



Tendency of JPO's Examination Practice of New-Type Trademarks in First Two Years following 2015 Trademark Law Revision

Yoshiki Toyama (patent attorney)
Nami Togawa (partner/patent attorney)
Seiwa Patent & Law (Tokyo, JAPAN)
May 8, 2017

Abstract

Almost two years have passed since the Japan Patent Office (JPO) began examination practice based on the revised Japan Trademark Law in April 2015, which opened the way for registration of certain types of non-traditional trademarks (color per se marks, sound marks, motion marks, hologram marks, and position marks; hereinafter “new-type trademarks”). This article summarizes the trends of the JPO's examination practice of such new-type trademarks thus far, and highlights a few specific examples which were successfully granted and registered by the JPO.

1. Introduction

The 2014-revisions to the Japan Trademark Law newly enabled registration of certain types of non-traditional trademarks such as color per se marks, sound marks, motion marks, hologram marks, and position marks (hereinafter collectively called “new-type trademarks”). The JPO revised its Examination Guidelines in accordance with the revised law, and began examination of new-type trademarks on April 1, 2015. Since then, there have been as many as 1,500 trademark applications for new-type trademarks as of April 2017, indicating that this new examination practice has attracted a high level of interest from many applicants.

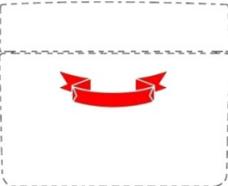
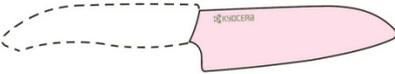
The JPO began allowing trademark applications of such new-type trademarks from around September 2015. While early successful cases were quickly allowed by the JPO without issuance of any reasons for rejection, there have recently been some interesting cases which the JPO initially rejected based on, e.g. lack of, distinctiveness, but then allowed and granted registration as a result of the applicant's specific argument.

In the following, we select and analyze some specific examples of new-type trademarks which were successfully granted and registered by the JPO.

2. Position marks

(1) Trends in examination of position marks

There have been over 340 trademark applications for position marks since April 2015, among which 23 trademark applications have been allowed and granted registration as of April, 2017. Most of the registered trademarks have a highly distinctive character in terms of the position for which the applicant sought protection, e.g. as follows.

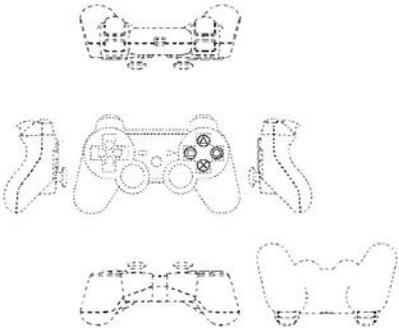
MARK	CLASS	Appln. No./ Appln. Date	Reg. No./ Reg. Date	Trademark Owner/ *Comments
 <p>(see Appendix 1A for enlarged image)</p>	03	2015-030025 01-Apr-'15	5804314 06-Nov-'15	Ciz Holdings Co., Ltd. * The position mark includes a distinctive design of ribbon.
 <p>(see Appendix 1B for enlarged image)</p>	09	2015-030239 01-Apr-'15	5808808 27-Nov-'15	Fujitsu Limited * The position mark includes the applicant's corporate logo.
 <p>(see Appendix 1C for enlarged image)</p>	08	2016-024565 07-Mar-'16	5918807 03-Feb-'17	KYOCERA Corporation * The position mark includes the applicant's corporate name.

In contrast to these successful examples, most of the position marks rejected by the JPO based on lack of distinctiveness are marks which do not have a distinctive character in terms of the position for which the applicant sought protection, e.g., marks including a decorative pattern at a specific position solely for aesthetic purpose, or just a color attached to a specific position. This is mainly because the JPO's revised Examination Guidelines prescribe that such position marks shall generally be deemed to lack distinctiveness.

(2) Examples

As of April 2017, there have been only two such trademark applications for which the JPO issued a reason for rejection based on lack of distinctiveness, but the applicant successfully overcame the reason for rejection by filing an argument.

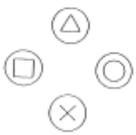
One of these applications was filed by Sony Interactive Entertainment Inc.

