

TM5

Guidelines for Application Requirements for Three-Dimensional Marks



Table of Contents

Sample three-dimensional marks:	4
Identifying the Mark	5
1. Must a three-dimensional mark (3D mark) be filed on a special application form? Please provide a link to proper online form.....	5
2. Are fees for a 3D mark the same as for a word mark or other figurative mark? Please provide amount if fees are not the same.....	5
3. Does your office list a special type or category of mark on your application form? If so, is “three-dimensional mark” listed as a special type or category of mark?.....	6
4. How would a three-dimensional mark be identified or designated when the applicant is filing?.....	7
5. Are 3D marks that feature a literal element registrable? If yes, please specify how this is indicated in application.....	7
6. Are 3D marks that do not feature a literal element registrable?.....	8
7. Are there any restrictions under national law as to what types of 3D marks may be registered? If yes, please indicate section(s) of law.....	8
8. Is matter that performs a function (is utilitarian) registrable? If no, please indicate criteria/standard used to make such a determination and include citation to law or court decision.....	9
9. Are there limits on what types of three-dimensional marks are registrable?.....	10
10. Does your office allow disclaimers?.....	11
11. If your answer to 5) and 10) was “yes,” may 3D marks that feature a literal element be:.....	12
Reproduction of the Mark	12
12. Is a graphical representation required?.....	12
13. How many renditions of a three-dimensional mark are permissible under national law?.....	13
14. A. Must a reproduction of a 3D mark be a pen-and-ink or computer-aided-design (CAD) line drawing?.....	13
15. If answer to 14.B. is “yes”.....	15
16. Is a description of the mark required by law or registration? If “no,” may a description be included voluntarily?	16
17. If your office requires or accepts a description of the mark, please provide a possible acceptable description of the mark for Example 1.....	17
Examples of Product Configuration Marks	17
18. Do you require a photograph showing an example of a 3D mark that consists of the product itself?.....	17
Searching Your Office Database for Three-Dimensional Marks	18
19. How does an examiner or applicant search for similar marks on your database?.....	18

20. A. Is your database of marks able to be searched online? If so, please provide a link to your searchable mark database.....19

21. If answer to 20.A. is “yes,” are there instructions for use of the search features online? If “yes,” please provide link to online material.....20

22. How would a user search your database for the mark in Example 1?21

23. How would a user search your database for the mark in Example 2?22

24. How would a user search your database for the mark in Example 3?23

25. What is the standard for determining likelihood of confusion for 3D marks?.....23

26. Would a two-dimensional image be a potential bar under relative grounds against a three-dimensional mark for related or identical goods or services?.....25

Distinctiveness..... 25

27. Can a three-dimensional mark for a product design ever be inherently distinctive? If yes, please provide an example of a registered product design mark that is inherently distinctive.....25

28. Can a three-dimensional mark comprising product packaging ever be inherently distinctive? If yes, please provide an example of a product packaging mark that is inherently distinctive.....28

Acquired Distinctiveness..... 30

29. Does your office recognize claims of acquired distinctiveness? If yes, please answer the questions 30-43 below.....30

30. What is the standard for acquired distinctiveness?31

31. What factors are required for proving acquired distinctiveness? Please provide a link to any online guidance. 31

32. What type of evidence is required to prove that a mark has acquired distinctiveness? Please provide a link to any online guidance.32

33. What amount of evidence is required to prove that a mark has acquired distinctiveness?.....34

34. Is evidence dependent upon geographic coverage (for example, is nationwide fame necessary)?34

35. What evidence is considered stronger or more probative?35

36. If a three-dimensional mark is refused, can an applicant overcome the refusal during examination and does the applicant have a deadline by which to submit the evidence?.....36

37. Please provide two examples of three-dimensional marks where sufficient evidence of acquired distinctiveness was provided to overcome a refusal.....37

38. Must the evidence provided in support of registration be legalized, notarized, certified or similar?.....40

39. If the evidence must be legalized, notarized, certified or similar, please explain the process and requirements in order for the evidence to be acceptable.....40

40. If a mark has registered on the basis of acquired distinctiveness, how is that indicated in your database?.....41

41. If your office accepts evidence of acquired distinctiveness, in what language must the evidence appear?.....42

42. If the evidence is in a foreign language, must it be translated? If yes, must this translation be certified or notarized?.....43

Additional Information for Users..... 43

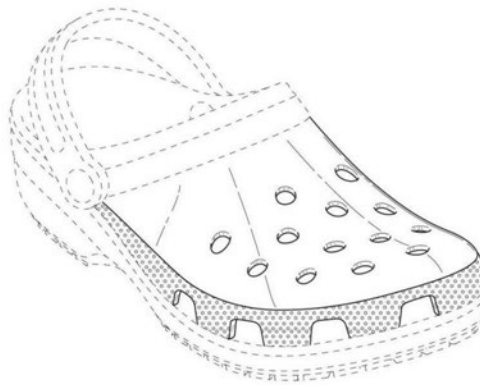
- 43. Does your office have a specific webpage with information about applying for three-dimensional marks?.....43
- 44. Does your office have any additional information about applying for three-dimensional marks that is not available online? If so, please attach this information with your response to this questionnaire.....44

Sample three-dimensional marks:

Example 1



Example 2



Example 3



Identifying the Mark

1. **Must a three-dimensional mark (3D mark) be filed on a special application form? Please provide a link to proper online form.**

USPTO

The USPTO does not have a specific application form for applying for three-dimensional marks. The applicant would choose one of the online TEAS forms for filing this mark, found at:

<https://www.uspto.gov/trademarks-application-process/filing-online/index-all-teas-forms>.

CNIPA

The CNIPA does not have a special application form for applying for three-dimensional marks.

The applicant could choose the general application form, and declare his application as a three-dimensional mark in the application form.

<http://sbj.cnipa.gov.cn/sbsq/sqss/201705/P020190226550868431181.doc>

EUIPO

The EUIPO does not make any differentiations between different kinds and types of trade marks as to the form of filing. All EUTM applications may be sent to the Office electronically (e.g., through e-filing), by post or by private delivery service.

The online tool to apply for an EUTM can be found at: <https://euipo.europa.eu/ohimportal/en/apply-now>.

JPO

The JPO does not have a specific application form for applying for three-dimensional marks. The applicant would use the common application form found at:

<https://www.jpo.go.jp/e/faq/yokuaru/forms.html>.

KIPO

The KIPO does not have a specific application form for applying for three-dimensional marks. The applicant would choose one of the online forms for filing this mark, found at:

<http://www.law.go.kr/lsBylSc.do?tabMenuId=tab174&eventGubun=060118>.

2. **Are fees for a 3D mark the same as for a word mark or other figurative mark? Please provide amount if fees are not the same.**

USPTO

Yes, the fees are the same.

CNIPA

Yes, the fees are the same.

EUIPO

Yes, the fees are the same:

- The basic fee covers one class for EUR 850 (e-filing) / EUR 1000 (paper filing)
- The fee for the second class of goods and services is EUR 50
- The fee for three or more classes is EUR 150 for each class

Applying for Collective and certification trade marks costs EUR 1500 (including one class) when filing electronically and EUR 1800 if using paper form. Same rules as above for additional class fees.

JPO

Yes, the fees are the same.

KIPO

Yes, the fees are the same.

3. Does your office list a special type or category of mark on your application form? If so, is “three-dimensional mark” listed as a special type or category of mark?

USPTO

The USPTO does not have a specific manner for indicating a special type or category for three-dimensional marks on the application form. The applicant would designate it is filing for a “special form” mark which includes figurative elements, words in stylized form and words combined with figurative elements.

CNIPA

Yes, the application form provides a list of application declarations, and it includes three-dimensional marks. The applicant could choose it to declare that the application is for a three-dimensional mark.

EUIPO

Yes, according to Article 3(3) of the [European Union trade mark Implementing Regulation \(EU\) 2018/626](#) (EUTMIR) the application concerning any of the trade mark types listed shall contain an indication to that effect and the EUIPO application form indeed contains such indication.

Shape marks are listed under Article 3(3)(c) EUTMIR, where they are defined as trade marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The term ‘extending to’ implies that these marks cover not only shapes per se, but also shapes that contain word or figurative elements such as logos or labels.

JPO

The applicant has to list “Three-dimensional mark” next to “Trademark for which registration is sought” on the application form.

KIPO

Yes. The KIPO provides a specific category on the application form to designate the type of mark. The applicant would select one, by checking a box on the form, among listed marks which includes three-dimensional marks.

