

Date	November 16, 2010	Court	Intellectual Property High Court, First Division
Case number	2010 (Gyo-Ke) 10169		
A case in which the court rescinded the trial decision of the Japan Patent Office that dismissed the request for a trial against the examiner’s decision of refusal of the application for registration of the three-dimensional trademark relating to the container of a lactic acid bacteria beverage product			

References:

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

(Background)

With regard to the trademark shown below, the plaintiff filed an application for registration of a three-dimensional trademark as of September 3, 2008, and was given a decision by the examiner of the Japan Patent Office (JPO) refusing this application. The plaintiff then filed a request for a trial against the examiner's decision of refusal, which was dismissed by the JPO. In this suit, the plaintiff seeks rescission of the JPO decision of dismissal.

The plaintiff's trademark (three-dimensional trademark)

Figure 1



(Point at issue)

The point at issue in this case is whether or not the plaintiff's trademark falls under the case set forth in Article 3, paragraph (2) of the Trademark Act, "as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person," on the presupposition that it falls within the category of a trademark that consists solely of a mark indicating the shape of goods in a common manner, as prescribed in paragraph (1), item (iii) of said

Article .

The JPO decision determined that the three-dimensional shape that constituted the plaintiff's trademark cannot alone be deemed to have acquired the capability to distinguish one's goods from others independently, because the container used by the plaintiff also carried trademarks consisting of the characters written in Japanese katakana and in alphabetical characters, “ヤクルト” (pronounced as “yakuruto”) and “Yakult.” Meanwhile, the court rescinded this decision, holding as follows.

“In order to acknowledge the applicability of Article 3, paragraph (2) of the Trademark Act to a trademark consisting of a three-dimensional shape (three-dimensional trademark), such as the plaintiff's trademark, it is a requirement that the three-dimensional shape that has been in use and the types of goods for which it has been used are in common with the three-dimensional shape of the filed trademark and the designated goods, and it is also a requirement that the three-dimensional shape that has been in use, as a result of having been used by the applicant for a considerable period of time, has become well-known to the extent that it can be distinguished from the shape of the same kind of goods, and consumers, by means of such shape, are now able to recognize the goods as those pertaining to a business of a particular person. In that case, even where the goods for which the three-dimensional shape is used carries an indication of the name or the trademark consisting of characters of the company, etc. which is the source of the goods, the applicability of Article 3, paragraph (2) of the Trademark Act with regard to said three-dimensional shape should not be denied only because of such fact, but the proper approach is to pay attention to the three-dimensional shape that remains after removing such trademark consisting of characters, and determine whether or not the shape has acquired its own capability to distinguish one's goods from others.”

“The court examines the plaintiff's trademark from this standpoint. The plaintiff's product for which the container in question is used is a lactic acid bacteria beverage product, which is the same as the designated goods of the plaintiff's trademark. Since the start of its sale in 1968, the plaintiff's product has achieved an amazing record of sales and market share. Each year, an enormous amount of money has been spent for advertising the product, and in particular, the advertising method aiming to give consumers a strong impression of the three-dimensional shape of the container has been adopted. For more than 40 years since the start of its sale, the plaintiff's product has been on sale continuously with no change to the shape of the container, and during this period, despite the fact that many other lactic acid bacteria

beverage products have been placed on the market while using containers similar to the container in question in shape, the recent questionnaire surveys showed that 98% or more of consumers responded that they would be reminded of “ヤクルト” (Yakult) when they saw the container in question. Taking all these circumstances into account, the court should determine that, as of April 12, 2010, when the JPO rendered the trial decision, in relation to the plaintiff’s trademark that was filed on September 3, 2008, the three-dimensional shape of the container in question was recognized among consumers as an indicator by which they could distinguish the plaintiff’s product from other companies’ products.

The container in question used for the plaintiff’s product carries red or blue patterns and the plaintiff’s famous trademark consisting of Japanese katakana characters, “ヤクルト,” in large size. According to the questionnaire surveys conducted in 2008 and 2009, most respondents who saw only the three-dimensional shape of the container in question presented thereto answered that they would be reminded of the plaintiff’s product, “ヤクルト” (Yakult). Some consumers, when seeing the products contained in containers considerably similar to the three-dimensional shape of the container in question, recognized those products as a “Yakult look-alike,” although clearly different product names were indicated on these containers. In view of these facts, the three-dimensional shape of the container in question can be found to be capable of attracting consumers’ attention as easily as or more easily than the plain trademark and patterns affixed to the container in question, and giving consumers a strong impression. Consequently, it is reasonable to determine that the three-dimensional shape of the container in question has acquired the capability to distinguish one’s goods from others independently.”

