

Case Study on Three-Dimensional Marks

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1. Trend in Registrations/Rejections of Three-Dimensional Trademarks

■ The registration of three-dimensional (3D) trademarks started in April 1997. In looking at the trends in registering 3D trademarks, we found that fewer 3D trademarks are being registered than regular marks.

(1) A large number of registered 3D trademarks are those in which letters, figures, etc. with distinctiveness are drawn on 3D shapes.



(2) 3D trademarks consisting solely of the shape of goods or the shape of packaging are refused registration as trademarks because they consist only of marks indicating the shape of the designated goods in a commonly used manner. (Reg. No. 5352451)

→ Many cases were contested in appeal trials, but the decisions of final rejection were maintained. Furthermore, lawsuits for many of those cases were filed to rescind the trial decision but the decisions were upheld by the high court in many cases. Examples include cases for “The Writing Instrument”, “The Whiskey Bottle”, and “The Hiyoko (Baby chick) shaped bun”.

→ The only case in which the decision was (believed to be) canceled was “The Chocolate Bar.”

→ There are cases in which the 3D trademarks were registered as a result of acquiring distinctiveness through use, after being acknowledged as trademarks consisting solely of marks that indicate the shape of goods in a commonly used manner are “The MINI MAGLITE” and “The Coca Cola Bottle”.

(3) There have been some favorable judgments for 3D trademarks that have unique shapes, decorative shapes that make a special impression, and which are difficult to predict from their functions and intended use. An example is “The Writing Instrument Case”, etc.

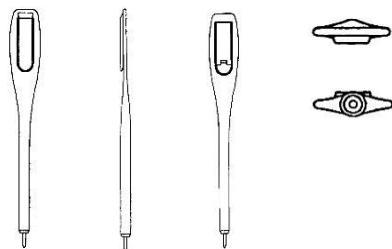
(* Please note that the summary of the court decisions in this presentation were abbreviated/summarized by the speaker.)

2. Not-Registered Cases in Lawsuits Rescinding Trial Decisions (Shape Commonly Used → No Distinctiveness Recognized as a Result of Use)

The Writing Instruments Case

- Applicable Law: Article 3 (1) (iii) determines that a trademark is merely a mark indicating the shape of the designated goods in a commonly used manner; and Article 3 (2) is not applicable because it determines that it has not acquired distinctiveness as a result of continuous use.
- Point: Case in which the court determined that Article 3 (2) of the Trademark Act cannot apply to the claimed trademark because: (1) it was merely a 3D trademark that is just the shape of the designated goods; (2) the shape of the claimed trademark, i.e. pencils or ballpoint pens on which no character marks are used, cannot be recognized to have become well known among consumers. (Tokyo High Court 1999 (Gyo-ke) No. 406, Date of Court Decision December 21, 2000)

Trademark



Summary

● Designated goods: Class 16 “Pencils, ballpoint pens, and other writing instruments”

(1) The claimed trademark can be recognized to have characteristics of a shape that writing instruments, such as simple pencils or ballpoint pens, can generally have. Although it gives a smart impression as a whole, it cannot be recognized to have any decorative shape that may have specific appearance or give an unexpectedly special impression based on the intended use and functions of writing instruments, such as simple pencils or ballpoint pens. Also, it is recognized that, when seeing the claimed trademark, traders and consumers could feel the function and some aesthetic impression, which can be generally adopted, and that, as a result, the claimed trademark may cause awareness of the shape of writing instruments. Therefore, the shape itself cannot be recognized to have any distinctiveness from other goods and to be merely a 3D trademark having the shape of the designated goods. The claimed trademark is deemed to fall under a trademark consisting solely of a mark indicating the shape in a commonly used manner.

(2) Since character marks consisting of “OKAYA” are used on the surface of pencils and ballpoint pens that were manufactured and sold by the plaintiff, there is no evidence that only the three-dimensional shape of the claimed trademark was manufactured and sold. Therefore, it cannot be said that the only three-dimensional shape of the claimed trademark independently has a distinctiveness to distinguish the goods from other goods. Based on this, it cannot be recognized that the claimed trademark has acquired any distinctiveness from other goods as a result of its continuous use.

2. Unregistered Case in Suits for Canceling Trial Decisions (Shape Commonly Used → Distinctiveness Through Use Not Approved)

The Whisky Bottle Case

- Applicable Law: Article 3 (1) (iii) determines that a trademark is merely a generally used shape; and Article 3 (2) is not applicable because it determines that it has not acquired distinctiveness as a result of use.
- Point: In this case, the court determined that Article 3 (2) cannot apply to the claimed trademark because: (1) the two-dimensional mark portion of the subject whisky bottle in use has a significant distinctiveness to distinguish the goods from other goods; and (2) as a result, the whisky bottle is not identical with the claimed 3D trademark.

