

The Legal System and Examination Standards Relating to Three-Dimensional Marks in Japan, and Relevance between Industrial Designs and Three-Dimensional Marks

WIPO NATIONAL WORKSHOP (in JAKARTA)

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1. Legal System and Examination Standards Relating to Three-Dimensional Marks in Japan



1. (1) Three-Dimensional (3D) Trademark System of Japan

- Three-dimensional (3D) trademarks are trademarks consisting of three dimensional shapes, or any combination thereof, or any combination thereof with two-dimensional trademarks (such as characters and figures). Examples include trademark dolls placed in front of restaurants. Based on the revision made to the Trademark Act of Japan in 1996, a system to add protection for 3D trademarks was introduced and came into force in April 1997.

Representative examples
of 3D trademark
registrations



(Trademark
Registration
No. 4164983)



(Trademark
Registration
No. 4153602)



(Trademark
Registration
No. 4190263)



(Trademark
Registration
No. 4157614)



(Trademark
Registration
No. 4157615)

1. (2) 3D Trademarks (under the Trademark Act of Japan)

(The underlined part means) Marks are marks consisting of character(s), figure(s), and three dimensional shape(s), which are things that exist anywhere in the world.

Article 2 (1) of the Trademark Act

“Trademarks” in this Act mean, among those that can be recognized by human perception, any character(s), figure(s), sign(s), three dimensional shapes, and colors, or any combination thereof, or sounds, or others specified by Cabinet Order (hereinafter referred to as “marks”) which are:

- (i) used in connection with the goods of persons who produce, certify, or assign the goods as a business; or
- (ii) used in connection with the services of persons who provide or certify the services as a business (except those provided for in the above item).

(In addition to the underlined part,) Trademarks = marks that are used in goods and services (designated goods and services) as a business

3D trademarks under the Trademark Act of Japan

⇒ mean three dimensional shapes, including characters, figures, signs, colors, or any combination thereof with colors, which are used in goods and services (designated goods and services) as a business

(Under the Trademark Act, 3D trademarks have the same effects as those of two dimensional trademarks. When trademark rights are established by registering trademarks, the trademark rights holders have exclusive rights to use trademarks as well as to designated goods and services, which are identical with their registered trademarks and their registered designated goods and services, respectively. These holders also have rights to prohibit the use of trademarks that are similar to their registered trademarks.)

Differences between the Trademark Act and other intellectual property Acts, such as the Patent Act and the Design Act: Under other intellectual property Acts, the purpose of the Acts is to protect “creations” as a result of human mental and intellectual activities. On the other hand, under the Trademark Act, there are no concepts of “novelty” and “inventive step.” The purpose of the Trademark Act is, by protecting trademarks, to establish and ensure the appropriate order of business transactions, so as to protect the interests of consumers.

1884



Establishment of the trademark system in Japan

1997



Expansion of trademark protection to include 3D trademarks

(When 3D trademarks became eligible to be registered, if users had used 3D trademarks before the revised Trademark Act came into force and applications were filed for the same trademarks, such users were allowed to continue using their trademarks within the scope of their businesses as rights of continued use.)

