



Gamification Code:
VACANT



The TM5 Unlocked

Essential Updates for International Filers



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Eleni Kokkini

PPT Legal



What is TM5?



TM5: Evolution of Global Trademark Cooperation

Core Definition

- Multilateral cooperation forum composed of the world's five largest trademark offices.
- Represents over 60% to 70% of all global trademark applications filed worldwide.

The Five Partners & Observers

- CNIPA: China National Intellectual Property Administration
- EUIPO: European Union Intellectual Property Office
- JPO: Japan Patent Office
- MOIP: Ministry of Intellectual Property of the Republic of Korea
- USPTO: United States Patent and Trademark Office
- Observer: World Intellectual Property Organization (WIPO)

Historical Timeline

2001 | The Foundation

Launched as the 'Trademark Trilateral' by JPO, EUIPO (formerly OHIM), and USPTO.

2011 | First Expansion

The Korean Intellectual Property Office (KIPO) officially joins the framework.

2012 | The Birth of TM5

China's CNIPA (formerly SAIC) joins, expanding the alliance into the TM5.

TM5 Mission:



Exchange of information on practices and programs



Joint projects aimed at the harmonization and improvement of trademark procedures



Development of user-friendly—and where possible, interoperable—trademark systems

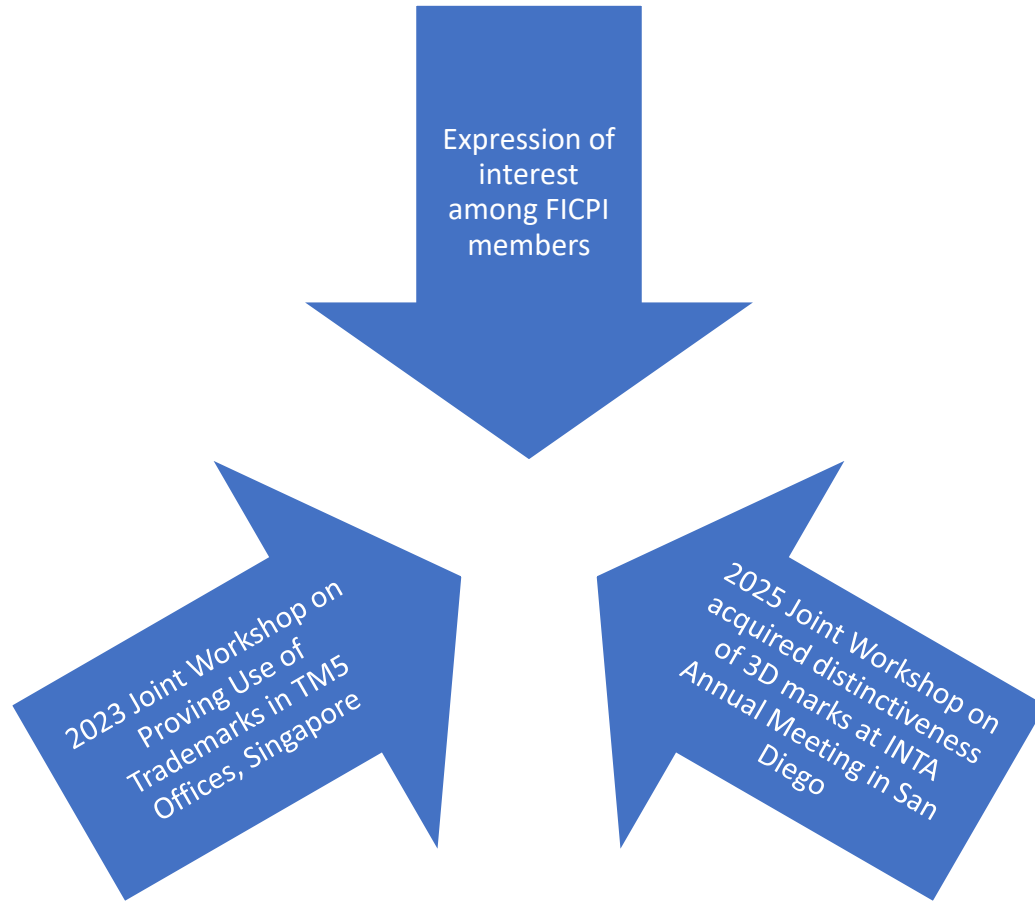


Fostering cooperation and collaboration among its members



Projects list: <https://tmfive.org/projects/project-list/>

Acquired distinctiveness of a TM through use



- Legal framework & procedure
- Ways to prove it!



Marianna Kondás

EUIPO





Acquired Distinctiveness through use EUIPO

1. Legal framework
2. Relevant point in time / Relevant public / What do we have to prove and where?
3. Evidence
 - Standard of proof
 - Means of evidence
 - General rules of assessment
 - Common mistakes in the presentation of evidence
4. Case law examples



Article 7(3) EUTMR

Article 7(3) EUTMR is an **exception** to the rule of Article 7(1)(b), (c), (d) EUTMR

‘Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.’

Article 7(3) requires a **claim** by the applicant

‘The application may include a claim that the sign has acquired distinctive character through use within the meaning of Article 7(3) ..., as well as an indication of whether this claim is meant as a principal or subsidiary one. Such claim may also be made within the period referred to in Article 42(2)...’

In the application or in the first reply to the objection; not possible for the first time in appeal proceedings

Two types : Principal claim ☐ One single decision Subsidiary claim ☐ Two separate decisions



Two different claims

Principal claim



- Applicant requests EUIPO to:
 - Decide on both inherent and acquired distinctiveness in the same decision
- One single decision

Subsidiary claim

Applicant requests EUIPO to issue a:

- First decision on inherent distinctiveness
- Only when this decision is final, the Office takes a second decision on acquired distinctiveness

Two separate decisions



Relevant Point in Time

Examination:

- EUTM applications (also cancellation) **Filing date** (Priority date)
- International Registrations (IR): **Registration date** (Designation date of EU)

Cancellation:

- If a trade mark has acquired distinctive character **after registration** it may not be declared invalid, Article 59(2) EUTMR).



