A No. 23, and A

No. 24)), a product of which all the surface is colored white and which has no upper blue portion and no gray portion (for example, "Balloon control unit OBCU" (Evidence A No. 19) and "High-frequency cautery power device ESG-100" (Evidence A No. 19)).

#### C Advertisements

(A) The appellant attended "Japan Digestive Disease Week" (Evidence A No. 31) which is one of the largest medical academic conferences in Japan and has been held every year in major cities in Japan from 1993 to 2015. In an item field of "main exhibition content (main exhibitions)" in the website, which introduces "Medical goods and medical instruments exhibition", of the academic conferences held from 2007 to 2015, "endoscope system and endoscope associated device" and the like are described (Evidence A No. 32).

Furthermore, in the extra edition of the academic conference (Evidence A No. 33), advertisement of the product to which the trademark in the application is applied is described. However, the date of publication and the source are unknown.

(B) The appellant placed an advertisement of the endoscope system and the endoscope associated device to which the trademark in the application is applied in "Digestive organ endoscope", Volume 27, No. 10 published by TOKYO IGAKUSHA (published on October 25, 2015: Evidence A No. 25), "INTESTINE", Volume 19, No. 6 published by Nihon Medical Center (published on November 20, 2015: Evidence A No. 26), and Japan Gastroenterological Endoscopy Society Newsletter No. 21 (published on November 15, 2015: Evidence A No. 27).

#### (4) Judgment

According to the facts described in (1) to (3), the following determination can be made.

A Use period, use method, sales amount, and the like of the trademark in the application

The appellant was established in 1919, and the main business of the appellant is manufacture and sales of the precision instruments centering on the medical service since the achievement of the practical use of the gastroscope in 1950 for the first time in the world. The sales amount of the medical instruments of the appellant in the business year ending at the end of March 31 in 2014 is 492.2 billion yen, and the appellant gained the top share in Japan.

It is acknowledged that the appellant has used the same colors as those of the trademark in the application on the front surface portion of the housing of the product "Endoscope integrated video system" since October 2011 at the latest and has used the color for the endoscope associated products after that.

Then, the sales amount of the endoscope manufactured by the appellant was 313.3 billion yen at the end of March in 2015 and was 341.6 billion yen at the end of March in 2016, and the market share in Japan in 2012 is 43%. Therefore, it is understood that the sales amount and the market share in Japan of the endoscope or the endoscope associated product are significantly high.

However, the trademark in the application is a color mark as described in No. 1 above and has the configuration in which a blue band-like shape is arranged in the upper portion, white is arranged in about half on the left side of the front surface, and gray is arranged in about half of the right side of the front surface on the front surface portion of the housing of the medical apparatus and instruments. Since the designated goods include goods for which the use is not acknowledged to be the same as that of the trademark in the application as the "light source integrated processor for an endoscope" and the "video printer for an endoscope"((3)A(C) and (D)), it is hard to say that the combination of the colors configuring the trademark in the application is uniformly used, and it cannot be said that consumers are impressed by the combination of the colors.

Moreover, as indicated in B in (3), the product catalog of the appellant includes a large number of products other than the designated goods of the trademark in the application. The catalog includes products of the medical apparatus and instruments having the housing that have a configuration largely different from that of the trademark in the application. Therefore, even if the sales amounts and the market shares in Japan of the endoscope and the associated products are significantly high, it should be considered that an actual sale amount and market share of the product for which the use is acknowledged to be the same as that of the trademark in the application are a part of the sales amounts and the market shares of the endoscope and the associated products.

Furthermore, in general, the outlined characters of "OLYMPUS" are constantly described in the upper blue portion of the trademark in the application used in the product catalog and the like, and in the industry handling the medical apparatus and instruments including the designated goods of the trademark in the application, as described in (2) in No. 2, the color is applied to the front surface portion of the medical instrument having the housing in order to enhance the aesthetic impression or the function of the product. Therefore, it is understood that the characters of "OLYMPUS" independently function as a mark identifying the source. Accordingly, it cannot be said that only the combination of the colors configuring the trademark in the application is observed separately from the characters of "OLYMPUS" and that this makes an impression as the mark for identifying the source of the appellant.