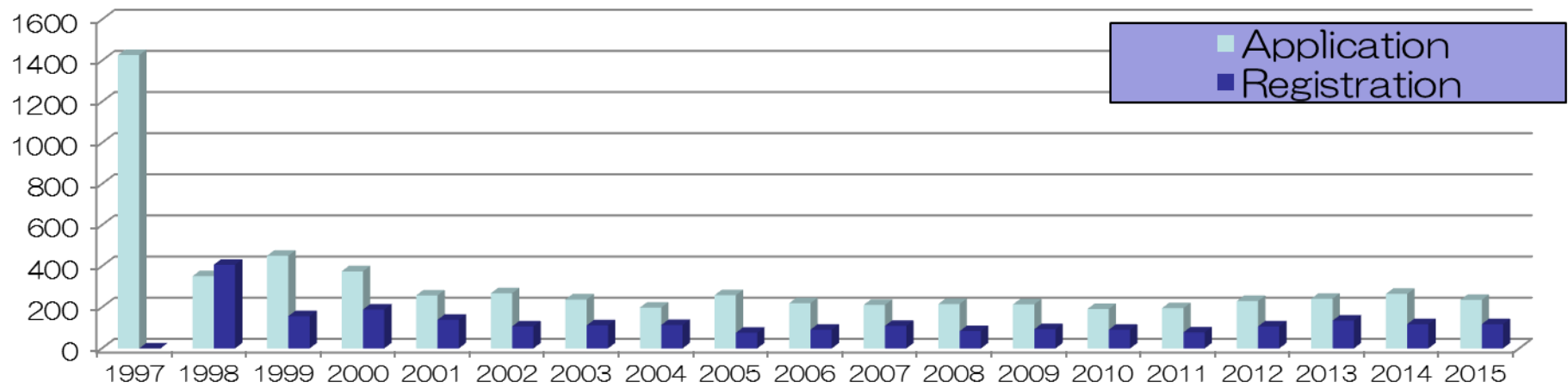
2015

Addition of sound trademarks, motion trademarks, hologram trademarks, and position trademarks

(When trademarks of sounds, motions, holograms, and positions became eligible to be registered, if users had used these non-traditional trademarks before the revised Trademark Act came into force and applications were filed for the same trademarks, such users were allowed to continue using their trademarks within the scope of their businesses as rights of continued use.)

1. (4) Number of Applications Filed in Japan to Register 3D Trademarks and Number of 3D Trademark Registrations

Number of Applications Filed in Japan to Register 3D Trademarks and Number of 3D Trademark Registrations



Total number

Number of applications ⇒ about 6000

Number of registrations ⇒ about 2700

Note: Figures are not based on the official ones at the JPO.

1. (5) Examination Process for Trademark Applications

Application to register a trademark

Formality examination

Substantive examination

Traditional trademarks

Non-traditional trademarks

Whether a filed trademark is recognized or can be used as a 3D trademark based on its specimen (mark drawing) (The principal paragraph of Article 3(1))

Whether a filed trademark is identified as a non-traditional trademark (except a 3D trademark) based on its composition and form (Article 5 (5))

Examinations in determining to have distinctiveness (Examinations to determine whether a filed trademark is subject to absolute reasons for refusal) (Article 3)

Examinations in determining to have distinctiveness (Examinations to determine whether a filed trademark is subject to absolute reasons for refusal) (Article 3)

Examinations on reasons why can't be registered (Examinations to determine whether a filed trademark is subject to relative reasons for refusal) (Article 4)

Examinations on reasons why can't be registered (Examinations to determine whether a filed trademark is subject to relative reasons for refusal) (Article 4)

Make judgment on whether a filed trademark should be registered or not.

1. (6) Documents Needed for Filing Applications to Register Non-Traditional Trademarks

In Japan, from April 1, 1997, a three dimensional (3D) trademark system was adopted. From April 1, 2015, five types of non-traditional trademarks became eligible for protection, which are “motion trademarks,” hologram trademarks,” “color trademarks,” “sound trademarks,” and “position trademarks.”

Development of Filing Procedures

Types of trademarks	Detailed written descriptions of trademarks	Articles to be submitted
Motion trademarks	○	×
Hologram trademarks	○	×
Color trademarks	○	×
Sound trademarks	△	○
Position trademarks	○	×
3D trademarks	×	×

Since the scope of rights for non-traditional trademarks are granted based on trademarks themselves and the detailed explanations of the trademarks, “detailed written descriptions of trademarks” are important. For sound trademarks, articles, i.e. audio files (audio reproductions of their sound marks in the form of electronic files) should be submitted.

For 3D trademarks, specimen should be attached in the form of figures or photographs to application forms, in order to specify that the claimed trademarks consist of three dimensional shapes.

1. (7) Items to be Included in Application Forms to Register 3D Trademarks

Applicant must write the following items in an application form:

- (a) Description of “**type of trademark**”
- (b) Description of **figure or photograph** of 3D trademark **viewed from one or two or more different angles**

Name of document: Application filed to register trademark
Filing date: ○, ○, 20xx
Addressee: Commissioner of the Japan Patent Office
Trademark that applicant seeks to register:
As attached sheet

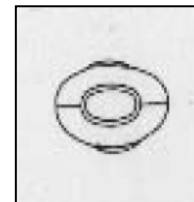
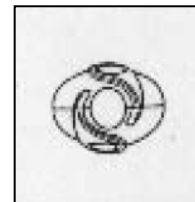
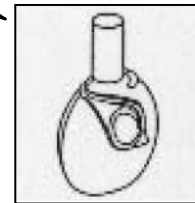
(a) Type of trademark

Three dimensional trademark
Designated goods and/or services and classes of designated goods and/or services:
Class ○
Designated goods (services): ○○○
Applicant for trademark registration:
Address or domicile: ○○○
Names and/or titles: ○○○ (Impress)

(b) Two or more figures or photographs of 3D trademarks can be described in attachment.