MARK	CLASS	Appln. No./ Appln. Date	Reg. No./ Reg. Date	Trademark Owner
 <p>(see Appendix 2 for enlarged image)</p>	09 28	2015-030226 01-Apr-'15	5858802 17-Jun-'16	Sony Interactive Entertainment, Inc.

The applicant sought protection for a combination of “○”, “△”, “□”, and “×” used for the controller of their computer game machine named “Play Station” as a position mark. The Examiner raised a reason for rejection against this position mark as lacking distinctiveness, on the grounds that the marks constituting this position mark would be recognized by general consumers as typical designs of operation buttons commonly used on a game controller, and could therefore not act as a source identifier.

In response, the applicant argued that this position mark had acquired distinctiveness through actual use. Specifically, the applicant stated that this position mark had been exclusively and continuously used for over 20 years since their “Play Station” was first launched in 1995, and game machines with this position mark had been sold extensively throughout the world.

The applicant also argued that it had prevented any third party from using this position mark since 1999, by obtaining a trademark registration for the following device mark.

MARK	CLASS	Appln. No./ Appln. Date	Reg. No./ Reg. Date	Trademark Owner
	09, 16, 25, 28	H10-011096 16-Feb-'98	4314087 10-Sep-'99	Sony Interactive Entertainment, Inc.

As a result of the applicant's argument, the JPO accepted that this position mark had acquired distinctiveness, and granted registration thereof.

3. Color per se marks

(1) Trends in examination of color per se marks

Although over 500 trademark applications for color per se marks have been filed since April 2015, none of them had been granted registration by the end of February 2017. This is presumably because JPO's revised Examination Guidelines prescribe that color-per se marks shall generally be deemed to lack distinctiveness. Accordingly, in order to obtain a trademark registration for a color per se mark, it is necessary for the applicant to prove that the mark acquired distinctiveness through actual use, by submitting sufficient evidence of such use.

According to Article 3, paragraph 2 of the Japan Trademark Law, a trademark lacking distinctiveness may be registered if the applicant demonstrates that Japanese consumers associate the mark with a particular commercial origin or source, i.e., if the mark is deemed to have acquired distinctiveness through its actual use. In this connection, the JPO's Examination Guidelines prescribe that in order to prove the level of recognition of a mark according to a trademark application among consumers, the applicant can rely on such evidence as listed below:

- (i) Photographs, movies, etc., showing the actual state of use of the mark;
- (ii) Business documents regarding the mark, such as order slips (slips of purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.;
- (iii) Advertisement by the applicant, such as in newspapers, magazines, catalogues, leaflets, TV commercials, etc., along with evidence showing the results of such advertisement;
- (iv) Articles regarding the mark in general newspapers, trade journals, magazines and on the Internet, etc., written by persons other than the applicant; and

(v) Reports of consumer surveys regarding the mark.

It should be noted that colors are generally used with other distinctive elements. Accordingly, in order to prove that a color-per se mark has acquired distinctiveness, it is important to prove consumers' recognition that the color-per se mark itself functions as a source identifier, apart from other distinctive elements used therewith. This can be achieved by, e.g., submitting a report of a consumer survey regarding the color per se mark.

(2) Examples

On March 1, 2017, the JPO officially announced that following two color-per se marks were granted for registration, and the news was widely broadcasted in Japan.

Applicant	Appln. No.	Trademark	Class/ Goods or Services
Seven-Eleven Japan Co., Ltd.	2015-30037		Class 35 “Retail services or wholesale services for personal articles foods and beverages, etc.”
Tombow Pencil Co., Ltd.,	2015-29914		Class 16 “Erasers”

Tombow's eraser



<<http://www.tombow.com/products/mono/>>

Seven Eleven's signboard



<http://www.sej.co.jp/sej_case/>



These combinations of colors are well-known among Japanese consumers, and were cited by the JPO as typical examples of color per se marks in its explanation materials regarding the 2014-revisions to the Japan Trademark Law. In addition, compared with single colors, combinations of two or more colors can more easily be deemed eligible for an exclusive trademark right. Taking these facts into consideration, we believe it inevitable that these marks became the first registration cases of color-per se marks.

