

Interview No.36

New Type of Applications for Trademark Registrations were made available as of April 1, 2015

Motions, holograms, colors, sounds, positions --- brand strategies will become diverse
【2015/2/19】

In addition to the traditional trademarks for conventional "characters" and "figures," trademarks for "motion," "hologram," "trademarks consisting solely of colors (hereinafter color mark)," trademarks such as "sound" and "position" can be filed as applications for registration to be protected in Japan, too, as of April 1, 2015. In mid-January, the Patent Office announced the date of enforcement, how to file an application, a draft guideline of the examination standard and the like. We asked Mr. Takao Okuno and Ms. Hiroko Sunaga, Patent Attorneys of Miyoshi & Miyoshi, about the outline of the revision of the Trademark Law relative to the introduction of the new type of trademarks as well as responses by companies.

Ms. Sunaga: In relation to the new type of trademarks, foreign countries precede Japan, that is, the U. S. has introduced such marks since the current Trademark Act was enacted in 1946, and EU as well as Australia in 1996. In South Korea, too, objects for protection were added in 2007 and 2012 in a stepwise fashion. Under these circumstances, the Japanese Patent Office has also repeated studies of methods of filing an application and examination standard toward introduction of the new type of trademarks for more than 10 years and has been proceeding with the preparation. Further, led by global companies, cases of registering in the overseas are increasing, and the needs for protection of rights within Japan are also increasing. Now with the expansion of objects needing protection with? Trademarks, companies will have more options for brand strategies for services, and it will become possible to protect rights at multiple levels by combining the services. Meanwhile, with the present revision, protections of "scent," "taste," "touch," and "trade dress" are not covered.

Mainly led by global companies, there are already many precedents of registration of colors and sounds overseas.

Ms. Sunaga: The "motion mark" means a trademark in which characters, figures and the like vary with the lapse of time. A typical example is Sony's registered trademark on a game device (European Registration No. 8195992) (Fig. 1).

The "hologram mark" is a trademark in which characters and figures vary by looking from

different angles by way of holography. A typical example is a seal which Nikon Corporation affixes to the corporation's camera products to show/verify/confirm the products are genuine (German Registration No. 304532819).

The "color mark" is not one in which figures and colors are combined, but a trademark consisting of a combination of single or multiple colors. As a typical example, there is a case where a package of "MONO" erasers with color arrangement of black, blue and white Tombow pencils (US Registration No. 3252941). In Australia, there is a case in which color lines of orange, green, and red is registered by 7-Eleven, Inc. as a color trademark (Australian Registration No. 749403).

The "sound mark" is a trademark recognized by a sense of hearing consisting of music, voice, natural sounds and the like. Hisamitsu Pharmaceutical Co., Inc.'s sound logo which we often hear in the TV commercial (European Registration No. 2529618) is famous. Also, a characteristic electronic chord played when starting a "Mac" which is a product of Apple Inc.'s PC (US Registration No. 4257783); in addition to Intel Corporation's commercial sound (European Registration No. 4610986), and the opening logo in which a lion roars by Metro-Goldwyn-Mayer Inc., MGM, a film company in Hollywood, U. S. (US Registration No. 1395550), etc., are registered.

The "position mark" is a trademark of figures and the like, by which the position to be affixed to goods and the like is specified. A red line affixed to a heel portion of PRADA S.A.'s shoes (EU Registration No. 1027747) (Fig. 2), and the position of a tag usually placed outside the shirt pocket by LEVI STRAUSS & CO., are examples registered by the use of this type of trademark (US Registration No. 2726253).



