

Acquired Distinctiveness through Use regarding 3D Trademarks

SASAKI Yugen
Deputy Director

Trademark Policy Planning Office, Trademark Division
Japan Patent Office (JPO)



ANNUAL MEETING

SAN DIEGO, CALIFORNIA, USA

May 17-21, 2025



Table of Contents

1. Legal Provisions
2. Examples of Registered 3D Trademarks in Japan



1. Legal Provisions



Japanese Trademark Act

Article3

Requirements for Trademark Registration related to Distinctiveness

Article4

Unregistrable Trademarks



Japanese Trademark Act

Article3

Requirements for Trademark Registration related to Distinctiveness

If the filed 3D mark falls under the provisions of Article3, the mark can not be registered due to the lack of distinctiveness.



Article 3(1)(iii)

(Indication of quality and other characteristics of the goods,
or indication of quality and other characteristics of provision of the services)

A trademark consisting 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 packages; the same shall apply in Article 26 (1)(ii) and (iii)), the method or time of production or use, or other characteristics, or quantity or price, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, modes, method or time of provision, or other characteristics, or quantity or price;

The following trademarks fall under this provision.

- Trademarks **indicating the characteristics of goods/services by means of 3D shapes.**
- Trademarks **recognized as not surpassing the shapes of the goods (including shape of packages)** or the shapes of articles for use for the provision of the services.



Article 3(1)(iii)

(Indication of quality and other characteristics of the goods,
or indication of quality and other characteristics of provision of the services)

How to judge “**recognized as not surpassing the shapes of the goods**”?

- If the 3D shape is adopted **for the purpose of contributing to the function or aesthetics of the goods.**

⇒ **Not distinctive**

- Even if a 3D shape has characteristics such as being changed from its usual shape or being decorated, **if the consumers can predict that the shape has been changed or decorated for functional or aesthetic reasons.**

⇒ **Not distinctive**



Article 3(2) (Distinctiveness acquired through use)

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

- The filed mark **should be identical with** the mark in use, in principle.
- The designated goods/services **should be identical with** those in use, in principle.
- The mark is **widely well-known among consumers in Japan** as an indication of trade source of a particular person.
- The evidence will be **advertising materials, photos, business documents, user survey** etc.
- The considered factors will be **amount of production and sales, period and areas of use** etc.



Article 3(2) (Distinctiveness acquired through use)

Where a trademark in use contains a mark other than the filed 3D mark,
but the filed 3D mark is recognized as an independent part distinguishing the mark for own business and goods/services of others.

⇒ **The 3D mark is distinctive.**

<Examples>

- (i) where the applicant's trademark is only a 3D shape and a photograph of the same 3D shape with letters is submitted as the trademark in use, but the 3D shape gives a strong impression to consumers and is independently recognized as a distinguishing mark.
- (ii) where the distinctive parts of the 3D shape of the applicant's trademark and the trademark used are identical and there are only slight differences in the parts other than the distinctive parts, and the distinctive parts are independently recognized as a sign for identifying the goods/services.



Japanese Trademark Act

Article4

Unregistrable Trademarks

Even if the filed 3D mark is distinctive, the mark is unregistrable if it falls under the provisions of Article4.



Article 4(1) (xviii) (Characteristics which goods, etc. must naturally have)

A trademark consisting solely of characteristics which its goods, etc. (meaning its goods or packages, or services; the same shall apply in Article 26(1)(v)) **must naturally have** and which are specified by Cabinet Order

With respect to "characteristics" which goods "must naturally have", the elements prescribed below will be considered.

- The mark consists solely of **3D shapes normally provided by the nature of the goods.**
- The mark consists solely of **3D shapes which are essential to secure the functions of the goods.**

⇒ Such 3D marks can not be registered.



Article 4(1) (xviii) (Characteristics which goods, etc. must naturally have)

How to judge "**characteristics**" which goods "**must naturally have**"?

- Whether alternative 3D shapes exist otherwise to secure the functions of a trademark's goods.
- Even if alternative 3D shapes exist, whether a trademark's goods can be produced at the same (or lower) cost with these alternatives.

⇒ If Yes, not fall under this provision.(registrable)



3D
trademark
application

Distinctive?

Yes

registrable

No

Article 3(1)(iii)

Yes

Article 3(2)

Distinctiveness
acquired through use?

No

Yes

Article 4(1) (xviii)

Characteristics which goods
must naturally have?

No

unregistrable

registrable

unregistrable



2. Examples of Registered 3D Trademarks in Japan



Registration No.6031305
Right holder: Meiji, Inc.
Class30: Chocolate confectionery

Process: Registered in examination as Second Action(SA)
Registration date: Mar.30,2018



<Provided evidence>

- Third largest market share in the chocolate confectionery sector in Japan
- Nearly 3 billion in sales each year in Japan
- Top sales in the field of chocolate confectionery in Japan
- No. 8 in the ranking of long-selling confectioneries in Japan in newspaper articles
- Continuous sales throughout Japan since 1975
- Results of online user survey (90% of consumers recognize the trademark)

High Market share

Long period and wide area of use

High consumers' awareness



Registration No. 6031041
Right holder: KIKKOMAN CORPORATION
Class30: Soy sauce [soya sauce] containing a
container for tables, soy sauce [soya sauce]