4. How would a three-dimensional mark be identified or designated when the applicant is filing?

USPTO

When entering the mark in the application form, the applicant must pick a drawing type from the following options:

- Standard character
- Special form
- Sound

When applying for a 3D mark, the applicant would select “special form.” The applicant must specify in the Mark Description section that the proposed mark is three-dimensional. See TMEP §§[808.1202.02\(c\)\(i\)](#), and [1202.02\(c\)\(ii\)](#).

CNIPA

The applicant should declare that his application is a three-dimensional mark and submit a reproduction. The reproduction should contain at least three views.

EUIPO

When applying for a mark, the applicant must tick in the application form the appropriate type of mark as stated by Article 3 EUTMIR. Where the application concerns any of the trade mark types listed in points (a) to (j) it shall contain an indication to that effect and the type of the trade mark and its representation shall accord with each other following the definitions and representation requirements provided in Article 3(3) EUTMIR.

JPO

When applicants file applications to register three-dimensional (3D) trademarks, the applicants need to describe in application forms that claimed trademarks are 3D marks. Also, when necessary to identify claimed trademarks, applicants must provide “detailed description of trademark,” i.e., detailed written descriptions of their claimed trademarks. In addition, it needs to be apparent that trademarks described in applications constitute 3D marks.

KIPO

When applying for a 3D mark, the applicant would select “three-dimensional mark” in the Trademark Type section.

5. Are 3D marks that feature a literal element registrable? If yes, please specify how this is indicated in application.

USPTO

Yes. The applicant would enter the words, numerals or characters in the box labeled “LITERAL ELEMENT” on the TEAS electronic filing form.

CNIPA

Yes, the applicant could include text elements and/or graphic elements in the submitted reproduction. If the applicant wants, he or she could describe this text elements and/or graphic elements in the trademark description column of the application form.

EUIPO

Yes, they are registrable, although there is no specific indication of the literal element which is represented in the sign. The mark is nevertheless protected as it appears in the application (including the word element that can be displayed in the shape element).

JPO

Yes. The applicant should submit a mark whose three-dimensional shape and literal elements are inseparable and recognized as a three-dimensional mark as a whole in the application form.

KIPO

Yes. 3D marks that feature a literal element are registrable. A drawing should include a literal element if there is a literal element in the mark.

6. Are 3D marks that do not feature a literal element registrable?**USPTO**

Yes.

CNIPA

Yes, if they have distinctive characteristics.

EUIPO

Yes, shape marks are trade marks which consist of, or extend to, a three-dimensional shape, therefore they do not necessarily need to contain any other element for these to be registrable. However, shape marks will be registrable as long as they are distinctive and don't fall foul of any other ground within Article 7 EUTMR. In this regard, the EU Courts have held that a sign that consists of the external appearance of the goods will normally not be perceived as a badge of origin, unless it 'significantly departs from the norms of the sector' or if it has acquired distinctiveness through use (secondary meaning).

JPO

Yes.

KIPO

Yes.

7. Are there any restrictions under national law as to what types of 3D marks may be registered? If yes, please indicate section(s) of law.**USPTO**

No. Any three-dimensional mark can be registered as a trademark as long as it is capable of functioning as a source identifier. However, matter in the mark that is functional cannot be registered and matter that is non-distinctive cannot be registered on the Principal Register without a showing of acquired distinctiveness. Marks deemed non-distinctive but "capable" of indicating source may be allowed on the Supplemental Register. See TMEP Section 801.02(a) for more information about the Supplemental Register.

CNIPA

Registration shall be refused where a three-dimensional mark produced by the nature of the commodity itself, the shape of the commodity necessary for obtaining technical effects, the shape of the commodity that makes the commodity of substantial value and the shape that lacks distinctive characteristics. Trademark Law Article 11(1), Article 12.

EUIPO

No. There are no actual "types" of shape marks.

As explained, Article 3(3)(c) EUTMIR, defines these as trade marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The term 'extending to' implies that these marks cover not only shapes per se, but also shapes that contain word or figurative elements such as logos or labels. Hence any sign falling into this category could be registered as such.

JPO

There are no restrictions under national law as to what types of three-dimensional marks may be registered. However, matter that is non-distinctive cannot be registered without a showing of acquired distinctiveness. Besides that, a trademark consists solely of three-dimensional shapes spontaneously arising from the goods, and a trademark consisting solely of three-dimensional shapes which are essential to secure the functions of the goods, cannot be registered.

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0316.pdf>

KIPO

No. Any three-dimensional mark can be registered as a trademark as long as it is capable of functioning as a source identifier. However, matter in the mark that is functional cannot be registered and matter that is non-distinctive cannot be registered without a showing of acquired distinctiveness.

- 8. Is matter that performs a function (is utilitarian) registrable? If no, please indicate criteria/standard used to make such a determination and include citation to law or court decision.**

USPTO

Matter that is functional cannot be registered. See 15 U.S.C. §1052(e)(5) and further explanation in TMEP §[1202.02\(a\)-\(a\)\(ii\)](#). Matter that is a generic configuration of packaging cannot be registered. Matter that is not distinctive cannot be registered without a showing of acquired distinctiveness. See TMEP §[1202.02\(b\)\(ii\)](#).

A feature is functional as a matter of law if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article." Please see TMEP §[1202.02\(a\)\(iii\)\(A\)](#) for more information on functionality.

CNIPA

No.

Trademark Law, Article 12.

EUIPO

Article 7(1)(e) EUTMR excludes from registration signs that consist exclusively of (ii) the shape of another characteristic of goods that is necessary to obtain a technical result.

The Court of Justice of the European Union has rendered two leading judgments concerning the subject of essentially functional shapes, which provide guidance concerning the examination of trade marks consisting exclusively of functional shapes (preliminary ruling of 18/06/2002, C-299/99, Remington, EU:C:2002:377; judgment of 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516) interpreting, inter alia, Article 3(1) of the Trade Mark Directive, which is the equivalent of Article 7(1) EUTMR.

In assessing an EUTM application against Article 7(1)(e)(ii) EUTMR, consideration should be given to the meaning of the expression 'technical result', which should be interpreted broadly. It includes shapes or other characteristic that, for example fit with another article, give the most strength, use the least material, or facilitate convenient storage or transportation. Other characteristic of the goods that are necessary to obtain a technical result may include particular sounds

JPO

Matter that is not distinctive cannot be registered.

See Article 3(1)(iii) of the Trademark Act. Matter that indicates, in a common manner, shape (including shape of packages) of goods or articles to be used in service provision cannot be registered because of lack of distinctiveness. See Examination Guidelines for Trademarks, Part I Chapter 5: Article 3(1)(iii) for more information.

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0105.pdf>

Matter that is functional cannot be registered.

See Article 4(1) (xviii) of the Trademark Act. A three-dimensional shape consisting solely of characteristics which its goods, etc. (meaning its goods or packages, or services) must naturally have, cannot be registered. See Examination Guidelines for Trademarks, Part III Chapter 16: Article 4(1) (xviii) for more information.

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0316.pdf>

KIPO

Matter that is functional cannot be registered.

See Article 34(1).15 of the Trademark Act and Part 5 of the Trademark Examination Guidelines- Any trademark consisting solely of the three-dimensional shape, color, combination of colors, sound, or smell, which is to secure the function of goods intended to obtain trademark registration or of the package of such goods.

9. Are there limits on what types of three-dimensional marks are registrable?**USPTO**

No. Any three-dimensional mark can be registered as a trademark as long as it is capable of functioning as a source identifier. However, matter in the mark that is functional cannot be registered and matter that is non-distinctive cannot be registered on the Principal Register without a showing of acquired distinctiveness. Marks deemed non-distinctive but "capable" may be allowed on the

Supplemental Register. See TMEP Section 801.02(a) for more information about the Supplemental Register.

CNIPA

Registration shall be refused where a three-dimensional mark produced by the nature of the commodity itself, the shape of the commodity necessary for obtaining technical effects, the shape of the commodity that makes the commodity of substantial value and the shape that lacks distinctiveness characteristics.

EUIPO

No. A shape mark can be registered as long as it is distinctive, meaning that it should be able to identify the product and/ or services in respect of which registration is applied for as originating from a particular undertaking. It is Article 7 (1)(e) EUTMR which excludes from registration signs that consist exclusively of i) the shape or another characteristic that results from the nature of the goods themselves; ii) the shape or another characteristic of goods that is necessary to obtain a technical result; or iii) the shape or another characteristic of the goods that gives substantial value to the goods.