## B Advertisements



(A) Product catalog

As described in A in (3), the products for which the use of the trademark in the application is acknowledged are only a part of the products described in the product catalog submitted by the appellant.

Furthermore, the appellant alleges that "the circulation of each product catalog using the trademark in the application is more than twenty thousand in 2016 on average, a large circulation exceeds 94 thousand, and the circulation of the catalogs in total is slightly less than 337 thousand". However, no evidence supporting the circulation is submitted, and distribution states are not obvious.

(B) Exhibitions

No evidence from which the state of the exhibition of the product using the trademark in the application in "Medical goods and medical instruments exhibition" of "Japan Digestive Disease Week" can be confirmed has been submitted. It cannot be determined whether or not the trademark in the application is exhibited in a state where the colors of the trademark in the application are prominently displayed in an exhibition where a large number of products are exhibited by a large number of companies.

Moreover, even when the appellant attended the academic conference since 1993, since the academic conference is held once a year, the product using the trademark in the application had been exhibited only about five times since October 2011 when the use of the trademark in the application has been started to 2015. It cannot be said that the number of times of exhibition is large.

(C) Magazines

As described in (B) in C in (3), the number of times of description in the magazines is only several times in specialized magazines.

C Summary

According to the above, even if it is acknowledged that the sales amount and the market share in Japan of the endoscope or the associated products of the appellant are significantly high, it cannot be said that the combination of the colors configuring the trademark in the application is uniformly used in the "light source integrated processor for an endoscope and video printer for an endoscope" in the designated goods of the trademark in the application and the products described in the product catalog other than the designated goods of the trademark in the application. Furthermore, it cannot be said that consumers are impressed by the colors of the trademark in the application, and it is considered that the products for which the use is acknowledged to be the same as that of the trademark in the application are only a part of the endoscope and the associated products, even if the sales amount and the market share in Japan of the

endoscope or the associated products are significantly high. The upper blue portion of the trademark in the application is constantly displayed with the outlined characters of "OLYMPUS", and only the combination of the colors configuring the trademark in the application is separately observed, and it cannot be said that this makes an impression as the mark for identifying the source of the appellant. The advertisements of the endoscope or the associated products of the appellant are limited. As described in 2 above, in the industry handling the medical apparatus and instruments including the designated goods of the trademark in the application, the color is applied, in general, to the front surface portion of the medical apparatus and instruments including the housing in order to enhance the aesthetic impression or the function of the product. In consideration of the above, it cannot be acknowledged that the colors of the trademark in the application are recognized by consumers as a mark for identifying the source related to the business of the appellant as a result of the use of the trademark in the application for the designated goods by the appellant.

Furthermore, sufficient evidences used to acknowledge this are not submitted.

Therefore, since the trademark in the application cannot be acknowledged as a trademark by which consumers are able to recognize the goods as those pertaining to a business of a particular person as a result of the use of the trademark in the application, the trademark in the application does not meet the requirement stipulated in Article 3(2) of the Trademark Act

#### 4 Appellant's allegation

(1) The appellant alleges that "although the product indicated in the original examination has the same blue color as the trademark in the application, the blue of the above product is largely different from the blue of the trademark in the application in brightness and the color saturation. In combination with differences in white and gray colors, the colors of the above product are easily recognized as being completely different from the colors of the trademark in the application. Furthermore, in the field of the endoscope, it is unusual to employ a plurality of colors including blue which is a chromatic color and white and gray which are achromatic colors on the front surface portion of the housing. The trademark in the application is consistently applied on the front surface portion of the housing of the light source device for an endoscope and the like and used as a mark for distinguishing relevant products from others so that the product using the above colors can be immediately recognized as the product of the appellant".

However, as described in 2 above, in the industry handling the medical apparatus and instruments including the designated goods of the trademark in the application, the

colors (including a combination thereof) are applied to the front surface portion of the medical apparatus and instruments including the housing in general in order to enhance the aesthetic impression or the function of the product. Since white similar to white on the left surface portion is arranged on a portion other than the front surface portion of the housing of the designated goods for which the trademark in the application is actually used (red colored portion in [Detailed Description of Trademark]), white on the left surface portion simply indicates the color of the housing.