Attachment

Trademark that applicant seeks to register:

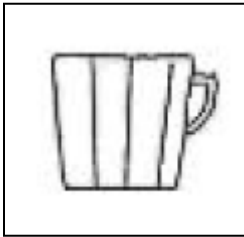


1. (8) Reasons for Refusal to Identify the Scope of Rights (for 3D Trademarks)

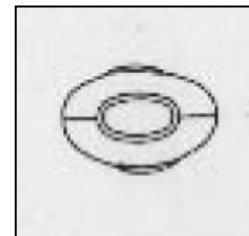
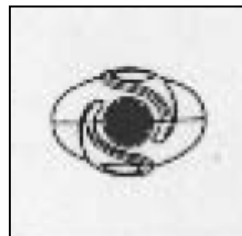
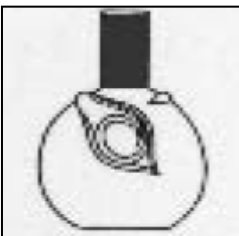
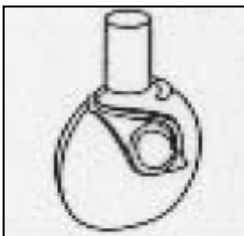
When claimed 3D trademarks cannot be recognized as 3D trademarks based on the specimens attached to the application forms,
⇒ the claimed trademarks will be refused on the grounds that they do not fall under “trademarks” stipulated in the principal paragraph of Article 3.

Examples of cases in which claimed trademarks cannot be recognized as 3D trademarks:



- (1) Not recognized to be three dimensional;
- (2) The three dimensional elements and two dimensional elements are separated. That is, the letter portion does not stick to the three dimensional elements in a three dimensional shape; and



- (3) Attached figures differ in terms of views of claimed trademarks.



Trademarks that are not considered to have a distinctiveness, i.e. function to distinguish the goods and services from other goods and services (under the items of Article 3 (1) of the Trademark Act)

Unregistrable Trademarks defined in the items of Article 3 (1)	Examples of trademarks and their designated goods, which lack distinctiveness
(i) Common names of goods or services	Trademark: “Alumi” Designated goods: Aluminum
(ii) Customarily used names	Trademark: “Masamune” Designated goods: Japanese rice wine
(iii) Marks that simply indicate places of origin, places of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), prices, etc. of goods or services	Trademark: “Tokyo Ginza” Designated goods: Clothes (place of sale)
	Trademark: “All purpose” Designated goods: Drugs (Efficacy of goods)
(iv) Marks indicating commonplace names or titles in a common manner	Trademark: “Yamada”/“YAMADA”/“Sato & Co.”
(v) Extremely simple and commonplace characters and figures	Trademark: “—“ (i.e. one straight line) / “AB” /  (i.e. column)
(vi) Marks that customers cannot recognize as goods or services connected with the business of particular persons	Trademark:  Designated goods: Papers, stationary (pattern on papers and stationary)
	Trademark: “New type of restaurant” Designated services: Providing food and beverage services

* In case claimed trademarks defined in the items (i) to (v) are specifically designed logos, they may be registered as trademarks.

* * In case claimed trademarks defined in the items (iii) to (vi) have become well known, they are considered to be exceptional cases and can be registered as trademarks, according to Article 3 (2) of the Trademark Act.

- Responding by revising the law
(Additional provision to Article 3 (1) (iii) of the Trademark Act)

In addition to “trademarks consisting solely of marks indicating, in a common manner, the quality of goods and the like,” which are subject to absolute reasons for refusal, the following trademarks are added:
“trademarks consisting solely of marks indicating the shape of goods in a common manner.”

- Examination practices

Claimed 3D dimensional trademarks can be refused because they are:

- (1) Trademarks consisting solely of marks indicating the shape of goods in a common manner (under Article 3 (1) (iii))
- (2) Trademarks consisting solely of extremely simple and commonplace marks (under Article 3 (1) (v)).