Judgment rendered on November 16, 2010

2010 (Gyo-Ke) 10169 Case of Seeking Rescission of a JPO Decision (Trademark)

Date of conclusion of oral argument: September 14, 2010

Judgment

Plaintiff: Yakult Honsha Co., Ltd.

Counsel attorney: SHIMADA Yasuo

Counsel patent attorney: SHIMUZU Tetsuo

Same as above: DAIGO Kunihiro

Defendant: JPO Commissioner

Designated representative: OSHIMA Yasuhiro

Same as above: SUZUKI Osamu

Same as above: TAMURA Masaaki

Main Text

1. The JPO decision in the Trial against the Examiner's Decision of Refusal No. 2009-15782 on April 12, 2010 shall be rescinded.
2. The court costs shall be borne by the defendant.

Facts and reasons

No. 1 Claims

The same as those stated in the "Main Text" above.

No. 2 Background

1. The plaintiff filed an application (the "Application") dated September 3, 2008 for registration of the following trademark (the "Trademark") as a three-dimensional trademark. Since the plaintiff received an examiner's decision of refusal, the plaintiff filed a request for a trial against said examiner's decision of refusal. However, the plaintiff received the JPO decision of dismissal of the request. This is a lawsuit to seek rescission of the JPO decision.
2. The issue in this case is whether the Trademark falls under the case set forth in Article 3, paragraph (2) of the Trademark Act, where "as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person," on the premise that the Trademark falls under Article 3, paragraph (1), item (iii) of said Act (a trademark that consists solely of a mark indicating the shape of goods in a common manner).

- Trademark (three-dimensional trademark)

(Figure 1)



(Figures 2 to 4 are as presented in the attached JPO decision)

- (Designated goods)

Class 29

"Lactic acid bacteria drinks"

No. 3 Claims made by the parties concerned

1. Grounds for the claims

(1) JPO proceedings

The plaintiff filed an application dated September 3, 2008 for registration of a three-dimensional trademark (Trademark Application No. 2008-72349). Since the plaintiff received an examiner's decision of refusal on May 26, 2009, the plaintiff filed the request for a trial against the examiner's decision of refusal.

The JPO examined said request as Trial against the Examiner's Decision of Refusal No. 2009-15782, made a JPO decision on April 12, 2010 that "The request for the trial is groundless," and served a certified copy of the decision to the plaintiff on April 27, 2010.

(2) Details of the JPO decision

The details of the JPO decision are as shown in the attached copy of the JPO decision. The grounds for the JPO decision may be summarized as follows: [i] the

Trademark, which merely indicates the container of goods (shape), may be considered to be a trademark that consists solely of a "mark indicating the shape of goods in a common manner" as specified in Article 3, paragraph (1), item (iii) of the Trademark Act, and [ii] since the package container used by the plaintiff carries a trademark consisting of the characters "ヤクルト" and "Yakult," it may not be recognized that the three-dimensional shape alone has independently acquired the capability to distinguish one person's goods from another's. Thus, the Trademark may not be considered to fall under the case set forth in Article 3, paragraph (2) of the Trademark Act, where "as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person."

(3) Grounds for rescission of the JPO decision

[i] While the plaintiff does not dispute the part of the JPO decision which recognizes that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act (a trademark that consists solely of a mark indicating the shape of goods in a common manner), [ii] the JPO erred in determining that the Trademark may not be considered to fall under the case set forth in Article 3, paragraph (2) of the Trademark Act where "as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person" (so-called "distinctiveness"), as described below.

(omitted)

No. 4 Court decision

1. There is a consensus between the parties concerned regarding the facts described in Grounds for the Claim (1) JPO proceedings and (2) Details of the JPO decision.

As described above, the plaintiff does not dispute the JPO decision as far as the statement that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act (a trademark that consists solely of a mark indicating the shape of goods in a common manner). The plaintiff only disputes the applicability of Article 3, paragraph (2) of said Act (as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person."). In the following sections, the validity of the JPO decision dated April 12, 2010 made for the Application dated September 3, 2008 is examined from the perspective of the applicability of Article 3, paragraph (2) of the Trademark Act.

