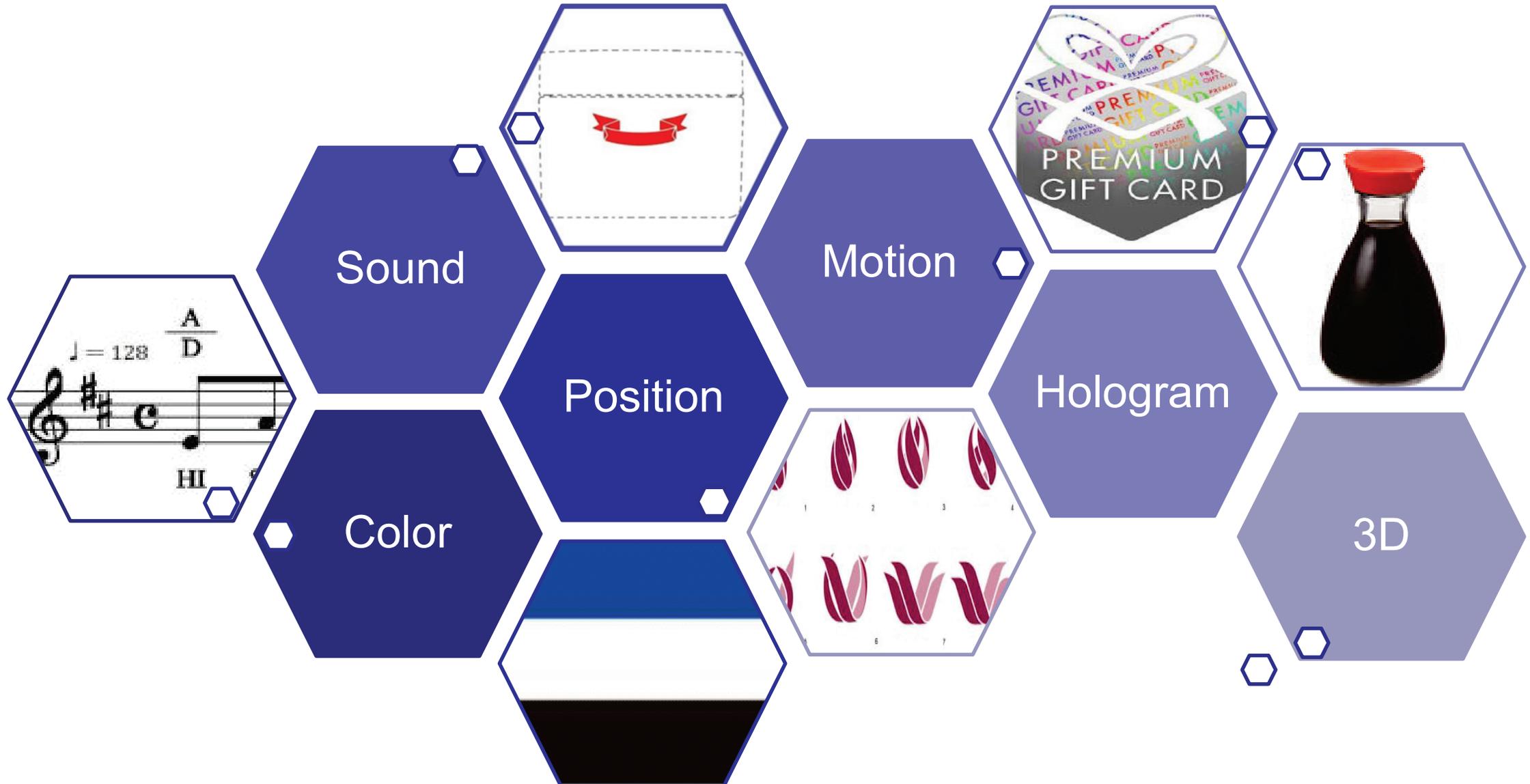


The Examination Practices on Non-traditional Trademarks

***May 21, 2018
Japan Patent Office***

Non-traditional TMs Acceptable in Japan



	Sound	Color	Position	Motion	Hologram	Total (except 3D)	3D
Number of applications	599	521	415	133	18	1686	6734
Number of registrations	226	4	57	94	12	393	3381
Number of rejections	265	436	223	13	5	942	-

(As of the end of March 2018)

On April 1, 2015, the JPO started accepting applications for five types of non-traditional trademarks. Three-dimensional trademarks have been accepted since 1996.