(Tokyo High Court 2002 (Gyo-ke) No. 581, Date of Court Decision August 29, 2003)

Trademark



Summary

- Designated goods: Class 33 “Whisky”

(1) The shape of the claimed trademark is merely a shape that can be generally adopted as a typical example of the same kinds of goods for the purposes of enhancing the function of a whisky bottle more effectively or improving the aesthetic impression. It is not an unexpectedly specific shape of a whisky bottle or a decorative appearance giving a special impression.

When the claimed trademark is used on the designated goods, i.e. the subject whisky, traders and consumers of the designated goods can recognize it merely as the shape of the whisky bottle itself. Therefore, it should be said that the claimed trademark falls under a descriptive trademark, which is a trademark consisting solely of a mark that indicates the shape of the package of the designated goods in a commonly used manner.

(2) The label on the surface of the subject whisky bottle indicates the Roman alphabet word “SUNTORY” representing the company name. Such two dimensional portion, compared with the three dimensional shape stated above, significantly draws attention of observers and has a strong distinctiveness to distinguish the goods from other goods.

The claimed trademark can be recognized to be identical with the subject whisky bottle in terms of use based on its three dimensional shape. However, they differ in terms of whether they have the distinctive two dimensional portion that distinguishes the goods from other goods. Therefore, when comparing them from the perspective of the entire composition, it should not be said that they are identical.

2. Unregistered Case in Suits for Canceling Trial Decisions (Shape Commonly Used → Distinctiveness Through Use Not Approved)

The Hiyoko (baby chick) Shaped Bun Case

- Applicable Law: Article 3 (1) (iii) determines that the claimed trademark is merely a common shape of a common Japanese confectionery, which can be generally adopted; and Article 3 (2) is not applicable because it determines that it has not acquired distinctiveness as a result of continuous use.
- Point: Case in which the court determined that the claimed 3D trademark, which was filed to register the “Hiyoko (baby chick) shaped bun,” has not become well-known throughout the nation and that it has not acquired distinctiveness as a result of continuous use.

(Intellectual Property High Court 2005 (Gyo-ke) No. 10673, Date of Court Decision November 29, 2006)

Trademark



Summary

- Designated goods: Class 30 “Steamed bean-jam bun”

(1) The shape of the claimed trademark is unavoidably a very common shape of a Japanese-style confectionery.

(2) Most of the defendant’s directly managed shops are located in the north part of Kyushu and the Kanto area, and not located everywhere in Japan.

In addition, the court found that there are a large number of confectioneries throughout Japan, which are very similar to the bird or chick shape of the claimed 3D trademark. Even if taking into account the sales volume of the applicant’s confectionery and the frequent advertising campaigns, it should be said that the claimed 3D trademark itself has not become well known throughout Japan.

3. Registered Cases in Lawsuits Rescinding Trial Decisions (Shape Commonly Used → Distinctiveness Generated Through Use)

The MINI MAGLITE Case

- Applicable Law: Article 3 (1) (iii) determines that it does not go beyond the scope of shape that is commonly used and Article 3 (2) determines that it has acquired distinctiveness through use.
- Point: Case in which the trademark was found to consist only of the 3D shape of the designated goods a “Flashlight.” It was determined that the trademark achieved the ability to distinguish one’s goods from another person’s goods through use. (Case No. 10555, 2006 (Administrative Lawsuit), Intellectual Property High Court, June 27, 2007)

Trademark



Summary

- Designated goods: Class 11 “Flashlight”
- (1) The claimed trademark has features such as a cylindrical face cap at the head of the flashlight, which is within the scope required to demonstrate the flashlight’s function and aesthetic appearance. Therefore, the claimed trademark can be considered as consisting only of a mark that uses the shape of goods etc. in a common way.
- (2) In view of factors such as the appearance, size, position where it was attached, degree of well-knownness/fame of the trademark used or the name/ mark attached to the goods, as well as taking into account whether the 3D shape is conspicuous and makes a deep impression on consumers even when the name/mark is attached to the trademark, it should be determined whether the 3D shape has independently acquired the ability to distinguish one’s goods from another person’s goods.
The designated goods has consistently maintained the same shape since sales of the goods started. Therefore, it can be acknowledged that as a result of conducting large-scale PR activities emphasizing the superiority of the design and selling a great number of goods over a long period, consumers will perceive the goods as a mark distinguishing one’s goods from another company’s goods.

Although the English letters “MINI MAGLITE” and “MAG INSTRUMENT” are affixed on the goods, it is a small part in view of the entire goods. Furthermore, thin lines are used for the letters themselves that are carved and therefore the letters are not conspicuous. As a result of use, the claimed trademark has acquired the function of distinguishing one’s goods from another person’s goods..

The claimed trademark should be considered as having acquired the ability to distinguish one’s goods from another person’s goods through use.

