


## Court Decisions


2023:

[January]

### ●Mitsubishi uni Pencil Color Mark Case (IP High Court)

| January 24, 2023 / R4 (Gyo-Ke) 10062 |  |   |
|--------------------------------------|--|---|
| Parties                              | Plaintiff: Mitsubishi Pencil Co., Ltd.<br>Defendant: Japan Patent Office   | <p>Summary:</p> <p>The trademark in this application is found to consist only of a symbol used to represent the features of the designated product (the color of the exterior of a pencil, etc.) in a way that merely enhances the image and aesthetic appeal of the product (a pencil), and is therefore not capable of distinguishing the goods of the applicant from those of others in the ordinary course of trade. In addition, considering the fact that the similar colors of the trademark are widely used for writing instruments including pencils, it is recognized that consumers would recognize the plaintiff's product as being related to the plaintiff's business not only by the trademark itself, but also in combination with the words "MITSU-BISHI," "uni," "Hi-uni," "uni★star," and others. Moreover, since the plaintiff and Tombow Pencil Co., Ltd. have a combined market share of over 80% for pencils, it is determined that even though the consumers who are relatively familiar with pencils have a narrow range of choices in their responses to questionnaire surveys, those who recalled the plaintiff's name or its brand names (Mitsubishi Pencil, uni, etc.) from the trademark alone amounted to less than half of the total respondents. Therefore, it is concluded that the trademark has not acquired the ability to distinguish the goods of the applicant from those of others through use.</p> <p>Comment:</p> <p>It seems that registering a trademark consisting only of a single color is still difficult, although this pencil color is familiar to a certain extent.</p> |
| Mark                                 | Applied for Color Mark<br><br>Class 16: Pencils (other than color pencils). |   |
| Conclusion                           | Non-distinctive<br>(Trademark Law 3-1-3)   |   |

●Red Sole Color Mark Case (IP High Court)

|                                      |  |  |
|--------------------------------------|--|--|
| January 31, 2023 / R4 (Gyo-Ke) 10089 |  |  |
| Parties                              | Plaintiff: X<br>Defendant: Japan Patent Office   | <p>Summary:</p> <p>The color and placement of the trademark in question are both ordinary, and the composition lacks uniqueness. While it is acknowledged that certain consumers, mainly women interested in luxury brands, recognize footwear bearing the trademark as belonging to the plaintiff's brand, the composition of the trademark is not considered unique, and the recognition is limited according to the survey results. As a result, it is judged that the trademark has not obtained a high degree of inherent distinctiveness to be recognized as having exclusive applicability as an exception to the public interest.</p> <p>Comment (supplementary explanation):</p> <p>The applied-for trademark consists solely of a single red color without any outlines and is not combined with any letters or designs. The location of the display (on the sole of a shoe) is specified.</p> |
| Mark                                 | <p>Applied for Color Mark</p>  <p>Class 25: High-heels shoes for women.</p> |  |
| Conclusion                           | Non-distinctive<br>(Trademark Law 3-1-3)   |  |