2. Applicability of Article 3, paragraph (2) of the Trademark Act to the Trademark

(1) According to the evidence (Exhibits Ko No. 1-1 to No. 1-6, Exhibit Ko No. 2,

Exhibits Ko No. 3-1 to No. 3-22, Exhibit Ko No. 5, Exhibits Ko No. 6-1 to No. 6-217, Exhibits Ko No. 7 to No. 10, Exhibits Ko No. 11-1 and No. 11-2, Exhibit Ko No. 14, Exhibits Ko No. 18 to No. 22, Exhibits Otsu No. 1 to No. 5) and the entire import of oral argument, the following facts may be found.

A. The background circumstances under which the Container was adopted and the commencement date of the use of the Container and the period during which the Container was in use

(A) After P succeeded in strengthening and culturing the strain shirota in 1930, P made efforts to develop the plaintiff's goods, "Yakult," and started manufacturing and selling "Yakult" from 1935, registering a trademark consisting of the characters "ヤクルト" (Yakult) in 1938. The plaintiff was established in 1955 and introduced a delivery agent system to sell Yakult through female Yakult sales staff in 1963. Since then, Yakult has been sold on a large scale nationwide. The plaintiff's goods, "Yakult," were certified as foods for specified health use in 1998.

(B) The package container of the plaintiff's goods, "Yakult," was initially made of glass when it was introduced to the market and was changed to a plastic container in 1968. Such change of the container, which was carried out in order to rationalize the plaintiff's operations, was as a means for reduction in distribution costs, enhancement of product management, a measure to deal with labor shortage, and improvement of working conditions, and also to improve the hygiene of the containers and to eliminate the troublesome process of returning the empty containers (Exhibits Ko No. 1-1 to No. 1-6).

(C) The three-dimensional shape of the Container was designed by [Person] Q, who was a famous designer. The design was created in consideration of the conditions that must be fulfilled for a container for beverage, such as the bottle mouth being an appropriate shape for drinking, comfortableness when drinking the content, ease of holding the container, compatibility with the shape of the guide in the conveyer line, compatibility with the automatic packaging machine, and desirable volume equivalent to that of the glass bottle. In this way, the three-dimensional shape of the Container was determined (Exhibit Ko No. 1-1).

(D) The Container won the FY2008 Good Design Longlife Design Award (Exhibits Ko No. 9 to No. 11). A relevant online article states "The current design was created in 1968 (omitted) as a result of the search for a thin, strong, cost-effective container that has the same volume as that of the previous glass bottle and has a form comfortable to the mouth of a drinker. Nowadays, this design has become so famous that any person who hears the word 'Yakult' would remember this shape and the taste

of Yakult. 'Yakult' has been sold in about 30 countries." (Exhibit Ko No. 10) The article also states, as the designer's comment on the news of the winning of the award, "(omitted) I wanted to create a design that allows viewers to easily associate the word 'Yakult' with the shape of the container, like a milk bottle. But, I wanted to avoid a design that looks interesting at first glance but becomes boring after a while. I was determined to make a container that can be used in daily life for many decades." (Exhibit Ko No. 10)

B. Types of the plaintiff's goods and the shape of the trademark in use

The main goods sold by the plaintiff are lactic acid bacteria drinks, which are the designated goods specified in the Application. The trademarks that have been used by the plaintiff are shown in the following photographs. The Container has been used for the plaintiff's goods, "Yakult," (Photograph 1) since 1968. Also, the Container has been used for the plaintiff's goods, "Yakult 400," (Photograph 2) since 1999 and for the plaintiff's goods, "Yakult 400LT," (Photograph 3) since 2008. In this way, the shape of the Container used for the plaintiff's goods has remained almost identical with slight variations due to difference in the amount of content. Since 2009, the container the same as the Container has been used for the goods titled "Yakult karorī hāfu" (Yakult calorie half) (2009). These containers have a red or blue aluminum cap and have some graphic design on their surface with characters, numbers, and figures positioned thereon, as well as the product name "ヤクルト," "ヤクルト 400," etc. indicated on their body. In particular, the lower body of each container carries the trademark "Yakult," below which the trademark "ヤクルト" is written in large, red, bold characters.

(Photograph 1)



(Photograph 2)



(Photograph 3)



In addition to the plaintiff's goods mentioned above, the plaintiff manufactures and sells other lactic acid bacteria drinks including "Yakult 80," "Yakult 300V," "Yakult 300VLT," "Yakult SHEs," "Pretio," "Bifia," and "Joie" (Exhibits Ko No. 1-1

and No. 1-2, Exhibits Ko No. 6-1 to No. 6-217, Exhibit Ko No. 14, and Exhibit Ko No. 21).

