

Date	April 21, 2011	Court	Intellectual Property High Court, Fourth Division
Case number	2010 (Gyo-Ke) 10366		
<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>- With regard to the plaintiff's trademark consisting of a three-dimensional shape of a perfume container, where the shape has a unique and peculiar feature and gives a strong impression to consumers, and it has been in use for more than 15 years, and in light of these facts, the shape has independently acquired the capability to distinguish the plaintiff's perfume from others; and as a result of having acquired such capability regarding perfume, when the trademark is used for other designated goods selected in the trademark application which are closely related to perfume, such as cosmetics, the trademark also has the capability to distinguish the plaintiff's goods from others, and in that case, the trademark satisfies 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, "beauty products (cosmetics), soaps, perfumery, cosmetics," 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 JEAN PAUL GAULTIER "CLASSIQUE" or Flacon Classique, in the container with the shape that constitutes the plaintiff's trademark.

The court rescinded the JPO decision, finding that the plaintiff's trademark fell under Article 3, paragraph (1), item (iii) of the Trademark Act but satisfied the requirement set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 using 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).

Looking at the three-dimensional shape that constitutes the plaintiff's trademark, the top end of the shape that functions as both the lid and the sprayer has the basic shape of a container for storing and emitting liquid perfume, which enables the container to effectively perform its spraying function. The shape of the remaining part of the container seems to have been chosen for the purpose of enhancing the aesthetic impression of the silhouette of the container. It is true that the three-dimensional shape that constitutes the plaintiff's trademark is distinctive to some extent, but some other perfume containers are also designed to look like a woman's body, so this three-dimensional shape cannot be deemed to go far beyond the range of shapes usually adopted for perfume containers.

Thus, the three-dimensional shape that constitutes the plaintiff's trademark, if viewed objectively as of the time of the JPO decision, is deemed to have been chosen for the purpose of making it contribute to the function or aesthetic impression of the perfume container, and it is within the range of shapes that consumers expect as those

to be chosen for the purpose of making them contribute to the function or aesthetic impression of the same kind of perfume containers. Therefore, this three-dimensional shape is regarded as a trademark which consists solely of a mark using the shape of the goods, etc. in a common manner, and therefore falls under Article 3, paragraph (1), item (iii) of the Trademark Act.

Article 3, paragraph (2) of the Trademark Act provides that a trademark which consists solely of a mark indicating the shape of the goods, etc. in a common manner and therefore falls under paragraph (1), item (iii) of said Article may be registered if, as a result of being used, it has acquired the capability to distinguish one's goods from others.

Whether or not a trademark consisting of a three-dimensional shape has acquired the capability to distinguish one's goods from others should be determined by comprehensively taking into consideration, (i) whether or not there are other goods, etc. whose shape is identical or similar to the shape of the trademark, and (ii) the circumstances concerning the use of the trademark, such as the period of time when the trademark has been in use, the volume of sales of the goods, and the period of time and scale of the advertisement of the goods.

(Omitted) The shape of the container part of the plaintiff's trademark is designed to look like a woman's body; it has two projection portions that correspond to a woman's breasts, has a constricted portion extending from those projection portions that corresponds to a woman's waist, and has a mildly bulged portion extending from that constricted portion down to the bottom. Thus, because of such a unique and peculiar feature, the three-dimensional shape that constitutes the plaintiff's trademark can easily catch the eyes of consumers and give them a strong impression. It has been in sale for more than 15 years since 1994, and has been in use, while appearing in perfume and fashion magazines. In light of these circumstances, there is no harm in determining that the three-dimensional shape that constitutes the plaintiff's trademark has acquired the capability to distinguish one's goods from others and has become distinctive to an extent that traders and consumers of perfume, etc. can recognize it as perfume, etc. sold by the plaintiff.

Taking all of these circumstances into consideration, when the plaintiff's trademark is used for the designated goods, traders and consumers can recognize such goods as those sold by the plaintiff, and therefore it satisfies the requirement prescribed in Article 3, paragraph (2) of the Trademark Act.

