

Trademark Right	Date	December 15, 2020	Court	Intellectual Property High Court, Third Division
	Case number	2020 (Gyo-Ke) 10076		
- A case in which, concerning an application for registration of a position trademark consisting of three-dimensional shapes placed on a container of a product, in a position from slightly above the middle of the body part of the container to a neck part, with the designated goods of "SAUCES FOR BARBECUED MEAT" in Class 30, the court held that the trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act and not under Article 3, paragraph (2) of the same Act.				

Case type: Rescission of Appeal Decision of Refusal

Result: Dismissed

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

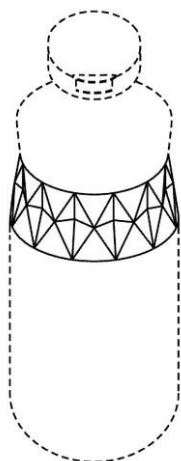
Related rights, etc.: Trademark Application No. 2015-47397, Appeal against Examiner's Decision of Refusal No. 2017-10633

Summary of the Judgment

1. Plaintiff filed an application for registration of the following position trademark (Trademark Application No. 2015-47397), and the JPO issued a decision of refusal. In response, Plaintiff filed an appeal against the decision of refusal (Appeal against Examiner's Decision of Refusal No. 2017-10633), and the JPO dismissed the appeal. As such, Plaintiff filed a lawsuit of the present case seeking rescission of the decision made by the JPO.

The issue concerns the applicability of Article 3, paragraph (1), item (iii), and Article 3, paragraph (2) of the Trademark Act. In the judgment of the present case, the court dismissed the claim filed by Plaintiff by holding that the position trademark pertaining to the application filed by Plaintiff falls under Article 3, paragraph (1), item (iii) of the Trademark Act and not under Article 3, paragraph (2) of the same Act, so that the decision by the JPO is not erroneous.

[The trademark for which registration is sought]



[Detailed description of the trademark]

The trademark for which registration is sought (hereinafter referred to as "Applied Trademark") is a position trademark which specifies the place to affix the mark, and consists of three-dimensional shapes placed on a container of a product, in a position from slightly above the middle of a body part of the container to a neck part. Said three-dimensional shapes consist of vertically-long diamond shapes that are placed in a row along the periphery of the container, and each diamond shape sinks in towards the center. The parts drawn in dashed lines represent one example of a container of a product, and are not constituent parts of the Applied Trademark.

[The class of goods or services, and the designated goods or services]

Class 30 Sauces for barbecued meat

2. The judgment of the present case is summarized below.

(1) Concerning the applicability of Article 3, paragraph (1), item (iii) of the Trademark Act

A. Framework for judgment

Article 3, paragraph (1), item (iii) of the Trademark Act provides that registration cannot be granted for a trademark which consists solely of a mark indicating, in a common manner, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packaging ...), the method or features including time of production or use, quantity, and price concerning goods, or, in the case of services, the location of provision, quality, articles to be used in the provision, efficacy, intended purpose, modes, method or features including time, quantity, or price of provision. The purport of this provision is that since the marks that are listed in the same item indicate or describe features of goods such as the place of origin and the place of sale of goods, use of these marks is often

necessary in a transaction, and any person would desire to use these marks, so that it is not appropriate, from the point of view of public interest, to grant the exclusive use of any of such marks to a specific person, and furthermore, that since these marks are commonly used marks, it is often the case that these marks lack distinctiveness and fail to perform the functions as a trademark, so that they shall not be granted registration. From among the marks described in the same item, the shape of goods, etc. is, in many cases, selected for purposes such as more effective performance of functions that are expected of goods, etc., and improvement of the goods, etc. in the aesthetic aspect. To the contrary, there are not many cases of the shape of goods, etc. being used as an indicator for showing the source of goods or services, or for distinguishing the goods or services from other goods or services. As such, customers recognize the shape of goods, etc. as having been selected for emphasizing the functionality or aesthetics of goods, unlike with the case of a mark that is shown by a letter, figure, or sign or the like in a flat shape, so that in many cases, customers do not recognize the shape of goods, etc. as having been selected as an indicator for identifying the source. Furthermore, the shape that is intended to contribute to the functionality or aesthetics of goods, etc. is such that if a person involved in goods, etc. of the same type is in need of such shape, the person would desire to use the shape, so that granting the exclusive use of such shape to a specific person based solely on the fact that an application for registration of a trademark was filed on an earlier date cannot be considered appropriate from the point of view of public interest. Accordingly, it is reasonable to interpret that the shape of goods, etc. falls under Article 3, paragraph (1), item (iii) of the Trademark Act as a trademark consisting solely of a mark indicating a feature of goods in a common manner, unless there are special circumstances, including the case of goods of the same type having a shape that is beyond the predictable scope of adoption for reasons of functionality or aesthetics.

B. Applicability of Article 3, paragraph (1), item (iii) of the Trademark Act

The Applied Trademark is a position trademark which specifies the place to affix the mark, and consists of three-dimensional shapes placed on a container of a product, in a position that is slightly above the middle of the body part of the container to the neck part. The three-dimensional shapes consist of vertically-long diamond shapes that are placed in a row along the periphery of the container, and each diamond shape sinks in towards the

center. Given that the vertically-long diamond shapes that are placed in a row on the surface of a packaging container constitute one of the three-dimensional decorations that are commonly adopted and used in transactions involving packaging containers for sauces for barbecued meat as something that contributes to the functionality or aesthetics of a product, and that the position is usually in the upper part or lower part of the packaging container, and furthermore, that it cannot be said that there is a particularly innovative feature with regard to these shapes, it is acknowledged that the three-dimensional shapes constituting the Applied Trademark, and the position for affixing the Applied Trademark are within a scope that is predictable, among customers and traders, as having been adopted for use for reasons of functionality or aesthetics of the product. In the figure of the Applied Trademark, the parts drawn in dashed lines represent one example of a container of a product, and are not constituent parts of the trademark. In addition, while attachment of a label, which indicates the product name and the like, to a place underneath the three-dimensional shapes is not included in the constitution per se of the Applied Trademark, given that the Applied Trademark is placed on a container in a position that is slightly above the middle of the body part of the container to the neck part, and that the designated goods are sauces for barbecued meat, it is easily predictable that a label, which indicates the product name and the like, would be placed underneath the Applied Trademark. By also taking this point of view into consideration, it is acknowledged that the three-dimensional shapes constituting the Applied Trademark are recognized among customers and traders as having been adopted or used for the purpose of contributing to the functionality or aesthetics, instead of identifying the source.

In that case, the three-dimensional shapes constituting the Applied Trademark are within a scope where it is predictable that a product of the same type would adopt the same for reasons of functionality or aesthetics of the product, and there are no special circumstances for sufficiently acknowledging that the shapes are beyond such scope. Accordingly, the Applied Trademark is a trademark consisting only of a mark that indicates, in a common manner, the shape of a package of a product, and thus it is acknowledged that the Applied Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act.

(2) Concerning the applicability of Article 3, paragraph (2) of the Trademark Act

A. Framework for judgment

Whether or not it can be said that a position trademark consisting of three-dimensional shapes has acquired distinctiveness through its use should be determined by comprehensively taking into consideration circumstances such as the following; namely, the shape of the trademark, the period and area of use of the trademark, the sales volume of the product bearing the trademark, the period and scale of advertisement of the trademark, and whether or not there are other products having a shape that is similar to the shape of the trademark.

- B. (A) Generally speaking, a glass bottle, plastic bottle, or other such container, which is a packaging container for edible or drinkable liquid, bears a label, and the label shows information such as a mark or letters indicating the product name, manufacturer, and distributor, and letters or the like describing the product. Often, the mark or letters indicating the product name, manufacturer, and distributor are shown in a noticeable manner, and the fact that customers identify a product by a label or that they recognize the source of a product from a label is a notable fact. As such, it is acknowledged that customers pay attention to a label when they look at a glass bottle, plastic bottle, or other such container, which is a packaging container for edible or drinkable liquid, and it is acknowledged that the description on a label gives a strong impression to customers. Furthermore, upon considering the products for which the Applied Trademark is used (hereinafter referred to as "Products Bearing Applied Trademark") (from among Plaintiff's products called "エバラ焼肉のたれ 黄金の味" [meaning "Ebara Sauce for Barbecued Meat Golden Taste" in English], ones that are sold in sizes of 210 g (from the time of first sale until 2015), 400 g (from 1979 until July 2017), and 360 g and 480 g (since July 2017)), it is acknowledged that, as shown by the modes of the products, in the Products Bearing Applied Trademark, the marks of "エバラ" ["Ebara" written using katakana letters] and "黄金の味" [meaning "golden taste" in English] indicated on the label give a strong impression to customers, and that customers would focus on the mark parts of "エバラ" and "黄金の味" on the label as an indicator for identifying the source. As shown above, considering that a mark or letters indicated on a label give a strong impression to customers, thereby serving the function of identifying the source, and that, to the contrary, the Applied Trademark consists of

vertically-long diamond shapes that are placed in a row and that constitute one of the three-dimensional decorations, which are commonly adopted and used in transactions involving packaging containers for sauces for barbecued meat as something that contributes to the functionality or aesthetics of a packaging container for sauce for barbecued meat, and is placed in a position near the label, thereby creating a state in which it is not easily recognized as an indicator showing the source other than the label which, conversely, gives a strong impression, it cannot be acknowledged that, in the Products Bearing Applied Trademark, the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source.

