

Part II: Article 3(2) (Distinctiveness acquired through use)

Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.;

1. “Use” of a trademark

(1) Trademark


Where the trademark in an application and the trademark as used are different in appearance, the trademark in an application is not recognized as being used.

Even if the trademark in an application and the trademark as used are not strictly identical to each other in appearance, the trademark in an application is recognized as being used if the difference is recognized as not affecting the identity of the trademark by considering the degree of differences in appearance and the actual state of transaction of the designated goods or designated services.

(Example 1) Trademarks which are recognized as identical

- (i) The only difference between a trademark in an application and a trademark as used is that they are described in vertical writing and horizontal writing;
- (ii) A trademark in an application and a trademark as used are described in commonly-used fonts, and the two trademarks do not have any characteristic which draws attention of traders or consumers, and their fonts are similar with each other.

(Example 2) Trademarks which are not recognized as identical

- (i) Whereas a trademark in an application is in Chinese characters of the cursive style, a trademark as used is in Chinese characters of either the square type or the semi-cursive style.
- (ii) Whereas a trademark in an application is in Japanese hiragana characters, a trademark as used is in Japanese katakana characters, Chinese characters or Roman characters.
- (iii) Whereas a trademark in an application uses Arabic numerals, a trademark as used uses Chinese numerals.
- (iv) Whereas a trademark in an application is indicated in such a form as , a trademark as used



is indicated in such a form as $\square P$, and $\square P$.

(v) Whereas a trademark in an application is indicated as a plane trademark, a trademark as used is a three-dimensional trademark.

(2) Goods or Services

Where the designated goods or designated services of a trademark in an application and the goods or services used by a trademark as used are different, the trademark as used is not recognized as being used in respect of the designated goods or designated services.

However, even if the designated goods or designated services and the goods or services to be used are not strictly identical to each other, the trademark in an application is recognized as being used in respect of the designated goods or designated services if the difference is recognized as not affecting the identity of the designated goods or designated services and the goods or services to be used by taking the actual state of their transaction into consideration.

2. The expression “The consumers are able to recognize the goods or services as those pertaining to a business of a particular person”

(1) Recognition of consumers

“The consumers are able to recognize the goods or services as those pertaining to a business of a particular person” in this paragraph means that the consumers of the goods or services throughout the country are able to perceive the trademark as an indication of trade source.

(2) Grounds of judgment

Judgment as to whether a trademark falls under this paragraph will be made, taking the following points into consideration.

Specifically, the level of consumers’ awareness, which will be estimated through a substantive grasp of the use of a trademark, will be utilized to judge the distinctiveness of a trademark.

(i) The composition and mode of the trademark in an application

(ii) The mode of use, volume of use (an amount of production and an amount of sales, etc.), period of use and areas of use of the trademark

- (iii) The method, period, areas and scale of advertising
- (iv) Whether a mark identical with or similar to the trademark in an application is used by any person other than the applicant (in case of an application for collective trademark registration, “the applicant or a person other than its members”) and states of its use.
- (v) The characteristics of the goods or services and the actual state of their transaction
- (vi) The outcome of the questionnaire regarding consumers’ awareness of the trademark

(3) Method of proving that the trademark is actually used

Facts as to whether a trademark falls under this paragraph will be provided based on, for example, the following evidences.

- (i) Photographs, movies, etc. showing the actual state of use of a trademark
- (ii) Business documents (Order slips (purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.)
- (iii) Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proofs proving his past record
- (iv) Articles in general newspapers, trade journals, magazines and the Internet presenting the trademark in an application by persons other than the applicant
- (v) Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark (However, due consideration will be given to the objectivity and neutrality of the questionnaire with respect to the conductor, method, and respondents).

(4) A trademark combined with another trademark

Where a trademark in an application is used in combination with another trademark, judgment as to whether the trademark has come to gain its distinctiveness through use will be made based on whether only the parts of the trademark in an application have come to gain its distinctiveness independently.

(5) Collective trademark

Judgment as to whether a collective trademark has come to gain its distinctiveness through use

will be made with due consideration given to the points stated in (2) above concerning the use by members of the owner of the collective trademark. To prove the use of a collective trademark by a member of a collective trademark, judgment is made by including the fact that the person is proved to be a member.

(6) Trademark in relation to retail services

If a trademark is indicated on goods, their packaging, price lists, business documents and advertisements, judgment as to whether or not a trademark is used in respect of retail services shall be made by examining, according to the form of indication, whether the trademark identifies the individual and specific source of goods or the source of retail services in connection with goods.

3. Identity of trademark as applied and trademark as used in case of three-dimensional trademark

(1) Example where identity can be recognized

Although a mark other than a trademark as applied is included in a trademark as used, a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

(i) The trademark as applied is comprised solely of a three-dimensional shape, and a photograph of an identical three-dimensional shape with characters attached thereto is submitted as a trademark as used. The portion corresponding to the three-dimensional shape can give a strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

(ii) The characteristic parts of three-dimensional shapes of a trademark in an application and a trademark as used are identical and differences in other parts are minor. The characteristic part can be recognized as a mark which can independently distinguish its goods and services from those of others.

(2) Example where identity cannot be recognized

A trademark as used is different from a trademark as applied (different marks).

(Examples)

(i) Major differences are found between the three-dimensional shapes of a trademark as applied and a trademark as used.

(ii) Whereas a trademark as applied is indicated as a three-dimensional trademark, a trademark as

used is a plane trademark.

(Note) When determining the identity of the trademark as applied, which is stated by a method such as drawing the mark in connection with the trademark with solid lines and other parts with broken lines, and the trademark as used, the other parts pertaining to the trademark as applied are not taken into consideration, unlike in the case of a position mark where the other parts pertaining to the trademark as applied are taken into consideration in order to identify the position of the mark.