TM identification

- When motion, hologram, color per se and position marks are to be registered, a mark drawing and detailed description must be submitted.
- For sound marks, sound files must be submitted in addition to drawing by musical notation or character.

Distinctiveness

- Color and sound are not inherently distinctive as a mark in principle.
- For position, motion and hologram marks, whether marks are distinctive or not is decided mainly by focusing on letters, figures and other symbols contained in them.

Determination of similarity

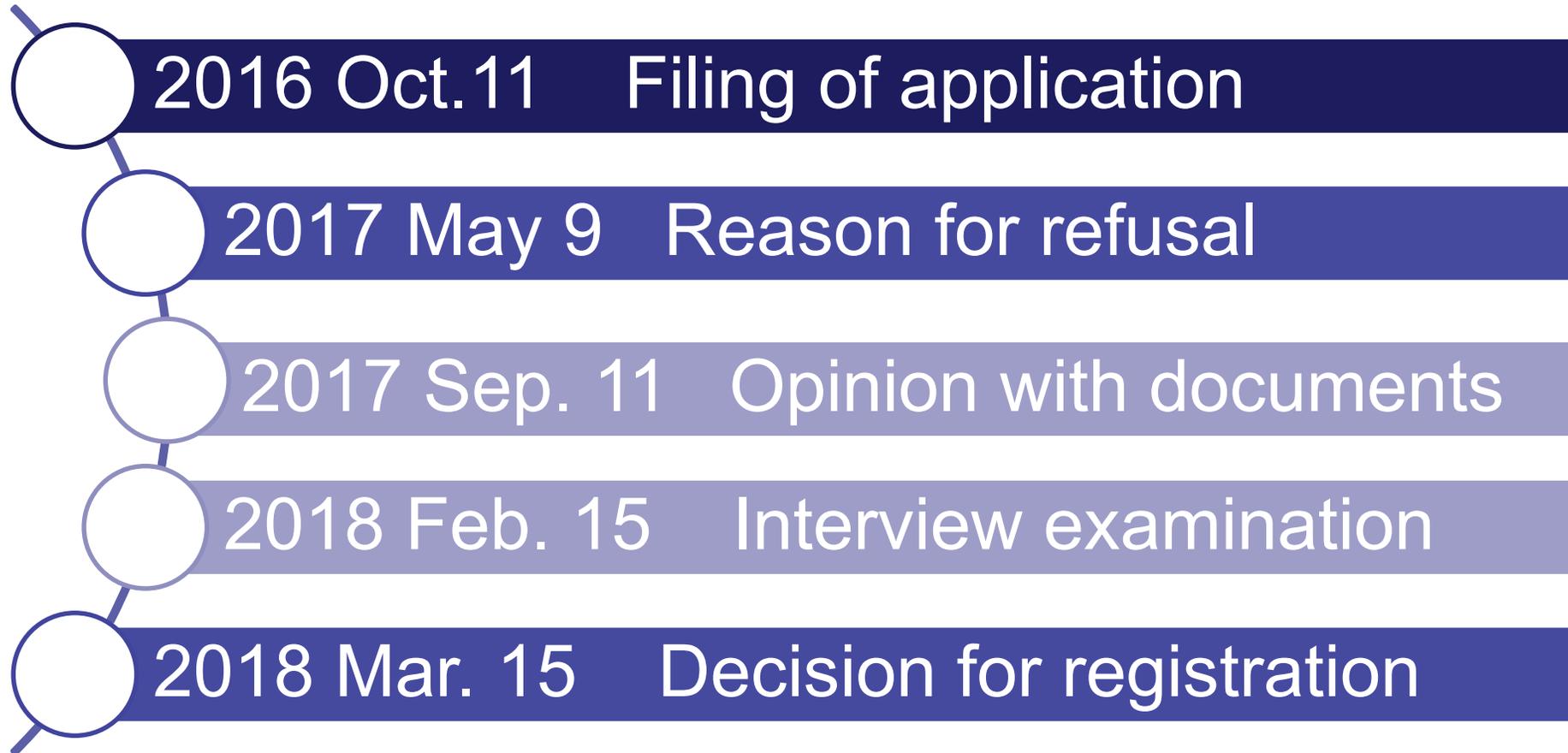
- Components such as the hue, intensity and brightness of colors are compared as a whole to decide whether the mark is similar to other trademarks or not.
- When sound marks contain linguistic elements, whether the linguistic elements are similar to other word trademarks will be examined.