(B) It is presumed that a majority of products called "エバラ焼肉のたれ 黄金の味" consist of the Products Bearing Applied Trademark. On the other hand, there are also products whose packaging is different from that of the Products Bearing Applied Trademark. Given these circumstances, it cannot be said conclusively that, even if products called "エバラ焼肉のたれ 黄金の味" come to be widely known, they would always be associated with the Products Bearing Applied Trademark. Furthermore, in light of the modes of the Products Bearing Applied Trademark, a label is the element which serves the function of distinguishing the products from other products, and it cannot be acknowledged that the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source. Accordingly, even if there is a considerable level of sales performance of the Products Bearing Applied Trademark, it cannot be acknowledged, as a result, that the three-dimensional shapes constituting the Applied Trademark are recognized as an indicator for identifying the source. Furthermore, concerning the advertisement which was actually carried out, it is acknowledged that in TV commercials, the time during which the three-dimensional shapes constituting the Applied Trademark placed on the surface of the containers of the Products Bearing Applied Trademark appear on the screen, so as to be visually recognizable, is short, so that it cannot be acknowledged that TV commercials contributed in making the three-dimensional shapes constituting the Applied Trademark give an impression to customers. In addition, given that the Applied Trademark is a position trademark consisting of three-dimensional shapes placed on the surface of a container of a product, it is acknowledged that it was difficult for listeners to recognize, through radio commercials, the three-dimensional shapes

constituting the Applied Trademark. Next, although TV commercials showed on the screen the outer appearance of a Product Bearing Applied Trademark when seen from the front, and pamphlets, leaflets, product information, products born out of various collaborations, and a mook (book-like magazine) showed photographs of the outer appearance of a Product Bearing Applied Trademark when seen from the front, it cannot be acknowledged, as described above in (A), that in the Products Bearing Applied Trademark, the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source. Furthermore, it cannot be acknowledged that, in the above advertisement, there were announcements or indications intended to cause the three-dimensional shapes per se to give a strong impression as an indicator for showing the source of the product, or as an indicator for distinguishing the product from other products, for example by referring to the three-dimensional shapes constituting the Applied Trademark as a feature of the product or its container, so that even if the outer appearance of a Product Bearing Applied Trademark when seen from the front is shown on the screen in the above advertisement, and a photograph of the outer appearance of the product when seen from the front is shown, it cannot be acknowledged that the three-dimensional shapes constituting the Applied Trademark came to be recognized as an indicator for identifying the source as a result. As for the questionnaire submitted as evidence, it cannot be acknowledged that, from the perspective of providing evidence for the assertion of whether or not the Applied Trademark has distinctiveness, the questionnaire is reasonable in regards to making a selection between a container of a Product Bearing Applied Trademark and the containers that are used for comparison. Accordingly, it cannot be acknowledged that the result of the questionnaire is one that provides evidence that the three-dimensional shapes constituting the Applied Trademark have a function of identification, so that the result of the questionnaire cannot be weighed heavily upon determining whether or not the three-dimensional shapes serve the function of identification.

(C) Based on the consideration given above in (A) and (B), the three-dimensional shapes constituting the Applied Trademark have been used in the Products Bearing Applied Trademark, and the Products Bearing Applied Trademark have been sold in a considerable number and have been advertised, but it cannot be acknowledged that the Applied Trademark has

acquired distinctiveness through its use. Accordingly, since the Applied Trademark does not fall under a trademark which, as a result of its use, can be recognized by customers as a product pertaining to the business of Plaintiff, it cannot be acknowledged that the Applied Trademark fulfills the requirement stipulated in Article 3, paragraph (2) of the Trademark Act.

Judgment rendered on December 15, 2020

2020 (Gyo-Ke) 10076 A case of seeking rescission of the JPO decision

Date of conclusion of oral argument: October 8, 2020

Judgment

Plaintiff: Ebara Foods Industry, Inc.

Defendant: Commissioner of JPO

Main text

1. Plaintiff's claim shall be dismissed.
2. Plaintiff shall bear the court costs.

Facts and reasons

No. 1 Claim

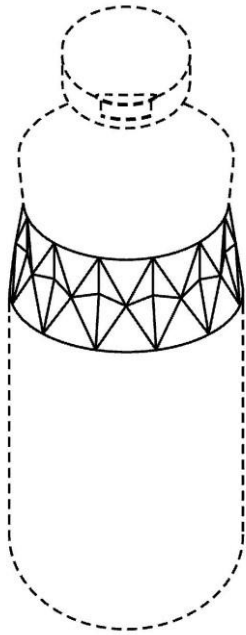
The decision made by the JPO on March 30, 2020 for the Case of Appeal against Examiner's Decision of Refusal No. 2017-10633 shall be rescinded.

No. 2 Outline of the case

1. Histories of procedures at the JPO

- (1) On May 20, 2015, Plaintiff filed an application for registration of the following position trademark (Trademark Application No. 2015-47397) (hereinafter referred to as "Application").

[The trademark for which registration is sought]



[Detailed description of the trademark]

The trademark for which registration is sought (hereinafter referred to as "Applied Trademark") is a position trademark which specifies the place to affix the mark, and consists of three-dimensional shapes placed on a container of a product, in a position from slightly above the middle of a body part of the container to a neck part. Said three-dimensional shapes consist of vertically-long diamond shapes that are placed in a row along the periphery of the container, and each diamond shape sinks in towards the center. The parts drawn in dashed lines represent one example of a container of a product, and are not constituent parts of the Applied Trademark.

[The class of goods or services, and the designated goods or services]

Class 30 Seasonings [other than spices]

- (2) On April 10, 2017, the JPO issued a decision of refusal.
- (3) On July 18, 2017, Plaintiff filed an appeal against the decision of refusal (Appeal against Examiner's Decision of Refusal No. 2017-10633).
- (4) In a written amendment dated July 18, 2017, Plaintiff amended the designated goods of the Application to "Sauces for barbecued meat" in Class 30.
- (5) On March 30, 2020, the JPO dismissed the appeal by holding that "the request for an appeal of the present case is groundless" (hereinafter referred to as "JPO Decision").
- (6) On May 25, 2020, a certified copy of the JPO Decision was delivered to

Plaintiff, and on June 23 of the same year, Plaintiff filed the lawsuit of the present case seeking rescission of the JPO Decision.

2. Summary of the reasons for JPO Decision

The reasons for the JPO Decision are as per the attached copy of the decision, and are summarized below.

(1) Concerning the applicability of Article 3, paragraph (1), item (iii) of the Trademark Act (the provisions appearing hereinafter are all from the Trademark Act)

It should be said that the three-dimensional shapes constituting the Applied Trademark and the position to attach the same are such that customers can recognize them to be within the scope of a type of three-dimensional decorations that are commonly placed on a packaging container of a product for the purpose of contributing to the functionality or aesthetics of the product. As such, it is reasonable to consider that the three-dimensional shapes per se would not be recognized, on their own, as an indicator showing the source of the product, or as an indicator that distinguishes the product from other products. Accordingly, the Applied Trademark is a trademark consisting solely of a mark indicating, in a common manner, the shape of a package of a product, and thus falls under Article 3, paragraph (1), item (iii).

(2) Concerning the fulfillment of the requirement stipulated in Article 3, paragraph (2)

Since June 1978, products called "エバラ焼肉のたれ 黄金の味" [meaning "Ebara Sauce for Barbecued Meat Golden Taste" in English] and bearing what seem to be the same shapes as the three-dimensional shapes which constitute the Applied Trademark and which are placed on a container of a product, in a position from slightly above the middle of the body part of the container to a neck part, have been sold and advertised nationwide, and in fiscal 2015 comprised a share of over 30% in the market for sauces for barbecued meat. Having said that, in regards to the aforementioned product, it can be said that a mark consisting of the letters, "エバラ" ["Ebara" written using katakana letters], or a mark consisting of the letters, "黄金の味" [meaning "golden taste" in English], is recognized by customers as an indicator showing the source of the product, or as an indicator for distinguishing the product from other products, but on the other hand, it cannot be said that what seem to be the same shapes as the three-dimensional shapes which constitute the Applied Trademark and which are placed on a container of a product, in a

position from slightly above the middle of the body part of the container to the neck part, are recognized by customers as such indicator. Accordingly, it cannot be acknowledged that the Applied Trademark is one which, as a result of use, came to be recognized by customers as a product that pertains to a business of a particular person, so that it cannot be acknowledged that the Applied Trademark fulfills the requirement stipulated in Article 3, paragraph (2).