(Omitted) As a result of the plaintiff's trademark having acquired the capability to distinguish the plaintiff's perfume from others, when it is used for the limited scope of

the designated goods selected in the trademark application which are closely related to perfume, such as cosmetics, traders and consumers of those designated goods, who overlap with traders and consumers of perfume, can also recognize such goods as those sold by the plaintiff, who sells perfume of the Jean Paul Gaultier brand.”

Judgment rendered on April 21, 2011, the original received on the same date, court clerk
2010 (Gyo-Ke) 10366 Case of Seeking Rescission of a JPO Decision

Date of conclusion of oral argument: March 24, 2011

Judgment

Plaintiff: Beauté Prestige International

Counsel attorney: SATO Masami

Same as above: FURUKI Mutsumi

Defendant: JPO Commissioner

Designated representative: IDE Eiichiro

Same as above: NOGUCHI Miyoko

Same as above: TOMITA Junichi

Main Text

1. The court rescinded the JPO decision dated July 15, 2010 concerning Trial against Examiner's Decision of Refusal No. 2008-650143.
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" of this judgment.

No. 2 Background

Regarding the proceedings described in 2. below concerning the application for registration of a trademark described in 1. below, while the JPO made a decision (the "JPO Decision") (the grounds for this decision are summarized in 3. below) as stated in the attached written JPO decision (copy) to the effect that the plaintiff's request for a trial against the examiner's decision of refusal is unacceptable, the plaintiff alleged that there are grounds for rescission of the JPO Decision as described in 4. below and sought rescission thereof.

1. Trademark claimed in the application (The "Trademark") (Exhibits Ko No. 1, No. 133, and No. 134, Exhibits Otsu No. 1 and No. 6-6)

Application filing date for international trademark registration (Date of subsequent designation): April 28, 2006

Application number: International Registration No. 600167 (Basic registration under the Madrid protocol: November 5, 1992, France)

Trademark: Three-dimensional trademark as shown in the attachment

Designated goods: Class 3: beauty products (cosmetics), soaps, perfume, cosmetics

(the goods specified in the report of limitation recorded in the International Register

dated December 17, 2008).

2. JPO proceedings

(1) Decision of refusal and a request for a trial

Date of decision of refusal: June 27, 2008 (Exhibit Otsu No. 6-4)

Date of request for trial: October 7, 2008 (Trial against Examiner's Decision of Refusal No. 2008-650143, Exhibit Otsu No. 6-5)

(2) JPO decision

Date of the JPO decision: July 15, 2010

Conclusion of the JPO decision: the request for this trial is unacceptable.

Date of the service of a certified copy of the JPO decision: July 28, 2010

3. Summary of the grounds for the JPO decision

In summary, the grounds for the JPO decision are as follows: The Trademark shall be refused on the grounds that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act and does not fulfill the requirement specified in paragraph (2) of said Article.

4. Grounds for rescission

(1) The JPO erred in determining that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act (Grounds for Rescission 1)

(2) The JPO erred in determining that the Trademark does not fall under Article 3, paragraph (2) of the Trademark Act (Grounds for Rescission 2)

(omitted)

No. 4 Court decision

1. Grounds for Rescission 1 (JPO's error in determining that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act)

(1) Article 3 of the Trademark Act and the shape of goods, etc. that can be regarded as a three-dimensional trademark

A. Article 3, paragraph (1), item (iii) of the Trademark Act specifies that any trademark that "consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision" may not be registered as a trademark. Paragraph (2) of said Article specifies as follows: "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." The purpose of these provisions is to specify that it is not conducive to the public interest to allow a particular person to exclusively use any trademark that falls under Article 3, paragraph (1), item (iii) of said Act, and that such trademark may be found to be a mark that is commonly used, incapable of distinguishing one's goods from others, and incapable of performing functions as a trademark, and therefore fails to fulfill the trademark registration requirements. However, if the mark acquires the capability to distinguish one's goods from others as a result of being used, the mark may be registered as a trademark.