Reg. No. 6031041

Right Holder: Kikkoman Corporation



Designated goods: Soy sauce in a table liquid container, Soy sauce



Main points of the reason for refusal

The trademark indicates a configuration of a shape normally applied to soy sauce containers

Consumers will acknowledge the trademark as merely indicating the shape of goods (shape of packages)

The filed trademark falls under Art. 3 (1) (iii), since it indicates the shape of goods in a common manner

Article of the Trademark Act

Article 3 (1) 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)**,.....



No distinctiveness

Main points of the opinion

The shape is inherently distinctive

Since its launch in 1961, the shape has given a strong impression on consumers as a brand symbol of the company

Even if the trademark is not inherently distinctive, it has acquired distinctiveness as a result of use

Will submit evidence items to prove its argument

Article of the Trademark Act

Article 3 (2) Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) through (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.

Secondary meaning?

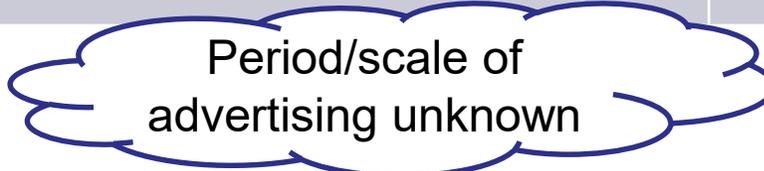
Factors for Judgment

- (i) The **composition** and **mode** of the trademark
- (ii) The **mode, volume, period 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** and states of its use
- (v) The characteristics of the goods or services and the actual state of their transaction
- (vi) The **consumers' awareness** of the trademark

Methods of Proof

- (i) Photographs, movies, etc. showing the actual state of use of a trademark
- (ii) Transaction documents, sales slips, invoices, bills, receipts, account books, etc.
- (iii) Advertisements used by the applicant and their past records.
- (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 consumer awareness of the trademark

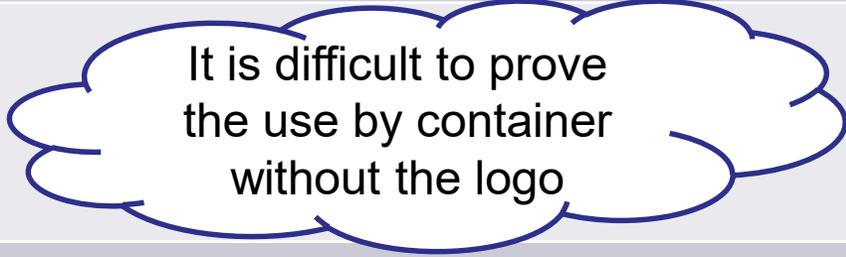
Factors	Methods	Proved Facts	Evaluation
(i) The composition and mode	Photos, Newspapers, Magazines, Catalogues, TV commercials	Started selling tabletop bottles with the same shape as the filed trademark in 1961. The company continues to sell the product.	Good
(ii) The mode, volume, period and areas of use	Transaction documents, Statistical data	240 million tabletop bottles sold	Better
	Press release articles, Sales slips, Advertising materials	57 years 	Good
	Press release articles, Sales slips, Advertising materials	Throughout Japan	Good
(iii) The method, period, areas and scale of advertising	Newspapers, Magazines, TV commercials, Internet articles	Was able to confirm that advertisements using the tabletop bottle were placed in newspapers, magazines, TV commercials, and TV programs.	Better