(omitted)

No. 5 Judgment of this court

1. Concerning the applicability of Article 3, paragraph (1), item (iii)

(1) Framework for judgment

Article 3, paragraph (1), item (iii) of the Trademark Act provides that registration cannot be granted for a trademark which consists solely of a mark indicating, in a common manner, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, shape (including shape of packaging ...), the method or features including time of production or use, quantity, and price concerning goods, or, in the case of services, the location of provision, quality, articles to be used in the provision, efficacy, intended purpose, modes, method, or features including time, quantity, or price of provision. The purport of this provision is that since the marks that are described in the same item indicate or describe features of goods such as the place of origin and the place of sale of goods, use of these marks is often necessary in a transaction, and any person would desire to use these marks, so that it is not appropriate, from the point of view of public interest, to grant the exclusive use of any of such marks to a specific person, and furthermore, since these marks are commonly used marks, it is often the case that these marks lack distinctiveness and fail to perform the functions as a trademark, so that they shall not be granted registration. From among the marks described in the same item, the shape of goods, etc. is, in many cases, selected for purposes such as more effective performance of functions that are expected of goods, etc., and improvement of the goods, etc. in the aesthetic aspect. To the contrary, there are not many cases of the shape of goods, etc. being used as an indicator for showing the source of goods or services, or for distinguishing the goods or services from other goods or services. As such, customers recognize the shape of goods, etc. as having

been selected for emphasizing the functionality or aesthetics of goods, unlike with the case of a mark that is shown by a letter, figure, or sign or the like in a flat shape, so that in many cases, customers do not recognize the shape of goods, etc. as having been selected as an indicator identifying the source. Furthermore, the shape that is intended to contribute to the functionality or aesthetics of goods, etc. is such that if a person involved in goods, etc. of the same type is in need of such shape, the person would desire to use the shape, so that granting the exclusive use of such shape to a specific person based solely on the fact that an application for registration of a trademark was filed on an earlier date cannot be considered appropriate from the point of view of public interest. Accordingly, it is reasonable to interpret that the shape of goods, etc. falls under Article 3, paragraph (1), item (iii) of the Trademark Act as a trademark consisting solely of a mark indicating a feature of goods in a common manner, unless there are special circumstances, including the case of goods of the same type having a shape that is beyond the predictable scope of adoption for reasons of functionality or aesthetics.

(2) Vertically-long diamond shapes placed in a row on the surface of a packaging container

A. Shapes placed on packaging containers of liquid products

In an industry that deals with food and drinks, it is often the case that a narrow-mouthed and vertically-long packaging container is adopted and used for containing a liquid product from the perspective of making it easier to carry, pour, drink, and the like. However, even under the certain restrictions that are required due to such nature of products, there are various shapes of packaging containers (Exhibits Otsu 1 to Otsu 5), and the following packaging containers, which are ones in which three-dimensional decorations are placed on the surface of the packaging containers, and in particular, ones with diamond shapes (diamond-shaped cuttings) placed in a row, are found.

[i] On the website called "Otsuka Pharmaceutical Co., Ltd. Official Online Shopping Site Otsuka Plus 1" (Exhibit Otsu 6), under the heading, "Story of the creation of Oronamin C Part II" (page 1), there are the words, "The surface of the glass bottle is decorated with diamond-shaped cuttings as a preventive measure against slipping when wet, in addition to giving a beautiful look" (page 2), along with a photograph of a glass bottle for a drink, with diamond shapes placed in a row, in a position

that is slightly above the middle of the body part of the container, and a label indicating the product name and the like in a noticeable manner placed underneath.

[ii] On a website run by Koiwai Dairy Products Company, Limited (Exhibit Otsu 7), under the heading, "'Koiwai gift for your body Lactococcus lactis strain Plasma Yogurt Drink' Newly released on Tuesday, December 4, 2012" (the part written in green on page 1), there are the words, "A new container that is easy to hold by hand, decorated in a stylish silhouette with diamond-shape cuttings", in a column for "Product features" (page 1), along with a photograph of a container for a drink, with diamond shapes placed in a row on the upper part, and the product name indicated in a noticeable manner underneath.

[iii] On a website run by Yamato Material Co., Ltd. (Exhibit Otsu 8), under the heading, "Food-related original products" (page 1), there are the words, "A slim bottle for dressing, decorated with diamond-shaped cuttings" (page 1), there are diamond shapes placed in a row on the lower part, along with a photograph of a container for seasoning, with a label attached thereon, indicating the product name and the like in a noticeable manner and placed on top of the diamond shapes.

Given the above, it is acknowledged that attachment of diamond shapes placed in a row on the upper or lower part of a packaging container of a liquid product is commonly adopted and used in transactions. Furthermore, in each of the above cases, it is found that a label indicating the product name and the like in a noticeable manner is placed, or the product name is indicated in a noticeable manner, either on top of or underneath the diamond shapes placed in a row that are attached to the packaging container, and in light of what is described in [i] and [ii], it is believed that diamond shapes are adopted from the perspective of functionality, such as making it easier to carry, and aesthetics.

B. Shapes that are placed on packaging containers for sauces for barbecued meat

(A) Decorations on the surface of packaging containers for sauces for barbecued meat

The designated goods for the Applied Trademark are "Sauces for barbecued meat", and with regard to packaging containers for sauces for barbecued meat, ones with three-dimensional decorations placed on the

surface are found as follows.

[i] On a website run by "NH Foods Ltd." (Exhibit Otsu 9), under the headings of "Sauce for barbecued sauce Sweet" (first page), "Sauce for barbecued meat Medium Spicy" (second page), "Sauce for barbecued meat Spicy" (third page), and "Sauce for barbecued meat Miso Flavor" (fourth page), there is a photograph of a glass bottle with slanted and striated, three-dimensional shapes placed in a row on the upper part, and a label indicating the product name and the like in a noticeable manner placed underneath.

[ii] On a website run by "Rakuten Market" (Exhibit Otsu 10), under the heading, "Bulgogi-flavor, Korean-style sauce for barbecued meat" (first page), there is a photograph of a container with slanted and striated, three-dimensional shapes placed in a row on the upper part, and a label indicating the product name and the like in a noticeable manner placed underneath.

[iii] On a website run by "Ichikawa Chiiki Brand Kyogikai" (Exhibit Otsu 11), under the heading, "Sauce for barbecued meat 'Pear flavor'" (first page), there is a photograph of a container with slanted and striated, three-dimensional shapes placed in a row on the upper part, and a label indicating the product name and the like in a noticeable manner placed underneath.

[iv] On a website run by "Amazon" (Exhibit Otsu 12), under the heading, "Tomura Honten Tomura sauce for barbecued meat 600 g" (first page), there is a photograph of a container with slanted and striated, three-dimensional shapes placed in a row on the lower part, and a label indicating the product name and the like in a noticeable manner placed on top.

[v] On a website run by "Jojoen Premium Shop" (Exhibit Otsu 13), under the heading, "Jojoen Salt-based sauce for barbecued meat" (first page), there is a photograph of a container, with vertically-long and striated, three-dimensional shapes placed in a row on the upper part, and a label indicating the product name and the like in a noticeable manner placed underneath.

[vi] On a website run by "Wagamachi Tokusan Net" (Exhibit Otsu 15), under the heading, "Shimane Prefecture local specialty sauce Sauce for barbecued meat 200 g × 6" (first page), there is a

photograph of a glass bottle, with vertically-long and striated, three-dimensional shapes placed in a row on the upper part, and a label indicating the product name and the like in a noticeable manner placed underneath.

[vii] On a website run by "Kawashimacho Seikatsu Kaizen Group Renraku Kyogikai" (Exhibit Otsu 16), under the heading, "Sauce for barbecued meat Kawashima local specialty product containing garlic!" [Kawashimacho Seikatsu Kaizen Group Renraku Kyogikai] (first page), there is a photograph of a glass bottle, with vertically-long and striated, three-dimensional shapes placed in a row on the upper part, and a label indicating the product name and the like in a noticeable manner placed underneath (second page) (Exhibit Otsu 16).

Given the above, it is acknowledged that the act of decorating a container for sauce for barbecued meat with three-dimensional shapes placed in a row on the upper or lower part of the container is commonly adopted and used in transactions. Furthermore, given the circumstances such as that in each of the above cases, it is found that a label indicating the product name and the like in a noticeable manner is placed thereon, either on top of or underneath the decoration of three-dimensional shapes on the surface of the packaging container, it is presumed that these striated shapes are also adopted from the perspective of functionality or aesthetics.

(B) Diamond shapes placed on packaging containers for sauces for barbecued meat

The following packaging containers, which are ones in which three-dimensional diamond shapes placed in a row are used as a type of three-dimensional decorations to be placed on the surface of packaging containers for sauces for barbecued meat, are found.