1. (9) Absolute Reasons to Refuse Applications for Registering 3D Trademarks (ii)

● Examination practices:

(1) Trademarks consisting solely of marks indicating the shape of goods in a common manner (under Article 3 (1) (iii))

i) When consumers recognize claimed trademarks as marks indicating a merely three dimensional shape that can be adopted as a typical example in the same kinds of goods

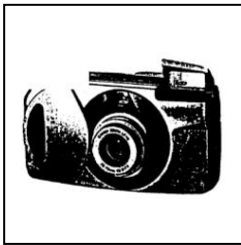
→ the claimed trademarks fall under the provision in principle.

ii) Even if claimed trademarks consist of three dimensional shapes to which distinctive changes and decorative elements are arranged, but when consumers recognize them as merely changes and decorative elements, which can be adopted as those improving the aesthetic appeal in the industry dealing with their goods or services,

→ the claimed trademarks fall under the provision in principle.

Examples of trademarks that can be basically refused as trademarks:

i) Three dimensional shapes that can be adopted as a typical example of goods that are identical with the designated goods

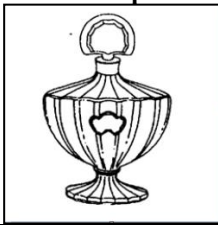


Class 9: Cameras



Class 14: Wristwatches

ii) Three dimensional shape to which some changes and decorative elements are arranged within the scope that can be adopted as those improving the aesthetic appeal



Class 3: Perfumes

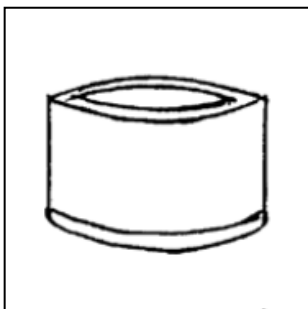
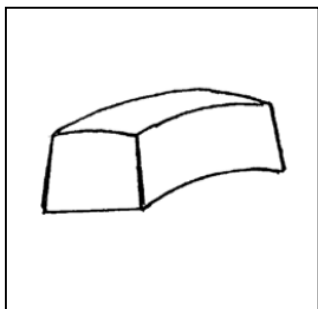


Class 14: Wristwatches

● Examination practices:

(2) Trademarks consisting solely of extremely simple and commonplace marks (under Article 3 (1) (v))

Examples of trademarks that can be basically refused as trademarks:



● Examination practices: trademarks that cannot be refused because they are considered to be exceptional cases and can be registered as trademarks :

(1) Trademarks that acquire distinctiveness as a result of continuous use (under Article 3 (2))

- Even if claimed trademarks fall under absolute reasons for refusal stated in the previous slide, but when they acquire distinctiveness as a result of continuous use, they can be given exceptional consideration and registered as trademarks.
- In order for claimed trademarks to be eligible and given exceptional consideration under the rules, they should have gained a certain degree of well-known status throughout the country as a result of long-term, continuous use as well as use in advertising and promotional campaigns, so that the claimed trademarks can be identified and distinguished from the shape of goods that are identical with the designated goods.

1. (9) Absolute Reasons to Refuse Applications for Registering 3D Trademarks (v)

● Examination practices - trademarks that cannot be refused because they are considered to be exceptional cases and can be registered as trademarks :

(1) Trademarks that acquire distinctiveness as a result of continuous use (under Article 3 (2))