C. Comparison between the Trademark and the three-dimensional shape of the Container

(A) Features of the three-dimensional shape of the Trademark

The three-dimensional shape of the Trademark, which is described in No. 2, 2. above, has the following features.

[i] The overall three-dimensional shape is a cylindrical container that is vertically long with a horizontal to vertical ratio of 1 to 2 with a circular mouth on the top of the container.

[ii] A close examination of the shape reveals that the container has the following parts as described from the bottom to the top thereof: a circular bottom that has a dome-shape concave area at its center, a lower cylindrical body part, a deep semicircular concave area circulating all around the body part of the container, an upper cylindrical body part, a cone-shape part that is placed on the upper cylindrical body part and becomes narrower in diameter as it rises to the top, and a circular opening mouth on the top.

[iii] The ratio of the height of the aforementioned lower cylindrical body part to that of the aforementioned upper cylindrical body part is 3 to 1.

[iv] No concavity and convexity are particularly observed in the aforementioned lower cylindrical body part, concave area, upper cylindrical body part, and cone-shape part. The surfaces of these parts are all flat.

(B) On the other hand, the three-dimensional shape of the Container used for the plaintiff's goods is as described in B. above. The three-dimensional shape excluding the content thereof and the characters, etc. affixed thereto is almost identical with the Trademark.

D. Sales and market share of the plaintiff's goods in Japan

(A) Sales

According to the section "Top brand share" of the "Food Marketing Handbook" of 2001 to 2009 (Exhibits Ko No. 3-13 to No.3-16, Exhibits Ko No. 3-18 to No. 3-22), the sales of the plaintiff's goods are about 30.9 billion yen in 2000, about 28.9 billion yen in 2001, about 31.4 billion yen in 2002, about 35.6 billion yen in 2003, about 36.0 billion yen in 2004, about 32.7 billion yen in 2005, about 33.1 billion yen in 2006, about 36.4 billion yen in 2007, and about 45.9 billion yen in 2008.

(B) Market share

According to "1985 Food Marketing Handbook (vol. 1)" (Kabushiki Kaisha Fuji Keizai, published on December 26, 1984, Exhibit Ko No. 3-1), the market share of the plaintiff's goods is described as follows: "[i] The market exists mainly around the Yakult headquarters. The market shares of Yakult 80 and Yakult are outstanding. The sales of the goods distributed mainly through a door-to-door delivery system are very strong. The goods are expected to keep the top market share."

According to the sections titled "4. or 5. Market Share" of "2000 Food Marketing Handbook No. 4" (Kabushiki Kaisha Fuji Keizai, published on February 17, 2000, Exhibit Ko No. 3-12), "2004 Food Marketing Handbook No. 5" (said company, published on January 22, 2004, Exhibit Ko No. 3-16), "2005 Food Marketing Handbook No. 5" (said company, published on January 20, 2005, Exhibit Ko No. 3-18), and "2009 Food Marketing Handbook No. 5" (said company, published on January 22, 2009, Exhibit Ko No. 3-22), the plaintiff's market share for lactic acid bacteria drinks was more than 50% from 1998 to 2007, 64.8% in 2008 (estimate), and 66.2% in 2009 (prediction). The plaintiff's goods alone accounted for more than about 42% of the relevant market from 2000 to 2008.

On the other hand, the market share of other companies' goods are as follows: the market share of Snow Brand Rolly was 5.2% (1998, ranked third), and 5.1% (1999, ranked third); the market share of Snow Brand Labio (former Snow Brand Rolly) was 3.8% (2000, ranked third), 3.9% (2001, ranked third); the market share of Kagome (Snow Brand Labio became Kagome Labio, a wholly-owned subsidiary of Kagome through business integration) was 4.6% (2002, ranked third), 4.2% (2003, ranked third); the market share of Nissin York was 4.2% (2004, ranked third), 3.8% (2005, ranked third), 5.0% (2007, ranked third), 5.1% (2008 (estimate), ranked third), and 5.1% (2009 (prediction), ranked third).

E. Advertisements

(A) Advertisement costs

The advertisement costs and broadcast advertising costs for the plaintiff's goods were about 960 million yen in 1968, which increased to about 2.0 billion yen in 1969, and then about 3.4 billion yen in 1973, about 5.0 billion yen in 1982, about 6.7 billion yen in 1987, about 7.6 billion yen in 1989, and about 8.6 billion yen in 2004. In this way, the costs increased almost every year and reached 9.5 billion yen in 2005. Since then, more than 9.0 billion yen has been spent every year (Exhibit Ko No. 5).