[i] On a website run by "Cosmo Foods Corporation" (Exhibit Otsu 17), under the headings, "From the north Sauce for barbecued meat Medium Spicy 350 g" (first page) and "From the north Sauce for barbecued meat Medical cuisine Medium Spicy 350 g" (third page), there is a photograph of a container with vertically-long and diamond-shaped, three-dimensional shapes placed in a row on the lower part, and a label indicating the product name and the like in a noticeable manner placed on top.

[ii] On a website run by "Food Label Co., Ltd" (Exhibit Otsu 18), under the heading, "Yakiniku Toraji Sauce for barbecued meat 240 g", there is a photograph of a container with vertically-long and diamond-shaped, three-dimensional shapes placed in a row on the lower part, and a label indicating the product name and the like in a noticeable manner placed on top.

[iii] On a website run by "Amazon" (Exhibit Otsu 19), under the heading, "Seijo Ishii Sauce for barbecued meat 350 g" (first page), there is a photograph of a container with vertically-long and diamond-shaped, three-dimensional shapes placed in a row on the lower part of the packaging container, and a label indicating the product name and the like in a noticeable manner placed on top.

[iv] On a website run by "Amazon" (Exhibit Otsu 20), under the heading, "Yakiniku Champion Sauce for barbecued meat 240 g" (first page), there is a photograph of a container with vertically-long and diamond-shaped, three-dimensional shapes placed in a row on the lid part and lower part, and a label indicating the product name and the like in a noticeable manner placed in the middle part in between.

Given the above, it is acknowledged that attachment of vertically-long diamond shapes placed in a row on the upper or lower part of a packaging container for sauce for barbecued meat is commonly adopted and used in transactions. Furthermore, given the circumstances such as that in each of the above cases, it is found that a label indicating the product name and the like in a noticeable manner is placed, either on top of or underneath the vertically-long diamond shapes placed in a row on the surface of the packaging container, it is presumed that these diamond shapes are also adopted from the perspective of functionality or aesthetics.

C. Plaintiff's explanation about the shapes constituting the Applied Trademark

It is acknowledged that Plaintiff explains as follows concerning the shapes constituting the Applied Trademark.

[i] On Plaintiff's website (Exhibit Otsu 21), under the heading, "Ebara's essence Story behind the creation of 'Golden Taste'" (first page), under the subject, "Origin of the name, 'Golden Taste', and the container with diamond-shaped cuttings" (first page), there are the words, "The diamond-shaped cuttings that are characteristic of the container for 'Golden Taste'

were adopted as emphasis was placed on the design which was influenced by the factors of 'high-class look' and 'more attractive appearance' that are found in perfumes and brandy bottles, as well as on the excellent resistance to shock and durability of a glass bottle with diamond-shaped cuttings" (second page).

[ii] In The Japan Food Journal (June 16, 2017 issue) (Exhibit Otsu 22), under the heading, "Special Feature on Sauces for Barbecued Meat: Trend among manufacturers = Ebara Foods Industry, Inc. Flagship 'Golden Taste' Large-scale renewal", there are the words, "This year, the 'Golden Taste' series will undergo renewal on a large scale for the first time since its first sale in 1978" (line 9 in the main text) and "The newly developed PET bottle replicates the diamond-shaped cuttings which are used on the current glass bottles. The new bottle has the convenience of being light and easy to carry, the functionality of being resistant to shock and having excellent durability, and the design that looks good in a store as well as on a table." (lines 21 to 23) Since the aforementioned article in "The Japan Food Journal" contains details about Plaintiff's products, it is presumed to be based on interviews conducted with Plaintiff, and it is acknowledged that the content of the article is based on Plaintiff's explanations.

Given the above, it is acknowledged that the explanation as to the shapes that constitute the Applied Trademark contributing to the packaging containers in terms of functionality or aesthetics was provided personally by Plaintiff, and was reported in newspapers accordingly.

D. Purport of adopting and using the shapes

By comprehensively taking the above into consideration, it is acknowledged that the vertically-long and diamond-shaped, three-dimensional shapes that are placed in a row on the surface of a packaging container constitute one of the three-dimensional decorations that are commonly adopted and used for packaging containers of liquid products, and from among such items, sauces for barbecued meat, for the purpose of contributing to the functionality or aesthetics of the product, and that the position is generally on the upper or lower part of a packaging container. Furthermore, in the actual examples of use, it is found that in each of the cases, a label indicating the product name and the like in a noticeable manner is placed, either on top of or underneath the three-dimensional shapes, and it is acknowledged that customers are able to easily recognize

the product name and the like by such label.

(3) Applicability of Article 3, paragraph (1), item (iii)

The Applied Trademark is a position trademark which specifies the place to affix the mark, and consists of three-dimensional shapes placed on a container of a product, in a position from slightly above the middle of the body part of the container to the neck part. Said three-dimensional shapes consist of vertically-long diamond shapes that are placed in a row along the periphery of the container, and each diamond shape sinks in towards the center. As described above in (2) D, the vertically-long and diamond-shaped, three-dimensional shapes placed in a row on the surface of a packaging container constitute one of the three-dimensional decorations that are commonly adopted and used in transactions, for packaging containers for sauces for barbecued meat, for the purpose of contributing to the functionality or aesthetics of the product, and the position is generally on the upper or lower part of a packaging container. Furthermore, given that it cannot be said that there is a particularly innovative feature with regard to the shape, it is acknowledged that the three-dimensional shapes constituting the Applied Trademark, and the position to which they are attached are such that they are within a predictable scope, by customers and traders, of having been adopted for reasons of functionality or aesthetics of a product. In the figure of the Applied Trademark, the parts drawn in dashed lines represent one example of a container of a product, and are not constituent parts of the Applied Trademark, and while the attachment of a label indicating the product name and the like to a place underneath the three-dimensional shapes is not included in the constitution per se of the Applied Trademark, given that the Applied Trademark is placed on a container, in a position from slightly above the middle of the body part of the container to the neck part, and that the designated goods are sauces for barbecued meat, attachment of a label indicating the product name and the like underneath is easily predictable. As such, by also taking this perspective into consideration, it is acknowledged that the three-dimensional shapes constituting the Applied Trademark are recognized by customers and traders as having been adopted and used as ones that contribute to functionality or aesthetics instead of identifying the source.

In that case, the three-dimensional shapes constituting the Applied Trademark are within a scope where it is predictable that a product of the same type would adopt the same for reasons of functionality or aesthetics of the

product, and there are no special circumstances for sufficiently acknowledging that the shapes are beyond such scope. Accordingly, it is acknowledged that the Applied Trademark is a trademark consisting solely of a mark indicating, in a common manner, the shape of a package of a product, and thus falls under Article 3, paragraph (1), item (iii).

(4) Consideration of the assertions made by Plaintiff

Plaintiff asserts that if a shape or pattern of a container of a product, or a shape or pattern attached to a specific place is not one that is widely used in general, but is instead unique in its constituent elements, a function of identification should be acknowledged, and that the position and shape of the Applied Trademark are not of a shape that is adopted by anyone but instead, have a function as an indicator of identification (as described above in No. 3, 1).

However, even if there are no containers, other than the one manufactured by Plaintiff, that bear the pattern of the exact same position and shape as the Applied Trademark, it cannot be acknowledged, immediately as a result, that the Applied Trademark has distinctiveness. As described above in (1), in light of the purport of Article 3, paragraph (1), item (iii), it should be said that the shape of a product or the like falls under the same item unless there are special circumstances, such as that a product of the same type has a shape that is beyond the predictable scope of adoption for reasons of functionality or aesthetics, and it cannot be said that there are aforementioned special circumstances simply based on the fact that there is no other container bearing the pattern of the exact same position and shape. As such, the above assertion by Plaintiff cannot be accepted.

Plaintiff makes assertions at great length on the applicability of Article 3, paragraph (1), item (iii), but none of these assertions can be accepted.

(5) Summary

Accordingly, there is no error with the JPO Decision which held that the Applied Trademark falls under Article 3, paragraph (1), item (iii).

2. Erroneous determination as to fulfillment of the requirement stipulated in Article 3, paragraph (2)

(1) Framework for judgment

Whether or not it can be said that a position trademark consisting of three-dimensional shapes has acquired distinctiveness through its use should be determined by comprehensively taking into consideration circumstances such

as the following; namely, the shape of the trademark, the period and area of use of the trademark, the sales volume of the product bearing the trademark, the period and scale of advertisement of the trademark, and whether or not there are other products having a shape that is similar to the shape of the trademark.