**Fig. 1 Example of motion mark
Held by SONY on devices, etc.**



**Fig. 2 Example of a position mark
A red line affixed to a heel portion of
PRADA S.A.'s shoes**

Mr. Okuno: With reference to overseas country data which precede in applications/registrations of the new type of trademarks according to the JPO's investigation, the success of applications/registrations of "color mark" are the most numerous in the number of registrations with USPTO, amounting to 360 cases (the number of applications: 860 cases); the number of registration cases with OHIM (Office of Harmonization in the Internal Market: 272 cases (the number of applications: 868 cases, 1996 - February, 2012); the number of registration cases with IPA (IP Australia): 200 cases (the number of applications: 878 cases, 1996 - 2008) (Fig. 3); followed by the "sound mark," amounting to 109 registrations with USPTO (the number of applications: 257 cases); the number of registrations with OHIM is 129 cases (the number of applications: 165 cases); and the number of registrations with IPA: 39 cases (the number of applications: 72). Further, with USPTO, the number of registrations of the "motion mark": 33 cases (the number of applications: 59 cases), and the number of registrations of the "hologram mark": 15 cases (the number of applications: 57 cases).

Incidentally, regarding "scent," "taste," and "touch," which are not yet protected in Japan, there have been hardly any registration successes even with USPTO.

Ms. Sunaga: In Korea, too, with global companies, the new type of trademarks have already been introduced, but I hear there have not been so many application successes so far.

○The number of applications/registrations in USPTO*

	Color	3D shape	Position	Motion	Hologram	Sound	Scent	Taste	Touch	Trade dress
Number of applications	360 cases	7,818 cases	n/a	59 cases	57 cases	257 cases	16 cases	n/a	10 cases	506 cases
Number of registrations	360 cases	3,160 cases	n/a	33 cases	15 cases	109 cases	12 cases	n/a	3 cases	210 cases

○The number of applications/registrations in OHIM (from 1996 to February 2012)

	Color	3D shape	Position	Motion	Hologram	Sound	Scent	Taste	Touch	Trade dress
Number of applications	868 cases	6,719 cases	n/a	n/a	10 cases	165 cases	7 cases	n/a	n/a	n/a
Number of registrations	272 cases	3,700 cases	n/a	n/a	3 cases	129 cases	0 cases	n/a	3 cases	n/a

*No new registration of scent, taste, and touch since 2002, graphical representations for which have not yet been established.

○The number of application/registration cases in IPA (from 1996 to 2008)

	Color	3D shape	Position	Motion	Hologram	Sound	Scent	Taste	Touch	Trade dress
Number of applications	878 cases	1,977 cases	n/a	n/a	n/a	72 cases	8 cases	n/a	n/a	n/a
Number of registrations	200 cases	625 cases	n/a	n/a	n/a	39 cases	1 case	n/a	n/a	n/a

○The number of applications/registrations in KIPO (from 2007 to December 2011; the number of applications cases for sound and scent, from March 15 to April 2012)

	Color	3D shape	Position	Motion	Hologram	Sound	Scent	Taste	Touch	Trade dress
Number of applications	n/a	516 cases	n/a	19 cases	14 cases	57 cases	0 case	n/a	n/a	n/a
Number of registrations	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a

*Prepared by JPO, based on replies from each authority. Color may sometimes include trademarks of a combination of color, characteristics, and figures; trade dress may sometimes include 3D shapes.

*The numbers of applications/registrations in USPTO are rough numbers of trademark applications/registrations as of February 9, 2012, and are not the numbers representing all the trademarks contained in the database. The total value of the principal and supplemental registrations.

Fig. 3 • States of Application/Registration for New type of trademarks in major countries
(the source: Patent Office Data)

In January, a draft guideline was disclosed. Having or not having distinguishability of components is indispensable.

Mr. Okuno: In mid-January, a draft examination standard was published by the Patent Office. In examining trademarks of any types, the distinguishability of one's and others' goods/services indicated by the requirements of registration under each item of the Trademark Law Article 3(1) is vital, and a judgment is given on each case.

While marks for "motion" and "hologram" are also considered in their entirety, if the marks

comprising of the characters and figures have no distinguishability, they are judged to have no distinguishability even if they were shown with changing motions and visual effects.

