

## New Types of Trademarks

### 1. Definition

Section 2(1) of the Japanese Trademark Law defines “trademark” as follows.

*(Section 2(1) of the Trademark Law)*

*“Trademark” in this Law means characters, figures, signs, three-dimensional shapes or any combination thereof, or any combination thereof and colors (hereinafter referred to as a “mark”):*

*(i) which are used in respect of goods by a person who produces, certifies or assigns such goods in the course of trade;*

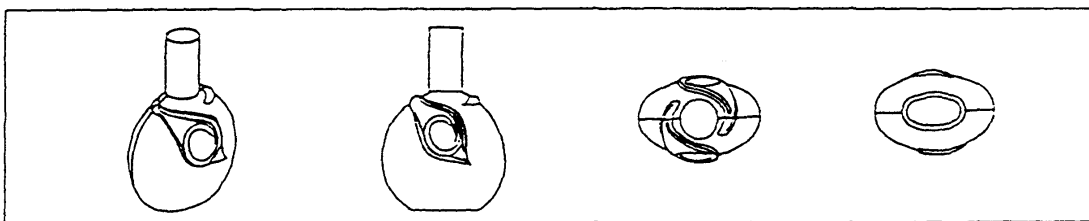
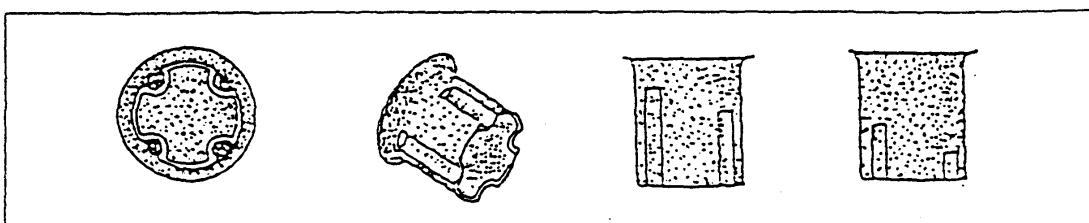
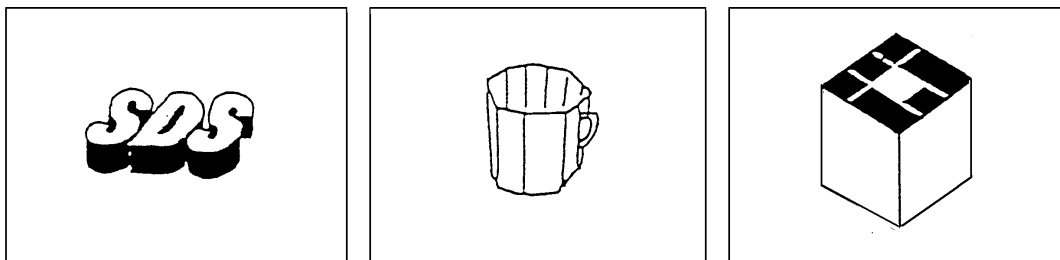
*(ii) which are used in respect of services by a person who provides or certifies such services in the course of trade (other than as in (i) above.)*

In Japan, only those marks that appeal to the visual sense are to be regarded as protectable under the trademark system. Thus, sounds, smells, and flavors are not deemed protectable subject matter under the Trademark Law even if they satisfy the other requirements of a trademark. Furthermore, neither holograms nor movements can be protected in Japan. On the other hand, three-dimensional marks can be protected. In the past, Japan explored the possibility of revising the definition of a trademark but decided not to modify the definition.

### 2. Method of representation of three-dimensional marks

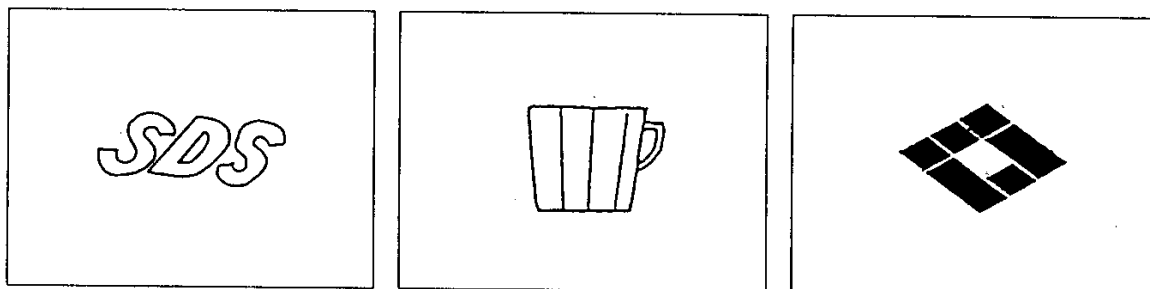
A trademark described as a three-dimensional trademark but not so recognized in composition and mode from its description in the relevant column (trademark description column) in an application form for trademark registration is unregistrable.