What do we have to prove?

The EUTM applicant must submit evidence that enables the Office to find that at least a significant proportion of the relevant ... public identifies the products or services ... as originating from a particular undertaking because of the trade mark .

(T-262/04, Briquet à Pierre, EU:T:2005:463, § 61 and the case-law cited therein).

- The burden of proof is on the applicant.
- The evidence must show use as a trade mark (not descriptive use).
- Evidence must be submitted for each of the goods and services claimed.



Where do we have to prove?

Acquired distinctiveness must be established throughout the territory in which the trade mark did not ab initio have distinctive character. (C-25/05 P)

A significant proportion of the relevant public (actual and prospective consumers of the goods/services)

In all the relevant territories and in respect of each of the goods/services.





Relevant public



PRADA

BURBERRY





Evidence: Standard of proof

Article 7(3) EUTMR is an exception. □ The required standard of proof is **high** and the assessment is **strict**.

The evidence must be **presented in a structured manner** (Art 55 EUTMDR) and must be clear and convincing. The applicant must clearly establish all the facts necessary to safely conclude that the mark has been used as a badge of origin to an extent that it has created a link with the goods or services in the mind of the relevant public.

According to Case-law there are **no fixed percentages** of market penetration or of recognition by the relevant public (judgment of 19/06/2014, C-217/13 and C-218/13, Oberbank e.a., EU:C:2014:2012, § 48).



Means of evidence

Sales brochures, Catalogues, Price lists

Invoices, Annual reports, Turnover figures

Advertisements (together with evidence of their intensity and reach), Advertising investment figures

Customer and/or market surveys, Declarations by professional associations , Affidavits





Means of evidence

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Customer and/or market surveys, Declarations by professional associations , Affidavits



Means of evidence of evidence (see also

Art. 97 EUTMR)

Direct evidence

- Customer surveys
- Market studies
- Declarations by professional associations

Corroborative evidence

- Sales brochures, Catalogues, Price list
- Advertisements,
- Advertising investment figures
- Affidavits

The Office's main focus is the evidential value of the documents

The applicant often focuses more on easy obtainability and volume



General Rules of Assessment

The Office must make an overall assessment of all the evidence submitted , weighing up each indication against the others , e.g.

- Market share held by the mark with regard to the relevant goods or services
- Extent of use of the mark (intensity, geographical reach, duration)
- Investment in promoting the mark for the relevant goods or services
- Proportion of the relevant public who actually, because of the mark, identifies the goods or services as originating from a particular undertaking

(C-108/97 and C-109/97, Chiemsee, EU:C:1999:230, § 31; T-378/07, Représentation d'un tracteur en rouge, noir et gris, § 32)



General mistakes in the evidence:

The evidence is not properly structured .  Clear and convincing

The date of use cannot be identified.  Relevant point in time

No link to the relevant territories / goods and services.  Relevant public

The evidence filed only corroborative evidence.  Consumer recognition



Common mistakes:

Evidence not related to the applied mark: sub-brand

Evidence does not specifically identify the services

- Example: 'biggest retail company...' retail of what?

Evidence without reference to independent sources:
affidavit

Territory: e.g. turnover numbers for Europe



Common mistakes:





Market share, advertising and turnover:

reference to the trade mark?

reference to the applied goods and services?

g/s marketed under several trade marks?

Length of use?



Proving acquired distinctiveness in the whole EU :

- “It would be unreasonable to require proof of acquired distinctiveness for each individual Member State.”
- Relevant evidence in relation to cross-border markets.
- Physical stores → online presence and online advertising (the internet and/or social media, and/or shops in popular tourist areas or airports, T-275/21)
- Evidence from non-EU states irrelevant, except for conclusions to be drawn about use within the EU





Case law examples



19/10/2022, T-275/21 , Louis Vuitton Malletier v
EUIPO - Wisniewski (Représentation d'un motif à
damier II

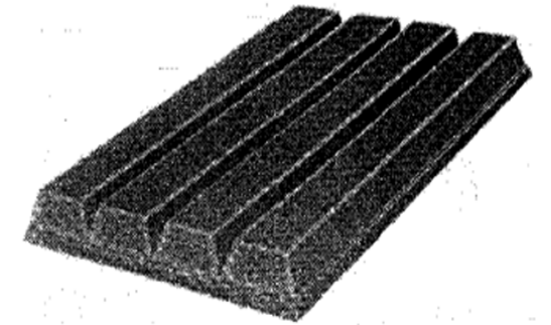
Case law examples



C 98/11 P, Hase EU:C:2012:307

SHAPE OF A 4-FINGER CHOCOLATE BAR C-84/17
P, C-85/17 P and C-95/17 P, EU:C:2018:596

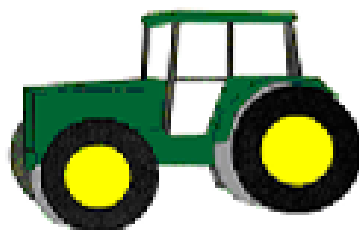
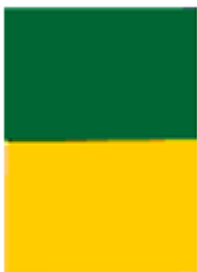
Regionalisation: neighbouring or commercially integrated national markets can be treated as one or sufficient knowledge due to the geographical, cultural or linguistic proximity