Shapes that are unrelated to the goods or services themselves are usually distinctive.

JPO

There are no limits on what types of three-dimensional marks are registrable. However, three-dimensional trademarks, as is the case with two-dimensional trademarks, can be refused for lacking distinctiveness or some other reasons under the Trademark Act. Matter that is non-distinctive cannot be registered without a showing of acquired distinctiveness.

Besides that, a trademark consisting solely of three-dimensional shapes spontaneously arising from the goods, and a trademark consisting solely of three-dimensional shapes which are essential to secure the functions of the goods, are not registrable.

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0316.pdf>

KIPO

No. The KIPO does not limit the types of three-dimensional trademarks that are registrable. As the answer to the Question 7 above, matter in the mark that is functional cannot be registered and matter that is non-distinctive cannot be registered without a showing of acquired distinctiveness.

10. Does your office allow disclaimers?

USPTO

Yes. See 15 U.S.C. §1056 and [TMEP §1213 and also §1202.02\(c\)\(ii\)-\(c\)\(iii\)\(B\)](#).

CNIPA

Yes.

EUIPO

No, as from 23 March 2016, verbal disclaimers are no longer possible.

However, visual disclaimers have been explicitly foreseen for position marks.

JPO

No.

KIPO

No.

11. If your answer to 5) and 10) was “yes,” may 3D marks that feature a literal element be:

A. Registered in their entirety?

B. Registered only with a disclaimer of the 3D shape?

USPTO

- a) Yes, both shape and literal element are registrable provided the shape is distinctive or has acquired distinctiveness and is not utilitarian/functional.
- b) A disclaimer of the overall three-dimensional shape is not required, but utilitarian/functional elements of the three-dimensional shape must be shown in dotted lines to indicate those aspects are not part of the mark being claimed. Further information about disclaimers of unregistrable elements of three-dimensional marks can be found at TMEP §1202.02(c)(ii)-(c)(iii)(B).

CNIPA

Both shape and literal element are registrable provided the shape is distinctive or has acquired distinctiveness and is not functional.

But if the shape is not distinctive, the applicant should include a disclaimer for the 3D shape.

EUIPO

- a) Yes, as explained, shape marks extend to other possible elements, such as words or labels that might give the trade mark distinctive character.
- b) As explained, no verbal disclaimers are possible. The shape mark, as applied for, will be examined as a whole, with all other elements, if any, included.

JPO

N/A

KIPO

N/A

Reproduction of the Mark

12. Is a graphical representation required?

USPTO

A graphical representation of the mark is required for a three-dimensional mark. See TMEP §[807.10](#) for more information.

CNIPA

Yes.

EUIPO

As a general rule, no. Pursuant to Article 4 EUTMR, an EUTM is no longer required to be represented graphically, as long as it is represented in a manner which enables the public and the competent authorities to determine the subject matter of protection with clarity and precision. However, when it comes to shape marks, Article 3 of the EUTM Implementing Regulation requires applicants to submit either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction.

JPO

Yes.

KIPO

Yes.

13. How many renditions of a three-dimensional mark are permissible under national law?**USPTO**

The USPTO allows the applicant to register only a single rendition of the mark appearing in three dimensions. An applicant may petition to waive the requirement for a single rendition in order to show multiple views if necessary to accurately depict the mark. See TMEP §§[807.01](#) and [807.10](#) for more information.

CNIPA

The graphic should contain three views at least.

EUIPO

Where the representation is not provided electronically, it may contain up to six different views.

JPO

The applicant would attach a drawing(s) or a photograph(s) to the application form to depict a view or two different views of the mark. There are no restrictions as to how many renditions of a three-dimensional mark are permissible.

KIPO

The applicant must provide two to five drawings or pictures of the mark.

- 14. A. Must a reproduction of a 3D mark be a pen-and-ink or computer-aided-design (CAD) line drawing?**
- B. If answer to A. is "no," is a photograph acceptable?**
- C. If answer to B. is "yes," please indicate any requirements for photograph submissions and provide link to any online guidance.**

USPTO

- A. No.

- B. Yes.
- C. Drawings consisting of either illustrated renderings or photographs of the mark are both subject to the same drawing requirements and must fairly represent the mark. See TMEP §807 for more information.

A photograph may be acceptable if it accurately depicts the mark and does not show additional matter that is not part of the mark. For example, a photograph of trade dress is not acceptable if it includes unnecessary background elements or informational matter such as net weight or contents.

CNIPA

- A. No.
- B. Yes.
- C. The photograph should be clear enough to determine the three-dimensional shape and contain three views at least. The length and width of the photograph should not be greater than 10 centimeters, not less than 5 centimeters.

EUIPO

- A. No, shape marks can be represented by submitting either a graphic reproduction of the shape including computer-generated imaging, or a photographic reproduction.
- B. Yes, as explained above.
- C. All acceptable formats are JPEG, OBJ, STL, and X3D. Link to table with all acceptable formats can be found here: <https://euipo.europa.eu/ohimportal/en/elimination-of-graphical-representation-requirement>.

JPO

- A. No.
- B. Yes.
- C. The applicant would attach a photograph(s) to the application form to depict a view or two different views of a 3D mark.

A photograph of a 3D mark must meet the following requirements:

- Sizes: 8x8cm. However, 15x15cm is acceptable when it is deemed absolutely necessary.
- The background must be plain.
- Photographs which should not easily deteriorate or fade.
- Photographs must be firmly attached to the application form without hiding the descriptions, and should not be folded.

When attaching photographs of the mark to show its more than one different views, the applicant must use the images to the same scale and leave a space between them.

KIPO

- A. No.
- B. Yes.
- C. The applicant must provide two to five drawings or photographs which clearly show features of the 3D trademark.

A 3D mark drawing may be rejected for the following reasons:

- Not shown in 3D shape
- 3D shape is shown separately from other flat surface features of the mark (see example below)
- Inconsistency of submitted drawings

A photograph of drawing of 3D mark must meet the following requirements:

- Size: width 210mm x length 297mm
- Photographs or drawing should not be deteriorated or faded
- Form of image: resolution must be from 300 dpi to 400 dpi of JPEG or PNG

✓ Wrong specimen



Not illustrated in 3D shape



3D shape is illustrated separately from the plane mark



3D shapes described in the specimen field do NOT match with one another

✓ Correct specimen



15. If answer to 14.B. is "yes":

- Must functional matter be included in reproduction?
- How is functional or informational matter indicated?
- Must informational or functional matter be disclaimed?

USPTO

- No. It may be included if it assists in providing perspective or shows placement of mark, such as the cap or the threading on the neck of a bottle as in Examples 1 and 3.
- Functional elements should be depicted in dotted or broken lines in the reproduction. See Examples 1 and 3, above. The description of the mark must also explain the functional matter is not a feature of the mark. See TMEP §§[807.08](#) and [1202.02\(c\)\(i\)](#) for more information.
- Because functional elements of a three-dimensional mark are unregistrable and cannot form part of the mark, a disclaimer is not an appropriate means of addressing functional matter in

a trade dress mark. See TMEP §1202.02(c)(iii)(A). Informational matter may be disclaimed or, in some cases, deleted from the drawing. See TMEP §807.14(a).

CNIPA

- A. No.
- B. There is no special requirement.
- C. Yes. If the applicant does not include a disclaimer, the examiner may require the applicant to do it.

EUIPO

- A. There is no such obligation.
- B. A shape mark will be examined as represented, with all elements it may contain and/or to which it may extend.
- C. There is no obligation (and no possibility) to disclaim any particular matter, as such.

JPO

- A. No.
- B. Functional matter is not required to be indicated in the reproduction. Indication of functional or informational matter is also not required.
- C. N/A

KIPO

- A. No
- B. N/A
- C. N/A

16. Is a description of the mark required by law or registration? If “no,” may a description be included voluntarily?

USPTO

The USPTO requires a detailed description of the mark. The applicant must include all elements of the mark in the description, including colors and any literal elements. The description must also indicate that the mark is three-dimensional and that dotted or broken lines represent matter that is not claimed as a feature of the mark. See TMEP §§[808](#) and [1202.02\(c\)\(i\)](#) for more information.

CNIPA

No, if the photograph could determine the three-dimensional shape.

If the applicant wants, he could submit a description in the trademark description column of the application form.