(1) Examples of Trademarks Recognized as Three-Dimensional in Form and Mode



(2) Examples of Trademarks not Recognized as Three-Dimensional in Composition and Mode

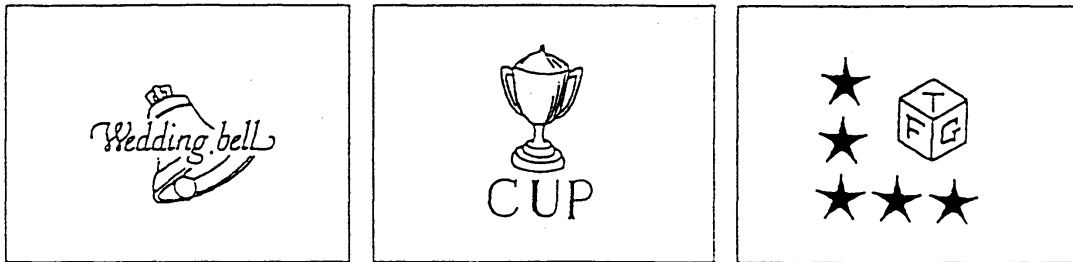
- ① A case in which the trademark is not drawn as a three-dimensional object in the trademark description box



(Note) A shape drawing of a trademark that does not include more than one dimension, such as an outer appearance of a three-dimensional object such as a thickness, etc.

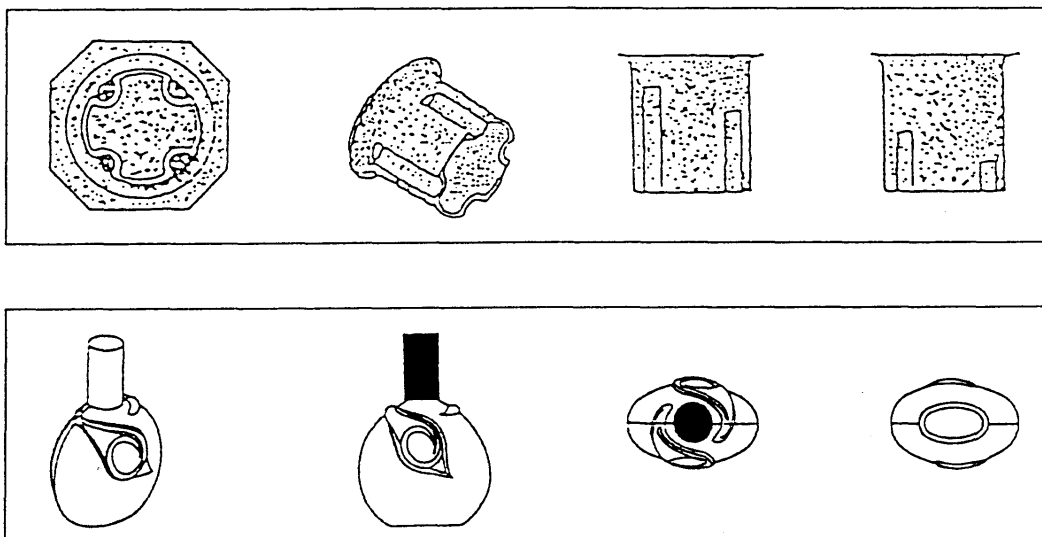
is not described and cannot be recognized as a three-dimensional trademark.

- ② A case in which a plain mark is drawn as a three-dimensional shape and described in separate compositions (i.e., picture, label, etc.) and separate modes (two dimension, three dimension, etc.).