(2) Use of the Applied Trademark

A. Modes of use

The three-dimensional shapes constituting the Applied Trademark are used for Plaintiff's products called "エバラ焼肉のたれ 黄金の味", in the ones, from among the foregoing, that are sold in sizes of 210 g (from the time of first sale until 2015), 400 g (from 1979 until July 2017), and 360 g and 480 g (since July 2017) (as described below in B (B); hereinafter, these products in which the three-dimensional shapes constituting the Applied Trademark are used are collectively referred to as "Products Bearing Applied Trademark"). The Products Bearing Applied Trademark bear the three-dimensional shapes which constitute the Applied Trademark and which consist of vertically-long diamond shapes that are placed in a row along the periphery of the container, with each diamond shape sinking in towards the center, placed on the container, in a position from slightly above the middle of the body part of the container to the neck part, and a label is attached thereon immediately underneath the three-dimensional shapes, in a position from around the middle of the body part to the lower part, and the front side of the label indicates the mark, "エバラ", which is Plaintiff's house mark, and the mark of "黄金の味", which is the product name, and letters and the like indicating the content of the product like "Sauce for barbecued meat", "Sweet", "Medium Spicy", or "Spicy". From among the foregoing, the mark of "黄金の味" [meaning "golden taste" in English] is written in gold or yellow color using a large font (Exhibits Ko 1 [page 78], Ko 3 to Ko 6, Ko 9-1 to Ko 9-4, Ko 11, Ko 20, Ko 29).

B. Period of use, etc.

(A) Manufacture and sale of products called "エバラ焼肉のたれ 黄金の味"

Plaintiff was established in May 1958 and began manufacturing and selling sauces and ketchup around that time, and has sold sauces for barbecued meat since the fourth decade of the Showa Period (1965 to 1974). In June 1978, Plaintiff began selling

nationwide products called "エバラ焼肉のたれ 黄金の味" (Sweet, Medium Spicy, 210 g), and in October of the same year, began selling the Spicy flavor of the product line. These products used the Applied Trademark (Exhibits Ko 1, Ko 2, Ko 4, Ko 29).

Later, the products called "エバラ焼肉のたれ 黄金の味" (Sweet, Medium Spicy, and Spicy) underwent additions and changes in size, adding the size of 400 g in 1979 (Exhibits Ko 3, Ko 5), the size of 590 g in 1987 (Exhibit Ko 3), the size of 920 g in 1994 (Exhibit Ko 3), and the size of 150 g in 2008 (Exhibit Ko 9-2 (seventh page)), and ending the sale of the size of 400 g in July 2017 and changing the same to the sizes of 360 g and 480 g (Exhibit Otsu 23), and adding the size of 40 ml in 2017 (Exhibit Otsu 24). In addition, since 2003, sizes for professional use (1 l, 1,550 g, 4.8 kg) began to be sold (Exhibits Ko 9-1 to Ko 9-4). In the meantime, the design of the packaging container for the glass bottle underwent changes in 1997 (Exhibit Ko 3), 2011 (Exhibits Ko 3, Ko 9-3), and in July 2017. From among the foregoing, the change in July 2017 involved change in the material used for the container, from glass to PET (Exhibits Otsu 22, Otsu 23). Throughout the above changes and additions, the three-dimensional shapes constituting the Applied Trademark were placed consistently on the packaging containers (Exhibits Ko 1, Ko 3, Ko 5, Ko 6, Ko 9-1 to Ko 9-4, Ko 29, Exhibits Otsu 22, Otsu 23). Today, products called "エバラ焼肉のたれ 黄金の味" are sold in various packaging containers, including ones on which the Applied Trademark is used (Exhibit Ko 9-4, Exhibits Otsu 23, Otsu 24).

(B) Packaging containers

From among the products called "エバラ焼肉のたれ 黄金の味", the Products Bearing Applied Trademark were sold in the size of 210 g, which was sold from the time of first sale until 2015 (Exhibits Ko 3, Ko 4, Ko 6), and in the size of 400 g, which was added in 1979 and sold until July 2017 (Exhibits Ko 3, Ko 5, Ko 6), and in the sizes of 360 g and 480 g, which have been sold since July 2017 (Exhibit Otsu 23). On the other hand, from among the products called "エバラ焼肉のたれ 黄金の味", the one in a "petite" size (42 g × 3 portions) is packaged in a rectangular pack containing small-sized portions (Exhibit Otsu 24). The one in a party size (590 g) and the one in the size of 920 g are

contained in PET bottles, having no three-dimensional decorations on the surface. While the container of the one for professional use in the size of 1 l is also a PET bottle, a three-dimensional shape of a horizontal line is attached to the upper half of the bottle. The container of the one for professional use in the size of 1,550 g is a bottle-shaped plastic container with a handle formed thereon, and the surface has no decorations. The container of the one in the size of 4.8 kg has the shape of a rectangular parallelepiped, with a string-like handle attached thereto on the upper part (Exhibits Ko 9-1 to Ko 9-4).

C. Sales performance

The sales by Plaintiff exceeded 10,000,000,000 yen in March 1979, 20,000,000,000 yen in March 1984, 30,000,000,000 yen in March 1990, 50,708,000,000 yen in fiscal 2015, from among which the sales from the food business amounted to 44,569,000,000 yen, of which the sales from seasonings for meat, including products called "エバラ焼肉のたれ" and "エバラ焼肉のたれ 黄金の味", amounted to 17,103,000,000 yen, respectively (Exhibits Ko 1, Ko 3, Ko 12, Ko 29).

Furthermore, in the product category of Sauces for Barbecued Meat, which includes the products called "エバラ焼肉のたれ" and "エバラ焼肉のたれ 黄金の味" that are manufactured and sold by Plaintiff, Plaintiff held the market share of 54.2 % between April 2013 and March 2014 (Exhibit Ko 11).

Furthermore, while Products Bearing Applied Trademark have been sold nationwide since the start of sale (Exhibits Ko 1, Ko 2, Ko 4, Ko 5, Ko 20, Ko 21-1 to Ko 21-5, Ko 29), the sales performance between 1998 and 2015, which was approximately 5,530,000,000 yen in 1998 for the one in the size of 210 g, gradually decreased thereafter to approximately 2,000,000,000 yen in 2015, whereas in the case of the one in the size of 400 g, the sales performance, which was approximately 7,140,000,000 yen in 1998, gradually increased thereafter to approximately 9,480,000,000 yen in 2015 (Exhibit Ko 14).

Then in fiscal 2015, the value of shipments of Products Bearing Applied Trademark comprised 24% of the value of all shipments by Plaintiff (a total of 4.2% for the size of 210 g and 19.8% for the size of 400 g; Exhibit Ko 13), and comprised 36.2% (a total of 9.7% for the size of 210 g and 26.5% for the size of 400 g; Exhibit Ko 13) in the comparison of

amounts in "Group of sauces for barbecued meat" in the SRI data collected by Intage Inc. (Point-of-sale data collected from the Nationwide Retail Store Panel Survey conducted by Intage Inc.), and the shipment volume of the products called "エバラ焼肉のたれ 黄金の味" for the same fiscal year was approximately 40,000,000 bottles, comprising approximately 40% of the share in the market for sauces for barbecued meat (Exhibit Otsu 23).

D. Achievements in advertisement

(A) TV commercials

Since the time of starting the sale of Products Bearing Applied Trademark (June 1978), Plaintiff has created TV commercials for the products by using entertainers and the like and broadcasted them nationwide (Exhibits Ko 1, Ko 4, Ko 5, Ko 16 to 18, Ko 29, Ko 30, Ko 34-1, Ko 34-2, Ko 35, Ko 36). From among these TV commercials, in the ones whose overall content is clear (commercials for "エバラ焼肉のたれ 黄金の味" according to Exhibit Ko 16, and commercials advertising "エバラ焼肉のたれ 黄金の味" along with other products; Exhibit Ko 34-1), the image of the outer appearance of the Product Bearing Applied Trademark when seen from the front was shown on the screen at the end of a commercial, but the time during which the three-dimensional shapes that constitute the Applied Trademark on the surface of the container of the product were shown, so as to be visually recognized, was short, and furthermore, during the most of the time of the shapes being shown, telops such as "エバラ黄金の味" and "エバラ焼肉のたれ 黄金の味" were also shown, accompanied simultaneously by sound.

(B) Radio commercials

Plaintiff advertised Products Bearing Applied Trademark on radio (Exhibit Ko 35, (71st and 72nd pages)).

(C) Pamphlets and leaflets

- a. Prior to the sale, in June 1978, of "エバラ焼肉のたれ 黄金の味" (Sweet, Medium Spicy, 210 g), which is a Product Bearing Applied Trademark, Plaintiff created a pamphlet (Exhibit Ko 4) with the heading, "Full of fruits / Ebara Sauce for Barbecued Meat Golden Taste / [Now on sale!!]", notifying distributors of information such as the product's features and specifications, and the outline of promotional activities. In addition, prior to the

additional sale, in 1979, of "エバラ焼肉のたれ 黄金の味" (Sweet, Medium Spicy, 400 g), Plaintiff created and distributed a pamphlet (Exhibit Ko 5) with the heading, "Good taste new on sale in a large size!! / Ebara Sauce for Barbecued Meat Golden Taste Large size", notifying distributors of information such as the product's features and specifications, and the outline of promotional activities. Both of these pamphlets showed on the cover the photograph of the outer appearance of the Product Bearing Applied Trademark when seen from the front.