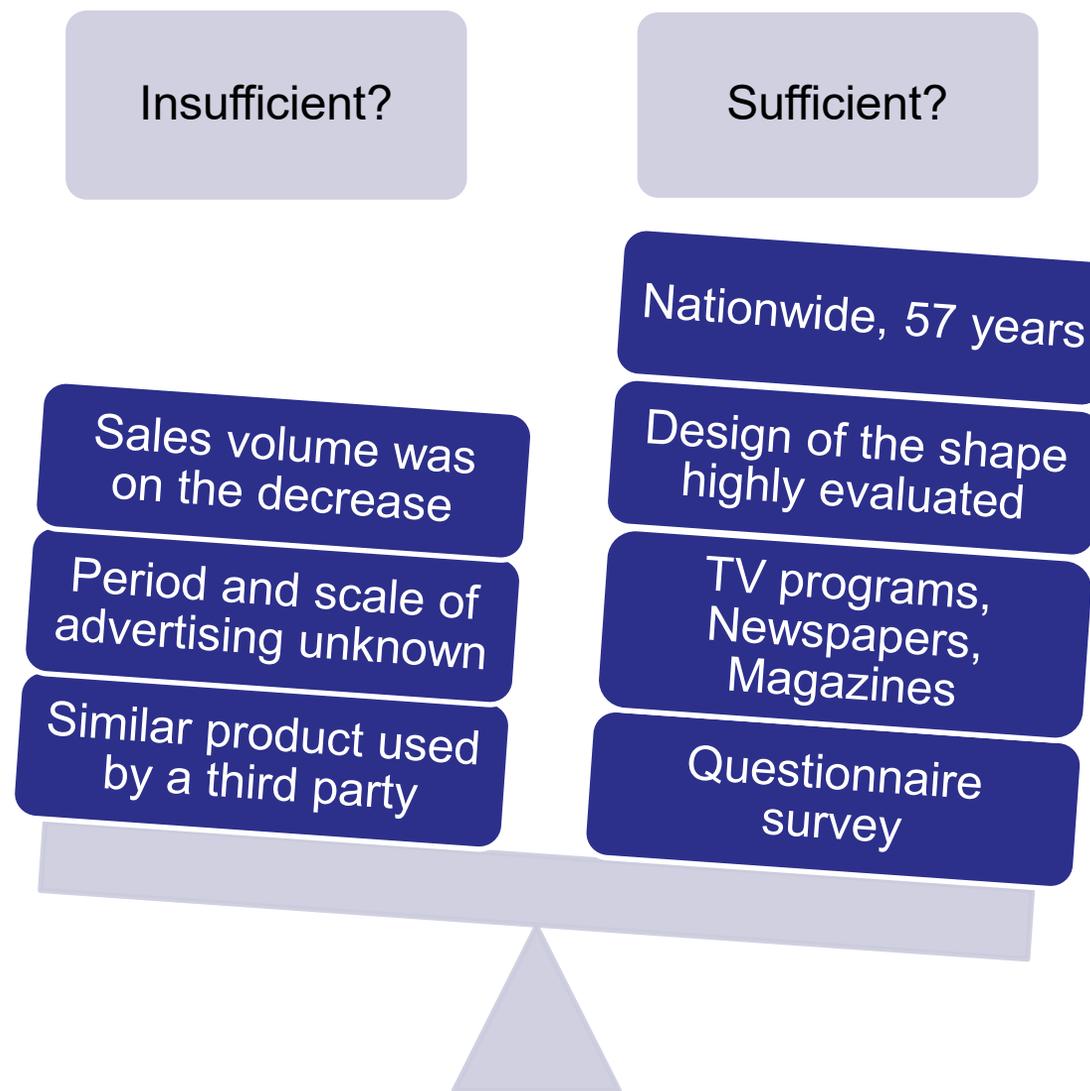


Period/scale of advertising unknown

Factors	Methods	Proved Facts	Evaluation
<p>(iv) Articles on newspapers, magazines and TV, etc.</p> 	<p>Newspapers</p>	<p>“There is a tabletop soy sauce bottle. It is that bottle with a red cap, slightly broadened shape toward the bottom, and whose content can be seen.” -Asahi Newspaper article on 3 April 1987</p> <p>“There is a product that has the same design even though it has been 34 years since it was first sold. It is Kikkoman’s ‘tabletop soy sauce bottle’ with its red cap and slightly broadened shape toward the bottom that attract attention.” -Yomiuri Newspaper article on 9 January 1995</p> <p>“In particular, the tabletop soy sauce bottle that is known for its non-drip function and smart shape is a long seller product since it was first sold in 1961 and approximately 400 million bottles have been manufactured for Japan and abroad.” -Asahi Newspaper article on 9 February 2015</p>	<p>Good</p>

Factors	Methods	Proved Facts	Evaluation
<p>(iv) Articles on newspapers, magazines and TV, etc.</p> 	<p>Magazines</p>	<p>“That was produced in Japan which became a world standard.” “It is a global standard item.” “The tabletop bottle with the company logo that came into being in this way has become a presence that fully creates the image that soy sauce equals Kikkoman.” <i>-mono magazine (Sold on 2 May 2017)</i></p>	<p>Good</p>
	<p>Books</p>	<p>A photo that only shows the silhouette of the bottle emphasizing the shape is printed at the beginning of the book. The cover of the book also partially shows the Kikkoman’s tabletop soy sauce bottle, <i>-The Design World of Kenji Ekuan (28 Feb. 2016, Bigaku Shuppan)</i></p>	