As for the "position mark," its right is narrow, depending on your way of thinking because the position of characters, figures and the like are specific. Meanwhile, because of the specific not only characters, figures and the like, but also their positions, there is room to enable to seek differentiation from others' trademarks. So, it can be said that a new way has been opened up in brand strategies.

Also, the "color mark" is examined as to whether or not colors themselves by a combination of a single color or plural colors have a distinguishability and meet the requirement for registration. However, if acceptance of registration results in registrations of many color marks, there will be little choice of trademarks when new goods are developed and sold, and it will likely make business dull. For this reason, I feel it necessary to watch the development as to how far the Patent Office will allow registrations to go (ie how strict examinations will be).

Regarding the application for registration of the "sound mark," I get the impression that applications from companies which are playing TV commercials are increasing, but there is also room for registering start-up sounds, and the like, of goods. So, I recommend that you review your company's goods once more.

"Details Column" newly provided in the application form

Ms. Sunaga: Concerning the actual procedure for application, it is only necessary to enter a mark in the "mark for which trademark registration is sought" column in the application form; however, when you are going to file a new type of trademark application, you should enter a detailed description of the mark in the application form, or affix an article specified by Ordinance of the Ministry of Economy, Trade and Industry to the application form. For example, if you are going to file an application for a "motion mark" in which a bird is flying or moving, you will need to show concretely main motions by plural figures in the "mark for which a trademark registration is sought" column, and further show, in the "detailed description of the trademark," column specifically and clearly a state of the bird with its wings closed and positioned in the lower left side in Fig. 1; a state of the bird with its wings up in Fig. 2; a state of the bird with its wings down in Fig. 3; a state of the bird with its wings up in Fig. 4; a state of the bird with its wings down in Fig. 5, expressing that the bird is gradually moving toward upper right from Fig. 2 to Fig. 5, and the trademark of motion takes 3 seconds as a whole. In this respect, it resembles a way of illustrating motions when filing an

application as a design registration about a design shown on the display such as an icon or the like.

Moreover, the "motion mark" is to be filed not with a movie file data but with drawings. In some foreign countries, as there are instances where movie files were accepted as trademark samples, Japan may be able to specify a trademark with a movie file in future.

As for the "sound mark," an application by a musical score and a voice file is acceptable, but a sonogram (a spectrum graph which can express the three elements of sound in a lump) is not. Regarding the "color mark," colors are described in the trademark column, with specific and clear description of No. in the color sample book, and arrangement of each color and how to combine colors (combination ratio of the three primary colors, i.e., RGB), etc., in the details column.

International Application, beware of the central attack.

Mr. Okuno: In filing an international application for a trademark which is to be newly protected, the trademark becomes registrable in Japan and can be filed in the contracting states, on the basis of Madrid Protocol thereafter, based on the Japanese application. Here, it is the central attack that we should beware of.

I get the impression that a company which desires to efficiently file a Madrid Protocol application should firstly make a basic registration and, depending on cases, it will be more necessary to take safety measures such as filing a foreign application after receipt of a decision of registration. For trademarks of ordinary characters and figures, it will become clear in about half a year or so after filing an application in Japan whether a mark is registrable or not. As it is uncertain how long it will actually take for examination of the non-conventional trademarks which are to be protected this time and whether they are likely registrable or not, it will be reassuring to file an application in each country upon registration in Japan, so as to avoid any risks in the case where registration of the basic application is rejected.

Concerning future development, some parts will be unknown until examples of registrations are accumulated, but in Japanese practice, publications of unexamined applications are issued after application. So, we can confirm the publications through the IPDL (Industrial Property Digital Library). As the information relative to registration will also be known sooner or later, companies which are going to utilize the new type of trademarks may take steps, watching the trend. Since trademarks are relatively more familiar intellectual property rights than patents, they are so important for companies as a communication tool with consumers. They will therefore be a popular news topic when registered.



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