EUIPO

No, descriptions are always optional, where expressly allowed by the legislation. In this sense, Article 3(2) EUTMIR expressly states where trademarks descriptions are possible, and this is for position marks, pattern marks, colour combination marks and hologram marks. For ‘Other’ marks (mentioned in Article 3(4) EUTMIR) there is also the possibility to accompany the representation of the trade mark by a description. No description has therefore been made available for shape marks.

JPO

When applicants file applications to register three-dimensional trademarks, and if they need to identify claimed trademarks, the applicants must provide "detailed description of trademark," i.e., detailed written descriptions of their claimed trademarks. (Article 5(4) of the Trademark Act of Japan, Article 4-8 (1) and (2) of the Ordinance for Enforcement of the Trademark Act).

KIPO

A description of the mark is not mandatory but the applicant may voluntarily provide it.

17. If your office requires or accepts a description of the mark, please provide a possible acceptable description of the mark for Example 1.

USPTO

The following could be an acceptable description of the mark for Example 1:

"Color is not claimed as a feature of the mark. The mark consists of a three-dimensional configuration of the container for the goods, namely, a bottle consisting of two concave sides, a neck, and a cap, the two concave sides creating an impression of the body of a cello or violin. The dotted outline of a portion of the neck and the entire cap of the bottle is not claimed as a feature of the mark."

CNIPA

"The trademark consists of a three-dimensional container for goods. It looks like a violin."

EUIPO

N/A

JPO

*This "Detailed Description of Trademark" is just an example.

"A trademark for which registration is sought is the three-dimensional (3D) trademark of the container for the goods. It must be noted that dotted lines are only provided to show an example of the shape of the cap part, and do not constitute a part of the trademark. "

KIPO

A description is not required when filing an application for a 3D mark, however, the following example can be accepted. KIPO would also require that the dotted line in the mark be represented as a solid line.

"The trademark consists of a three dimensional violin shaped container for goods."

Examples of Product Configuration Marks

18. Do you require a photograph showing an example of a 3D mark that consists of the product itself?

USPTO

Yes, in most cases. To show the 3D mark in use in the marketplace, an acceptable "specimen of use" is a photograph of the goods. To show a 3D mark in use for services, a photograph of the 3D object in the advertising or rendering of the services is required. See TMEP §§[904](#) and [1102](#) for more

information. Such photographs may be filed either with the application or later in the examination process. In applications relying solely on reciprocity under the Paris Convention or the Madrid Protocol, the USPTO may require a photograph to determine if the 3D mark is distinctive.

CNIPA

No. The applicant shall describe how it uses the 3D trademark in the application form.

EUIPO

No. The representation of shape marks requires the submission of either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction.

But no other requirement in that sense is required. It is nevertheless important to state that the filing of a sample or a specimen does not constitute a proper representation of a trade mark as explicitly mentioned under Article 3(9) EUTMIR.

JPO

No, a photograph showing an example of a 3D mark for which registration is sought is not required.

KIPO

No.

Searching Your Office Database for Three-Dimensional Marks

19. How does an examiner or applicant search for similar marks on your database?

USPTO

A search can be conducted for key words used in the description of the mark, such as shape, trade dress, configuration, design, three-dimensional, and packaging. In addition, USPTO design codes corresponding to the shape in the mark can be searched.

If the mark also contains a literal element, the literal element and any translations or variations that may be phonetic equivalents will also be searched. If the mark appears in color, the color as applied to packaging or containers will be searched by using design codes for any corresponding colors claimed in the mark or the name of the color in the mark description.

CNIPA

We use the graphic coding based on the Vienna classification (Second Edition) to index and search 3D marks.

If the 3D mark also contains text elements, the examiner should also search Chinese or English text elements. If the applicant declares the meaning of the foreign language, the Chinese meaning of French, Russian, Spanish and Arabic will also be searched.

EUIPO

The use of the advanced search to search within EUIPO's databases enables one to carry out a detailed search using a multitude of search criteria: filing date, trade mark type, trade mark representation, trade mark status, trade mark number, trade mark name, description (if any), by type of mark, Vienna classification, and also, to look for similar marks through an image based search.

JPO

When performing a search for similar figurative marks and three-dimensional marks in our database, an examiner or an applicant uses the Japanese Subsection Table of the Vienna Classification; the lower classification codes of the Vienna Classification of Figurative Elements of Marks under the Vienna Classification.

To search figurative marks including three-dimensional marks, the examiner or the applicant would select an appropriate code from the Japanese Subsection Table of the Vienna Classification according to the shape. Accordingly, the code enables them to perform a search for similar figurative marks.

If a 3D trademark includes literal elements, they would also perform a search for letter strings and pronunciations.

KIPO

A search can be conducted by using a KIPO code number (980300) or select a checkbox for three-dimensional marks and additionally a Vienna code for figurative marks assigned to the mark. In the case that the mark contains a literal element, it may also be searched by entering it in a search box.

20. A. Is your database of marks able to be searched online? If so, please provide a link to your searchable mark database.
- B. If answer to A. is "yes," is a fee required to use this service?
- C. If answer to A. is "yes," is a login account required to use this service?

USPTO

- A. Yes. It can be accessed at <https://www.uspto.gov/trademark>, select "Search TESS."
- B. There is no fee.
- C. A login account is not required.

CNIPA

- A. A. Yes. It can be accessed at http://wcjs.sbj.cnipa.gov.cn/txnT01.do?locale=en_US&locale=en_US; it is the English page and has five modes of trademark search.
- B. B. There is no fee.
- C. C. A login account is not required.

EUIPO

- A. Yes. It can be accessed at <https://euipo.europa.eu/eSearch/>. As explained, the advanced search tool enables one to filter trade marks per need, and there is also a possibility of doing an image search.
- B. There is no fee.
- C. A login account is not required.

JPO

- A. Yes, external users can access to the "J-platpat" database. Trademark and figurative mark search database can be accessed at: <https://www.j-platpat.inpit.go.jp/t0100>.
- B. There is no fee.

- C. A login account is not required.

KIPO

- A. Yes, a trademark database which is used by KIPO examiners is not available online but the Korean Institute of Patent Information (KIPI) provides a free online database service with data received from KIPO. (<http://kdtj.kipris.or.kr/kdtj/searchLogina.do?method=loginTM>).
- B. There is no fee.
- C. A login account is not required.

21. If answer to 20.A. is “yes,” are there instructions for use of the search features online? If “yes,” please provide link to online material.

USPTO


Additional information on searching is available here: <https://www.uspto.gov/trademarks-application-process/search-trademark-database> and <http://tmsearch.uspto.gov/webaka/html/help.htm>.

The Design Code Manual is available here: <http://tess2.uspto.gov/tmdb/dscm/index.htm>.

Videos with instructions on searching and other topics are available here:

<https://www.uspto.gov/trademarks-getting-started/process-overview/trademark-information-network>.

CNIPA

We give tips about search methods on the search page. When you click the icon (), the content will be displayed.

Guidelines for the declaration of goods and services and similar goods and services table:

<http://sbj.cnipa.gov.cn/sbsq/sphfwfl/>.

Graphic coding:

<http://sbj.cnipa.gov.cn/sbsq/txys/>

EUIPO

Yes; Instructions for use have been made available at the EUIPO webpage which can be found here: <https://euipo.europa.eu/ohimportal/en/eseach>.

JPO

Brief instructions on searching are available on our website.

Trademark and figurative mark search: <https://www.j-platpat.inpit.go.jp/help/en/t01/t0101.html>.

KIPO

Users can find search instructions here: <http://beginner.kipris.or.kr/beginner/beginnerMain.jsp>.

The English version of the search instructions is available here:

<http://eng.kipris.or.kr/enghome/tutorial/tutorial.jsp>.

A video tutorial and download on searching is available here:

http://www.kipris.or.kr/khome/guide/easy/easy_kdtj02.jsp.

The English version of video tutorial and download is available here:

http://eng.kipris.or.kr/enghome/guide/easy/easy_kpat.jsp

22. How would a user search your database for the mark in Example 1?

USPTO

Using the appropriate search field, key words from the description may be searched, such as violin\$, cello\$, bottle\$. The use of the dollar signs in the search will also yield the plural versions of these terms.

Design codes for various bottles may also be searched such as bottles with concave sides (design code 19.09.04), a catch-all "other bottles" category (design code 19.09.25), and the code for violins and similar stringed instruments (design code 22.01.07).

CNIPA

Examiners or users could search the code for violin (22.1.15) and the code for bottles (19.7.1).