- b. In November 2000, Plaintiff created and distributed 23,000 copies of leaflets (Exhibit Ko 6) pertaining to the Product Bearing Applied Trademark, with the heading, "We always use the Golden Taste after all! / Ebara Golden Taste". On the front of the leaflet were the words indicating how the product was changed, "Further pursuit of goldenness!! Even better taste achieved by the balance between refreshing sweetness and richness" and "Shining golden label! With the shining new label, improved level of appeal to customers Exceptionally eye-catching effect", along with a photograph of the outer appearance of the Product Bearing Applied Trademark when seen from the front. On the back of this leaflet were information about how the product was changed, such as about the adoption of ecological resin hinge caps, as well as cooking examples (photographs) using the Product Bearing Applied Trademark and information about product standards, along with a photograph of the Product Bearing Applied Trademark in a column for product standards.

(D)Product information

Plaintiff created and distributed pamphlets, which contain product information, in the number of 7,000 copies in July 2003 (Exhibit Ko 9-1), 5,000 copies in July 2008 (Exhibit Ko 9-2), 12,000 copies in July 2011 (Exhibit Ko 9-3), and 10,100 copies in December 2015 (Exhibit Ko 9-4), respectively. Such product information was to provide distributors and the like with information such as the outline, standards, and the outer appearance of the product when seen from the front, for each of the various products that are manufactured and sold by Plaintiff for household use and for professional use, and for each case, the

Product Bearing Applied Trademark was categorized by items such as taste and volume, with a photograph of the outer appearance of the product from the front being shown.

(E) Various collaborations

- a. From February 3, 2009 until the end of May of the same year, Plaintiff collaborated with Morinaga & Co., Ltd. in the nationwide sale of a new flavor, "Barbecued Meat", for a product called "Ottotto", which is a snack sold by the company, and a photograph showing the outer appearance of the Product Bearing Applied Trademark when seen from the front was shown on the packing bag (Exhibits Ko 38, Ko 39).
- b. Plaintiff collaborated with Sanyo Foods Co., Ltd. in the sale of a product called "Sapporo Ichiban Yakisoba flavored with sauce for barbecued meat" as a cup yakisoba manufactured by the company, and the product was sold on May 24, 2010, and the package indicated a photograph of the outer appearance of the Product Bearing Applied Trademark (Medium Spicy) when seen from the front (Exhibits Ko 42, Ko 43).
- c. Plaintiff collaborated with Japan Frito-lay Ltd. in the sale of a collaboration product, as a type of a product called "Chee-tos", which is a snack sold by the company, from September 2011 until June 2012, and 18,000 cases (12 packages / case) of the collaborated product were sold, with the packing bag showing a photograph of the outer appearance of the Product Bearing Applied Trademark (Medium Spicy) when seen from the front, along with a label part (Exhibits Ko 40, Ko 55).
- d. Plaintiff collaborated with Natori Co., Ltd. in the sale of a product called "Beef jerky flavored with sauce for barbecued meat", as the company's beef jerky product, from June 4, 2018 until October 31 of the same year, and 170,000 packages of the collaborated product were sold nationwide, with the packaging bag showing a photograph of the outer appearance of the Product Bearing Applied Trademark (Medium Spicy) when seen from the front (Exhibits Ko 41, Ko 55).

(F) Supervising, etc. of a mook

When Gakken Publishing Co., Ltd. published a mook (book-like magazine) titled "Gakken Hit Mook / Ebara Sauce for Barbecued Meat

Golden Taste Recipes for using up the sauce" on March 27, 2013, Plaintiff was involved in coming up with recipe ideas and supervised the content of the mook. The mook mostly contains recipes for various dishes using products called "エバラ焼肉のたれ 黄金の味", and describes how the product, 35 years after its creation in 1978, became a long-selling product, shipping 37,000,000 bottles annually (record dated 2011), and how the product comes in three flavors (Sweet, Medium Spicy, Spicy) and three sizes (210 g, 400 g, 590 g), and other features of the product, along with a photograph of the outer appearance of the Product Bearing Applied Trademark when seen from the front (Exhibit Ko 20).

E. Survey by questionnaire

In order to understand the degree to which the customers, who are presented with a colorless container of the Product Bearing Applied Trademark (one without any flat mark such as letters being placed thereon, and one that is empty), would recall "エバラ焼肉のたれ 黄金の味", which is the Product Bearing Applied Trademark, Plaintiff asked a research company called Marketing Applications Inc. to conduct the questionnaire of the present case under the title, "Search on recall of '黄金の味' bottle design". The survey targeted "persons aged between 20 years old and 69 years old, either male or female, living anywhere in Japan, who personally purchase at least one product of commercially available seasoning for barbecued meat per year", and the number of samples was 1,000 persons. A written report on the survey result (dated June 20, 2017) showed the following (Exhibit Ko 24).

- (A) As a prompt for "unaided recall", photographs showing containers of four types of products (ones bearing no flat marks such as letters, and ones that are empty, but ones specifying the shape of the whole container (outline) as well as the shape and color of the cap part), including the Product Bearing Applied Trademark, were shown to the respondents, who were asked to answer the product name of each of the seasonings for barbecued meat which came to mind. For the container of the Product Bearing Applied Trademark, 28% responded "Golden Taste / Golden Sauce / Golden", and 36% responded "Ebara / Ebara Sauce for Barbecued Meat".
- (B) As a prompt for "aided recall", respondents were presented with the

choices of "Ebara Golden Taste", "Moranbong Jan", "Kikkoman My house is a barbecued meat restaurant", and "Jojoen Sauce for Barbecued Meat", and "Don't know", and were asked to answer the product name which they think is applicable for each of the photographs showing the four types of containers described above in (A). For the photograph showing the Product Bearing Applied Trademark, 66% chose "Ebara Golden Taste".

- (C) As a prompt for determining "misperception / intention behind sale", respondents were asked, "If a seasoning for barbecued meat that is not 'エバラ黄金の味' is sold using this bottle design, are you likely to mistake it for 'エバラ黄金の味'?", and 14% answered "Yes", 19% answered "Probably", 36% responded "Neither", 21% responded "Probably not", and 11% "No".

Next, to the question of "Then, what do you think about this bottle design being used for a seasoning for barbecued meat that is not 'エバラ黄金の味'?", 9% responded "I don't want it to be sold", 21% responded "I prefer that it not be sold", and 70% responded "I don't care".

The respondents who answered "I don't want it to be sold" or "I prefer it not being sold" stated reasons such as "The image of this bottle being the one for 'エバラ黄金の味' is so strong", "I may purchase it by mistake if I hold it by hand without really paying attention", and "Because the part consisting of crystal shapes is the trademark for "黄金の味".

(3) Whether or not there is a function of identification

- A. Generally speaking, a glass bottle, PET bottle, or other such container, which is a packaging container for edible or drinkable liquid, bears a label, and the label shows information such as a mark and letters indicating the product name, manufacturer, and distributor, and letters or the like describing the product. Often, the mark or letters indicating the product name, manufacturer, and distributor are shown in a noticeable manner, and the fact that customers specify a product by a label or that they recognize the source of a product from a label is a notable fact. As such, it is acknowledged that customers pay attention to the label when they look at a glass bottle, PET bottle, or other such container, which is a packaging container for edible or drinkable liquid, and it is acknowledged that the

description on a label gives a strong impression to customers. Given the above, upon considering the Products Bearing Applied Trademark, the modes of the products are as described above in (2) A, according to which it is acknowledged that, in the Products Bearing Applied Trademark, the marks of "エバラ" and "黄金の味" indicated on the label give a strong impression to customers, and that customers would focus on the mark parts of "エバラ" and "黄金の味" on the label as an indicator for identifying the source. As shown above, considering that a mark or letters indicated on a label give a strong impression to customers, thereby serving the function of identifying the source, and that, to the contrary, the Applied Trademark consists of vertically-long and diamond-shaped, three-dimensional shapes that are placed in a row and that constitute one of the three-dimensional decorations that are commonly adopted and used in transactions involving packaging containers for sauces for barbecued meat as ones that contribute to the functionality or aesthetics of a packaging container for sauce for barbecued meat (as described above in 1 (2) D), and is placed in a position near the label (as described above in (2) A), thereby creating a state in which it is not easily recognized as an indicator showing the source other than the label which, conversely, gives a strong impression, it cannot be acknowledged that, in the Products Bearing Applied Trademark, the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source.