While the Trademark Act specifies that, even if the trademark claimed in the trademark applications has a three-dimensional shape (including those combined with character(s), figure(s), sign(s) or color(s) or any combination thereof), the trademark may be registered as long as it satisfies the predetermined requirements (Article 2, paragraph (1) and Article 5, paragraph (2) of said Act). Article 4, paragraph (1), item (xviii) of said Act specifies that, notwithstanding Article 3 of said Act, no trademark that "consists solely of a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function" shall be registered. In light of these facts, these provisions may be interpreted as specifying that exclusive use by a particular person is not permissible for any three-dimensional shape of goods or their packaging that is essential for enabling the goods or their packaging to perform their functions.

B. In many cases, the shape of goods or their packaging is determined for the purpose of enhancing the performance of the functions that the goods, etc. are expected to carry out or improving the aesthetic impression of the goods, etc. and not for the purpose of simply serving as a mark to distinguish one's goods from others by immediately indicating the source of the goods. In this way, from the perspective of the manufacturers and suppliers of goods, etc., the shape of goods etc. alone may not be considered to have the function of indicating the source of the goods, etc. and the function of distinguishing one's goods from others in many cases. In other words, the shape of goods, etc. alone may not be considered to be carrying out trademark functions. Also, the consumers who see the shape of goods, etc., would usually recognize that, unlike a two-dimensional mark consisting of characters, figures, signs, etc., the shape of the goods, etc. has been determined for the purpose of facilitating the functions and emphasizing the aesthetic impression of the goods, etc. and would rarely recognize that the shape of the goods, etc. has been determined for the purpose of indicating the source

of the goods, etc. and distinguishing one's goods from others.

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 using 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.

C. 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).

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

A. Structure of the Trademark

The Trademark has the structure described in the attachment. The section titled "Description of the mark" contains the statement that "Bottle resembling a naked female body: side and 3/4th view" and the statement concerning colors that "silver cap, partly transparent or translucent lightly-tinged pink bottle" (Exhibit Ko No. 134, Exhibit Otsu No. 1).

According to the aforementioned descriptions, the Trademark is the three-dimensional shape of a container (package container) of perfume, etc., which is the designated goods. The shape consists of a cap that functions as both the lid and the sprayer on the top and a bottle, i.e., the container part, below it that has a shape designed

to look like a woman's trunk.

The cap part of the aforementioned part that functions as both the lid and the sprayer has a shape that looks like multiple disks of the same diameter being stacked up extending to the spray part that has a push-type lever on the top. The container part has two projection portions that correspond to a woman's breasts, a narrowed portion extending from those projection portions that corresponds to a woman's waist, and a mildly bulged portion extending from that narrowed portion down to the bottom, which is partially made of glass-like translucent material.

The color of the upper part that functions as both the lid and the sprayer is silver, while the color of the lower part, i.e. the container part, is partly transparent or translucent lightly-tinged pink with two brownish projection portions (Exhibits Ko No. 1 and No. 134).

B. Creation of the Trademark

The shape of the Trademark was designed by a designer, Jean Paul Gaultier, as a perfume container in a way that would evoke an image of a woman's silhouette (Exhibit Ko No. 108, the entire import of argument).

C. Shapes of perfume containers

Containers of perfume, etc. are included in the designated goods stated in the trademark application. The shapes of perfume containers have various sophisticated designs. Many containers have a three-dimensional shape with the top part functioning as both the lid and the sprayer (Exhibits Ko No. 97, No. 107, and No. 115 to No. 117, Exhibits Otsu No. 2 to No. 4). Apart from JEAN-PAUL GAULTIER LE MALE, there are the following containers for which the body part underneath the top part looks like a human body, etc.: Claude Montana, HEROS UOMO EDT SP, ZUT DE SCHIAPARELLI EDP SP, DALIFLOR EDT SP, EVITA EDP SP, SIREN EDP SP, DOLLY GIRL EDT SP, etc. (Exhibit Ko No. 108, Exhibit Otsu No. 4).

