

Date	April 21, 2011	Court	Intellectual Property High Court, Fourth Division
Case number	2010 (Gyo-Ke) 10386		
<p>- Where a shape of goods, etc. is within the range of shapes that are expected to be chosen for the purpose of making them contribute to the function or aesthetic impression of the same kind of goods, etc. under restrictions arising from the intended use, nature, etc. of the goods, etc., such shape falls under Article 3, paragraph (1), item (iii) of the Trademark Act, even if it has a distinctive feature.</p> <p>- Although the perfume provided in the container with the three-dimensional shape that constitutes the plaintiff's trademark has achieved a certain level of sales during a certain period of time and has appeared in magazines, etc., the shape is so simple and has nothing distinctive, and some other perfume containers have similar shapes, a few of which closely resemble that shape. In light of these facts, the three-dimensional shape that constitutes the plaintiff's trademark cannot be deemed to have independently acquired the capability to distinguish the plaintiff's goods from others. Moreover, the designated goods selected in the trademark application contain such goods whose traders and consumers do not completely coincide with those of perfume, namely, "bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations." Taking all of these circumstances into consideration, when the plaintiff's trademark is used for those designated goods, traders and consumers of perfume cannot recognize such goods as those sold by the plaintiff, and therefore we should say that it fails to satisfy the requirement prescribed in Article 3, paragraph (2) of the Trademark Act.</p>			

References:

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

The plaintiff filed an international application for registration of a three-dimensional trademark for the designated goods, "bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; beauty products (cosmetics), soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices," and was given a decision by the examiner of the Japan Patent Office (JPO) refusing this application. The plaintiff filed this suit to seek rescission of the JPO decision dismissing the plaintiff's request for a trial against the examiner's decision of refusal. In the trial decision, the JPO ruled that the plaintiff's trademark fell under Article 3, paragraph (1), item (iii) of the Trademark Act and failed to satisfy the requirement set forth in paragraph (2) of said Article. The plaintiff sells perfume named L'EAU D'ISSEY, in the container with the shape that constitutes the plaintiff's

trademark.

The court dismissed the plaintiff's claim, finding that the plaintiff's trademark fell under Article 3, paragraph (1), item (iii) of the Trademark Act and failed to satisfy the requirement set forth in paragraph (2) of said Article.

“Where it is objectively found that the shape of goods, etc. is adopted for the purpose of making it contribute to the function or aesthetic impression of the goods, etc., unless there are special circumstances to the contrary, such shape is regarded as a trademark which consists solely of a mark indicating the shape of the goods, etc. in a common manner, and therefore falls under Article 3, paragraph (1), item (iii) of the Trademark Act

In addition, if a shape of goods, etc. is designed to contribute to the function or aesthetic impression of the goods, etc., those who deal with the same kind of goods, etc. may also wish to use the shape. In this respect, it is not conducive to the public interest to allow a particular person to exclusively use such shape only because that person files a trademark application earlier than others.

Consequently, where a shape of goods, etc. is within the range of shapes that are expected to be chosen for the purpose of making them contribute to the function or aesthetic impression of the same kind of goods, etc. under restrictions arising from the intended use, nature, etc. of the goods, etc., such shape falls under Article 3, paragraph (1), item (iii) of the Trademark Act, even if it has a distinctive feature.

On the other hand, in the case of a three-dimensional shape that cannot be assessed as being indispensable for goods or their packaging to properly function, even where the shape is chosen for the purpose of enabling the goods, etc. to effectively exhibit their function or pursuing the aesthetic impression of the goods, etc., such shape may be registered as a trademark if the shape is used as an indication of the source of the goods, etc. for distinguishing one's goods from others, and as a result of being used, acquires the capability to distinguish one's goods from others (Article 3, paragraph (2) of the Trademark Act).

Although the perfume provided in the container with the three-dimensional shape that constitutes the plaintiff's trademark has achieved a certain level of sales during a certain period of time and has appeared in magazines, etc., the shape is so simple and has nothing distinctive, and some other perfume containers have similar shapes, a few of which closely resemble that shape. In light of these facts, the three-dimensional shape that constitutes the plaintiff's trademark cannot be deemed to have independently acquired the capability to distinguish the plaintiff's goods from others.

Moreover, the designated goods selected in the trademark application contain such goods whose traders and consumers do not completely coincide with those of perfume, namely, “bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.” Taking all of these circumstances into consideration, when the plaintiff’s trademark is used for those designated goods, traders and consumers of perfume cannot recognize such goods as those sold by the plaintiff, and therefore we should say that it fails to satisfy the requirement prescribed in Article 3, paragraph (2) of the Trademark Act.