3. Registered Cases in Lawsuits Rescinding Trial Decisions (Shape Commonly Used → Distinctiveness Generated Through Use)

The Coca Cola Bottle Case

■ Applicable Law: Provisions of Article 3 (1) (iii) determine that it does not go beyond the scope of shape that is commonly used and Article 3 (2) determines that it has acquired distinctiveness through use..

■ Point: Case in which it was acknowledged that the trademark consisting merely of a 3D shape for the bottle of the designated goods “Cola Beverage” came to be perceived as a mark that distinguishes it from goods of other companies (acquired the ability to distinguish) through use.

(Case No. 10215, 2007 (Administrative Lawsuit), Intellectual Property High Court, May 29, 2008)

Trademark



Summary

● Designated goods: Class 32 “Cola Beverage”

(1) The features of the claimed trademark are a fairly long neck which gradually swells toward the middle part from the top part and a constricted part that is 1/5 from the bottom. However, the shape of the bottle for the cola beverage can be acknowledged as being adopted for functional purpose or for effectively increasing its beauty and within the scope predictable by consumers. Therefore, the claimed trademark is a trademark consisting only of a mark that uses the shape of goods etc. in a common way.

(2) Since the sales of the plaintiff’s goods contained in returnable bottles were started in Japan, the goods have achieved an outstanding sales record and have continued to be sold for a long period without changing the shape and the company has repeatedly conducted PR activities that created a strong impression of the features of the shape. Therefore, it can be acknowledged that at least by the time the trial decision was made, the 3D shape of the plaintiff’s goods was perceived by consumers as a mark that distinguishes it from other company’s goods.

The accumulated distinctiveness of the 3D shape of the returnable bottles should be regarded as extremely strong and thus factors such as the name “Coca- Cola” affixed to the goods do not prevent the shape of the claimed trademark from being acknowledged as having acquired the ability to distinguish one’s goods from other person’s goods.

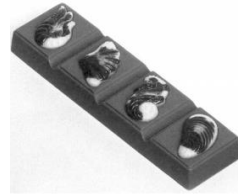
Therefore, the claimed trademark should be considered as having acquired distinctiveness through use.

3. Registered Cases in Lawsuits Rescinding Trial Decisions (Shape Commonly Used → Distinctive as a Shape)

The Chocolate Bar Case

- Applicable Law: The court determined that the claimed trademark would not fall under Article 3 (1) (iii) because it is very distinctive as a mark for consumers and not a mark that is generally used.
- Point: Case in which the court determined that the shape itself of the goods (chocolate) has sufficient, inherent distinctiveness from other goods.
(Intellectual Property High Court 2007 (Gyo-ke) No. 10293, Date of Court Decision June 30, 2008)

Trademark



Summary

- Designated goods: Class 30 “Chocolate”

The examination as well as trial decision at the JPO determined that the claimed trademark was a mark using the shape of the goods in a common manner. However, the court rescinded their decisions because the claimed trademark does not fall under Article 3 (1) (iii) of the Trademark Act, which defines trademarks consisting solely of marks indicating the shape of goods in a common manner (which are subject to absolute reasons for refusal). As a result, the decisions misapplied the Article to the claimed trademark.

(1) The claimed trademark can be recognized to be sufficiently unique based on the grounds that the court cannot find any similar mark at least in terms of the following evidence: (1) the choice of four seafood patterns, i.e. a Japanese tiger prawn, fan-shaped shell, sea horse, and blue mussel; (2) the order of the pattern arrangement; and (3) the marbled pattern of these chocolates, which are three-dimensionally composed.

The claimed trademark can be recognized to be uniquely created. Also, the court does not consider that the claimed trademark falls under a trademark that should not be exclusively treated in the industry dealing with chocolates.

(2) The claimed trademark consists of four patterns, i.e. a Japanese tiger prawn, fan-shaped shell, sea horse, and blue mussel, which are arranged in order from the left. In addition, these patterns are composed of three dimensional shapes of chocolates having a marbled pattern. In terms of the choice and order of these patterns as well as the combination of the marbled pattern, a mark involving the claimed trademark is quite new. Accordingly, even if all the evidence is reviewed, the court cannot find any mark that is identical with, or similar to, this mark.

And, when general consumers, who consume chocolate, consider making additional purchases of chocolates, the court recognizes that the claimed trademark is sufficiently unique enough for those consumers to recognize it as a mark influencing their decisions whether or not to buy the designated goods having the claimed trademark. Also, there is not enough evidence to recognize that “the claimed trademark cannot function as a trademark.”

Therefore, with regard to the trial decision which determined that the claimed trademark was merely a mark using the shape of the goods in a commonly used matter, the court determined that the trial decision misinterpreted and misapplied Article 3 (1) (iii) of the Trademark Act.

Terima Kasih
Thank you!!
ありがとうございました!!