(B) Advertisement articles in newspapers and magazines

In 1968, in which the container of the plaintiff's goods "Yakult" was changed from a glass bottle to a plastic container, i.e., the Container, advertising statements "The

container will be changed to a new one soon, from a glass bottle to a plastic container." and "No need to return the bottle!" were published together with the patterns affixed to the Container (Exhibit Ko No. 6-1).

In 1969 and 1970, the advertisement articles were published by stating "Every day, a new container, just for you. This is a new container of 'Yakult.' Light and easy-to-hold. A form of the new age" under the heading "This is the new container that can satisfy customers' requests!" together with a large photograph of the Container lightly held by a right hand in the center (Exhibit Ko No. 6-7). The features of the new containers were described as follows, together with some photographs of the Container: "[i] Every day, a new container, just for you; [ii] No need to return the empty containers; [iii] Every day, the color of the cap changes; [iv] The container is made of polystyrene, which is light and shatter proof; [v] Integrated production starting from the manufacturing of containers to the bottling process; [vi] Easy to open using fingers. No need for a bottle opener; and [vii] The empty container may be used as a flower vase, coin jar, etc. (Exhibits Ko No. 6-9, No. 6-10, No. 6-12, No. 6-13, and No. 6-20). Subsequently, the advertisement articles always include photographs of the Container or the patterns affixed to the Container (Exhibits Ko No. 6-1 to No. 6-217).

F. Results of a questionnaire survey

(A) Questionnaire Survey in 2008 (Exhibits Ko No. 8)

A questionnaire survey was conducted in 2008 in order to examine whether general consumers who see the shape of the transparent container of the plaintiff's goods, "Yakult," associate the shape with the name of the manufacturer, etc. or not. The survey was conducted by the central location test method at a total of eight sites, namely, four sites in Tokyo and four sites in Osaka for a period of eight days in total (October 2 to October 5 in the Tokyo area and October 9 to October 12 in the Osaka area). This survey was conducted on 480 people, both males and females, aged 20 to 59 and who could satisfy the requirements to the effect that any person who participated in this survey and any of his/her family members shall not be working for a manufacturer, retailer, or delivery agent of any drinks or for an advertisement agency, research company, or mass media company. They were shown a photograph of a three-dimensional shape identical with the Trademark in substance and asked questions including what image they acquired from the container (Q1) and which goods they associated with the container (Q2). For both Q1 and Q2, 98.8% of the respondents associated the container with "Yakult."

(B) Questionnaire survey in 2009 (Exhibits Ko No. 19 and No. 20)

Following the questionnaire survey in 2008, a similar questionnaire survey was conducted in 2009 in order to examine whether general consumers who saw the shape of the transparent container of the plaintiff's goods "Yakult" would associate the shape with the name of the manufacturer, etc. or not. The survey was conducted by the Internet survey method on 5000 people, both males and females, aged 15 to 59 living in Japan who could satisfy the requirements to the effect that any person who participated in this survey and any of his/her family members shall not be working for a manufacturer, retailer, or delivery agent of any drinks or for an advertisement agency, research company, or mass media company. They were shown a photograph of a three-dimensional shape identical with the Trademark in substance and asked questions including what image they acquired from the container (Q7) and which goods they associated with the container (Q8). In Q7, 93.8% of the respondents associated the container with "Yakult." Even amongst the respondents who did not reply 'Yakult' in Q7 above, 74.3% of them associated the container with "Yakult" in Q8. A total of 98.4% of the respondents associated the container with "Yakult" in either Q7 or Q8.

G. Distribution of other companies' goods similar to the Container and the users' awareness

(A) In the lactic acid bacteria drink industry, since the plaintiff's adoption of the Container for the plaintiff's goods, "Yakult," in 1968, plastic single-use containers have become common for the package containers of lactic acid bacteria drinks. Most of those containers hold 65ml and have a three-dimensional shape with the mouth on the top of the cone-shape part, and have a body part underneath the cone-shape part. At least 12 types of containers have a constricted area or concave area in their body part (Exhibit Ko No. 7, Exhibit Ko No. 16, Exhibit Ko No. 18, Exhibits Otsu No. 1 to No. 5).