In both cases, the JPO initially rejected the trademark application based on lack of distinctiveness. In order to overcome the reason for rejection, the applicant submitted a substantial volume of evidence proving that the mark had been used all over Japan and had thereby acquired distinctiveness through its actual use. The submitted evidence included: documents indicating the sales figures of goods/services with which the mark had been used, advertisements of such goods/services, and articles about such goods/services. As a result, the JPO finally allowed the application, and granted registration of the color-per se mark.

In Seven-Eleven's case, the applicant submitted reports of consumer survey results twice. The JPO judged that the first report was insufficient to prove acquired distinctiveness, possibly for the following reasons.

- a) The first consumer survey was carried out on randomly-selected general consumers, not on actual consumers of the designated services of the application.
- b) The first survey was carried out on 300 respondents, which number was deemed insufficient to show significant results.
- c) The first survey was carried out using questionnaire items which were so ambiguous that only 48% of the answerers associated the color combination according to the trademark application with the applicant.

With regard to item (c) above, one of the questionnaire items of the first survey was: "*Which retail store's corporate color do you recall from the color combination shown here?*". We assume that most of the respondents did not answer this question as the applicant expected, since some general consumers did not know exactly what the term "corporate color" means, while some others did not distinguish the applicant (Seven-Eleven Japan Co., Ltd.) from its holding company (Seven & i Holdings Co., Ltd.).

Based on the failure of the first survey, the applicant carried out a second consumer survey on 1000 specific consumers of their retail services, and using more specific and easy-to-answer questions, e.g.: "*This picture shows a color combination used by a certain retail*



store for its signboard, etc. Which retail store's name do you specifically recall from this color combination?". In this second survey, 88.8% of the answerers associated the color with the applicant. Submitting the results of this second survey, the applicant successfully obtained trademark registration of the color per se mark.

By contrast, in the Tombow Pencil case, the applicant did not submit any consumer survey results to prove acquired distinctiveness through actual use. Instead, the applicant submitted a considerable amount of evidence showing that the color combination according to the trademark application (combination of blue, white, and black) had been used not only on product packages, but also on posters and signboards in various trade shows and exhibitions relating to their products. The applicant also submitted articles in magazines and newspapers stating that this color combination had been used for a long time as the applicant's products (erasers), and was familiar to Japanese consumers.

From these examples, we believe that in order to prove acquired distinctiveness of a color-per se mark, it is important to prove that consumers recognize the color (or the color combination) itself as a source identifier of the applicant's goods or services, since colors (or color combinations) are generally used with other distinctive elements. The most effective means to prove this is to submit consumer survey results showing the level of consumer recognition of the color per se mark. However, this method has drawbacks: carrying out a consumer survey is very costly in Japan, and survey results may be rather negative. Even when the results are positive, the JPO may not consider the results if it considers the survey procedure arbitrary or inductive, or in any other way inappropriate. Therefore, we recommend carefully considering whether and how to conduct a consumer survey before actually conducting one.

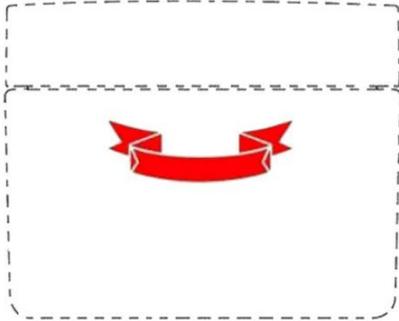
4. Others

We believe that the examples explained above are informative in obtaining trademark registrations for position marks and color per se marks. On the other hand, in specific categories of non-traditional trademarks, such as sound marks without any character elements or single color per se marks, there have been no trademark applications successfully granted trademark applications so far. Therefore, we will continue monitoring the results of such non-traditional trademark applications in the future.

-END-

APPENDIXES

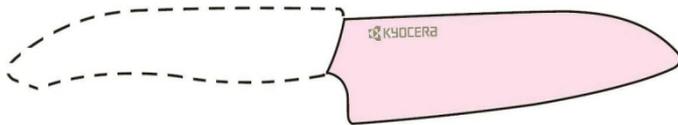
Appendix 1A



Appendix 1B



Appendix 1C



Appendix 2