Case law examples

28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 33-42 et seq



EUTM 63289

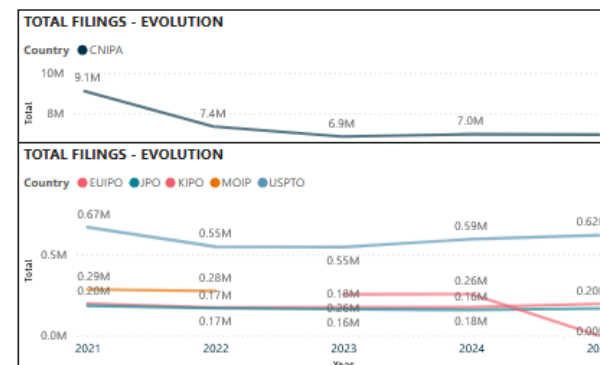
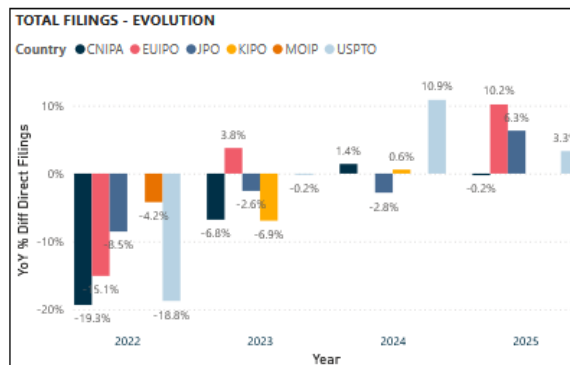
Extrapolation: evidence from some Member States can be extended to others if market conditions are sufficiently similar and some use is shown there as well.



TM5 Statistical Information

2025

TM5 statistics 2025 for Power BI



TOTAL FILINGS - EVOLUTION												
Año	2021			2022			2023			2024		
Country	Direct filings	International filings	Total	Direct filings	International filings	Total	Direct filings	International filings	Total	Direct filings	International filings	Total
CNIPA	9,084,571	26,572	9,111,143	7,327,812	25,681	7,353,493	6,830,539	21,814	6,852,353	6,927,417	21,814	6,927,417
EUIPO	165,922	31,976	197,898	140,930	33,222	174,152	146,223	29,465	175,688	152,085	29,465	152,085
JPO	164,537	20,094	184,631	150,506	19,769	170,275	146,664	17,397	164,061	142,540	17,397	142,540
KIPO							241,130	14,079	255,209	242,545	14,079	242,545
MOIP	270,421	15,400	285,821	259,075	16,710	275,785						
USPTO	639,189	28,725	667,914	519,320	29,195	548,515	518,423	27,312	545,735	574,680	27,312	574,680
Total	10,324,640	122,767	10,447,407	8,397,643	124,577	8,522,220	7,882,979	110,067	7,993,046	8,039,267	110,067	8,039,267

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70%

Microsoft Power BI

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<https://tmfive.org/statistics/>



TM5 Joint Communication Action (EUIPO+MOIP) – News items and Newsletter

<https://tmfive.org/news-and-events/>

TM5

Five Trademark Offices

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Title	Date
Save the Date: TM5 User Session May 28th	2026-05-26
TM5 Releases Comprehensive Guide for Color Mark Application Requirements	2026-05-20
Update of Interactive Table with 2025 Statistical Information	2026-05-12
TM5-INTA 10th Annual Joint Workshop in London – May 4th	2026-05-04
TM5 Partners Convene in Bangkok to Combat Bad Faith Trademark Applications	2026-04-14
Forecasting Expert Meeting 2025	2025-12-23
Main Outcomes from the TM5 Annual Meeting 2025	2025-12-10
Save the Date – TM5 Annual User Session in Alexandria, Virginia	2025-10-01
TM5 IT Support Expert Meeting 2025	2025-09-19

About **TM5**
Newsletter

TM5

NEWS

Save the date for 11 December for the TM5 User Session 2024 in Hakone, Japan

TM5 IT Support for Trade Mark Examination Project and Classification Expert meetings 2024

Publication of 2023 TM5 Statistics

TM5 Midterm meeting

TM5 User Meeting & Joint Workshop in Atlanta

Partner Office Updates

[See all >](#)

 Domestic Brands Make Way Into Drivers' Top 10

2024-03-27

 European Council adopts new regulation on geographical indications for agricultural products, wines and spirit drinks

2024-03-28

 Preliminary Statistical Data on Applications, Requests and Registrations

2024-03-28

 KIPPO Announced its World's First Hyperscale AI Language Model Exclusively for Patents

2024-01-09

 IP Champions: Expanding the innovation ecosystem

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY

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Chanyang Lee

*Ministry of Intellectual Property
Republic of Korea*





Acquired Distinctiveness Through Use in the Republic of Korea

Evidence That Matters in Practice

Chanyang LEE

Deputy Director, Trademark Examination Policy Division
Ministry of Intellectual Property (MOIP), Republic of Korea



Today's Roadmap

1

Legal framework

Article 33(2) of the Korean Trademark Act —
and the level of consumer recognition required

2

Evidence & procedure

What examiners look for, survey reliability, and Korea's two-stage collegial review

3

Three recent cases

Tosokchon Samgyetang (2024) · Dosirak (2025) · Buldak (2026) —
different evidence, same outcome