4. Identity of trademark as applied and trademark as used in case of motion mark

(1) Example where identity can be recognized

Although an element other than constituent elements of a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

An animated film uses a motion mark in not the total but a portion of a TV commercial, and the animated film is submitted as a trademark as used. A portion identical to the trademark as applied can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

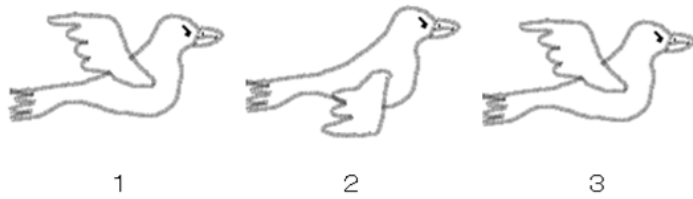
(2) Example where identity cannot be recognized

(i) A trademark as used is different from a trademark as applied (different marks, marks' different change of states with respect to time passage, etc.)

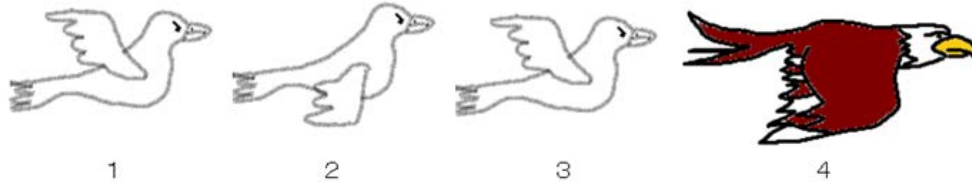
(ii) If an element other than constituent elements of a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied cannot be recognized as a mark which can independently distinguish its goods and services from those of others.

(Example)

- Trademark as applied



• Trademark as used



5. Identity of trademark as applied and trademark as used in case of hologram mark

(1) Example where identity can be recognized

Although a mark other than a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

A credit card uses a hologram mark in a portion of the credit card, and the credit card is submitted as a trademark as used. A portion identical to the hologram mark can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

(2) Example where identity cannot be recognized

A trademark as used is different from a trademark as applied (different marks, marks' different change of states (different visual effects) based on holography and other means, etc.)

6. Identity of trademark as applied and trademark as used in case of color mark

(1) Example where identity can be recognized

Although a mark other than a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

A pencil case is blue on all of its surfaces and has one small circle figure on its cover, and an evidence of the pencil case is submitted as a trademark as used.

The pencil case's blue color as a color mark identical to the trademark as applied can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

(2) Example where identity cannot be recognized

(i) Part or whole of hue (color shade), chroma (vividness of color) or brightness (chromatic luminosity) values of a trademark as used and a trademark as applied are different.

(ii) The color combination ration of an applied color mark and that of a color mark as used are different from each other.

(iii) The color positions of a trademark as applied and those of a trademark as used are different from each other

7. Identity of trademark as applied and trademark as used in case of a sound mark

(1) Sound marks which consumers recognize as identical

Even if a trademark as applied is a sound mark, and if the trademark as applied is not strictly identical to a trademark as used, the trademark as applied and the trademark as used shall be judged to be identical when consumers can recognize them as the same sound marks.

When judging whether consumers can recognize trademarks as identical, following points shall be considered.

(i) Whether sound elements (such as melodies, harmony, rhythm or tempos, tones and other natural sounds, etc. which are musical elements) which constitute sound marks are identical to each other.

It is required that at least melodies are the same in order for consumers to be able to recognize that sound marks consisting of musical elements are identical. Whether melodies are the same. Even if melodies are the same, different rhythm, tempos or harmony gives different impression to consumers, and due consideration must be given.

Whether tones are different. For example, if tones are very close although types of instruments played are different, due consideration must be given because consumers may recognize the tones

as the identical sound mark in many cases.

(Examples of trademarks falling under this provision)

If a violin is played for an application as applied, and a viola is played for a trademark as used, it shall be assumed that consumers may recognize the trademarks as the identical sound mark because the tones of both instruments are very close.

(ii) Whether linguistic elements (such as lyrics, etc.) which constitute sound marks are identical to each other.

(2) Example where identity can be recognized

Although a trademark as applied is included in a part of a trademark as used (a mark other than the trademark as applied is included in the trademark as applied), the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(Examples of trademarks falling under this provision)

A trademark as applied is a sound logo lasting for several seconds, and a motion picture which records a whole commercial advertisement is submitted as a trademark as used. While the sound logo is played at the end of the commercial advertisement, the sound logo can give strong impression to consumers, and can be recognized as a mark which can independently distinguish its goods and services from those of others.

(3) Example where identity cannot be recognized

(i) Consumers get very different impression from a trademark as a whole because the rhythm, tempo or harmony of the trademark is different from that of another trademark even if their melodies are the same.

(ii) Consumers get very different impression from the tones or trademarks as a whole, for example, a violin is played for a trademark as applied while a piano played a trademark as used or an orchestra plays it.

(iii) Sounds of the trademark as applied are not recognized as a mark which can independently distinguish its goods and services from those of others because elements of a trademark other than

sounds of the trademark as applied (such as characters, figures and other sounds) are included in the material submitted as the trademark as used.

8. Identity of trademark as applied and trademark as used in case of position mark

(1) Example where identity can be recognized

Although a mark other than a trademark as applied is included in a trademark as used, only a portion corresponding to the trademark as applied can be recognized as a mark which can independently distinguish its goods and services from those of others.

(2) Example where identity cannot be recognized

A trademark as used is different from a trademark as applied (different marks, different positions of marks)