	<p>TV programs</p>	<p>“A design that can be said to be the soul of Japanese people,” “This shape is precisely the ‘Image of the dining table,’” and furthermore, “One knows that it is that bottle just by looking at its silhouette.” <i>-TBS Program “Gacchiri Monday!!” (Aired on 26 August 2007)</i></p>	

Factors	Methods	Proved Facts	Evaluation
(v) Whether a mark identical with or similar to the trademark is used by any other person	Ex officio investigation by examiners	Soy sauce bottled in a slightly similar container was sold by a third party.	Better
(vi) Whether the container alone independently has distinctiveness	Photographs showing use and advertisements of containers alone		-
	Newspapers, Magazines, Internet articles	The same as previously stated.	Good
	The outcome of the questionnaire regarding consumers' awareness of the trademark	Consumers were shown the same graphic image as the filed trademark and asked to state the matter, product, name of company/ manufacturer, or brand name that comes to their mind. About 60% of the respondents answered "Kikkoman."	Very good



Application of Article 3 (2) (Acquisition of distinctiveness through use) was approved.

- It is difficult to prove that the shape of a container alone independently has acquired distinctiveness.
- In such cases, it is effective to conduct a consumer awareness survey.
- Impartiality and neutrality are required for awareness surveys.
 1. No arbitrary or loaded questions?
 2. No artificially manipulated results?
 3. Were the target respondents and their number appropriate?

Case 2: Color Per Se Trademark

Reg. No. 5930334

Right Holder: Tombow Pencil Co., Ltd.



