

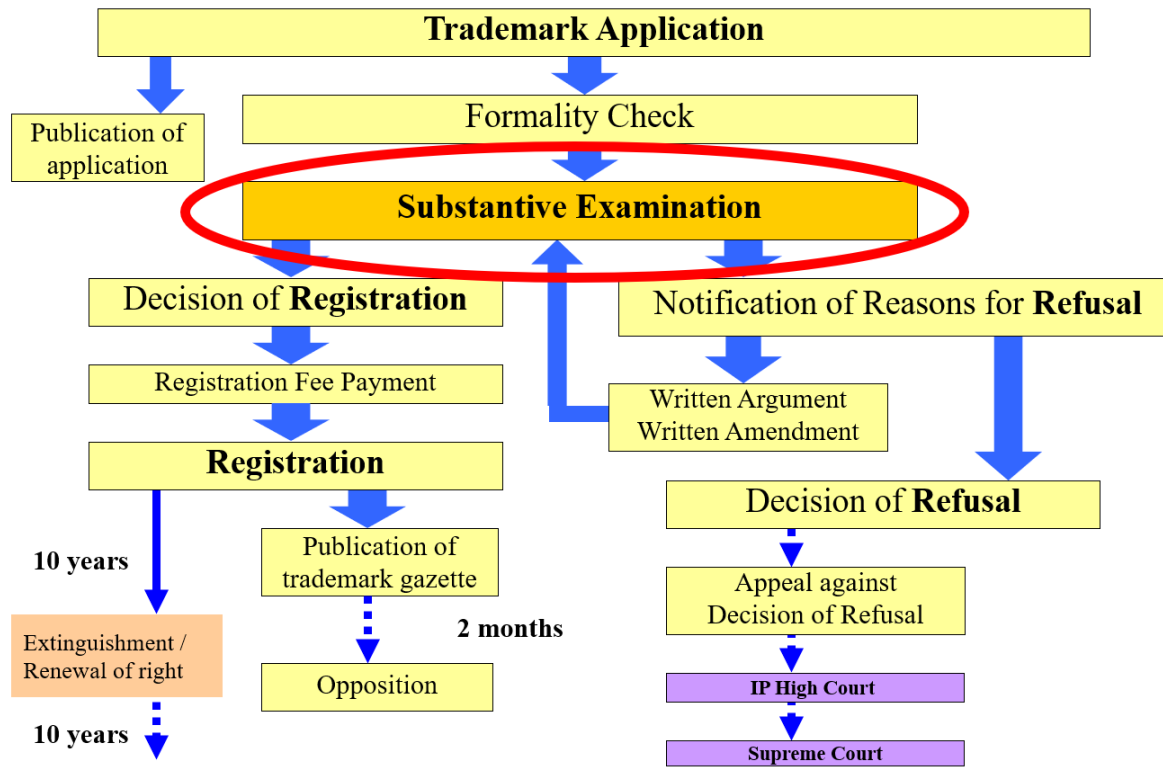
Proving Use of Trademarks in TM5 Offices

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Procedures for Obtaining a Trademark Right



Cases where proving use of trademarks is required

Cases	Type(s) of Proof	Examples of Proof Methods
[Case 1] Doubts about use or the intent to use	Facts of use	<ul style="list-style-type: none"> • Advertising materials (catalogs that show the goods handled, etc.) • Business documents of the goods handled (invoices, receipts, etc.)
	Intention of use	<ul style="list-style-type: none"> • Documents clearly specifying the intention to use the trademark • Documents outlining the preparations for the planned operation
[Case 2] Trademark lacks distinctiveness	<ul style="list-style-type: none"> • Facts of use • Distinctiveness through use 	<ul style="list-style-type: none"> • Photos, movies, etc. showing the actual state of use of a trademark • Business documents (purchase orders, bills, receipts, etc.) • Advertisements (newspapers, magazines, TV commercials, etc.) used by the applicant, and proof of her/his past record • Articles (magazines or online, etc.) presenting the trademark in an application by persons other than the applicant • Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark

1. Case where there is doubt about use or the intention to use

- The trademark must be used in connection with the goods or services pertaining to the applicant's business.
- 1. ~ 4. are regarded as reasons for refusal since it is judged to be doubtful whether or not the trademark is used.