EUIPO

[eSearch plus](#) uses image recognition technology to find similar-looking trade marks and designs. The search system analyses the colours, shapes and textures, rather than keywords as in the classic text-based search systems. The system allows for the upload of 1 image when searching for trade marks.

In order to perform a basic search by images similar to the mark in Example 1, please find some recommendations below (and [here](#)).

1. Click on the camera icon or in the dedicated box or drag and drop your image(s)- Supported file formats are JPEG, PNG, GIF and TIFF extensions, larger than 100x100 pixels and with a maximum size of 2 Megabytes.
2. Once your image(s) is uploaded, you can:
 - Click and adjust the rectangle to select the area of the image(s) to search.
 - Select if you want to search for trade marks, designs or both. When uploading 1 image you'll have the possibility to search for both, if uploading more than one image the system will show results only for designs.
 - Type the necessary characters in the search bar in case you want to do a combined search of an image along with trade mark name or design verbal elements.
3. You can preview the details of each trade mark or design, check full information about, zoom in the images or generate reports. In the design results tab you can also browse through the different views available of the design by clicking on the arrows at the side of the image.

Generate reports: Select the trade marks (or designs) you want to include in your report by clicking in the tick box next to each image and click on 'Generate PDF'. The report with your selection will be created instantly. You also have a 'select all' option. This option will allow you to select a maximum of 100 trade marks to include in the report.

To obtain further information of a trade mark or a design, hover over the image and select 'View full info'.

JPO

A user would select codes he/she thinks appropriate from the Japanese Subsection Table of the Vienna Classification at: <https://www.j-platpat.inpit.go.jp/t1101>.

Then, the user would enter, for example, the following codes he or she thinks appropriate to perform a search:

*11.3.1 Drinking vessels, cups (trophies)

*19.7.2 Bottles or flasks in horizontal cross section other than circular or elliptical

If he or she thinks another code is appropriate, it is possible to add the code to perform a search using the SQL "AND" condition or "OR" condition. One such example is:

22.1.15 Stringed instruments.

Meanwhile, if the user wishes to perform a search for three-dimensional marks only, it is also possible to add the following code:

40.1 Three-dimensional Mark.

KIPO

A search can be conducted by entering the code combining a KIPO code number for three-dimensional marks (980300) and a Vienna code (190702 or 190706 or 190709) for figurative marks.

*190702 bottles or flasks in horizontal cross section other than circular or elliptical

*190706 Bottles or flasks representing a human being, an animal, part of a human body or of an animal's body, or of an animal's body, or an inanimate object

*190709 Bottles or flasks, slender

23. How would a user search your database for the mark in Example 2?**USPTO**

Using the appropriate search field, key words from the description may be searched, such as shoe\$, clog\$, footwear\$ and sandal\$. The use of the dollar signs in the search will yield the plural versions of these terms.

Design codes may be searched, such as slippers (09.07.04), men's shoes (09.07.05), women's shoes (09.07.06), parts of shoes (09.07.08) and a catch-all category of "other stylized footwear" (09.07.25).

CNIPA

Search the code for shoes (9.9.1).

EUIPO

Same methodology as explained above.

JPO

The user would follow the same steps described in 22 above.

The following codes are considered appropriate to perform a search for the mark in Example 2.

*9.9.1 Footwear

A9.9.25 Other footwear.

KIPO

A search will be conducted by entering the code combining a KIPO code number (980300) for three-dimensional marks and a Vienna code (090914) for figurative marks assigned to the mark.

24. How would a user search your database for the mark in Example 3?

USPTO

Using the appropriate search field, key words from the description may be searched, such as bottle\$ or curve\$ or concave\$. The use of the dollar signs in the search will yield the plural versions of these terms.

Design codes for various bottles may be searched, such as bottles with concave sides (19.09.04), a catch-all "other bottles" category (19.09.25).

CNIPA

Search the code for bottles (19.7.1).

EUIPO

Same methodology.

JPO

The user would follow the same steps described in 22 above.

The following codes are considered appropriate to perform a search for the mark in Example 3.

*11.3.1 Drinking vessels, cups (trophies)

*19.7.1 Bottles or flasks in circular or elliptical horizontal cross section

A19.7.9 Bottles or flasks, slender

A19.7.17 Bottles or flasks with bulging, protruding or rounded sides.

KIPO

A search can be conducted by entering the code combining a KIPO code number for three-dimensional marks (980300) and a Vienna code (190702 or 190706 or 190709) for figurative marks assigned to the mark.

25. What is the standard for determining likelihood of confusion for 3D marks?

USPTO

The standard for determining likelihood of confusion is the same for three-dimensional marks as for two-dimensional marks: the likelihood of consumer confusion due to similarity of appearance, sound (if any), meaning and relationship of the goods and channels of trade.

Confusion may be found with similar shapes or even two-dimensional designs for the same shape for related goods and/or services or for the literal equivalent of words (e.g., CELLO BOTTLE or CELLO). The question is whether consumers would believe the marks identified the same source. Please see

TMEP §[1207.01\(c\)\(i\)](#) for more information about the comparison of words and their equivalent designs.

CNIPA

The standard for determining likelihood of confusion is the same for three-dimensional marks as for two dimensional marks.

First, it should be determined whether goods or services are the same or similar.

Secondly, it is necessary to judge whether the trademark itself is identical or similar by observing and comparing the main parts of the trademark as a whole, taking the general attention of the public concerned as a standard from the aspects of the shape, sound, meaning and the overall form of expression of the trademark.

At the same time, considering the distinctiveness of the trademark itself, prior trademark popularity and the use of the same or similar goods (services) easy to confuse the relevant public on the source of goods (services) and other factors.

EUIPO

The same basic principles for two-dimensional marks are to be applied equally to three-dimensional (shape) marks. The Office, upon a notice of opposition, will check the following relevant factors relating to likelihood of confusion:

- i. similarity of the goods and services;
- ii. the relevant public and the level of attention;
- iii. similarity of the signs taking into account their distinctive and dominant elements;
- iv. the distinctiveness of the earlier mark.

JPO

As is the case with two-dimensional marks, similarity for 3D marks is determined in a comprehensive manner based on the appearance, sound and concept.

See Examination Guidelines for Trademarks, Part III Chapter 10: Article 4(1)(xi).

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0310.pdf>.

Judgment on the similarity of trademarks is made by observing in whole the trademark as applied and the cited trademark by taking into consideration the impression, memory, association, etc., given to consumers by the appearance, sound or concept, etc., of such marks and then considering whether or not the trademark as applied is likely to cause confusion as to the source of goods or services with respect to the cited trademark when the trademark as applied is used for its designated goods or designated services.

KIPO

In principle, similarity of three-dimensional marks will be determined by comparison between three-dimensional marks (based on appearance, sound and concept).

In case a three-dimensional mark contains a literal or figurative element, since such element can cause confusion as to the source of the goods, character or figurative marks would be subject to searching.

As a three-dimensional mark, by nature, could appear differently depending on the angle you look at, similarity of three-dimensional marks will be determined based on the following criteria:

If the appearance of a three-dimensional mark perceived from a certain angle is the same as that of two-dimensional trademark, they will be considered similar.

The sound and concept of the mark can be created not only by the three-dimensional mark as whole but also the appearance of the trademark perceived from a certain angle.

26. Would a two-dimensional image be a potential bar under relative grounds against a three-dimensional mark for related or identical goods or services?

USPTO

Yes, a two-dimensional design for the same shape for identical or related goods or services may be a potential bar under the likelihood of confusion standard.

CNIPA

Yes.

EUIPO

Yes, in principle, a two-dimensional sign for identical or similar goods/services can indeed be a potential bar under relative grounds for refusal against a similar or identical three-dimensional (shape) marks, for similar or identical goods/services.

JPO

Yes, an identical or similar two-dimensional mark for identical or similar goods or services may be a potential bar under relative grounds against a three-dimensional mark for such goods or services, if someone has already filed an application for or registered a two-dimensional mark for such goods or services.

KIPO

Yes. If a two-dimensional image is similar to the appearance of a three-dimensional mark perceived from a certain angle, thereby causing confusion as to the source of the goods, it can be a potential bar.

Distinctiveness

27. Can a three-dimensional mark for a product design ever be inherently distinctive? If yes, please provide an example of a registered product design mark that is inherently distinctive.

USPTO

No. Per the U.S. Supreme Court, product design may only register with a showing of acquired distinctiveness. Please see TMEP § [1202.02\(b\)\(i\)](#) on Distinctiveness and Product Design Trade Dress for more information.