Designated goods: Erasers

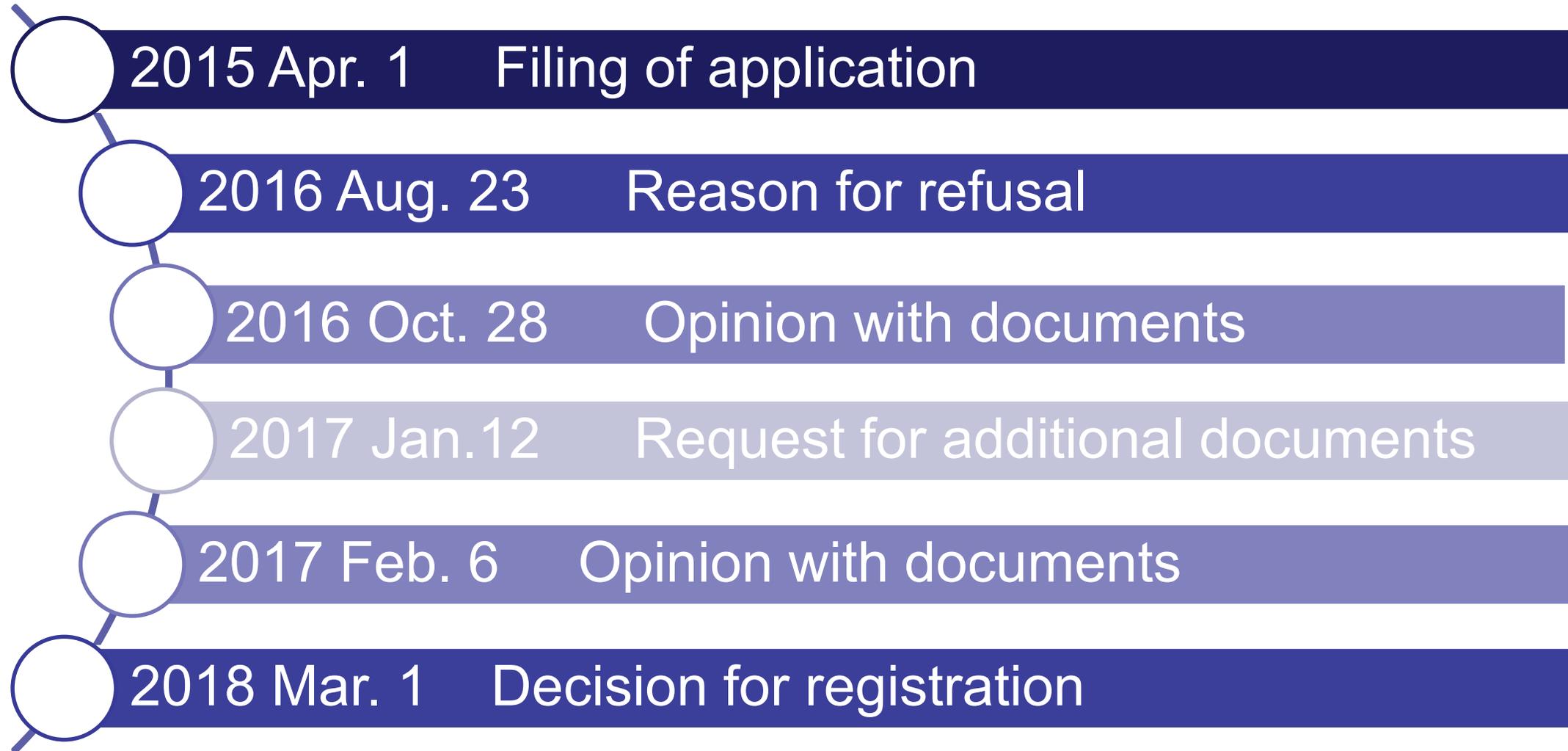
Description

The trademark seeking registration (hereinafter “the trademark”) is a color per se trademark consisting of a combination of colors. The colors combined are blue (Pantone 293C), white (Combination of process colors: C=0, M=0, Y=0, K=0), and black (Combination of process colors: C=0, M=0, Y=0, K=100). The color arrangement is the colors blue, white and black from the top that divide the trademark into three equal parts vertically.



Example of Use

Source: Tombow Pencil Co., Ltd. Website



Main points of the reason for refusal

In many cases, color is used to increase the attractiveness of goods and will not be acknowledged as being a distinguishing mark.



In the industry of the designated goods for the filed trademark, a combination of colors is generally used to increase attractiveness, etc.



Consumers will acknowledge the trademark merely as indicating colors normally used for goods or packages of goods.



The filed trademark is only indicating the features of the goods in a common manner and therefore falls under Article 3 (1) (iii).

Article of the Trademark Act

Article 3 (1) 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..... or **other features**.....



Main points of the opinion

The filed trademark has acquired distinctiveness through use.

The trademark has already acquired distinctiveness by the part other than the letters "MONO" (Colors alone)

The high level of distinctiveness of the filed trademark is verified by each evidence item.

Will submit the evidence items to prove the argument.

Article of the Trademark Act

Article 3(2) Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) through (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.