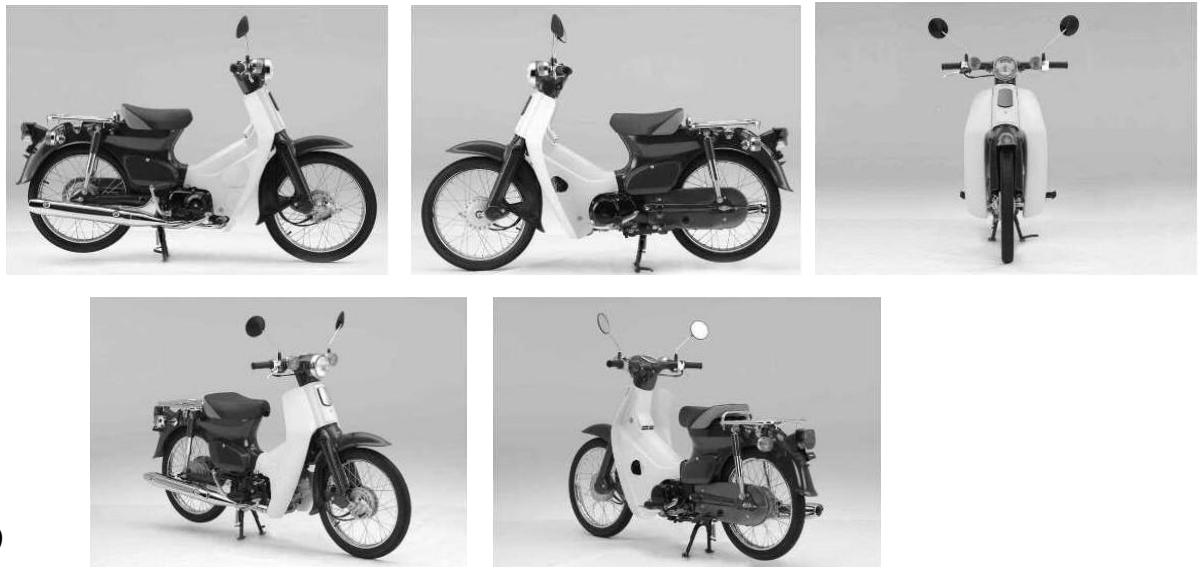
Examples of registered trademarks:

Bottle shapes of coke



Trademark registration No. 5225619
The Coca-Cola Company

Shapes of motorcycle



Trademark registration No. 5674666
Honda Motor Co., Ltd.

● Examination practices - trademarks that cannot be refused because they are considered to be exceptional cases and can be registered as trademarks :

(1) Trademarks that acquire distinctiveness as a result of continuous use (under Article 3 (2))

(2) Trademarks consisting of three dimensional shapes on which distinctive characters and figures are depicted

Such trademarks are considered distinctive as a whole.

Examples of registered trademarks:



Trademark registration No.
5352451







Trademark registration No.
5181517



Trademark registration No.
5430546

(Reference) Relative Reasons to Refuse Trademark Applications

Trademarks that cannot be registered as trademarks from the perspectives of public interests or protecting private interests (under Article 4 (1) (i) to (ix))

Unregisterable trademarks defined in the items of Article 4 (1)	Examples of unregisterable trademarks
(i) National flags, the imperial chrysanthemum crest, decorations, medals or foreign national flags	
(ii), (iii) and (v): Trademarks designated by Minister of Economy, Trade and Industry (Marks or emblems indicating the United Nations and other international organizations)	
(iv) Emblems and marks of the Red Cross and others	
(vii) Trademarks that are likely to cause damage to public order and morality	“PATENT UNIVERSITY” “WHITE HOUSE”
(viii) The names or stage names of others (Those obtaining approval from the concerned persons can be registered)	“AKB48” “ICHIRO 51”
(vi) Marks of national and local governments, business for public interests, etc.	
(xvi) Trademarks that are likely to mislead, in terms of the quality of the goods or services)	Trademark: “viva MEXICO” Designated goods: Confectionery ⇒ “Confectionery made in Mexico”
(xviii) trademarks consisting solely of a three dimensional shape of goods or their packaging, which is indispensable for securing functions of such goods or their packaging)	

Trademarks that are likely to cause confusion with registered trademarks or famous trademarks of others and trademark applications filed in bad faith (under Article 4 (1) (x), (xi), (xv), and (xix))

Unregisterable trademarks defined in the items of Article 4 (1)	Examples of unregisterable trademarks
(xi) Trademarks that are identical with, or similar to, earlier registered trademarks of others	Filed trademark: “PHOENIX” ÷ Registered trademark “Felix”
	Filed trademark: “pba” ÷ Registered trademark “BBA”
(x, xv, and xix) Trademarks that are identical with, or similar to well-known/famous trademarks	Filed trademark: “ILANCELI” ÷ Famous trademark “LANCEL” (xv)
	Filed trademark: “iOffice2000” ÷ Famous trademark “Office2000” (xix)

1. (10) Relative Reasons to Refuse Applications for Registering 3D Trademarks (i)

Trademarks consisting solely of characteristics specified by the Cabinet Order, which should be justifiably held by goods, i.e. goods or their packaging or services (the same shall apply under Article 26 (1) (v)) (Article 4 (1) (xviii))