CNIPA

Yes.

Example:



Goods: chocolate, cocoa, candy, pastries

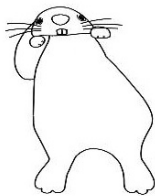
Registration No. G615994

EUIPO

Yes, a shape mark consisting of the shape of the goods themselves (which does not result from the nature of the goods, does not have an essentially technical function and does not give substantial value to the goods) can be inherently distinctive provided that the shape is so materially different from basic, common or expected shapes that it enables a consumer to identify the commercial origin of the goods just by their shape.

[EUTM 12269511](#)

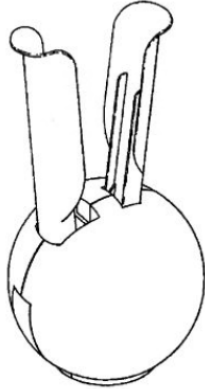
Accepted for protective covers for mobile phones in Class 9



JPO

Yes, a three-dimensional mark for product design can be inherently distinctive under the Trademark System in Japan.

Example 1



Reg. 4925446

Designated goods: Hand-operated pepper mills etc.

Trial decision: It has peculiar features that cannot be predicted from the uses and functions of products. It is beyond the scope of the shape of this kind of goods that can be usually adopted.

Example 2



Reg. M0803104 (expired April 4, 2013)

Designated goods: Chocolate, pralines

Court decision: The selection, combination and order of the arrangement of the four kinds of symbols, and the marble color are combined is new. It is sufficiently distinctive to make it a sign for consumers to decide to purchase goods.

KIPO

Yes. A three dimensional mark for product design may be registered if it has inherent distinctiveness or has acquired distinctiveness.

(example) ice cream



Registration No. 401138531.

28. **Can a three-dimensional mark comprising product packaging ever be inherently distinctive? If yes, please provide an example of a product packaging mark that is inherently distinctive.**

USPTO

Yes. The bottle shown below was determined to be an inherently distinctive product packaging mark for "sprits and liqueurs."



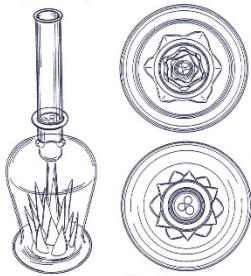
Registration No. 3825320

But, the US Supreme Court cautions that because it is often hard to distinguish between product packaging and product design, when there is any doubt as to type of mark, we must consider a mark to be product design and require the applicant to show acquired distinctiveness through evidence. Please see TMEP § [1202.02\(b\)](#) for more information on the distinctiveness of trade dress.

CNIPA

Yes.

Example:



Goods: Alcoholic beverages, except beer

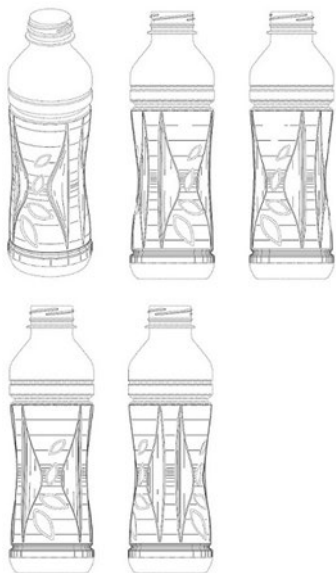
Registration No. 4612943

EUIPO

Yes, the same criteria described above in respect of the shape of the goods apply in respect of the packaging of the goods.

[EUTM 012485702](#)

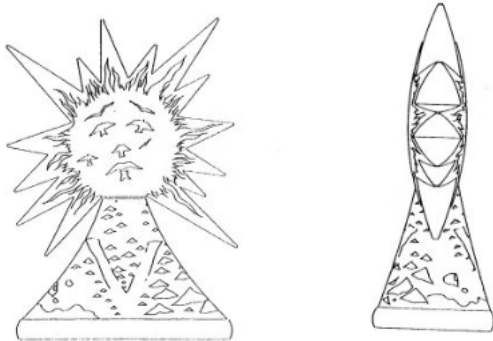
Accepted for goods in Classes 29, 30 and 32 (including milk beverages, coffee-based beverages, fruit juices and beers).



JPO

Yes, a three-dimensional mark for product packaging can be inherently distinctive under the Trademark System in Japan.

Example 1



Reg. 4170258

Designated goods: Cosmetics, perfume and flavor materials, etc.

KIPO

Yes. A three-dimensional mark comprising product packaging or container may be registered if it has inherent distinctiveness.

(example) ice cream



Registration No. 401413320

Acquired Distinctiveness

29. Does your office recognize claims of acquired distinctiveness? If yes, please answer the questions 30-43 below.

USPTO

Yes.

CNIPA

Yes.

EUIPO

Yes. Article 7(3) EUTMR enables trademarks which despite not complying with Article 7(1) (b),(c) or (d) to be registered provided it has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.

JPO

Yes.

KIPO

Yes.

30. What is the standard for acquired distinctiveness?**USPTO**

Consumers must perceive the mark as a source indicator.

CNIPA

After use, consumers are able to identify the source of goods or services through the mark.

EUIPO

There must exist, in the perception of the public, a link between the sign and the goods and services in the sense that the relevant class of persons, or at least a significant proportion thereof, identify the goods and services as originating from a particular undertaking because of the trade mark.

JPO

Consumers are able to recognize the goods or services as those pertaining to a business of a particular person as a result of the use of the trademark.

KIPO

When the trademark is recognizable to consumers as a trademark indicating the source of goods of a specific person as a result of using the trademark before filing an application for trademark registration, trademark registration may be granted limited to the goods on which such trademark is used.

31. What factors are required for proving acquired distinctiveness? Please provide a link to any online guidance.**USPTO**

Factors considered will include length and exclusivity of use, advertising expenditures, unsolicited media coverage, consumer studies, other evidence of consumer recognition, and promotional materials showing the applied-for mark used in a trademark manner (as opposed to merely illustrative or decorative manner) in advertisements. No single factor is determinative. See [TMEP §§1212 et seq.](#) for general discussion of acquired distinctiveness.

CNIPA

The following factors should be considered comprehensively:

- the public's recognition of the mark,
- the time and mode of use of the mark,

- sales volume, turnover and market share of goods/services using the mark;
- advertising and publicity coverage of goods/services using the mark;
- other factors that make the mark acquire distinctiveness characteristics.

More information in the Trademark Examination Standards:

http://sbj.saic.gov.cn/tzgg/201701/t20170104_233075.html.

EUIPO

In establishing acquired distinctiveness, account may be taken of, inter alia, the following factors:

- The market share held by the mark with regard to the relevant goods or services;
- How intensive, geographically widespread and long-standing use of the mark has been;
- The amount invested by the undertaking in promoting the mark for the relevant goods or services;
- The proportion of the relevant public who, because of the mark, identifies the goods or services as originating from a particular undertaking.

Here, we provide a link to the [Office Guidelines on Article 7\(3\) EUTMR](#), where more information on Standard of Proof, the actual assessment of the evidence or even information on length of use can be found.

JPO

2.(2), Part II: Article 3(2), Examination guideline

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0200.pdf>.

KIPO

As a result of exclusive use of a trademark by the trademark owner, acquired distinctiveness would be recognized factoring in length of use (in principle, we require a period of at least more than five years; however, even if the mark has been used less than five years, we can find acquired distinctiveness where other factors other than the time period can be sufficiently proved), the status of use, sales revenue and advertising records as well as characteristics of the goods in relation to the trademark. (See Chapter 9 'Acquired Distinctiveness' of Part 4 'Requirements for Trademark Registration' of the Trademark Examination Guidelines.)

32. What type of evidence is required to prove that a mark has acquired distinctiveness? Please provide a link to any online guidance.

USPTO

Length and exclusivity of use, advertising expenditures, sales success, unsolicited media coverage, consumer studies, survey evidence, other evidence of consumer recognition, and promotional materials showing the applied-for mark used in a trademark manner (as opposed to merely illustrative or decorative manner) in advertisements. See [TMEP §1212.06](#) for discussion of evidence of acquired distinctiveness.

CNIPA

Any evidence that could prove the five aspects listed in 31. The evidence should also clearly indicate the pending trademark, the designated goods and/or services, the date of using the trademark, and the trademark user's name.