Legal Framework — Article 33, Trademark Act

Art. 33(1) Non-distinctive marks

(iii) Descriptive marks

- (iv) Conspicuous geographical names
- (v) Common surnames or names
- (vi) Simple and commonplace signs
- (vii) Other non-distinctive signs

use before filing =
recognized as a
source indicator



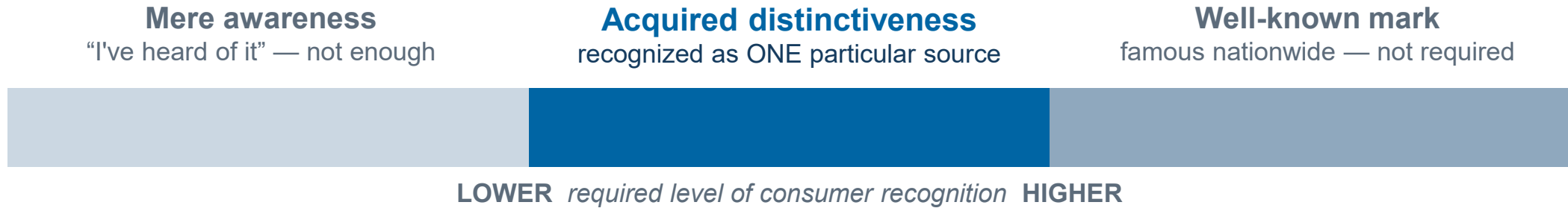
Art. 33(2) Registrable through acquired distinctiveness

*A strictly construed exception —
assessed on the totality of objective evidence*

Excluded: generic names (i) and customary marks (ii) can **never** acquire distinctiveness —
however long the use.



How Well-Known Must the Mark Be?



“It suffices that consumers, on seeing the mark, would recognize it as indicating the goods of a particular source — nationwide fame is not required.”

Patent Court, 20 July 2017, Case 2016Heo9271 (paraphrased)

Same mark · Same goods. Distinctiveness is recognized only for a mark substantially identical to the mark actually used, on the goods actually used — no extension to similar marks or goods.



What Examiners Look For — Five Factors

- | | | |
|---|---|--|
| 1 | Duration & continuity of use | From before filing until the decision to register — in principle, 5+ years of substantially exclusive and continuous use |
| 2 | Sales, volume & market share | Absolute figures — and comparison against the industry average adds persuasive force |
| 3 | Advertising & promotion | Ad spend, plus online marketing: social media, YouTube, influencer campaigns |
| 4 | Third-party materials | Media coverage, awards and other objective external records |
| 5 | Consumer recognition surveys | Objective evidence of source recognition — a key input in the assessment |



Consumer Surveys — When Are They Reliable?

Representative sample

Actual / potential consumers of the goods, balanced by region, gender and age

1,000+ respondents

A sample of this size is assessed as highly reliable

Fair questions

No leading questions; neutral, properly structured design

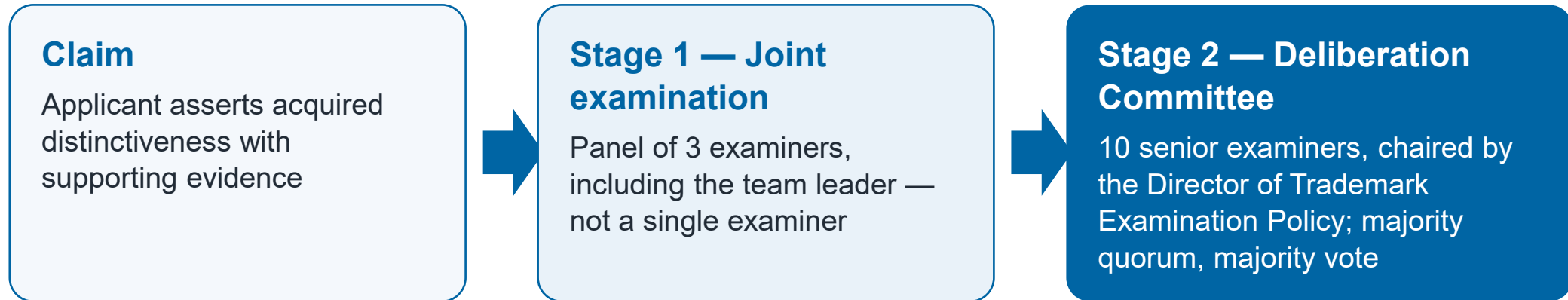
In such a survey, **recognition by more than 50%** of respondents as the mark of a particular source is considered **highly persuasive evidence**.

Practice tips

- Follow the IP Trial & Appeal Board's survey-methodology guidelines; commission a reputable professional survey firm
- Timing matters — a survey close to filing or examination carries more weight than a remote one



Korea's Two-Stage Collegial Review



Convened ad hoc, whenever a case is ready for deliberation · Recognition is recorded on the register as an Art. 33(2) registration

What this means for you: your written record must persuade a collegial body, not one examiner — link every claim to its evidence, and put the numbers in tables.



Three Recent Recognitions — Three Evidentiary Patterns

토속촌삼계탕

Tosokchon Samgyetang

2024 · Restaurant services (Cl. 43)

40 years, one location + court decision

도시락

Dosirak

2025 · Instant noodles (Cl. 30)

40 years of use + 5.8 billion units sold

불닭

Buldak

2026 · Noodles & sauces (Cl. 30)

89.2% consumer recognition in 14 years

All three passed the Deliberation Committee — each on a different mix of evidence.



Case 1 · Tosokchon Samgyetang (2024)

토속촌삼계탕



Descriptive: place-related term + the dish itself
· restaurant services, Cl. 43

Since 1983

40+ years of continuous service at a single location in Seoul

70–80×

annual sales of KRW 11–14.5 bn — far above the industry average

47.6% / 84.5%

awareness among respondents / of those aware, recognized it as one particular restaurant (sample: 500)

Court decision

injunction under the Unfair Competition Act found the sign well-known — filed as evidence

The survey was not read in isolation — the evidence was assessed as a whole.



Case 2 · Dosirak (2025)

도시락



“Dosirak” = lunchbox in Korean · square-container ramyeon since 1986, Cl. 30

Since 1986

≈40 years of continuous use on the same square-container product

5.8 bn units

cumulative sales —
exceptional for a ≈KRW 1,000 low-price item

Prior mark cleared

conflicting registration removed via non-use
cancellation before examination resumed

2 : 1

the Stage-1 joint panel split —
the collegial system at work; the Committee
then recognized the mark

Even an everyday word can acquire distinctiveness — with 40 years and 5.8 billion units behind it.