Characteristics of trademarks for goods, which are specified by the Cabinet Order under Article 4 (1) (xviii) and Article 26 (1) (v) of the Trademark Act, should be three dimensional shapes, colors, or sounds (those of trademarks for services are three dimensional shapes, colors, or sounds, which are used on articles for which services are provided. (Article 1 of the Order for Enforcement of the Trademark Act))

- “Characteristics that should be justifiably held by goods or their packaging or services” include three dimensional shapes that are indispensable for securing functions of the goods or their package or services, and colors or sounds, which should be justifiably held by the goods. They in principle fall under Article 3 (1) (iii).
- Applying Article 3 (1) (iii) becomes a problem when claimed trademarks are those to which Article 3 (2) (distinctiveness as a result of continuous use) are allowed to apply.



1. (10) Relative Reasons to Refuse Applications for Registering 3D Trademarks (ii)

● Dealing with by revising the law (Article 4 (1) (xviii) of the Trademark Act)

When the JPO expanded trademark protection to include 3D trademarks in 1997, the JPO added “trademarks consisting solely of three dimensional shapes that are indispensable for securing functions of the goods or their packaging” as trademarks that are subject to relative reasons for refusal. If such trademarks are allowed to be registered as trademarks, this may semi-permanently grant exclusive rights in essence to the trademark rights holders for producing and selling the goods. Also, that is likely to prevent any appropriate competition in the market.

In expanding protection to include color trademarks and sound trademarks in 2015, the JPO set forth a rule that reasons for refusal should apply to “trademarks consisting solely of characteristics specified by the Cabinet Order, which should be held by the goods or their packaging or services.” Also, the JPO stipulated that the Cabinet order would identify specific characteristics that include “three dimensional shapes that are indispensable for securing functions of the goods or their packaging or services.”

● Specific examples

Designated goods “automobile tires” have a “three dimensional, round shape.”

Designated goods “baseball balls” have a “three dimensional, ball shape.”

(As an example of sound trademarks, sounds made by grilling meat in services that serve grilled meat)

● Examination practices

Characteristics falling under Article 4 (1) (xviii) include those of goods and services under Article 3 (1) (iii). However, acquired distinctiveness as a result of continuous use (under Article 3 (2)) becomes a problem.

● Examination Guidelines

Examiners at the JPO consider the following when determining whether claimed trademarks fall under this provision:

(a) Whether there are other three dimensional shapes or colors or sounds, which can alternatively ensure the functions of the goods and services; and

(b) Even if there are such alternative three dimensional shapes or colors or sounds, whether they can be produced at the same (or lesser) cost.

2. Relevance between Japan's Three-Dimensional Trademarks and Industrial Designs

(From the Perspective of Provisions for Adjusting Conflict between Claimed Trademarks and Earlier Registered IP Rights of Others)



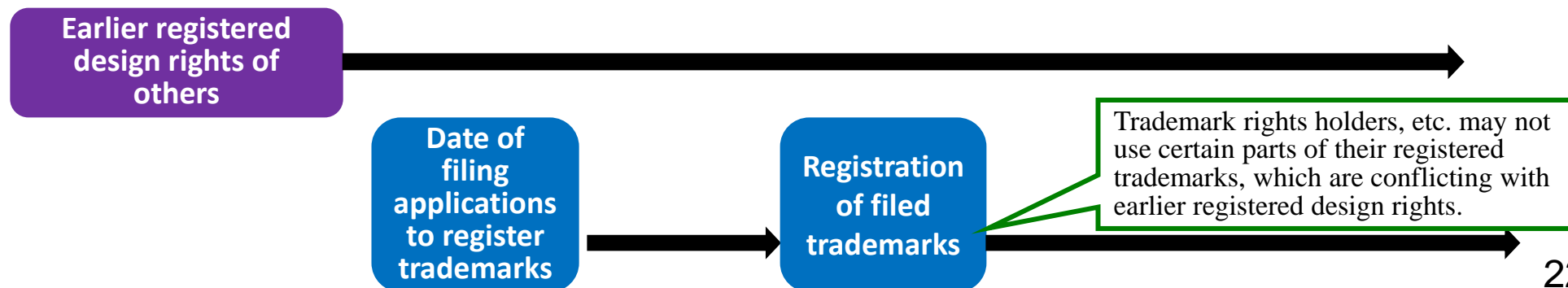
2.(1) Provisions for Adjusting Conflict between Trademark Rights and Other IP Rights (i)

- In Japan, Article 29 of the Trademark Act may serve to adjust cases in which trademark rights are conflicting with earlier registered patent rights, utility model rights, design rights and copyrights of others.