1. Designation of a wide range of goods or services in one class
2. Designation of more than one of the retail services that are not similar to each other
3. Designation of general retail services by an individual
4. Designation of services that need qualifications

1-1. Methods to prove *the fact of use*

■ Examples of documents (Wide range designation, Several retail services, General retail services)

- a) Printed matter such as catalogs and leaflets including the goods by the applicant
- b) Photographs of the interior of the store operated by the applicant, and the goods that s/he handled
- c) Business documents showing goods handled by the applicants (delivery slips, bills, receipts, etc.)
- d) Articles on newspapers, magazines, internet, etc. presenting the content of business and goods handled by the applicant.
- e) Documents stating the sales amount of the goods related to retail services (only general retail services)

1-1. Methods to prove *the fact of use*

■ Points to confirm (General retail services)

- i) that the applicant is a retailer or wholesaler.
- ii) that the above retailer or wholesaler is providing retail services at one establishment for a variety of goods in each of the fields of clothing, foods/beverages, and livingware, and taking all goods together.
- iii) that the sales of the above goods account for around 10% to 70% of the total sales.

■ Points to confirm (Services which require qualification)

- iv) that the applicant has the national qualification as an individual
- v) that the applicant is a juridical person that may execute the business connected with the designated services

1-2. Methods to prove *the intention of use*

- The following documents should be submitted regarding the intention of use:
 - (i) Document clearly stating the applicant's intention to use the trademark
 - (ii) Document outlining preparations for the planned operation

Example of (i)

Declaration of Intention to Start Using the Trademark

Currently, our company does not conduct the business connected to the designated goods or designated services, but we have a business plan to manufacture the designated goods "XX" or transfer the right to manufacture the designated goods "XX" including selling them, or a business plan to provide the designated services therefor, and we plan to start using the trademark around MM in YY.

The above statement is true and correct.

Date: day/month/year

Applicant:

Address:

Name of Company:

Name of Representative:

Example of (ii)

Business Plan

Outline of the Plan

MM, YY Plan to start construction of or borrow a plant or store

MM, YY Plan to start manufacturing or selling goods

Date: day/month/year

Applicant:

Address:

Name of Company:

Name of Representative:

2. Cases where a trademark lacks distinctiveness

- Trademarks that lack distinctiveness cannot be registered (Article 3(1)(i)~(v)).
- However, the trademark may be registered if it acquires distinctiveness as a result of use (Article 3(2)).

Examples of trademarks unable to be registered

- Quality of the Goods or Services

Trademark “wool” for designated goods “sweaters”

- Common Surname

Common surname: e. g., “Suzuki”

- Very Simple and Common Marks

Single letters: e. g., “A”

Mere numbers: e. g., “12”

Simple figures: e. g., “□”



**Registration may be possible
if distinctiveness is acquired.**

2. Cases where a trademark lacks distinctiveness

- The requirements for registration by acquiring distinctiveness through the use of the trademark

1. The identity between the trademark applied for, and the trademark used

Trademarks whose differences are recognized as not affecting the identity of the trademark : OK

Example 1: $\begin{matrix} A \\ B \\ C \end{matrix}$ and ABC **OK** **Example 2:** \bigcirc P and \square P **NG**

2. The identity between the designated goods/services and the used goods/services

Goods/Services whose differences are recognized as not affecting their identity by considering the actual state of transaction : OK

Example : "Ice candy" and "Chocolate flavored ice candy"

3. Recognition throughout the country

- It needs to be recognized throughout the country among consumers of the goods/services as an indication of the origin of a particular person.
- Grounds for consideration include the following: the period and area of the trademark's use, the amount of production and sales under the trademark, and the method, period, area and scale of advertising.

2-1. Methods of prove the fact of use and distinctiveness through use

- Evidence to prove that the trademark has acquired distinctiveness as a result of use

Examples

- 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/certificates of receipt), bills, receipts, account books, etc.)
- iii) Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proof of his/her 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 of the questionnaire intended for consumers regarding awareness of the trademark

(Reference) Related Articles

[Article 3]

(1) **Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered**, unless the trademark:

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- (i) consists solely of a mark indicating, in a common manner, the common name of the goods or services;
- (ii) is customarily used in connection with the goods or services;
- (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, in the case of services, the location of provision, quality (…);
- (iv) consists solely of a mark indicating, in a common manner, a common surname or name;
- (v) consists solely of a very simple and common mark; or
- (vi) in addition to 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.

(2) 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.**

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**Thank
You!**

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