Case 3 · Buldak (2026)



1.4 bn units

domestic noodle sales in the last five years alone



89.2%

of survey respondents recognized it as one particular company's product

“Fire chicken” — descriptive of the spicy character · noodles, instant noodles & sauces, Cl. 30 · launched 2012

1,000 sample

nationwide, population-proportional design — a textbook reliable survey

Global reach

K-content marketing, international festivals, domestic and overseas awards

Intensive marketing and explosive recognition can do in ~14 years compared with the 40-year cases.



Same Outcome, Different Evidence

	Tosokchon (2024)	Dosirak (2025)	Buldak (2026)
Use period	40+ yrs, one location	≈40 yrs	≈14 yrs
Quantitative core	Sales 70–80× industry avg.	5.8 bn units cumulative	1.4 bn units in 5 yrs
Survey	47.6% aware · 84.5% source (n=500)	— (volume-led case)	89.2% source (n=1,000)
Distinctive extra	Court decision (UCPA)	Non-use cancellation first; 2:1 panel	K-content global marketing

There is no fixed formula — what matters is the overall evidentiary picture, built around the particular strengths of each case.



Four Takeaways for Your Korean Filings

1

Match the filing to actual use

File the mark as used, for the goods as used — substantial identity is the gate

2

Screen out generic & customary marks

They cannot acquire distinctiveness — check before you build the case

3

Submit concrete, objective proof

Sales, volume, market share, recognition surveys — evidence that consumers see one source

4

Use outcomes of parallel proceedings

Court decisions and trial results can serve as powerful supporting evidence

The two-stage collegial review is Korea's way of making this judgment predictable and consistent.

Thank you — questions welcome at the end of the session. · Chanyang LEE, MOIP



TM5 Projects Led by MOIP

1

Trademark Protection in Virtual Space

Comparative study of how the five offices examine and classify goods and services in virtual environments (metaverse, NFTs, virtual goods)

Final report now in the **validation stage** among TM5 partners —
to be published on the TM5 website upon completion

2

TM5 Official Website · tmfive.org

Operated by MOIP —
the single access point to all TM5 deliverables, statistics, news and meeting outcomes

**All TM5 project outcomes are public —
check tmfive.org before advising clients on virtual goods and services.**



Saho Munakata

Japan Patent Office

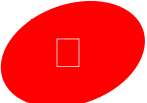


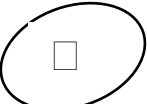
Acquired Distinctiveness Through Use in Japan

September 17, 2026

Saho Munakata
Specialist for Trademark Planning,
Trademark Division
Japan Patent Office



 Legal Framework and Requirements

 Case Studies

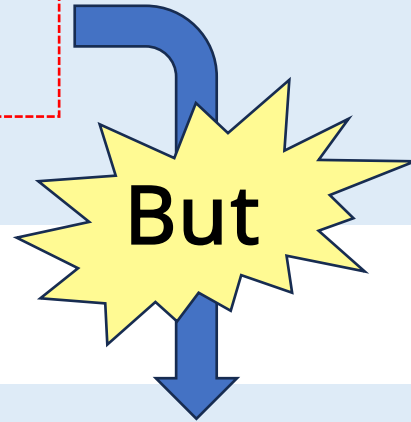
 Key Takeaways

Refusal Grounds Relating to Distinctiveness under the Japanese Trademark Act

Descriptive and non-distinctive marks are **not** registrable.

(Article 3 (1) of Trademark Act)

- i) Generic terms
- ii) Customary indications
- iii) Descriptive indications
- iv) Common surnames and names
- v) Simple and common marks
- vi) Other non- distinctive marks



Marks that have acquired distinctiveness through use may be registered.

(Article 3 (2) of Trademark Act)

Article 3

(2) ...a trademark that falls under any of items (iii) through (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.

Policy Balance behind Article 3(2)

Article 3(2) balances the interests of trademark owners with the public interest in keeping non-distinctive signs available for all to use.



Requirements for Establishing Acquired Distinctiveness

1

The applied-for trademark
= The trademark actually used

e.g., 1

A
B & ABC
C



e.g., 2



2

The designated goods/services
= The goods/services covered
by the evidence of use

e.g.

ice cream and
ice cream containing
chocolates



3

Nationwide consumer recognition



How JPO Assesses Acquired Distinctiveness

■ Typical evidence

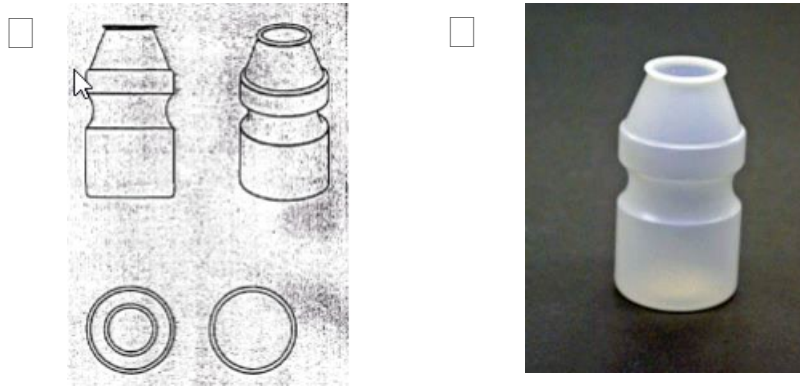
- ① **Photographs, videos,**
or other evidence demonstrating the actual use of the trademark
- ② **Transaction records**
such as purchase orders, shipping documents, delivery notes, invoices, receipts, and accounting records
- ③ **Advertising records**
- ④ **News articles**
- ⑤ **Consumer surveys (not mandatory)**

■ Factors Considered by the JPO

- ✓ The nature of the mark
- ✓ Extent and duration of use
- ✓ Geographic scope of use
- ✓ Advertising and promotional activities
- ✓ Third-party use of similar marks
- ✓ Market conditions and trade practices
- ✓ Consumer survey evidence (where available)
- etc.