Among these perfume bottles that look like a woman's body, the Trademark is the only one that has two projection portions that correspond to a woman's breasts, a narrowed portion extending from those projection portions that corresponds to a woman's waist, and a mildly bulged portion extending from that narrowed portion down to the bottom.

D. According to A. and C. above, in the case of the three-dimensional shape that constitutes the Trademark, the top end that functions as both the lid and the sprayer has the basic shape of a container for storing and emitting liquid perfume, which enables the container to effectively perform its spraying function. The shape of the remaining part of the container seems to have been chosen for the purpose of enhancing the aesthetic

impression of the silhouette of the container. It is true that the three-dimensional shape that constitutes the Trademark is distinctive to some extent, but some other perfume containers are also designed to look like a woman's body, so this three-dimensional shape cannot be deemed to go far beyond the range of shapes usually adopted for perfume containers.

Thus, the three-dimensional shape that constitutes the Trademark, if viewed objectively as of the time of the JPO decision, is deemed to have been chosen for the purpose of making it contribute to the function or aesthetic impression of the perfume container, and it is within the range of shapes that consumers expect as those to be chosen for the purpose of making them contribute to the function or aesthetic impression. Therefore, this three-dimensional shape is regarded as a trademark which consists solely of a mark using the shape of the goods, etc. in a common manner, and therefore falls under Article 3, paragraph (1), item (iii) of the Trademark Act.

(3) Plaintiff's allegations

The plaintiff alleged that such shape as the Trademark has not been conceived of by any other person, and has not been commonly used due to the difficulty in manufacturing it and therefore has the capability to distinguish one's goods from others.

However, even if the plaintiff's subjective purpose is to make the shape of the Trademark have the capability to distinguish one's goods from others, that would not affect the determination as to the objective features of the three-dimensional shape of the Trademark. Furthermore, in view of the facts that there is not sufficient evidence to prove the difficulty in manufacturing it and that, as mentioned in (2) above, as of the date of the JPO decision in question, there were many other perfume containers that look like a human body, etc. including the ones that look like a woman's body, the shape of the Trademark may not be considered to go beyond the range of the shapes that could be expected as the shape of the Trademark.

(4) Summary

As described above, Grounds for Rescission 1 do not exist.

2. Grounds for Rescission 2 (JPO erred in determining that the Trademark does not fall under Article 3, paragraph (2) of the Trademark Act.)

(1) Purpose of Article 3, paragraph (2) of the Trademark Act

As described in 1. above, Article 3, paragraph (2) of the Trademark Act provides that a trademark which consists solely of a mark indicating the shape of the goods, etc. in a common manner and therefore falls under paragraph (1), item (iii) of said Article may be registered if, as a result of being used, it has acquired the capability to distinguish one's goods from others.

Whether or not a trademark consisting of a three-dimensional shape has acquired the capability to distinguish one's goods from others should be determined by comprehensively taking into consideration, [i] whether or not there are other goods, etc. whose shape is identical or similar to the shape of the trademark, and [ii] the circumstances concerning the use of the trademark, such as the period of time when the trademark has been in use, the volume of sales of the goods, and the period of time and scale of the advertisement of the goods.

In principle, the shape of the trademark and the goods in use must be identical with the shape of the trademark claimed in the application in substance, and the goods are required to fall under the designated goods. However, in light of the fact that the shape of goods, etc. could be changed in order to maintain the functions or to launch a new product, even if the three-dimensional shape of the goods, etc. in use is slightly different from the shape of the trademark claimed in the application, the question of whether the three-dimensional shape has independently acquired the capability to distinguish one's goods from others or not should be determined by comprehensively taking into consideration such issues as whether the three-dimensional shape attracts consumers' attention and gives them a strong impression.