(Note) A drawing (only) of a composition or mode with a plain mark not fitted on the surface of a three-dimensional shape but with a plain mark separate from a three-dimensional shape is not considered to indicate a shape as an outer appearance of a three-dimensional object and that is not in actuality a three-dimensional object is not recognized as a three-dimensional trademark.

- ③ A case in which the individual drawings in the trademark description box do not match each other



(Note) The three-dimensional shapes, figures, characters and colors indicated do not match each other.

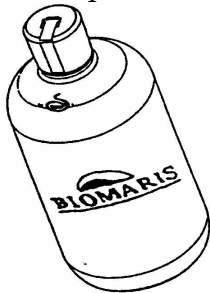
④ Other unregistrable examples

(a) A case in which a description of a three-dimensional trademark or figure is misleading as the description consists of photographs and sectional views with different scales

(b) A case in which a photograph of the shape of a three-dimensional trademark is so unclear that the entire trademark cannot be clearly identified.

(c) A case in which a shape of a three-dimensional trademark is composed of a shape of designated goods, and among the designated goods of the related trademark application, there are goods whose mode of use is clearly unassociated with the trademark of the said trademark application.

[Example]



Designated goods

Class 5

Pharmaceuticals, dental material, medical armband, medical oil paper, sanitary mask, gauze, eye patch, absorbent cotton, adhesive plaster, bandage

(Note) In the application, all of the above goods were designated. The wavy line shows the goods for which the above trademark cannot be registered, and the corresponding application would need to be amended so that the designated goods were only “pharmaceuticals.”

(d) A case in which a photograph or figure that depicts the shape of a three-dimensional trademark consists of stores or houses on a street, or landscape, or when within the photograph or figure along with buildings and structures, it depicts plants, people, or pedestrian streets.

(e) A case in which the edge of a photograph that shows the shape of a three-dimensional trademark has been torn (damaged), and as a result the entire contour, and thus the entire shape, of the three-dimensional trademark cannot be seen or specified.

### 3. Additional cost

There is no additional cost to register a three-dimensional trademark.

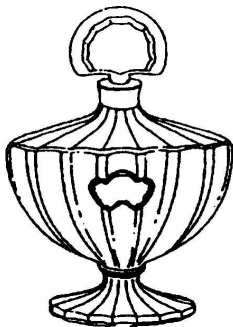
### 4. Principles of three-dimensional trademarks

For a three-dimensional trademark (claimed in a trademark application) comprised of the three-dimensional shape of designated goods (including packaging) or goods used for providing designated services (hereinafter referred to as “designated goods, etc.”) or comprised of a characteristic shape or characteristic packaging or accompanied by letters or figures, the policies described below will be followed in conducting an examination regarding distinctiveness.

1. A three-dimensional trademark that is comprised of a shape that is acknowledged by consumers as a shape that does not go beyond the scope of the shape of the designated goods, etc. itself, is deemed as lacking distinctiveness.

In this case, in relation to the designated goods, etc., even if the three-dimensional shape that can be adopted by the same type of “goods (including the packaging) or the goods used for providing services” (hereinafter “goods etc.”) is characteristically changed or decorated characteristically, the three-dimensional trademark will be deemed to lack distinctiveness as long as the shape as a whole is acknowledged as being a representation of the designated goods, etc.

[Examples]



Class 3 (perfume)

\*The shape of the mark may be characteristic but not registrable as a

three-dimensional trademark.

2. When letters or figures that are distinctive are attached to a three-dimensional shape that is deemed to lack distinctiveness and when it can be acknowledged that the mark is being used as a symbol to identify and represent the source of the goods or service, the mark will be deemed to have distinctiveness.

3. A three-dimensional trademark consisting solely of a shape that can only be acknowledged as being within the scope of a simple and common three-dimensional shape will be deemed to lack distinctiveness.

4. Even if a three-dimensional trademark falls under the provisions of the previous items 1 and 3, the trademark will be deemed distinctive provided that the three-dimensional trademark is acknowledged by consumers as being connected to a business by a third party and the trademark has become sufficiently well-known to enable it to be distinguished from the shape of similar goods, through use over a long period of time, or even during a short period of time through aggressive advertisements and publicity.

Trademarks consisting solely of a three-dimensional shape of goods or their packaging with the shape being indispensable to securing the functions of the goods or their packaging are not registrable.