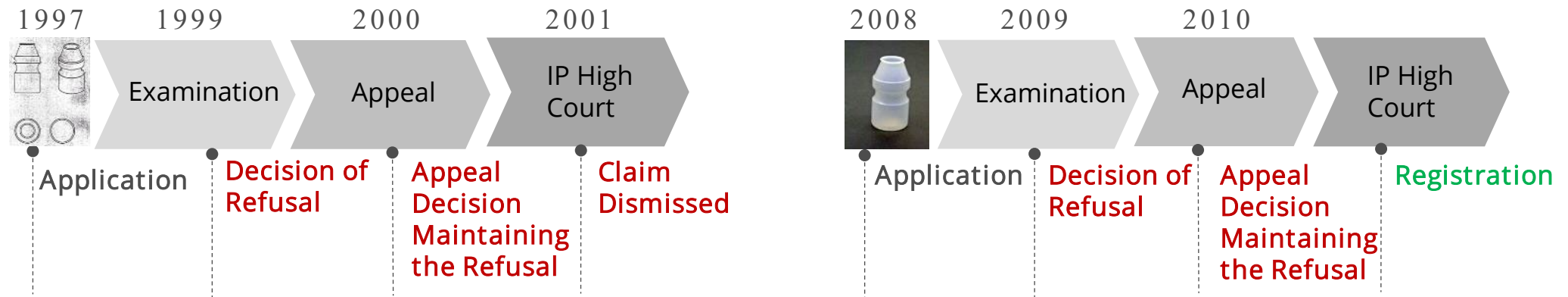
Yakult Case

Applied-for Trademarks (3D Mark)



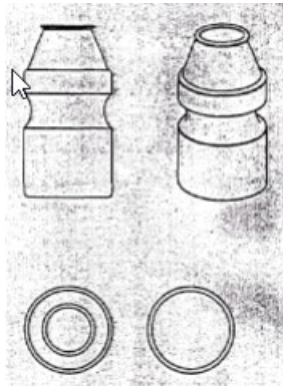
- Application No. □ □ H09-101120 □ 2008-72349
- Applicant □ KABUSHIKI KAISHA YAKULT HONSHA
- Designated Goods □ Class 29 Lactic acid bacteria drinks
- Actual goods in use □ Lactic acid bacteria drinks

Path to Registration



Yakult Case 1

Applied-for Trademarks (3D Mark)



- Application No. □ H09-101120
- Applicant □ KABUSHIKI KAISHA YAKULT HONSHA
- Designated Goods □ Class 29 Lactic acid bacteria drinks
- Actual goods in use □ Lactic acid bacteria drinks

Submitted Evidence

- **Articles** showing that the 3D shape of the applied-for mark was designed by a well-known designer
- **Evidence** showing that third parties began using containers with similar shapes only after the applicant adopted the three-dimensional shape of the applied-for mark
- **Photographs** showing the actual use of the mark
- **Statements or certificates** from public authorities, industry associations, or similar organizations recognizing that the applied-for shape has distinctiveness as a three-dimensional mark
- **Consumer survey results** demonstrating public recognition of the mark
- **Evidence** showing that a container identical to the applied-for mark has been registered as a trademark in foreign jurisdictions etc.

Yakult Case 1

The Tokyo High Court's Reasoning (No. 2000 (Gyo-Ke) 474, Judgement of July 17, 2002)

1. Identity between the Applied-for Mark and the Mark in Use



2. Identity between the Designated Goods and the Goods Actually Used



3. Nationwide Consumer Recognition



- By the filing date, containers similar to the applied-for 3D shape had already been used by numerous third parties for lactic acid beverages and related products.
- Consumers were therefore more likely to identify the product by the word mark rather than by the container shape itself.
- The statements submitted by public authorities and industry associations were not sufficient to demonstrate that the container shape itself was recognized as a source identifier.
- The survey evidence did not compare the applied-for shape with competing products and included potentially leading questions.
- Foreign trademark registrations were not determinative, as foreign legal frameworks need not be interpreted in the same manner as the Japanese trademark system.



Distinctiveness acquired through use is not proved

Yakult Case 2

Applied-for Trademarks (3D Mark)



- Application No. □ 2008-72349
- Applicant □ KABUSHIKI KAISHA YAKULT HONSHA
- Designated Goods □ Class 29 Lactic acid bacteria drinks
- Actual goods in use □ Lactic acid bacteria drinks

Submitted Documents

- Articles demonstrating that the container shape was designed by a renowned designer and had received awards in the field of design
- Publications showing the sales performance and market share of the applicant's product in Japan
- Evidence of advertising and promotional expenditures, including broadcasting expenses
- Photographs showing the actual use of the mark
- Advertising materials published by the applicant (newspapers, magazines, and Internet articles)
- Consumer survey results demonstrating recognition of the mark
- Photographs and Internet articles showing the market presence of similar containers used by third parties and consumer perceptions regarding those products etc.

Yakult Case 2

The IP High Court's Reasoning (No. 2010 (Gyo-Ke) 10169, Judgement of November 16, 2010)

1. Identity between the Applied-for Mark and the Mark in Use



2. Identity between the Designated Goods and the Goods Actually Used



3. Nationwide Consumer Recognition



- The assessment should focus on whether the shape alone functions as an indicator of origin.
- The container shape was innovative for a lactic acid beverage container when first introduced and had been used substantially unchanged for more than 40 years.
- Yakult alone accounted for over 40% of the market.
- The applicant invested substantial amounts in advertising every year, and many advertisements emphasized the distinctive features and advantages of the container shape.
- Consumer survey evidence showed that more than 98% of respondents associated an unmarked container having the same shape as the applied-for mark with Yakult.
- Although many **competing products** used similar container shapes, all entered the market after the applicant had adopted the shape, and consumers tended to regard those products as imitations or look-alikes of Yakult.