Process: Registered in examination as Second Action(SA)
Registration date : Mar.30,2018



<Provided evidence>

- Distinctive design by the late world-renowned designer, Kenji Ekuan
- Record sales in the seasoning field in Japan
- More than 450 million bottles shipped in Japan and abroad
- Long seller with more than 10 million bottles sold in Japan in the last 10 years since its launch in 1961
- Used in the same form for more than 56 years
- Sold in grocery stores and supermarkets throughout Japan
- Advertised in newspapers, books, and on TV for many years
- No use of the mark identical or similar to the trademark by others
- Online user survey results (approximately 60% of more than 1,000 subjects recognized the applicant's trademark)

*The composition and mode
of the trademark*

High volume of use

*Long period and wide area of use with the
same shape*

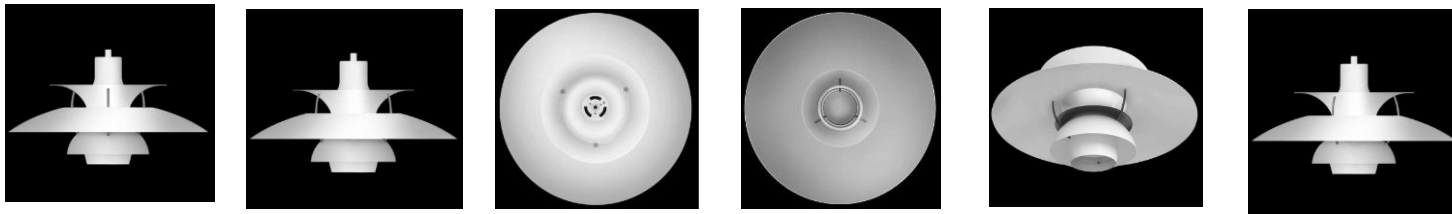
Not used by others

High consumers' awareness



Registration No. 5825191
Right holder: Lewis Paulsen A ray/S
Class11: Lamp shade

Process: Registered in Trials and Appeals
Registration date: Feb.12,2016



<Provided evidence>

- Lampshade shape designed by applicant in 1958
- Exclusive use in markets **worldwide for over 55 years**
- Started **selling in Japan in 1972**.
- Sold in furniture stores and other **outlets throughout Japan**
- Long seller with **over 500,000 units sold worldwide**
- Approximately **75,000 units sold in Japan between 1999 and 2014**
- **Long-standing advertising track record since 1972**
- Received the Good Design Award from the Ministry of Economy, Trade and Industry in 1997
- Featured in a Japanese high school textbook in 2012

Long period and wide area of use

The method and scale of advertising



Registration No. 5446392
Right holder: Carl Hansen & Sun Japan, Inc.
Class20: Armrest chair

Process: Registered following the decision in IP High Court
(2010(Gyo-Ke)10253)
Registration date: Oct.28,2011



<Provided evidence>

- Designed by Hans J. Wegner, **considered a master of modern furniture design**, and known as the “Y chair”, one of the best-selling chairs in the world
- **Continuously sold since its launch in 1950 with no change in shape or characteristic parts**
- Started **selling in Japan in 1962**
- A total of **97,548 chairs were sold from 1994 to 2010**, an outstandingly large number for a single chair type.
- In Japan, the chair has been **introduced in magazine articles since 1960 and is regarded as one of the best-selling imported chairs in Japan.**
- Featured in trade magazines and textbooks for junior high school students.
- **Considerable expense for advertising activities.**

————— *The composition and mode of the trademark*

} *Long period of use with the same shape*

————— *High volume of use*

} *The method and scale of advertising*



<Reference: Cases not registered >



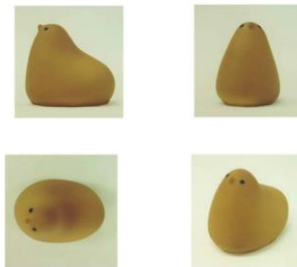
Class9: Joint box

- No evidence to prove the market share of the products used, although a considerable amounts of products are manufactured and sold.
- The method of user survey is not appropriate because the target subjects is limited to specific vendors.

(2012 (Gyoke) No. 10346)

- The applicant's stores are located in a limited area and not throughout Japan.
- The sales style and advertising are such that consumers pay attention to the character trademark, not the 3D mark itself.
- There are many confectioneries throughout Japan that are extremely similar to the shape of the bird of this 3D trademark.

(2005 (Gyoke) No. 10673)



Class30: Steamed filled dumplings



Class16: Pencil, ballpoint pen, or other writing utensil

- No evidence to show the goods are manufactured and sold with only this 3D trademark.
- Since the character trademark is affixed to this 3D mark in all evidence, and this 3D shape is within the scope of the usual shape of the writing utensil, this 3D shape alone is not distinctive.

(1999 (Kyoke) No.406)



Thank you!

Speaker

SASAKI Yugen

Deputy Director,
Trademark Policy Planning Office,
Trademark Division, Japan Patent Office (JPO)



**International
Trademark
Association**

www.inta.org

Official hashtag #INTA2025 Instagram @INTAGLOBAL X @INTA LinkedIn @GoINTA Facebook.com/goINTA