(B) The following statements may be found on the Internet with regard to other companies' goods similar to the Container.

- "Disposable containers are called single-use containers. They are manufactured by use of a special production machine. (omitted) Many companies, such as Snow Brand Rolly Ace, make lactic beverage by using containers that are almost identical with the containers of Yakult." "As (omitted) said, there are many containers similar to that shape." (Exhibit Otsu No. 1)

- Together with a photograph of goods called "クロレラ乳酸菌 (Kurore Ra Nyūsankin)," the following statements are displayed: "I've just drunk a bottle of this left in the fridge. I believed it was Yakult without any doubt. But, ..."; "Maybe, it is

not Yakult although the container is identical with that of Yakult." (Exhibit Otsu No. 2)

- Together with a photograph showing Yakult placed side by side with another company's product that is similar to Yakult in terms of shape, the following statements are displayed: "Left: Yakult look-alike, Right: Genuine Yakult"; "When I only drink a Yakult look-alike, I'm satisfied with its Yakult-like taste. But, when I drink both products at the same time to make a comparison ... Oh! It's so watery. Yakult is much denser (omitted). The package is slightly different as well." (Exhibit Otsu No. 3)

- Together with a photograph of goods called "りんご青森(Ringo Aomori)," the following statements are displayed: "(omitted), this container reminds me of Yakult. Since Yakult is a lactic acid bacteria drink, I have diarrhea when I drink too much of it. (omitted). Not only me, but also many other people who see a container of this design and size would associate it with lactic acid bacteria drinks. Amazing example of imprinting." (Exhibit Otsu No. 4)

- Under the title "Look-alikes, welcome! Yakult edition," together with a photograph showing goods called "みどりプチコング(Midori Puchi Kongu)," the following statements are displayed: "The content is always 65ml, the same as Yakult. The taste is not very different, and the ingredients are almost the same. It also has the same effect on my belly, when I drink it. (omitted) After all, the only difference between Yakult and Yakult look-alikes is the price. (Exhibit Otsu No. 5)

- Together with a photograph of goods called "ペプチド乳酸菌(Pepuchido Nyūsankin)," the following statement is presented: "Here again, a Yakult look-alike. Lactic acid bacteria drink in a 65ml plastic bottle." (Exhibit Otsu No. 5)

- Together with a photograph of goods called "クロレラパッカルゴールド(Kurorera Pakkaru Gōrudo)," the following statements are presented: "Look at this! Isn't it similar to Yakult?"; "These days, every time I find a Yakult look-alike, I wonder if there is a design registration for the shape of the container." (Exhibit Otsu No. 5)

(C) The plaintiff has never taken any measures such as legal action, e.g., giving a warning or seeking an injunction against any other company that used a package container similar to the three-dimensional shape of the Container.

(2) A. Article 3, paragraph (2) of the Trademark Act specifies that "notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person." Therefore, like the Trademark, even in the case of "a

trademark that consists solely of a mark indicating the shape of goods in a common manner," which falls under Article 3, paragraph (1), item (iii) of said Act, the trademark may be registered if "as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person."

In order to acknowledge the applicability of Article 3, paragraph (2) of the Trademark Act to a trademark having a three-dimensional shape (three-dimensional trademark), such as the Trademark, it is a requirement that the three-dimensional shape that has been in use and the types of goods for which it has been used are in common with the three-dimensional shape of the filed trademark and the designated goods, and it is also a requirement that the three-dimensional shape that has been in use, as a result of having been used by the applicant for a considerable period of time, has become well-known to the extent that it can be distinguished from the shape of the same kind of goods, and consumers, by means of such shape, are now able to recognize the goods as those pertaining to a business of a particular person. In that case, even if the goods for which the three-dimensional shape is used carries an indication of the name or the trademark consisting of characters of the company, etc. which is the source of the goods, the applicability of Article 3, paragraph (2) of said Act with regard to said three-dimensional shape should not be denied only because of such fact, but the proper approach is to pay attention to the three-dimensional shape that remains after removing such trademark consisting of characters, and determine whether or not the shape has acquired its own capability to distinguish one's goods from others.

From the perspectives mentioned above, the Trademark is examined below.

B. Based on a comprehensive evaluation of various facts found in (1) above, the three-dimensional shape of the Container may be described as follows.

(A) The plaintiff's goods are lactic acid bacteria drinks, which are the designated goods of the Trademark.