- B. (A) Since June 1978, Plaintiff has sold the Products Bearing Applied Trademark (as described above in (2) B (A)), and the sales performance for fiscal 2015 for the Products Bearing Applied Trademark was approximately 2,000,000,000 yen for the one in the size of 210 g, and approximately 9,480,000,000 yen for the one in the size of 400 g (as described above in (2) C), and the shipment volume of the products called "エバラ焼肉のたれ 黄金の味" for the same fiscal year was approximately 40,000,000 bottles, comprising approximately 40% of the share in the market for sauces for barbecued meat (as described above in (2) C). Incidentally, from among the products called "エバラ焼肉のたれ 黄金の味", there are also products whose packaging containers are different from that of the Products Bearing Applied Trademark (as described above in (2) B (B)). However, given that the Products Bearing Applied Trademark are not for professional use but for general consumers (as described above in (2) B

(B)), and have been advertised (as described above in (2) D), it is presumed that the Products Bearing Applied Trademark comprise most of the products called "エバラ焼き肉のたれ 黄金の味". As such, it is found that the three-dimensional shapes constituting the Applied Trademark have been used for approximately 40 years on Products Bearing Applied Trademark, and that the sales of Products Bearing Applied Trademarks have reached a considerable amount, and that the number of shipments has reached a considerable number, and that the share of the Products Bearing Applied Trademarks has comprised a considerable percentage among the products of the same type.

In addition, it is found that Products Bearing Applied Trademark have been advertised in TV commercials, radio commercials, pamphlets, leaflets, product information, various collaborations, and a mook (as described above in (2) D), and as a whole, the number of advertising materials has reached a considerable number.

As described above, the sales performance and achievements in advertisement of Products Bearing Applied Trademark have extended to a considerable level, and it is presumed that the product name of "エバラ焼き肉のたれ 黄金の味" and the fact that the manufacturer is "エバラ", or Plaintiff, have become known to consumers as a result.

(B) a. However, while it is presumed that Products Bearing Applied Trademark comprise a large part of the products called "エバラ焼き肉のたれ 黄金の味" (as described above in (A)), considering that, on the other hand, there are products whose packaging is different from that of the Products Bearing Applied Trademark (as described above in (2) B (B)), it cannot be said conclusively that even if products called "エバラ焼き肉のたれ 黄金の味" came to be widely known, they would always be associated with the Products Bearing Applied Trademark.

b. In addition, as described above in A, given the modes of the Products Bearing Applied Trademark, in the Product Bearing Applied Trademark, it is the label that performs a function of distinguishing the product from other products, and it cannot be acknowledged that the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source, so that even if the sales performance of Products Bearing Applied Trademark has reached a considerable level, it cannot be acknowledged, as a result, that the three-dimensional shapes

constituting the Applied Trademark are recognized as an indicator for identifying the source.

Furthermore, concerning the advertisement that was actually carried out, it is found that in TV commercials, the time during which the three-dimensional shapes constituting the Applied Trademark and placed on the surface of the container of the Product Bearing Applied Trademark appeared on the screen, so as to be visually recognizable, was short (as described above in (2) D (A)), so that it cannot be acknowledged that TV commercials caused the three-dimensional shapes, which constitute the Applied Trademark, to give an impression to customers, and considering that the Applied Trademark is a position trademark consisting of three-dimensional shapes placed on the surface of a container of a product, it is found that it was difficult for listeners of radio commercials to recognize the three-dimensional shapes constituting the Applied Trademark. Next, although TV commercials showed on the screen the outer appearance of a Product Bearing Applied Trademark when seen from the front (as described above in (2) D (A)), and pamphlets, leaflets (as described above in (2) D (C)), product information (as described above in (2) D (D)), products born out of various collaborations (as described above in (2) D (E)), and a book (as described above in (2) D (F)) showed photographs of the outer appearance of a Product Bearing Applied Trademark when seen from the front, it cannot be acknowledged, as described above in A, that in the Products Bearing Applied Trademark, the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source. Furthermore, it cannot be acknowledged that, in the above advertisement, there were announcements or indications intended to cause the three-dimensional shapes per se to give a strong impression as an indicator for showing the source of the product, or as an indicator for distinguishing the product from other products, for example, by referring to the three-dimensional shapes constituting the Applied Trademark as a feature of the product or its container, so that even if the outer appearance of a Product Bearing Applied Trademark when seen from the front is shown on the screen in the above advertisement, and a photograph of the outer appearance when seen from the front is shown, it cannot be acknowledged that the three-dimensional shapes constituting the Applied Trademark came to be recognized as an indicator for identifying the source

as a result.

Incidentally, between April 2010 and March 2011, it is found that Plaintiff, through Kabushiki Kaisha Yokohama Agency, engaged in promotional activities for products called "エバラ焼き肉のたれ 黄金の味", including provision of "recipes on mobile app", submission of articles for newspapers and magazines and the like, creation of TV commercials, and creation of advertising materials for stores and events (Exhibits Ko 19, Ko 35, Ko 36). However, as for TV commercials, matters are as described above, and the specific content of other promotional activities is unclear, so that it cannot be acknowledged that the three-dimensional shapes constituting the Applied Trademark came to be recognized as an indicator for identifying the source as a result.

(C) According to the questionnaire of the present case, when respondents were presented with photographs showing containers of four types of products, including the Product Bearing Applied Trademark, followed by a question (unaided recall) asking for the respective product names of the seasonings for barbecued meat which came to mind, 28% responded "Golden Taste / Golden Sauce / Golden", and 36% responded "Ebara / Ebara Sauce for Barbecued Meat" concerning the container of the Product Bearing Applied Trademark. When respondents were presented with a plural number of choices of specific product names, followed by a question (aided recall) asking for the applicable product name for each of the photographs of containers of four types of products, 66% chose "Ebara Golden Taste" for the photograph showing the container of the Product Bearing Applied Trademark. Next, concerning the method used in the questionnaire, the questionnaire of the present case adopts the method of comparing the whole containers of other products with the whole container of the Product Bearing Applied Trademark. Since the Applied Trademark consists of three-dimensional shapes that are placed on a part of a container of a product, it is difficult to compare only said part with other products, so that, concerning the method of comparing the whole containers of other products with the whole container of the Product Bearing Applied Trademark in order to confirm whether or not such three-dimensional shapes have distinctiveness, as with the case of the questionnaire of the present case, it cannot be said conclusively that such method per se is unconditionally inappropriate.

However, upon comparing the whole containers, as described above, it is necessary to take into consideration how the shape of the whole container, and the impression given by parts other than the three-dimensional shapes constituting the Applied Trademark contribute to the distinction. In questions of the questionnaire of the present case, containers of four types of products, including the container of the Product Bearing Applied Trademark, were presented ([i] to [iv]; Exhibit Ko 24 [from paged 4 to 6]), from among which two types ([ii], [iii]) are short in height, with a diameter that is large compared to the height, giving a thickish impression overall, whereas the other two types ([i], [iv]), including the Product Bearing Applied Trademark, are tall in height compared to the diameter, giving a slim impression. As such, the approximate shapes of the whole containers give different impressions. Furthermore, from among the ones that are tall in height ([i], [iv]), in the one that is different from the Product Bearing Applied Trademark ([iv]), the diameter of the cap is the same as the diameter of the upper half of the container, so that the whole container, including the cap, has the constitution that gets thicker in the lower half and slimmer in the upper half, and the whole container, including the cap, gives an impression of a unified and simplified shaping. To the contrary, the Product Bearing Applied Trademark ([i]) is such that, in the main body of the container, the upper half has a smaller diameter than the lower half, and on the top, there is a cap whose diameter is smaller than that of the main body, and the shape of the cap has the constitution from which the cap can be distinguished separately from the main body, so that the container, as a whole, gives a functional impression that takes into consideration the operability of the cap. As such, due to the shape of the whole container, the container of the Product Bearing Applied Trademark has features that are different from the containers of other products, which were used for comparison, thereby giving a different impression. Accordingly, in the questionnaire of the present case in which the whole containers were compared, even if there was a considerable number of respondents who answered that the container of the Product Bearing Applied Trademark is a product of Plaintiff, as well as those who answered that it is a product called "エバラ焼き肉のたれ 黄金の味", it is considerably likely that these persons identified the bottle based on the impression given by the whole container, and it cannot be

acknowledged that they identified the bottle based on the three-dimensional shapes constituting the Applied Trademark. Incidentally, in the questionnaire of the present case, in a photograph of a container of the Product Bearing Applied Trademark, there is a red frame that surrounds a part that has the same shape as the three-dimensional shapes constituting the Applied Trademark (Exhibit Ko 24 [pages 4 and 5]), but since the photograph shows the whole container, it cannot be acknowledged, based on the fact that a red frame is shown, that the bottle was identified based on the part that is the same as the three-dimensional shapes constituting the Applied Trademark.