Distinctiveness acquired through use is proved

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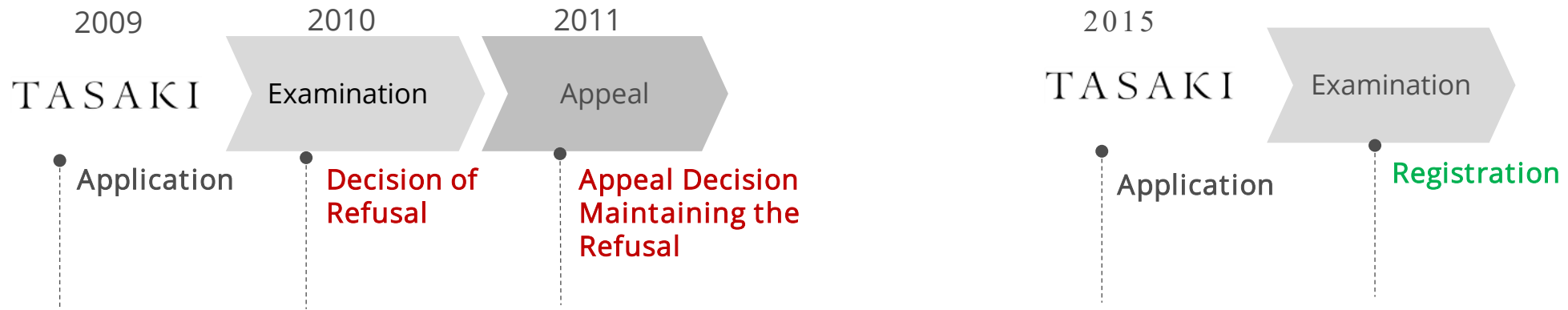
Tasaki Case

Applied-for Trademark □ common surname □

TASAKI

- Application No. □ □ 2009-46305 □ 2015-26725
- Applicant □ TASAKI Co., Ltd.
- Designated Goods/services □
Class 14 □ Personal ornaments [jewellery]; Semi-wrought precious stones and their imitations
Class 35 □ Retail services or wholesale services for Personal ornaments [jewellery] or semi-wrought precious stones and their imitations
- Actual goods/services in use: all the above goods/services

Path to Registration



Tasaki Case 1

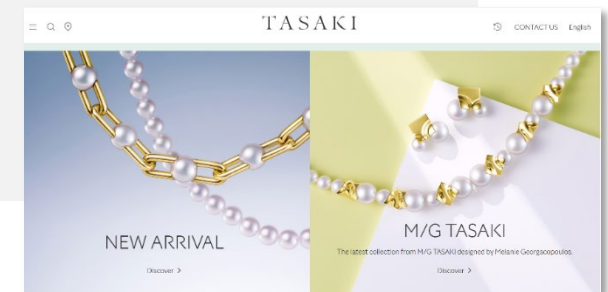
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Submitted Documents

- Evidence of the applicant's business scale and reputation (e.g., history, sales, number of stores, sponsorship activities)
- Photographs of the applicant's stores
- Third-party certificates confirming that the applied-for mark is well known as indicating the applicant's business etc.



Source: Applicant's website

Tasaki Case 1

Reasoning at Appeal Decision (Appeal No.2010-19739)

1. Identity between the Applied-for Mark and the Mark in Use

- The applied-for mark differs significantly from the applicant's long-used marks, such as "TASAKI SHINJU" (in Kanji characters), and thus lacks identity with the mark in actual use.

2. Identity between the Designated Goods/Services and the Goods/Services Actually Used

3. Nationwide Consumer Recognition

- Use period was less than 2 years.
- The evidence did not clearly show the extent of sales or advertising.
- The submitted sales and advertising data covered only 3 years.
- The advertising evidence consisted of only 4 magazine advertisements.
- The applicant did not submit evidence of its sales ranking in the jewelry industry.
- The evidence did not show that the applicant's market presence significantly exceeded that of its competitors.
- Third-party declarations lacked a clear factual basis and carried limited evidentiary weight.

 Distinctiveness acquired through use is not proved

Tasaki Case 2

Applied-for Trademark □ common surname □

TASAKI

- Application No. □ 2015-26725
- Applicant □ TASAKI Co., Ltd.
- Designated Goods/services □
 - Class 14 □ Personal ornaments [jewellery]; Semi-wrought precious stones and their imitations
 - Class 35 □ Retail services or wholesale services for Personal ornaments [jewellery] or semi-wrought precious stones and their imitations
- Actual goods/services in use: all the above goods/services

Submitted Documents

- In-house publications, website articles, and newspaper and magazine advertisements showing the commencement, duration, and geographic scope of use of the applied-for mark, the sales volume of goods bearing the mark, and the applicant's business scale
- Documents showing advertising expenditures in relation to sales revenue
- Photographs of the applicant's stores
- Product catalogs
- Articles featuring the applied-for mark in connection with events sponsored by the applicant etc.