(B) The container that is almost identical with the Container in terms of shape was designed by a famous designer in 1968, when the container of the plaintiff's goods was changed from a glass bottle to a plastic one-way container. While the container had a simple shape created with the emphasis on functionality such as a comfortable drinking experience, ease of holding the container, compatibility with the shape of the guide in the conveyer line, and compatibility with the automatic packaging machine, the shape of the container was novel as a container for lactic acid bacteria drinks at that time.

The Container has been consistently used for the plaintiff's goods for more than 40 years since its introduction in 1968.

(C) The sales of the plaintiff's goods have been more than 30.0 billion yen since 2000. In particular, the sales reached 45.9 billion yen in 2008. During the period from 1998 to 2007, the plaintiff's share in the lactic acid bacteria drink market was always higher than 50%. The market share of plaintiff's goods alone accounted for more than about 42% of the relevant industry.

(D) The advertisement costs of the plaintiff's goods were about 960 million yen in 1968, in which year the plaintiff's goods, "Yakult," packed in the Container were first sold, increasing significantly to about 2.0 billion yen in the following year, and then, continuing to gradually increase year by year thereafter. The costs reached about 5.0 billion yen in 1982, about 7.6 billion yen in 1989, and 9.5 billion yen in 2005. In this way, a huge amount of money was spent every year in order to advertise the plaintiff's goods.

(E) Since around 1968, when the Container was adopted, there have been many advertisement articles focusing on the features and benefits of the shape of the Container. Subsequently, the advertisements of the plaintiff almost always contained photographs of the Container or the patterns affixed to the Container as if the Container were the symbol mark of the plaintiff. In this way, the advertisements for the plaintiff's goods have been carried out in a manner that leaves consumers a strong impression about the Container.

(F) According to the questionnaire surveys conducted in 2008 and 2009, in both the central location test conducted on 480 people, males and females, in Tokyo and Osaka and the online survey conducted on 5000 people, males and females, more than 98% of the respondents who saw a transparent container with a three-dimensional shape identical with the Trademark replied that said container reminded them of "Yakult."

(G) At present, in the lactic acid bacteria drink market, other companies sell many goods using containers with three-dimensional shapes similar to the Container. According to the evidence, there are at least 12 types of containers with three-dimensional shapes similar to the Container. All of those goods appeared after the plaintiff's adoption of the Container in 1968. Furthermore, consumers who come across the goods with three-dimensional shapes extremely similar to the Container may be considered to suspect that those containers are imitations of the Container according to the following statements included in the online articles (Exhibits Otsu No. 1 to No. 5): "This container is almost identical with Yakult," "Yakult look-alikes," and "This container reminds me of Yakult."

C. As described above, the plaintiff's goods for which the Container is used are lactic acid bacteria drinks, which is the same as the designated goods of the Trademark. Since the start of its sale in 1968, said goods has achieved an amazing record of sales and market share. Each year, an enormous amount of money has been spent for advertising the goods, and in particular, the advertising method aiming to give consumers a strong impression of the three-dimensional shape of the Container has been adopted. For more than 40 years since the start of its sale, said goods has been on sale continuously with no change to the shape of the Container, and during this period, despite the fact that many other lactic acid bacteria drinks have been placed on the market while using containers similar to the Container in terms of shape, the recent questionnaire surveys also showed that at least 98% consumers responded that they would be reminded of "ヤクルト" (Yakult) when they see the Container. Taking all these factors into account, the court should determine that, as of April 12, 2010, when the JPO rendered the trial decision, in relation to the Trademark that was filed on September 3, 2008, the three-dimensional shape of the Container was recognized among consumers as an indicator by which they could distinguish the plaintiff's goods from other companies' goods.

As described above, the Container used for the plaintiff's goods carries red or blue patterns and the plaintiff's famous trademark consisting of Japanese katakana characters, "ヤクルト," in large size. As mentioned above, according to the questionnaire surveys conducted in 2008 and 2009, most respondents who saw only the three-dimensional shape of the Container replied that they would be reminded of the plaintiff's goods, "ヤクルト" (Yakult). Some consumers, when seeing goods in containers considerably similar to the three-dimensional shape of the Container, recognized those goods as "Yakult look-alikes," although clearly different product names were indicated on these containers. In view of these facts, the three-dimensional shape of the Container can be found to be capable of attracting consumers' attention as easily as or more easily than the two-dimensional trademark and the patterns affixed to the Container, and giving consumers a strong impression. Consequently, it is reasonable to determine that the three-dimensional shape of the Container has acquired the capability to distinguish one's goods from others independently.