Then, since the characters of "OLYMPUS" are displayed in the upper blue portion, only the color is separately observed, and it cannot be said that this makes an impression as the mark for identifying the source of the appellant.

Therefore, even if the trademark in the application and the product cited in the decision of refusal in the original examination (Evidence A No. 49 to A No. 51) are different in color phases of blue, white, and gray applied to the products, each product has a combination of the same colors, and it is not acknowledged that only the trademark in the application is recognized as a mark indicating the source of goods or a mark for distinguishing relevant products from others in actuality.

(2) The appellant alleges that "the designated goods of the trademark in the application are the device associated with the endoscope. Whereas, each product indicated in the original examination is not a product associated with the endoscope. Even if both belong to the medical apparatus and instruments in the broad sense, the product is completely different from the designated goods of the trademark in the application in the use purpose, the use place, and the user."

However, both of the designated goods of the trademark in the application and the product presented in the original examination are products in the category of the medical apparatus and instruments.

Then, as the appellant alleges in the written request for appeal that "consumers of the designated goods of the trademark in the application are health workers such as gastroenterological physicians and surgeons, medical technologists, nurses, and the like who provide medical examination services in the hospitals and the like", consumers of the designated goods of the trademark in the application are health workers.

Accordingly, it should be said that the designated goods of the trademark in the application and the product presented in the original examination have common consumers, use purpose, use place, and the like.

(3) The appellant alleges that the trademark in the application is well known based on the fact such that a surgical system and a gastroenterological endoscope system won the Good Design Award.

However, even if it may be acknowledged that the shape of the award-winning product is employed to enhance the aesthetic impression from the fact that the product of the appellant won the Good Design Award, it cannot be acknowledged that the above fact guarantees that the colors of the trademark in the application display the source of goods and function as a mark for distinguishing relevant products from others.

(4) The appellant alleges that "on the assumption that the trademark in the application acquires high prominence, the trademark in the application is used for the goods together with the characters of 'OLYMPUS' that have significantly high distinctiveness and has been continuously used in this way. Therefore, the colors configuring the trademark in the application are recognized as a mark for identifying the appellant, and the distinctiveness should not be denied in an automatic manner as focusing on the fact that the trademark in the application is used together with the characters".

However, as described above, it has not been determined that the colors of the trademark in the application do not have the source distinctiveness only because the colors of the trademark in the application are used together with the characters of "OLYMPUS".

(5) Therefore, the appellant's allegations cannot be accepted.

#### 5 Summary

As described above, the trademark in the application falls under Article 3(1)(iii) of the Trademark Act and does not meet the requirement stipulated in Article 3(2) of the Trademark Act. Accordingly, the trademark in the application cannot be registered.

Therefore, the appeal decision shall be made as described in the conclusion.

May 22, 2019

Chief administrative judge: HAYAKAWA, Fumihiro  
Administrative judge: SATSUMA, Junichi  
Administrative judge: HAMAGISHI, Ai

Attachment 1 The trademark in the application

(1) Trademark for which registration is sought (regarding colors, refer to the original)



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(2) Detailed Description of Trademark

A trademark for which registration is sought (hereinafter referred to as the "trademark") is a color trademark consisting of a combination of colors and has a configuration in which blue (PANTONE 287C) is applied in the upper portion, white (PANTONE Cool Gray 1C) is applied on the left portion, and gray (PANTONE 7540C) is applied on the right portion on a front surface portion of a housing of medical instrument. Note that, a red colored portion of the housing of the medical instrument indicates an example of the shape of the product and is not an element configuring the trademark.

Attachment 2 Use example of the designated goods of the trademark in the application

(1) Light source device for an endoscope (High-luminance light source device CLV-290: Evidence A No. 19) (regarding colors, refer to the original)



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(2) Video processor for an endoscope (3D video processor 3DV-190: Evidence A No. 24) (regarding colors, refer to the original)



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(reference: endoscope videoscope system of the appellant "EVIS LUCERA ELITE")



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(Name of each unit of endoscope system)

- 1: LCD monitor
- 2: peripheral device such as video printer
- 3: video processor
- 4: light source device