

Date	April 21, 2011	Court	Intellectual Property High Court, Fourth Division
Case number	2010 (Gyo-Ke) 10406		
<p>– A case in which, with regard to a three-dimensional trademark designating perfume, etc. as the designated goods, the court ruled that the three-dimensional shape of the trademark was adopted for the purpose of contributing to the function or beautiful appearance of a container for perfume and it is within the scope of shapes which consumers can predict to be a shape intended to contribute to the function or beautiful appearance of a container for perfume and that it falls under Article 3, paragraph (1), item (iii) of the Trademark Act as a trademark consisting solely of a mark using, in a common manner, a shape of goods, etc.</p>			

Reference:

Article 3, paragraph (1), item (iii) and paragraph (2) of the Trademark Act

The plaintiff filed an international application for trademark registration for a three-dimensional trademark (the "Trademark") by designating as the designated goods "bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, beauty products, soaps, perfumery, essential oils, cosmetics, hair lotions, and dentifrices," but received an examiner's decision of refusal. This is an action to seek rescission of a JPO decision to the effect that the plaintiff's request for a trial against an examiner's decision of refusal is to be dismissed. The JPO decision was to the effect that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act and does not fall under paragraph (2) of said Article. The plaintiff sells perfume whose container is of the shape pertaining to the Trademark, specifically, JEAN PAUL GAULTIER's "Le Mâle" or Flacon Le Mâle.

In this judgment, the court ruled that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act, as mentioned below. Based on this ruling, the court dismissed the plaintiff's claim.

"From an objective standpoint, a shape of goods, etc. that is recognized as being adopted for the purpose of contributing to the function or beautiful appearance of the goods, etc. falls under Article 3, paragraph (1), item (iii) of the Trademark Act as a trademark consisting solely of a mark using, in a common manner, a shape of goods, etc., unless there are special circumstances.

In addition, a shape intended to contribute to the function or beautiful appearance of goods, etc. is a shape which those engaging in a business of goods, etc. of the same type want to use. Therefore, it is not appropriate from the perspective of public interest to permit a particular person to exclusively use such shape only on the grounds that

he/she has first filed a trademark application therefor.

Consequently, if a shape is within the scope of shapes that can be predicted to be selected as a shape intended to contribute to the function or beautiful appearance in relation to goods, etc. of the same type under the constraints based on the usage, property, etc. of the goods, etc., it should be regarded as falling under said item even if said shape has a certain feature. ...

In the three-dimensional shape of the Trademark, the lid and spray part at the top is of a basic shape of a container to store and dispense perfume, which is liquid, and it is intended to execute the spray function more effectively. The shape of the container part under said top part is recognized as a shape intended to improve the beautiful appearance of the outline of the container. Although the three-dimensional shape pertaining to the Trademark has certain features, there are other human body-shaped and blue-themed containers for perfume. Therefore, said three-dimensional shape is not recognized as one that significantly exceeds the scope of shapes ordinarily adopted for containers for perfume.

In that case, the three-dimensional shape of the Trademark is recognized as having been adopted for the purpose of contributing to the function or beautiful appearance of a container for perfume if it is objectively seen from the basis of the time when the JPO decision was rendered. In addition, it is within the scope of shapes which consumers can predict to be a shape intended to contribute to the function or beautiful appearance of a container for perfume. Therefore, it should be regarded as falling under Article 3, paragraph (1), item (iii) of the Trademark Act as a trademark consisting solely of a mark using, in a common manner, a shape of goods, etc.

... Incidentally, the plaintiff has made no allegation concerning paragraph (2) of said Article though the JPO determined, in its decision, that the Trademark does not fulfill the requirement set forth in paragraph (2) of said Article and the defendant also made the allegation to that effect in the principal action. Even on the basis of all pieces of the evidence in this case, it is also impossible to recognize that where the Trademark is used in connection with the designated goods, including "bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations," consumers can recognize that relevant goods are goods sold by the plaintiff.