

Date	January 15, 2018	Court	Intellectual Property High Court, Fourth Division
Case number	2017 (Gyo-Ke) 10155		
<p>– A case in which the court held that [i] the three-dimensional trademark for the designated goods of Class 6 "pilings" falls under Article 3, paragraph (1), item (iii) of the Trademark Act as a trademark solely consisting of a mark indicating the shape of goods, etc. in a common manner, since its steric shape is not found to be exceeding the scope of consumers' prediction as a shape of a piling that is intended to contribute to its function or aesthetic appearance, and that [ii] it cannot be said that said three-dimensional trademark has acquired the capability to distinguish the plaintiff's goods from others' as a result of use and should be registered under Article 3, paragraph (2) of the Trademark Act.</p>			

Reference: Article 3, paragraph (1), item (iii), Article 3, paragraph (2), Article 4, paragraph (1), item (xviii) of the Trademark Act before the amendment by Act No. 36 of 2014

Number of related rights, etc.: Trial against Examiner's Decision of Refusal No. 2015-16890 (the trial in question), Trademark Registration Application No. 2014-61502 (the application in question)

Summary of the Judgment

The plaintiff filed an application for trademark registration for a three-dimensional trademark (the "Trademark") for the designated goods of Class 6 "pilings." Since the application was refused by the JPO, the plaintiff filed a request for a trial against the examiner's decision of refusal. The JPO dismissed this request by determining that the Trademark cannot be registered as it falls under Article 3, paragraph (1), item (iii) of the Trademark Act and does not fall under paragraph (2) of the same Article. Unsatisfied with this decision, the plaintiff instituted this action to seek rescission of the JPO decision. The issues in this case were whether the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act and whether it falls under paragraph (2) of the same Article.

The court maintained the JPO decision by holding as follows.

(1) The Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act as a trademark solely consisting of a mark indicating the shape of goods, etc. in a common manner, since the steric shape of the Trademark is found to have been adopted as a shape of a piling for the purpose of contributing to its function or aesthetic appearance and it is found to be not exceeding the scope of consumers' prediction as a shape of a piling that is intended to contribute to its function or

aesthetic appearance.

(2) Whether a trademark consisting of the steric shape has acquired the capability to distinguish one's goods from others' as a result of use should be determined by comprehensively considering the following factors: [i] the shape of the trademark and whether there are any other goods, etc. that have a similar shape; and [ii] the period for which the trademark had been used, quantity of the goods sold, period and scale of advertisement, etc.

[i] It cannot be said that the steric shape of the plaintiff's goods is a unique shape that is not seen among other similar goods. [ii] Although the plaintiff's goods have been sold to a certain extent, its share is unknown; there exist utility model rights and design rights; even if the advertisement of the plaintiff's goods had been displayed constantly, it is found that traders and consumers had distinguished the plaintiff's goods from others' by focusing on the character trademark that had been used along with the three-dimensional trademark. In light of these facts, it should be said that the steric shape of the plaintiff's goods has not acquired the capability to distinguish the plaintiff's goods from others' solely by itself and independently from the character trademark.

Thus, it cannot be said that the Trademark has acquired the capability to distinguish the plaintiff's goods from others' as a result of use and should be registered under Article 3, paragraph (2) of the Trademark Act.