

Column No.12

Selection of Trademark - Indication of Quality and the Like

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What naming will be effective in starting to market new goods and to provide new services? When selecting a trademark, it is effective to choose one that is easy to remember, or familiar to people. However, because of a very strong intention to reflect the contents of the goods or services on the service names, general words are often chosen; namely, words which have no distinguishability between one's own and others' goods/services. A trademark having no distinguishability between one's own and others' goods/services is not an indication which can distinguish one's own goods/services from others' goods/services on the market. Therefore, it is not registrable in principle. This legally falls under the Trademark Law Article 3 (1).

Here, I will explain, focusing on trademarks falling under the Trademark Law Article 3 (1) (iii) which are often problematic in business, that is, "trademarks indicated with a purpose to describe features of goods/services in some way."

Trademark Law Article 3

(1) Any person may obtain a trademark registration of a trademark to be used in respect of goods or services in connection with his business, except in the case of the following trademarks:

Trademark Law Article 3

(1) (iii) trademarks which consist solely of a mark indicating in a common way, the origin, place of sale, quality, raw materials, efficacy, use, quantity, shape (including packaging shape) or price of the goods, or the method or time of manufacturing or using them; or the location of provision of the services, quality, articles for use in such provision, efficacy, use, quantity, modes, price or method or time of the provision of services;

(1) Origin, place of sale and location of provision of the services

According to the examination standard of trademarks, names of states, noted geographical names, busy shopping avenues, maps, etc., are not registered in principle due to indication of the origins of goods. The Supreme Court made a judgment in the case of "Georgia (□1)" to the effect that, for a trademark to fall under the origin of the goods, "the designated goods are not necessarily actually produced or sold in the land indicated by the trademark, ...it suffices to be generally recognized that the designated goods are supposedly produced or sold in the land indicated by the trademark." (January 23, 1986, Supreme Court No. 1985 (Line Tsu))

No. 68). Thereafter, registration of trademarks recognized to indicate place names tend to be rejected. As examples judged to indicate origins, places of sales are given; "Heiwadai" (steamed bean-jam bun) and "Seto-Ohashi" (cake).

(2) Quality, raw materials, efficacy, use, location of provision of the services, quality, articles for use in such provision, efficacy, etc.

"デラックス" (Delux) for an automobile, "疲労回復" (Soothing Effect) for provision of bathing facilities and the like are not registrable, because they indicate the quality of goods and efficacy of services.

However, according to the examination standard, trademarks indirectly indicating the quality of goods are registrable. According to the judicial precedent, even though "セロテープ" (adhesive cellophane tape) implied its designated goods, that is 'tape made of cellophane', it was judged as not being indicative of the quality, raw material, and shape (December 21, 1967, Tokyo High Court 1963 (Line Ke) No. 27). Additionally "太肉麺" (Ta-ramen) cannot be considered as a trademark which indicates the quality of services, 'provision of ramen mainly with a thick piece of pork served over' (September 28, 2000, Tokyo High Court 1999 (Line Ke) No. 381).

Naming reflecting the contents of goods/services is advantageous in that it is easily understandable and easy to create an image of goods or the like for consumers, but it is disadvantageous in distinguishing from others' products and hard to be remembered as a trademark. On the other hand, in some cases a trademark consisting of coined word(s) requires marketing costs until they are accepted by consumers, but once firmly fixed, they can easily remain in a consumers' memory because of the strong distinguishability from others' goods and the originality of the words. Many noted trademarks consisting of coined words exist, such as "Sony", "Bridgestone", "Rolex" and the like.

When you actually select a trademark, please also take the above points into consideration.

□1: The case that the trademark "Georgia" designating coffees and coffee beverages as goods was judged to fall under the Trademark Law Article 3 (1) (iii).

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