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

A. Shape of the trademark and the existence or nonexistence of other goods, etc. similar to said shape

(A) As described in 1. above, the Trademark is the three-dimensional shape of the container (package and container) for perfume, etc., which is one of the designated goods. The shape consists of a cap that functions as both the lid and the sprayer on the top and a bottle, i.e., the container part, below it that has a shape designed to look like a woman's trunk, which was designed in such a way that would evoke an image of a woman's silhouette. While containers of perfume, etc. are included in the designated goods stated in the trademark application, the shapes of perfume containers have various sophisticated designs. Many containers have a three-dimensional shape with the top part functioning as both the lid and the sprayer. The container parts of some containers look like a human body, etc. The shape of the Trademark may not be considered to go far beyond the range of the shapes that could be expected as the shape of a perfume container. The Trademark may be considered to fall within the range of the shapes that could be expected by consumers as described in 1. above. However, among the perfume containers that look like a woman's body, the Trademark is the only one that has the shape that has two projection portions that correspond to a woman's breasts, a narrowed portion extending from those projection portions that corresponds to a

woman's waist, and a mildly bulging portion extending from that narrowed portion down to the bottom.

(B) Since 1993 and 1994, in which the perfume product (Jean Paul Gaultier "Classique") was launched by using the Trademark, the package design and bottle design thereof have received many comments. Some of those comments that appeared in magazine, etc. are "novel," "impactful," "stimulating," "bold and provocative," "unique and elegant," "breaking the conventional norms and setting new rules," "mysterious but with a sense of realism as if it were alive" (Exhibits Ko No. 6 to No. 8, No. 25, No. 26, No. 32, No. 35, No. 50 to No. 58, and No. 108 to No. 110).

(C) In this way, the three-dimensional shape of the Trademark is distinctive to a certain extent. The three-dimensional shape is likely to attract consumers' attention and make a strong impression upon them.

B. Actual state of use

(A) The plaintiff is a cosmetic company headquartered in France and a group company of Shiseido (Exhibits Ko No. 2 and No. 3). The plaintiff has a perfume brand called "JEAN PAUL GAULTIER").

(B) In 1993, the plaintiff started selling the perfume JEAN PAUL GAULTIER "Classique" packed in a container that has a three-dimensional shape identical with the Trademark. In Japan, the plaintiff started selling said product in 1994 and continued selling said product up to the date of the JPO decision in question (Exhibit Ko No. 135, the entire import of argument).

The annual sales of JEAN PAUL GAULTIER "Classique" in Japan have been around 45 to 58 million yen since 2004 (Exhibit Ko No. 135).

(C) JEAN PAUL GAULTIER "Classique" is often presented and advertised in perfume magazines, fashion magazines, etc. (Exhibits Ko No. 4 to No. 107, No. 115 to No. 117, and No. 120).

(D) The shape of JEAN PAUL GAULTIER "Classique" sold in Japan and presented in magazines, etc. is almost identical with the Trademark in substance although there is a slight difference in shape in some cases.

In some cases, the color of the container part is orange, etc., which is not identical with the Trademark or has a decoration that looks like clothing (Exhibits Ko No. 11, No. 24, No. 40, No.53, No.57, No. 58, No.60, No.63, No.68, No.75, No.81, No.83, No.99, No.115, and No.117). The defendant has admitted that the shape of the goods in use is almost identical with the three-dimensional shape of the Trademark.