EUIPO

Article 97 EUTMR contains a non-exhaustive list of means of giving or obtaining evidence in proceedings before the Office, which may serve as guidance to applicants. Examples of evidence that may help to show acquired distinctiveness include, inter alia:

- sales brochures
- catalogues
- price lists
- invoices
- annual reports
- turnover figures
- advertising investment figures and reports
- advertisements (press cuttings, billboard posters, TV adverts), together with evidence of their intensity and reach
- customer and/or market surveys
- affidavits.

The Office must make an overall assessment of all the evidence submitted (judgement of 04/05/1999, C-108/97 and 109/97, Chiemsee, EU:C:1999:230, § 49), weighing up each indication against the others.

More guidance can be found in the same [link](#).

JPO

2.(3), Part II: Article 3(2), Examination guideline

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0200.pdf>

KIPO

Those who claim the acquired distinctiveness need to provide evidence of ① a trademark in use, ② the goods to which the mark has been applied, ③ the fact that the mark has been used for a considerable length of period, ④ the fact that the mark has been used across the country or in a certain area, ⑤ production, manufacture, process, certification, sales volume, revenue and market share, ⑥ how and how often the mark has been used, ⑦ how and how often, and how long the mark has been advertised and what has been advertised, ⑧ objective consumer studies, ⑨ information which can prove quality or reputation of the goods, ⑩ data that prove the applied-for mark has been exclusively used.

33. What amount of evidence is required to prove that a mark has acquired distinctiveness?**USPTO**

No set amount is required. A claim of acquired distinctiveness is highly dependent on the nature of the mark and the goods and services and is determined on a case-by-case basis. The less distinctive the mark, the more evidence or higher quality evidence is required.

CNIPA

No set amount is required, but the more effective evidence the better. We take the rule of corroboration, and a single piece of evidence is not enough for proving acquired distinctiveness. All the evidence should constitute a chain, to show that the pending trademark has been widely or continuously used, and has been accepted by the public as a trademark.

EUIPO

Applicants should take great care to make sure not only that the evidence shows use of the mark applied for but also that it is sufficient to identify the dates of such use and the specific geographical territory of use within the EU. No precise or set amount of evidence is required. Evidence that cannot be related to a certain point in time will normally be insufficient to show that distinctiveness had been acquired before the filing date, and evidence of use outside the EU cannot show the required market recognition of the relevant public within the EU. Furthermore, evidence that mixes material relating to the EU with that relating to non-EU territories, and does not permit the Office to identify the specific extent of EU-only use, will be similarly devoid of probative value for the relevant EU public.

JPO

Evidence is required to show that the consumers of the goods or services throughout Japan are able to perceive the trademark as an indication of trade source, and the amount of evidence is less important.

KIPO

There is no set amount of evidence required to prove that the mark concerned has acquired distinctiveness by its use.

Any person who claims acquired distinctiveness may submit evidence that shows, for instance, 1) the mark which he/she has used, 2) specific goods on which he/she has used the mark, 3) the fact that the mark has been used continuously for a considerable period of time, 4) the fact that the mark has been used nationwide or in certain regions, etc.

34. Is evidence dependent upon geographic coverage (for example, is nationwide fame necessary)?**USPTO**

No, there are no geographic requirements. However, a showing of nationwide recognition of the mark would be strong evidence of acquired distinctiveness.

CNIPA

No. It should be based on the knowledge of the domestic public. Evidence of nationwide recognition is good for proving acquired distinctiveness.

EUIPO

Pursuant to Article 1 EUTMR, a European Union trade mark has a unitary character. Accordingly, a mark must be refused registration even if it is devoid of distinctive character only in part of the European Union. And as a logical consequence, acquired distinctiveness must be established throughout the territory in which the trade mark did not ab initio have distinctive character.

This may prove difficult and burdensome for the applicant, particularly when an objection exists throughout the European Union. Despite the fact that acquired distinctiveness must be shown throughout the European Union, the Court has held that it would be unreasonable to require proof of acquired distinctiveness for each individual Member State (judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307, §62). In light of this, the Office considers that in certain cases, it is possible to extrapolate from selective evidence to draw broader conclusions, and as a result, evidence showing distinctiveness acquired through use in certain Member States can be used to make inferences with regard to the market situation in other Member States not covered by the evidence.

Extrapolation is nevertheless only possible where the following two conditions are met:

- The market is homogenous; and
- At least some evidence of use is submitted for the area where the evidence is extrapolated.

Please find more information on Acquired distinctiveness and the referred extrapolation in the [following link](#). (paragraph 6.3).

JPO

Yes. "The consumers are able to recognize the goods or services as those pertaining to a business of a particular person" means that the consumers of the goods or services throughout Japan are able to perceive the trademark as an indication of trade source.

KIPO

Basically, it is assumed that a trademark has nationwide fame, but, in some cases, a trademark could have fame only in a certain area considering the nature of the goods.

35. What evidence is considered stronger or more probative?**USPTO**

"Direct" evidence is considered stronger and more probative. Direct evidence demonstrates that the applicant has been successful in educating the public to associate the proposed mark with a single source. Direct evidence may include affidavits or declarations by the consuming public asserting recognition of the mark as a source indicator, surveys or market research showing that the consuming public views the proposed mark as an indication of the source of the product or service, and advertisements promoting the mark, rather than promoting the goods generally. "Look for" advertising, which highlights the mark as identifying source, is particularly relevant.

Circumstantial evidence that demonstrates general exposure of the mark to the purchasing public but not that the public views the mark as a source indicator may be relevant but is not conclusive. This evidence may include long use of the mark in commerce, prior registrations, product advertising materials and expenditures, sales figures, and unsolicited media coverage.

See TMEP §[1212.06](#).

CNIPA

Evidence that directly proves that the applicant has used the trademark for a long time, continuously and authentically in the specified goods/services. And evidence that directly proves that consumers are able to distinguish goods/services from other goods/services providers.

EUIPO

The Court has declared that direct evidence such as declarations by professional associations and market studies are usually the most relevant means for proving acquired distinctiveness through use. Invoices, advertising expenditure, magazines and catalogues may help to corroborate such direct evidence (judgment of 29/01/13, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 74).

JPO

Evidence (a photograph, advertising literature, results of consumer surveys, etc.) that only the three-dimensional shape is functioning independently as an indication of trade source for identifying its goods or services.

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0200.pdf>

KIPO

A Consumer Awareness Survey can be used as evidence to identify acquired distinctiveness. The survey shall be conducted by a reliable research agency that meets certain requirements. For example, a polling organization in accordance with the Public Official Election Act falls under the criteria. The survey is considered reliable if it is designed to have sample representativeness in some respects—e.g., geographic region, gender, age, etc.—targeting actual or potential consumers of the same product concerned and it uses a sample size of more than 500 respondents, and if the questionnaire is fairly and appropriately structured. Examiners are not bound to the survey results; however, they may consider the results as strong evidence when making decisions about acquired distinctiveness by use where a survey that meets the reliability requirements indicates that more than 50% of respondents recognize the mark as representing a specific person's goods and/or services.

36. If a three-dimensional mark is refused, can an applicant overcome the refusal during examination and does the applicant have a deadline by which to submit the evidence?

USPTO

Yes, a refusal may be overcome during examination. The applicant may submit evidence during the response period indicated by the Office action. Generally, an applicant has six months to respond to a refusal.

CNIPA

The examiner may ask the applicant to make an explanation or amendment to the application to overcome the refusal. The applicant may submit feedback and evidence within 15 days after receipt of the notice.

But the procedure is initiated by the examiner, and is not a necessary procedure.

EUIPO

Yes, by submitting a claim indicating that the sign has acquired distinctive character through use within the meaning of Article 7(3) EUTMR. It can be made together with the application or at the latest, in reply to the examiner's first objection and it can be invoked as principal or as a subsidiary claim.

The applicant can overcome a refusal based on Article 7 (1) (b), (c) or (d) EUTMR, (if per se devoid of any distinctive character, descriptive or customary trade marks), but on the contrary, objections under Article 7(1)(e) EUTMR (marks consisting of shapes or other characteristics that follow from the nature of the goods, shape or other characteristics that are necessary to obtain a technical result or shapes or other characteristics giving substantial value to the goods) cannot be overcome by acquired distinctiveness.

The deadline for submitting evidence is of two months counting from the objection letter (in the case of principal claims), and two months as from the moment the decision on inherent distinctiveness has become final.

JPO

Yes, the applicant may overcome a refusal during the examination by submitting written opinion, which is not limited to three-dimensional marks.