Relationship with patent rights, etc. of others

Article 29

When the use of registered trademarks in a particular manner in connection with their designated goods or designated services conflicts with others' rights of patents, utility models or designs, for which applications had been filed before the date on which applications for the said registered trademarks were filed, or others' copyrights and neighboring rights arising prior to the filing date of the same, none of the trademark rights holders, exclusive rights holders, or non-exclusive rights holders may use the registered trademarks in the same manner on the conflicting part used in the designated goods or designated services.



2.(1) Provisions for Adjusting Conflict between Trademark Rights and Other IP Rights (ii)

Outline of Article 29 of the Trademark Act

Article 29 serves as a provision for adjusting conflict between trademarks and other IP rights of others.

When rights to use registered trademarks in their designated goods or designated services conflicts with others' rights of patents, utility models or designs, for which applications had been filed before the date on which applications for the said registered trademarks were filed, or others' copyrights and neighboring rights arising prior to the filing date of the same, any of the conflicting parts of the registered trademarks may not be used in the designated goods or designated services.

- Article 29 was created to serve as a provision for adjusting conflicts between trademark rights and other IP rights of others based on a first-to-file principle.
- The provision may limit the scope of trademark rights within a certain range.
- The underlined latter part of the provision “the conflicting part of the registered trademarks may not be used in the designated goods or designated services” means that, for example, any of the conflicting parts of the registered trademarks, i.e. the parts that are conflicting with the parts of articles containing earlier registered designs or their similar articles, may not be used in their designated goods.

2.(1) Provisions for Adjusting Conflict between Trademark Rights and Other IP Rights (iii)

Outline of Article 29 of the Trademark Act: Why do provisions for adjusting conflicts of rights apply to the examination process?

- Even if claimed trademarks are conflicting with prior rights of designs, etc., the following should be taken into account: (1) trademarks are protected to ensure the reliability of the businesses of persons who use the registered trademarks, and the purpose and scope of their protection are different from those of other IP rights (e.g. design rights protect creations of designs); (2) trademarks consisting of 3D shapes can be registered as trademarks only when they have acquired distinctiveness as a result of their continuous use or have specific shapes; and (3) trademarks can be registered as trademarks only when they are not regarded as those that are indispensable for securing functions of the goods.
- Based on reasons (1) to (3), examiners at the JPO basically do not need to examine whether claimed trademarks are in conflict with other registered IP rights such as design rights in the examination process. After allowing the possibly conflicting rights of both the claimed trademarks and other IP rights, examiners will adjust the scope of the rights for the claimed trademarks based on a first-to-file principle.
- Also, another reason is that examiners have practical difficulties in examining whether claimed trademarks are conflicting with copyrights, etc. in the examination process.

2.(1) Provisions for Adjusting Conflict between Trademark Rights and Other IP Rights (iv)

Development of Article 29 of the Trademark Act

- Before the Trademark Act was revised in 1997, the Act included provisions for adjusting only cases in which trademark rights and design rights or copyrights would be conflicting.
- After the revision was made in 1997 to add protection for 3D trademarks, provisions were added to adjust conflicts between trademark rights and patent rights or utility model rights.
- After the Trademark Act was revised in 2015 to add protection for sound trademarks, provisions were added to adjust conflicts between trademark rights and copyright and neighboring rights.

Articles similar to Article 29 of the Trademark Act

- When applications had been filed to register trademarks prior to the dates on which applications were filed for patent rights, utility model rights, or design rights, and if the rights to use the registered trademarks in their designated goods and services are conflicting with the patent rights, the utility model rights or/and the design rights, any working may not be conducted for the conflicting parts of the patented inventions, the registered utility models, and the registered designs. (Article 72 of the Patent Act, Article 17 of the Utility Model Act and Article 26 of the Design Act)
- The Copyright Act does not include such adjustment provisions.

2.(2) Cases in which Trademark Rights are Conflicting with Patent Rights and Utility Model Rights

Cases of “Conflicts”

1. Cases in which trademark rights are conflicting with patent rights and/or utility model rights:

When registered trademarks are used as 3D trademarks that are conflicting with the shapes of goods that are protected by patent rights and utility model rights

In these cases, based on Article 29 of the Trademark Act, any rights holders of the registered trademarks may not use their registered trademarks. The exclusive rights to use the registered trademarks may be limited.