C. As described above, the shape of the container part of the Trademark is designed to look like a woman's body; it has two projection portions that correspond to a woman's

breasts, a narrowed portion extending from those projection portions that corresponds to a woman's waist, and a mildly bulged portion extending from that narrowed portion down to the bottom. Thus, because of such a unique and peculiar feature, the three-dimensional shape that constitutes the Trademark can easily catch the eyes of consumers and give them a strong impression. It has been in sale for more than 15 years since 1994, and has been in use, while appearing in perfume and fashion magazines. In light of these circumstances, there is no harm in determining that the three-dimensional shape that constitutes the Trademark has acquired the capability to distinguish one's goods from others and has become distinctive to an extent that traders and consumers of perfume, etc. can recognize it as perfume, etc. sold by the plaintiff.

Taking all of these circumstances into consideration, when the Trademark is used for the designated goods, traders and consumers can recognize such goods as those sold by the plaintiff, and therefore it satisfies the requirement prescribed in Article 3, paragraph (2) of the Trademark Act.

(3) Defendant's allegations

A. The defendant alleged that the plaintiff had stated that, since the Trademark does not fall under Article 3, paragraph (1), item (iii) of the Trademark Act, it is not necessary to discuss the issue of whether the JPO decision contains an error in interpreting and applying paragraph (2) of said Article.

However, in response to the JPO decision that presented the JPO's determination on paragraph (2) of said Article, the plaintiff alleged that, in the JPO decision, the JPO erred in interpreting and applying paragraph (2) of said Article and that the Trademark is well-known. The defendant gave a counterargument to the plaintiff's allegation. In consideration of these facts, the court examined whether the JPO erred in determining that the Trademark does not fall under paragraph (2) of said Article.

B. The defendant alleged that, since the perfume sold by using the Trademark does not have clear information in terms of its sales sites, sales territory, sales volume, and advertising costs and has a low market share, general consumers of perfume do not recognize the Trademark as an identifier of the source of the plaintiff's goods.

However, although it is desirable to have clear information about its sales territory, sales volume, advertisement costs, etc., even if those are not necessarily clear, the Trademark could be capable of distinguishing one's goods from others thanks to its distinctive shape. Unlike an inexpensive daily commodity, in the case of perfume, consumers who see advertisements on some goods on perfume magazines, fashion magazines, etc. could recognize the plaintiff as the source of the goods based on the distinctive shape of the container of the goods.

C. The defendant alleged that, since the content of the evidence submitted by the plaintiff is limited to the information about perfume and fails to present any allegations and evidence regarding any other goods, the Trademark may not be considered to have acquired the capability to distinguish one's goods from others as a result of use.

However, the plaintiff issued the report of limitation recorded in the international register dated December 17, 2008 and deleted, from the initial designated goods, Class 3 "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; essential oils, hair lotions, dentifrices" and limited the designated goods to "beauty products (cosmetics), soaps, perfumery, cosmetics."

Furthermore, the plaintiff sold Perfumed Bath and Shower Gels, Perfumed Body Lotion and Perfumed Body Cream under the Jean Paul Gaultier brand (Exhibits Ko No. 83, No. 106, and No. 116) and a set consisting of the eau de toilette "Classique" of Jean Paul Gaultier and Bath and Shower or Body Lotion (Exhibits Ko No. 76 to No. 78, No. 90, No. 91, No. 101 to No. 103, and No. 105). In this way, there are extremely close relationships between perfume and other designated goods (beauty products (cosmetics), soaps, perfume, cosmetics), which share many traders and consumers.

Therefore, as a result of the Trademark's acquisition of the capability to distinguish the plaintiff's perfume from others, if the Trademark is used for the limited scope of the designated goods selected in the trademark application which are closely related to perfume, such as cosmetics, traders and consumers of those designated goods, who overlap with traders and consumers of perfume, can also recognize such goods as those sold by the plaintiff, who sells perfume of the Jean Paul Gaultier brand."

(4) Summary

Therefore, Grounds for Rescission 2 exist.

3. Conclusion

On these grounds, the plaintiff's claim shall be accepted.

Intellectual Property High Court, Fourth Division

Presiding judge: TAKIZAWA Takaomi

Judge: TAKABE Makiko

Judge: INOUE Yasuhito

(Attachment)
Trademark