A domestic applicant is required to submit the evidence within 40 days from the mailing date of the Notification of Reasons for Refusal, and an applicant who resides overseas is required to submit it within 3 months from the said date. Further, the applicant may request an extension of time.

https://www.jpo.go.jp/e/system/patent/shinsa/kyozetu_entyou_160401.html

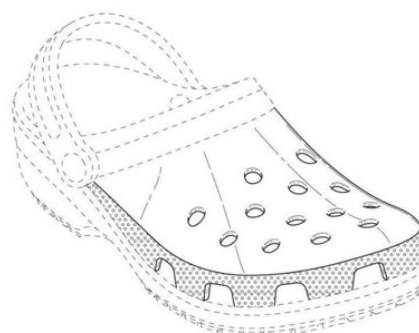
KIPO

Yes, the applicant may overcome a refusal during examination by submitting a written opinion, accompanied by evidence within the response period, which is generally two months to respond to a refusal.

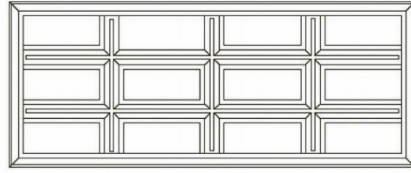
37. Please provide two examples of three-dimensional marks where sufficient evidence of acquired distinctiveness was provided to overcome a refusal.

USPTO

[Registration No. 5149328](#)



[Registration No. 4322502](#)



CNIPA
N/A

EUIPO

[EUTM 541581](#)



[EUTM 1580521](#)



JPO

Registration No. 5225619



Registration No. 5674666



KIPO

Registration No. 401165784



Registration No. 401194532



38. Must the evidence provided in support of registration be legalized, notarized, certified or similar?

USPTO

Yes. Declarations attesting to the truth of the matter asserted must be signed under penalty of perjury in accordance with 37 C.F.R. §2.20 or 28 U.S.C. §1746.

See [TMEP §804.01\(a\)](#) Verification with Oath for more information.

CNIPA

The evidence should be authentic and legally accurate. A trademark registered by deception, including the provision of false evidence, can be declared invalid.

EUIPO

No, there is no obligation to provide legalized, notarized, certified or similar evidence.

JPO

No.

KIPO

No.

39. If the evidence must be legalized, notarized, certified or similar, please explain the process and requirements in order for the evidence to be acceptable.

USPTO

The applicant or any knowledgeable party may submit a statement of the facts and include the following language:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true. (37 C.F.R. §2.20).

Or

Wherever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required or permitted to be supported, evidenced, established, or proved by the sworn declaration, verification, certificate, statement, oath, or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than a notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

- 1) If executed outside the United States, its territories, possessions, or commonwealths: "I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on (date).

(Signature)".

- 2) If executed within the United States, its territories, possessions, or commonwealths: "I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct.

Executed on (date).

(Signature)".

See [TMEP §804.01\(a\)\(i\)](#) for verifications made in a foreign country.

CNIPA

The evidence should be original or notarized copy.

EUIPO

Although, as said above, evidence does not need to be legalized, in those cases where the submitted evidence is sworn or affirmed, the following applies: In order for a statement to be considered sworn or affirmed, it must be understood by the parties that making a false statement would be considered a criminal offense under the law of the Member State in which the document was drawn up. Where that is not the case, the document will be considered simply as any other written document or statement (judgment of 28/03/2012, T-214/08, Outburst, EU:T:2012:161, §32 and the case-law cited therein).

<https://guidelines.euipo.europa.eu/1803422/1789088/trade-mark-guidelines/4-means-of-taking-evidence>

JPO

N/A

KIPO

N/A

40. If a mark has registered on the basis of acquired distinctiveness, how is that indicated in your database?

USPTO

The mark in the USPTO database will indicate that the mark has registered under "Section 2(f)" or "Section 2(f) in part." Section 2(f) is the provision under US trademark law that permits registration of nondistinctive matter when acquired distinctiveness has been established to the satisfaction of the Office.

CNIPA

There are no special tags in the open database of the Internet.

EUIPO

Within the Trade mark information at the eSearch tool, there will be an indication that the trade mark was registered due to acquired distinctiveness, when that is the case.

JPO

The data of a trademark on which our office made a judgment that 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 and registered under the Trademark Act, Article 3 (2) is stored in our database with a flag.

Accordingly, the "additional information" stored in our database is displayed as "Under article 3-2". This enables us to confirm that the trademark was registered under the said clause.

Trademarks registered "Under article 3-2" include;

Registration No. 5225619

Registration No. 5384525

You can enter the registration numbers to confirm the details on the J-platpat screen.

<https://www.j-platpat.inpit.go.jp/t0000>

KIPO

It will be indicated as a trademark that has acquired distinctiveness in accordance with Article 33(2) of the Trademark Act. There is a denotation in the database.

41. If your office accepts evidence of acquired distinctiveness, in what language must the evidence appear?**USPTO**

English.

CNIPA

Chinese.

EUIPO

According to Article 24 EUTMIR, supporting documents to be used in written proceedings before the Office may be filed in any official language of the Union. Where the language of such document is not the language of the proceedings, the Office may, of its own motion or upon reasoned request by the other party, require that a translation be supplied. But it is therefore not a requirement.

JPO

Japanese.

KIPO

Korean.

42. If the evidence is in a foreign language, must it be translated? If yes, must this translation be certified or notarized?

USPTO

Yes, foreign evidence must be translated. Certification or notarization is not required. The translator should sign the translation, but does not have to swear to the translation. See TMEP [§710.01\(b\)](#) regarding internet evidence, including foreign evidence.

CNIPA

Yes. The evidence is written in a foreign language, a Chinese translation shall be attached. Otherwise, it is deemed not to be submitted.

No. The translation does not require notarization.

EUIPO

We refer to the answer provided to question 41 here above.

Whenever a translation is provided, there is no need for it to be certified or notarized.

JPO

Yes, a Japanese translation must be attached to foreign evidence. However, translation in itself is not sufficient. The applicant is required to submit evidence to prove that the trademark is recognized among the consumers in Japan. Hence, particularly, advertising materials, newspaper articles, magazine articles are generally expected to be originally written in Japanese.

Certification or notarization is not required for this translation.

KIPO

Yes, any evidence in a foreign language must be translated, however, certification or notarization thereof is not required.

Additional Information for Users

43. Does your office have a specific webpage with information about applying for three-dimensional marks?

USPTO

No. While there is no specific webpage dedicated to three-dimensional marks, all guidance for applicants is available in our online Trademark Manual of Examining Procedure, which can be searched by topic and keyword. [Section 1202.02](#) discusses registration of trade dress and 3D marks.

CNIPA

No.

EUIPO

The EUIPO webpage provides information on how to apply for trade marks and designs. In this [link](#) the Office provides examples of the different type of trade marks, as well as the corresponding acceptable file formats, which for shape marks are JPEG, OBJ, STL, X3D.

Also, the Office Guidelines has a dedicated section to the formalities aspect of the examination, which can be found [here](#).

As to our Guidelines on non-distinctive trade marks in this [link](#), there is information as to when the Office considers shape marks to be distinctive (on paragraph 10).

Finally, information on Article 7(1)(e) EUTMR can be found [here](#) (Article which excludes from registration signs that consists exclusively of (i) the shape or another characteristic that results from the nature of the goods themselves; (ii) the shape or another characteristic of goods that is necessary to obtain a technical result; or (iii) the shape or another characteristic of the goods that gives substantial value to the goods).

JPO

No. There is no specific webpage dedicated to three-dimensional marks.

KIPO

No. There is no specific webpage dedicated to three-dimensional marks.

44. Does your office have any additional information about applying for three-dimensional marks that is not available online? If so, please attach this information with your response to this questionnaire.

USPTO

No. All information is available at the office webpage www.uspto.gov and in the Trademark Manual of Examining Procedure, available at <https://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.html>. [Section 1202.02](#) discusses registration of trade dress and 3D marks.

CNIPA

No.

EUIPO

All the information is available at the Office webpage <https://euipo.europa.eu/ohimportal/en/home> and in the corresponding Office Guidelines available at <https://euipo.europa.eu/ohimportal/en/trademark-guidelines>.

JPO

No. All information is available at the office webpage <https://www.jpo.go.jp/e/index.html> and in the "Examination Guidelines for Trademarks", and "The Trademark Examination Manual", available at <https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/index.html>.

KIPO

No. All information is available at the office webpage www.kipo.go.kr and in the Trademark Examination Guidelines.