D. Court determination concerning the defendant's allegations

(A) The defendant alleged that, regarding the fact described in B., (F) above, the statement "If I hear the word 'Yakult,' I would associate it with the shape of the container and the taste of Yakult" (Exhibit Ko No. 11-1) suggests that it is just natural

for the respondents to reply that the container reminded them of 'Yakult,' which has become synonymous with lactic acid bacteria drinks, in consideration of the adopted survey methods.

However, in the aforementioned surveys, the respondents were not asked "what kind of shape do you associate with the word 'Yakult.'" In reality, it was the other way around. The respondents were shown a transparent container and asked what image and product name they associate with the container. Therefore, the above-mentioned defendant's allegation is unacceptable.

(B) Regarding the facts described in B., (F) above, the defendant alleged that, since the questionnaire surveys conducted in 2008 and 2009 did not ask similar questions using the containers of lactic acid bacteria drinks manufactured by rival companies, the questionnaire surveys conducted using only the Container are insufficient and inappropriate due to the lack of evaluation of the Container relative to similar containers of other companies.

However, the main purpose of this type of questionnaire survey is to find out which goods the respondents would be reminded of if the transparent three-dimensional shape of the Container is presented to them after all the trademarks consisting of the characters such as "ヤクルト" and the patterns are removed from the Container. The main purpose of the surveys is not to examine whether the respondents can distinguish the three-dimensional shape of the Container from other companies' goods that have a similar container shape. Thus, it is not necessary to ask similar questions about the similar containers of lactic acid bacteria drinks manufactured by rival companies. On these grounds, the defendant's allegation regarding this point is unacceptable.

(C) Regarding the fact described in B., (G) above, the defendant acknowledged the current state of the market where there have been many other companies' package containers that are similar to the Container in terms of shape, and denounced the plaintiff's inaction against the existence of similar containers of other companies.

The superiority of the three-dimensional shape of the preceding goods is often one of the factors to prompt many imitations to be distributed in the market immediately after the launch thereof, resulting in goods with similar three-dimensional shapes existing in the market. As far as traders and consumers recognize them as similar goods or imitations of the preceding goods and the preceding goods are distinguishable from those similar goods and imitations in the market, the preceding goods may be considered to retain the capability to distinguish one person's goods from another's despite the existence of similar goods and imitations.

In this court case, as found above, the plaintiff's goods, "Yakult," are the pioneering product in the lactic acid bacteria drink market. The design of the three-dimensional shape of the Container was created by a famous designer upon request of the plaintiff. The plaintiff was the first company to use the Container for lactic acid bacteria drinks. In consideration of the facts that the currently distributed goods packed in containers with similar three-dimensional shapes appeared on the market after the launch of the plaintiff's goods packed in the Container and that, despite the existence of many similar goods, most of the consumers who come across the three-dimensional shape of the Container would associate the shape with "Yakult" according to the results of the surveys, it is not necessary to be over-concerned about the monopolization of the shape of goods in the market as far as this case is concerned.

(D) Regarding the online articles described in B., (G) above, the defendant alleged, in summary, that, in light of the common sense and recognition of the general consumers that the containers of lactic acid bacteria drinks including the plaintiff's "Yakult" are all alike, it has been proven that the three-dimensional shape of the Trademark alone may not be considered to have acquired the capability to distinguish one person's goods from another's.

However, as described above, the important fact that may be found based on the online articles is not the vague idea that "the containers of lactic acid bacteria drinks including the plaintiff's goods are all alike," but the consumer's realization that there are many containers of lactic acid bacteria drinks that are almost exact imitations of the Container. Despite the defendant's allegation to the contrary, this finding indicates that, despite the existence of many other companies' goods packed in the containers similar to the Container in terms of shape, consumers are aware that the three-dimensional shapes of those containers are imitations of the Container. This strongly suggests that the three-dimensional shape of the Container has the capability to distinguish one person's goods from another's.

3. Conclusion

On these grounds, in the JPO decision dated September 3, 2008, the JPO may be found to have erred in refusing to apply Article 3, paragraph (2) of the Trademark Act to the Trademark. Therefore, the JPO decision may be found illegal and shall be rescinded.

The court accepted the plaintiff's claim and rendered a judgment in the form of the main text.

Intellectual Property High Court, First Division

Presiding Judge: NAKANO Tetsuhiro
Judge: SHOJI Tamotsu
Judge: YAGUCHI Toshichika