← When the trademark rights holders wish to use the conflicting parts of their registered trademarks, they need to obtain a license for the patent rights and the utility model rights.

2.(3) Cases in which Trademark Rights are Conflicting with Design Rights

Cases of “Conflicts”

2. Cases in which trademark rights are conflicting with design rights:
When registration is established for trademarks that are identical with the appearance and shape of articles for which a design registration was granted:

Examples:

- Cases in which third parties obtained trademark rights to use their 3D trademarks that are identical with the appearance and shape of an advertising mascot for which a design registration was granted
- Cases in which third parties obtained rights to use their figurative trademarks that are identical with the pattern portion of registered clothing designs

In the cases above, based on Article 29 of the Trademark Act, no rights holders of the registered trademarks can use their trademarks. Their exclusive rights may be limited.

← When the rights holders wish to use the conflicting parts, they need to obtain a license for the design rights.

2.(4) Cases in which Trademark Rights are Conflicting with Copyrights

Cases of “Conflicts”

3. Cases in which Trademark Rights are Conflicting with Copyrights:

Copyrights are not specifically connected to articles. When pictures and figures within the scope of earlier registered copyrights are used as trademarks:

Example:

- Cases in which third parties obtained registration for their trademarks that are identical with the character pattern for which copyrights had been granted to specific persons.

In these cases, based on Article 29 of the Trademark Act, no rights holders of the registered trademarks can use their trademarks. Certain limits may be imposed on their exclusive rights.

← When the rights holders wish to use the conflicting parts, they need to, for example, establish the rights of publication for the copyrights..

2.(5) Relation between 3D Trademarks and Designs (i)

- 3D trademarks are trademarks consisting of three dimensional shapes of goods or their packaging or articles for which services are provided, and are used in connection with goods or services related to the businesses of applicants. The purpose of protecting 3D trademarks is, by upholding their functions of distinctiveness from other goods and services, to ensure the reliability of the businesses of persons who use the registered trademarks.
- Designs mean any shapes, patterns, colors, or any combinations of these, in an article, which create an aesthetic impression in the eyes and minds of the observers. Designs need novelty and creativity in order to be registered as designs. The purpose of granting design rights is to protect creations of designs.




3D trademarks and designs differ in concepts, such as purposes of protection. Nonetheless, in some cases, the scope of protection, i.e. three dimensional shapes (3D trademarks) and the shapes of articles (designs), may be identical.




Article 29 of the Trademark Act, etc. serves to adjust such cases. (Basically, under these laws, redundant protection is assumed. Actually, in some cases, applications were filed to register trademarks that were identical with designs, which had been earlier registered but expired.)

2.(5) Relation between 3D Trademarks and Designs (ii)

- The period of protection for trademark rights is 10 years from the date on which the rights were registered. Nonetheless, trademark rights can be renewed any number of times, so that the rights can continue almost permanently..
- The period of protection for design rights is limited to 20 years from the date on which the rights were registered.



Nonetheless, in some cases, the scope of protection, i.e. three dimensional shapes (3D trademarks) and the shapes of articles (designs), may be identical. If the rights holders (applicants) are identical, they are able to strategically ensure their rights by registering both the 3D trademarks and designs.



(1) One example is that applicants obtained design rights ahead of trademark rights for their intellectual properties. For example, when filing trademark applications for packing containers, it is difficult for the trademarks consisting solely of three dimensional shapes to be registered as 3D trademarks. Nonetheless, if these packing containers have some creativity, etc., their shapes may be protected as designs. Also, if they have become well-known as a result of continuous use, they may be registered also as 3D trademarks, so that the applicants could maintain their rights almost permanently.

(2) Another example is that applicants obtained trademark rights ahead of design rights for their intellectual properties. For example, when filing trademarks consisting of characters, their rights may be established relatively early. Accordingly, applicants first obtained trademark rights for their trademarks consisting of characters, so as to ensure the rights as brands. After that, they may further acquire trademark rights for their 3D trademarks using these registered character trademarks, or the shapes of the goods may be protected by acquiring trademark rights as 3D trademarks, design rights, or patent rights.

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Thank you!!
ありがとうございました!!