Tasaki Case 2

Reasoning at Examination

1. Identity between the Applied-for Mark and the Mark in Use



2. Identity between the Designated Goods/Services and the Goods/Services Actually Used



3. Nationwide Consumer Recognition



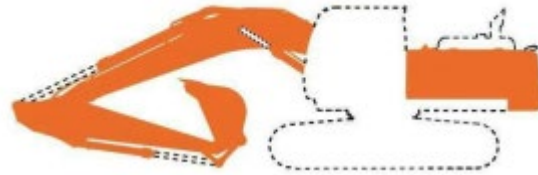
- The applied-for mark had been used extensively in a consistent manner for approximately 6 years throughout Japan and ranked 7th in the jewelry industry.
- The brand ranked 5th in a consumer survey of jewelry brand image.
- The applicant consistently invested around 10% of sales in advertising and promotion.
- The mark was advertised nationwide through newspapers and magazines.
- The applicant received a reader's advertising award in 2012.



Distinctiveness acquired through use is proved

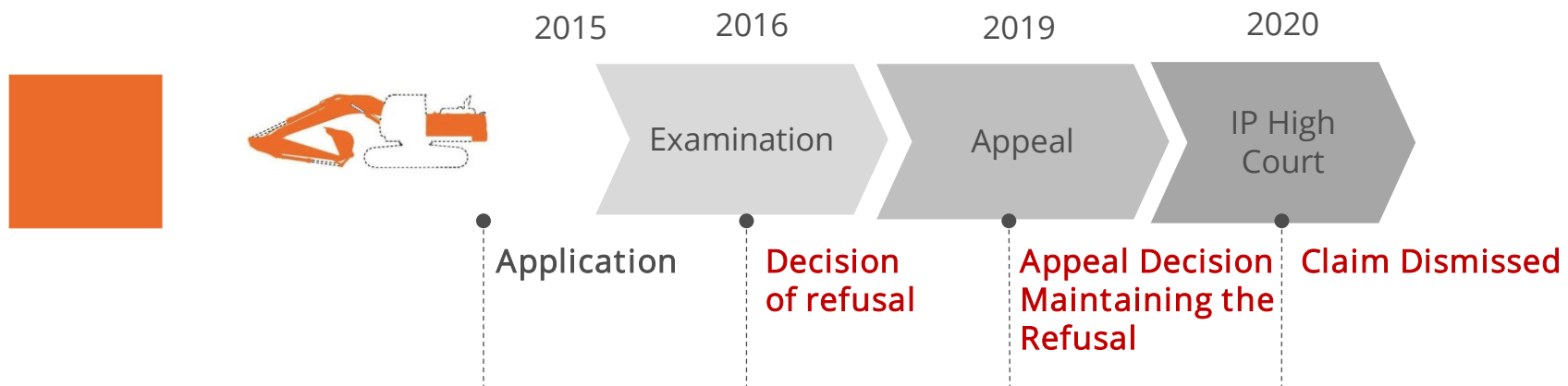
Hitachi Case

Applied-for Trademark □ color marks □



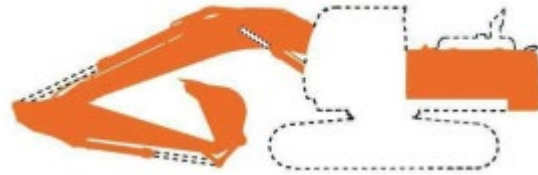
- Application number: ①2015-29999 ②2015-30000
- Applicant:
Hitachi Construction Machinery Japan Co., Ltd
- Designated goods:
Class 7 : Hydraulic shovel
- Actual goods in use:
Hydraulic shovel

Application History



Hitachi Case

Applied-for Trademark ☐ color marks ☐



- Application number: ①2015-29999 ②2015-30000
- Applicant:
Hitachi Construction Machinery Japan Co., Ltd
- Designated goods:
Class 7 : Hydraulic shovel
- Actual goods in use:
Hydraulic shovel

The Submitted Documents

- Evidence (including historical materials and photographs) showing that the orange colour had been used for approximately 50 years.
- Sales records and Market share data
- Evidence showing nationwide sales and use of the excavators throughout Japan.
- Advertising materials and product catalogues
- A consumer survey intended to show that the orange color was recognized as indicating applicant's excavators. etc.

Hitachi Case

The IP High Court's Reasoning (①No.2020 (Gyo-Ke) 10147, Judgement of June 23,2020)
(②No,2020(Gyo-Ke)10146, Judgement of August 19, 2020)

1. Identity between the Applied-for Mark and the Mark in Use



2. Identity between the Designated Goods and the Goods Actually Used



3. Nationwide recognition



- The mark must function as a mark distinguishing the applicant's goods from those of others, not merely as a product feature. At the same time, granting exclusive rights to the mark must be justified and acceptable in light of the public interest.
- Orange is a common colour and is widely used in the construction industry.
- Hydraulic excavators are generally purchased based on performance, specifications, durability, and price, rather than their color.
- The survey evidence was given limited weight because the surveyed population represented only part of the relevant consumers, and the survey questions were not designed to demonstrate that consumers had come to recognize the colour itself as identifying the applicant's goods.
- The advertising evidence did not sufficiently demonstrate a strong connection between the applied-for mark and the applicant's hydraulic excavators.



Distinctiveness acquired through use is not proved

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Practical Takeaways

- ✓ Ensure that the applied-for mark is substantially identical to the mark in actual use.
- ✓ Ensure that the designated goods/services are limited to the goods/services actually used.
- ✓ No single magic document/ No fixed market share threshold
Totality of circumstances matters.
- ✓ Ensure that the survey targets appropriate respondents and uses non-leading questions (where applicable).

☞ The JPO seeks objective evidence demonstrating that the mark has come to function as an indication of origin for Japanese consumers.

TM5 Projects Lead by JPO

1. User Involvement Project

Joint Workshop at INTA Annual Meeting

2. Bad-faith Trademark Project

“ASEAN Report on Examination Guidelines/Practices against Bad Faith Trademark Filings” is currently being prepared
(Expected to be published via TM5 website in late 2026 or early 2027)

“Bad Faith Trademark Filing Seminars”

3. IT Support for Trademark Examination Project

Thank you



Gamification Code:

VACANT



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