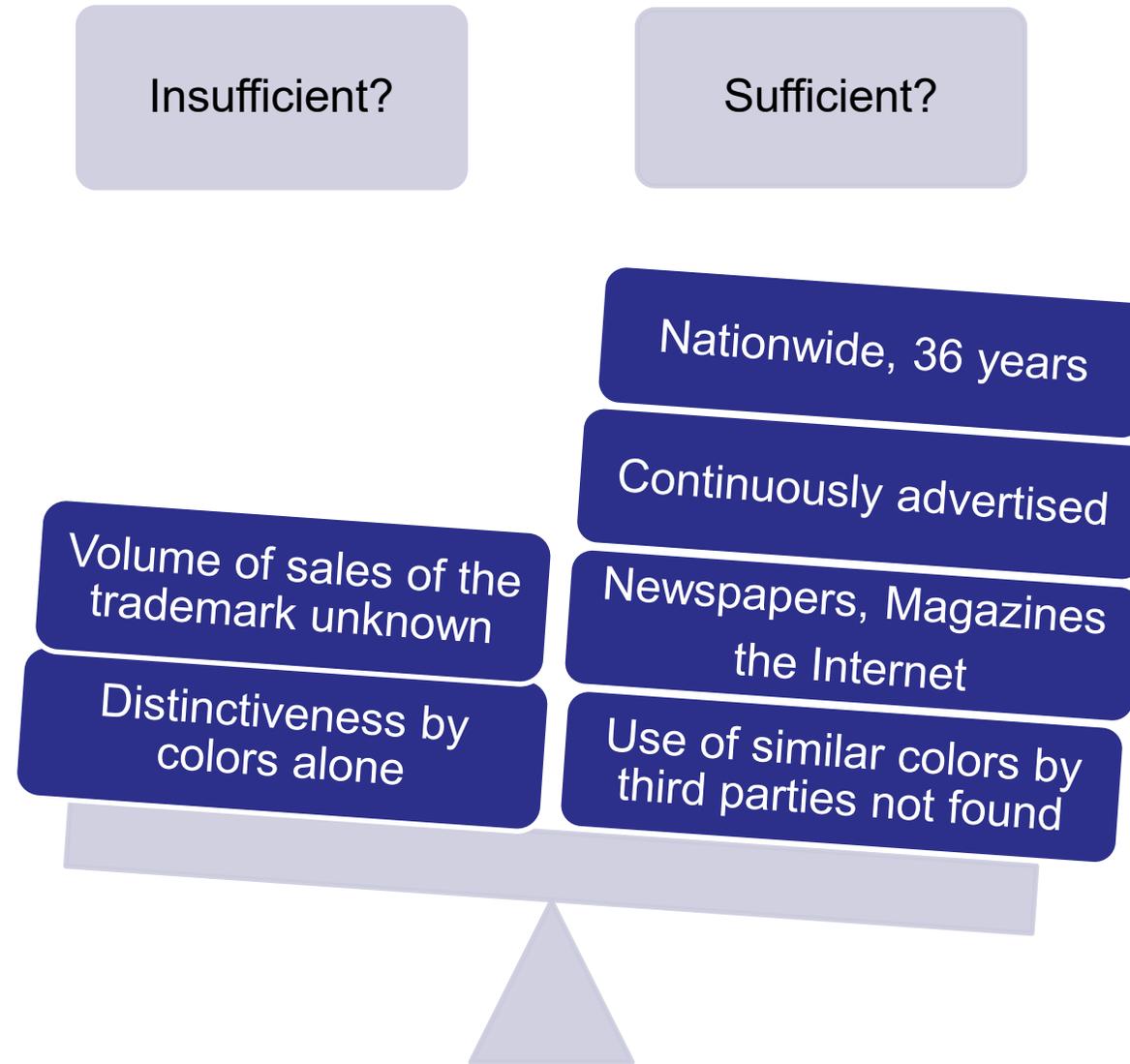
Secondary meaning?

