

*** Place Names**

[Distinctiveness]

It is likely that place-names contained in trademarks are considered to be non-distinctive but they are sometimes considered to be distinctive when they are not understood as the place of sale or origin in relation to the specific goods, for example when they have different meanings in addition to the place-names or they are conceptually combined with other words.

With regard to the service marks, in comparison with goods marks, the standard of examination seems to be more relaxed since place-names do not necessarily seem to indicate the location of provision of services.

[Similarity]

In many cases, place-names are excluded from the trademarks, as non-distinctive elements, in considering similarity between the trademarks by a single Examiner at the first examination stage.

But in the appeal trial thereafter, it is likely that place-names are considered to be inseparable from the other elements when they are conceptually combined as wholes. It is more likely when matters are concerned with the service marks.

[Limitation of Goods]

When trademarks including place-names other than in Japan such as "Paris" are filed, it is usual that the Examiners request limitation of goods to those made in the subject countries such as "clothing all made in France", no matter it is true or not, in order not to mislead the consumers as to the place of origin. But if the place-names are conceptually combined with the other elements such as "Paris Celeb", the place-names do not necessarily seem to indicate the place of origin and the marks are not considered to be misleading as wholes.

["GEORGIA" Case at Supreme Court (S60(1985)(gyo-tsu)68)]



With regard to the trademark application for "GEORGIA" covering the goods "tea, coffee and cocoa", the Supreme Court said that when refusing the registration due to non-distinctiveness merely indicating the place of sale or origin (Japanese Trademark Law §3-1-3), it is not necessary that the subject goods are actually sold or made in the subject place but sufficient if the consumers or traders can generally suppose so. This means that place-names could indicate the place of sale or origin even though the products are not actually sold or made in those places.

Non-distinctive trademarks are not registered since everyone needs to use such indications and they should not be monopolized by a single party. Therefore, if a trademark does not actually indicate the place of sale or origin of goods, it is not necessary for everyone to freely use it and the registration of such trademark does not disturb anyone's right, which should lead to the conclusion that the subject trademark is distinctive enough to be registered.

According to the Supreme Court's logic, our opinion is that a place-name which does not actually indicate the place of sale or origin but misleads consumers should not be refused on the ground of non-distinctiveness but should be refused on the ground of liability to be misleading as to the origin of goods (§4-1-16).

● Distinctiveness (: Distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
PROVENCE	21		2000-2975	
KINGSTON	9		2000-5803	
KÖLN	42		2001-1429	
GREENWHICH	14		2002-2832	There is the former Royal Observatory.
IGUAZU	7		2002-11584	Not understood as the city in southern Brazil.
SANTA LUCIA	30		2003-12738	
KEY WEST	25		2004-20494	
Swiss-One	36		2005-10140	
CASABLANCA	35,36,42		2005-20020	
LONG ISLAND	14		2006-21974	
LUXOR	10		2006-18803	

ST. GERMAIN	33		2007-15301	
ALPS	Old 28		S56(1981)-10579	
WINBLEDON	Old 17		S58(1983)-12491	Not the place of origin of clothing.
GRAND CANYON	24,25		2004-2411	
Niagara	Old 21		S62(1987)-2377	Niagara Falls is not the place of sale or origin of accessories or bags.
OXFORD	Old 25		S60(1985)-7808	Not the place of origin of papers or stationery.
SOFIA	Old 14	X	H2(1990)-5175	The Capital of Bulgaria and known for knitted goods.
ORLEANS	Old 7	X	H3(1991)-13916	Place-name in France.
ACAPULCO	Old 29	X	H58(1983)-10891	Known for the port to export coffee.
GEORGIA	Old 29	X	H58(1983)-12523	Republic of Georgia known for the origin of tea and grape.
SANMORITZ	Old 24	X	H2(1990)-5496	The spelling is different from "Saint Moritz" but foreign place-names are not always understood with correct spelling.
Mediterranean Sea	42	X	H7(1995) - 17266	Merely indicating the place of provision of Italian food.
MONTMARTRE	12,28	X	2004-65062	"GEORGIA" Case was cited for rejection reason.
Niagara	Old 26	X	H61(1986)-22634	Descriptive of the contents of Niagara Falls in relation to books, films, videos, pictures and postcards.
OXFORD	Old 25	X	S58(1983)-8176	No proof that papers are not manufactured. *The same mark was accepted for registration in 1985 as shown above.
	Old 17	X	S58(1983)-18261	Map of State of California (USA).
	Old 21	X	S58(1983)-5946	Map of Australia. Liable to be misleading in relation to the goods not made in Australia.

● Similarity (= : Similar, X : Dissimilar)

Trademark	Similarity	Cited Trademark	Class	Case No.	Memo
FRENCH CONNECTION	=	CONNECTION	Old 4	1983-11084	
SHANGHAI DRAGON	=	DRAGON	42	2002-3132	
LILY OF FRANCE	X	RYRY	Old 17	1982-25139	
French Clover	X	Clover	16,26	2006-90224	
PHOTONICS ASIA	×	PHOTONIC INTERNET FORUM	35,41	2004-21013	
DARJEELING DAYS	X	DAYS	18	2006-7434	
Paris Celeb	X	CELEB	25,35	2007-12515	