Furthermore, in regards to the container that is tall in height ([iv]) and that is different from the Product Bearing Applied Trademark, as shown in the questionnaire of the present case, it is found that no three-dimensional shapes are placed on the surface of the container (Exhibit Ko 24 [pages 4 and 6]). However, given the existence of packaging containers for sauces for barbecued meat that are decorated with three-dimensional shapes on the surface (as described above in 1 (2) B (A)), and the existence of three-dimensional diamond shapes that are placed in a row and that constitute a type of three-dimensional decorations to be placed on the surface of packaging containers for sauces for barbecued meat (as described above in 1 (2) B (B)), and furthermore, that it is found that all of these containers are tall in height compared to their diameters according to the evidence described above in 1 (2) B (A) and in 1 (2) B (B) (Exhibits Otsu 9 to Otsu 13, Otsu 15 to Otsu 20), in order to consider that the three-dimensional shapes constituting the Applied Trademark have distinctiveness, it is necessary to provide evidence to support the assertion that the three-dimensional shapes constituting the Applied Trademark have distinctiveness, by also taking into consideration how they relate to the containers that are tall in height, like the container of the Product Bearing Applied Trademark, and that are decorated with three-dimensional shapes on the surface of a packaging container, or that use the three-dimensional diamond shapes that are placed in a row and that constitute a type of three-dimensional decorations to be placed on the surface of a packaging container. However, in the questionnaire of the present case, no container that is tall in height, like the container of the Product Bearing Applied Trademark, and that is decorated with three-dimensional shapes on the

surface of a packaging container, or that uses three-dimensional diamond shapes that are placed in a row and that constitute a type of the three-dimensional decorations to be placed on the surface of a packaging container is presented for comparison with the container of the Product Bearing Applied Trademark, so that no evidence is provided to support that the three-dimensional shapes constituting the Applied Trademark has distinctiveness in terms of how they relate to such container.

In that case, from the perspective of providing evidence in support of whether or not the Applied Trademark has distinctiveness, it is acknowledged that the questionnaire of the present case cannot be considered reasonable for making a selection between the container of the Product Bearing Applied Trademark and the containers that were used for comparison, and it cannot be acknowledged that the result of the questionnaire of the present case provides any evidence to support that the three-dimensional shapes constituting the Applied Trademark have a function of identification, so that the result of the questionnaire cannot be weighed heavily upon determining whether or not the three-dimensional shapes serve a function of identification.

- C. Based on the consideration above in A and B, although the three-dimensional shapes constituting the Applied Trademark have been used in Products Bearing Applied Trademark, and a considerable number of Products Bearing Applied Trademark have been sold and advertised, it cannot be acknowledged that the Applied Trademark has acquired distinctiveness through use, and thus does not fall under a trademark which, through its use, can be recognized by customers as goods pertaining to the business of Plaintiff, so that it cannot be acknowledged that the Applied Trademark fulfills the requirement stipulated in Article 3, paragraph (2).

(4) Consideration of the assertions made by Plaintiff

A. Use of the Applied Trademark

Plaintiff asserts that, due to the nature of the designated goods for the Applied Trademark, which are sauces for barbecued meat, customers look at the container per se upon purchasing or using the product, and actually touch the container repeatedly, so that even if the Applied Trademark is not mentioned as a particular feature in advertisement and the like, customers come to unconsciously and naturally identify, through these daily activities, the source of the product based on the three-dimensional shapes

constituting the Applied Trademark (as described above in No. 3, 2 (1) A).

However, as described above in (3) A, it cannot be acknowledged, in the Product Bearing Applied Trademark, that the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source, so that even by taking into consideration that the designated goods for the Applied Trademark are sauces for barbecued meat, and that, due to the nature of the product, customers look at the container per se upon purchasing or using the product, and actually touch the container repeatedly, it cannot be acknowledged that customers would identify the source of the product based on the three-dimensional shapes constituting the Applied Trademark. Accordingly, the above assertion by Plaintiff cannot be adopted.

- B. Whether or not there is an act that causes a position trademark to give a strong impression as an indicator for identifying the source

Plaintiff asserts that even if a product that uses an applied trademark, which is a position trademark, indicates a mark other than the applied trademark, whether or not the applied trademark has acquired distinctiveness through use should be determined by considering whether or not the applied trademark part has become independent on its own and come to be recognized as an indicator for distinguishing the product from other products, and that it is not a requirement for the user to advertise the product in a manner that gives a particularly strong impression, and asserts that the JPO Decision and the explanation provided are erroneous in determining whether or not the Applied Trademark has acquired distinctiveness through use by requiring that Plaintiff advertise in a manner that particularly causes something which can be visually regarded as being the same as the three-dimensional shapes constituting the Applied Trademark to give a particularly strong impression (as described above in No. 3, 2 (2)).

However, as described above in (3) A, in the Product Bearing Applied Trademark, it cannot be acknowledged that the three-dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source, so that although TV commercials showed on the screen, for a short time, the outer appearance of a Product Bearing Applied Trademark when seen from the front (as described above in (2) D (A)), and pamphlets, leaflets (as described above in (2) D (C)), product information

(as described above in (2) D (D)), products born out of various collaborations (as described above in (2) D (E)), and a mook (as described above in (2) D (F)) showed photographs of the outer appearance of a Product Bearing Applied Trademark when seen from the front, it cannot be acknowledged immediately that, as a result, the three-dimensional shapes constituting the Applied Trademark came to be recognized as an indicator for identifying the source. Accordingly, if, during the advertising, there was any indication or description or the like which causes the three-dimensional shapes per se, which constitute the Applied Trademark, to give a strong impression as an indicator showing the source of the product, or as an indicator that distinguishes the product from other products, there may be room to assess that the three-dimensional shapes constituting the Applied Trademark would be recognized, as a result, as an indicator for identifying the source, but since no such indication or description or the like can be found at all, it cannot be acknowledged that the three-dimensional shapes constituting the Applied Trademark came to be recognized as an indicator for identifying the source. The purport of the explanation and determination made in the JPO Decision is the same as the above, and it does not require a user to advertise in a manner that particularly causes the applied trademark part to give a strong impression as a general requirement for acquiring distinctiveness through use. Accordingly, the above assertion by Plaintiff cannot be accepted.

C. Survey by questionnaire

Plaintiff asserts that the explanation provided in the JPO Decision concerning the questionnaire of the present case is erroneous (as described above in No. 3, 2 (3)). However, matters concerning the questionnaire of the present case are as described above in (3) B (C), and, in the questionnaire of the present case in which the whole containers were compared, although there was a considerable number of respondents who answered that the container of the Product Bearing Applied Trademark is a product of Plaintiff, as well as those who answered that it is a product called "エバラ焼き肉のたれ 黄金の味", it is considerably likely that these persons identified the bottle based on the impression given by the whole container, and it cannot be acknowledged that they identified the bottle based on the three-dimensional shapes constituting the Applied Trademark. Furthermore, according to the questionnaire of the present

case, there is no evidence to support the assertion that the three-dimensional shapes constituting the Applied Trademark have distinctiveness, in terms of how they relate to the containers that are tall in height, like the container of the Product Bearing Applied Trademark, and that are decorated with three-dimensional shapes on the surface of the packaging container, or to the three-dimensional diamond shapes that are placed in a row and that constitute a type of three-dimensional decorations to be placed on the surface of a packaging container, so that it cannot be acknowledged that the results of the questionnaire of the present case provide any evidence to support the assertion that the three-dimensional shapes constituting the Applied Trademark have a function of identification. In that case, it cannot be acknowledged that the explanation provided in the JPO Decision concerning the questionnaire of the present case is erroneous, and thus the above assertion by Plaintiff cannot be accepted.

D. Display in stores

In regards to the JPO Decision which provided the explanation that when a customer selects a product, it is reasonable to consider that the customer would pay attention to what is indicated on a label of the product in order to, at least, confirm the source of the product, and that something which can be visually regarded as being the same as the three-dimensional shapes constituting the Applied Trademark does not function as an indicator for distinguishing the product from other products, Plaintiff asserts that the explanation provided in the decision is erroneous because the practice of using a plural number of marks on a single product is commonly conducted, and because it is normal, depending on how the product is displayed, for customers to recognize the shape of a container first as an indicator for identification (as described above in No. 3, 2 (4)).

However, it is acknowledged that customers pay attention to the label when looking at a glass bottle or PET bottle or the like, which is a packaging container for edible or drinkable liquid (as described above in (3) A), so that if a Product Bearing Applied Trademark is displayed at a store in a state which makes it difficult to see the label clearly or in which only the three-dimensional shapes constituting the Applied Trademark can be seen, it is presumed that customers would identify the product by confirming the label. Next, as described above in (3) A, in the Product Bearing Applied Trademark, it cannot be acknowledged that the three-

dimensional shapes constituting the Applied Trademark would be recognized as an indicator for identifying the source. Accordingly, there is no error with the explanation provided in the JPO Decision, and the above assertion by Plaintiff cannot be accepted.

E. Although Plaintiff makes assertions at great length on the fulfillment of the requirement stipulated in Article 3, paragraph (2), none of these assertions can be accepted.

(5) Summary

Accordingly, the JPO Decision which held that the Applied Trademark does not fulfill the requirement stipulated in Article 3, paragraph (2) is not erroneous.

3. Conclusion

Based on the above, the reasons for rescission as claimed by Plaintiff are groundless, and the JPO Decision does not contain any illegality due to which it should be rescinded.

Therefore, the Plaintiff's claim shall be dismissed, and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Third Division

Presiding judge:	TSURUOKA Toshihiko
Judge:	UEDA Takuya
Judge:	NAKADAIRA Ken