Factors	Methods	Proved Facts	Evaluation
(i) Whether the filed trademark and the used trademark are identical	Photographs, Newspapers, Magazines, Catalogues	The proportion of the colors was different when the eraser was first sold. Between 1974 and 1980, the proportion was changed to the present proportion.	Good
(ii) The volume, period and areas of use	Transaction documents, Statistical data	No official evidence for the sales volume but the share of erasers in the industry was 29.2% in FY 2014.	Better
	Press release articles, Sales slips, Advertising materials	Started sales in 1969. Since at least 1980, erasers with similar proportion of colors have been sold, which are still sold now. → For 36 years	Good
	Press release articles, Sales slips, Advertising materials	Sold in 7-Eleven stores throughout Japan (Approx. 20,000 stores). Display Contests are held in retail stores throughout Japan.	Good
(iii) The method, period, areas and scale of advertising	Newspapers, Magazines, Internet articles	It was acknowledged that the applicant has continuously carried out a certain amount of advertising activities for the filed trademark.	Good

Factors	Methods	Proved Facts	Evaluation
<p>(iv) Articles on newspapers, magazines and TV, etc.</p> <div data-bbox="53 535 619 1110" style="border: 1px solid gray; border-radius: 50%; padding: 20px; width: fit-content; margin: 20px auto;"> <p>The fact that consumers have come to perceive a certain origin of goods by the colors of the filed trademark alone, can be highly evaluated.</p> </div>	<p>Newspapers</p>	<p>“When we hear the word eraser, the striped pattern of blue, white and black comes to the mind.” -Asahi Newspaper (November 14, 2009)</p> <p>“A memorable ‘Tricolor Flag’ design.” -Tokyo Newspaper (December 12, 2010)</p> <p>“The blue, white and black design has been acknowledged by consumers.” -Nikkei Industrial Newspaper (March 10, 2014)</p> <p>“The eraser with the striped pattern of blue, white and black already had a high degree of recognition.” -Nikkei Marketing Journal (May 22, 2015)</p>	<p>Good</p>

Factors	Methods	Proved Facts	Evaluation
<p>(iv) Articles on newspapers, magazines and TV, etc.</p> 	<p>Magazines</p>	<p>“Eraser well known by the MONO colors of ‘Blue, white and black.’” <i>-Nikkei Trendy (2007 August Edition)</i></p> <p>“A smash hit by the blue, white and black design,” “Strong impression given by the blue, white and black colors of (...) that imitated a flag,” “When it comes to erasers, we are reminded of ‘blue, white and black.’” <i>-Nikkei Trendy (2012 May Edition)</i></p> <p>“The blue, white and black stripe is the standard of erasers,” “The Tombow Pencil Co., Ltd.’s MONO eraser is one of the national stationery items that everyone has used at least once.” <i>-Stationery Awards 2013-2014</i></p>	<p>Good</p>
<p>Internet articles</p>	<p>“A simple stripe design of three colors, blue, white and black. The company has created an impression that when it comes to erasers, it’s ‘MONO.’” <i>-2011 Good Design Long Life Design Award</i></p>		

Factors	Methods	Proved Facts	Evaluation
<p>(v) Whether a mark identical with or similar to the trademark is used by any other person</p>	<p>Ex officio investigation by examiners</p>	<p>Use by third parties was not found.</p>	<p>Good</p>
<p>(vi) Whether a color per se mark has distinctiveness by the color(s) alone</p> 	<p>Holding of events and sales promotion goods</p>	<p>There are examples of use by colors alone that are not combined with the letters MONO.</p> <ul style="list-style-type: none"> ▪ Exhibitions targeted at distributors held. ▪ At the sales promotion events in Tokyo and Kyushu, goods were displayed in shops, etc. ▪ Sales promotion goods (paper bags, round fans) were distributed at the International Stationery/Paper Product Exhibition in Tokyo 	<p>Better</p>



Application of Article 3 (2) (Acquisition of distinctiveness through use) was approved.

- As letters are affixed to the goods, it was difficult to prove that colors alone independently have acquired distinctiveness.
- Based on various articles introducing the goods (in newspapers, magazines, etc.) written by third parties, it was acknowledged that the filed trademark (color) independently lets consumers perceive a specific origin of the goods.
- Evidence items that prove the use were submitted to reinforce this point.

- The eraser is an office supply item at the JPO.



Thank you for your attention