

Coca-Cola Case
Distinctiveness of a three-dimensional mark
Supreme Court
Case H19 (Gyo-Ke) No. 10215 (July 2, 2003)

A three-dimensional shape representative of the goods in question can acquire secondary meaning through extensive use and is thus registrable pursuant to Trademark Law Art. 3(2).

FACTS

The Coca-Cola Company, plaintiff, filed an application for registration of a three-dimensional (3D) mark representing the shape of a bottle for its cola beverage in Class 32. The Patent Office, defendant, refused distinctiveness of the mark on the grounds that a 3D mark is merely the configuration of the container for the product covered by the application based on Art.3(1)(iii) of the Trademark Law, and that the mark itself was not yet distinctive enough to acquire secondary meaning pursuant to Art.3(2) of the same law. The plaintiff brought an action before the Intellectual Property High Court, requesting that the Court cancel the Patent Office decision.

ISSUES

1. Whether the subject 3D mark representing the shape of the goods or its container is unregistrable based on Art.3(1)(iii).
2. Whether the subject three-dimensional mark representing the shape of the goods or its container has acquired distinctiveness based on Art.3(2).

DECISION

1. The 3D mark in question itself has no distinctiveness.
2. However, based on the facts proved by evidence, the three-dimensional shape of the plaintiff's mark has acquired distinctiveness through extensive use of the mark in Japan since 1957, even though the mark in question is used with other distinctive marks applied thereon. The grounds for the decisions include:
 - (a) continuous sales of the goods in the same shape for a long period of time;
 - (b) high sales volume of the goods;
 - (c) extensive advertisement;
 - (d) unchanged characteristic shapes available in the market;
 - (e) existence of word marks on the shapes does not diminish the distinctive function of the 3D mark.

The Court thus concluded that the subject mark is registrable according to Art.3(2) of the Trademark Law.

Tsu-tsu-mi-no-o-hi-na-kko-ya Case
Similarity of a compound word mark
Supreme Court
Case H19 (Gyo-Hi) No. 223 (September 9, 2008)

The registered trademark "つつみのおひなっこや [tsu-tsu-mi-no-o-hi-na-kko-ya] " which includes another trademark, is not considered similar to prior registered trademark "堤 [tsu-tsu-mi] ", which acquired distinctiveness through continuous use.

FACTS

1. The mark "つつみのおひなっこや, pronounced "tsu-tsu-mi-no-o-hi-na-kko-ya", was registered under Reg. No. 4,798,358 in October 2004, whereupon the owner of the trademark "堤", which is read "tsu-tsu-mi" (Reg. No. 2,365,147, December 1999), lodged an Invalidation Trial against the above-mentioned registration. Both marks designate dolls,
2. In the Patent Office, the Trial Examiner denied the possibility of confusion of the marks and the owner of the prior-registered mark lost the case. However, the Tokyo High Court found a possibility of confusion, noting that the pronunciation "tsu-tsu-mi" separately derives from the prior-registered trademark, and thus "tsu-tsu-mi-no-o-hi-na-kko-ya" is considered similar to "tsu-tsu-mi" in pronunciation.

In Japanese, "no" is equivalent to "of", and thus "tsu-tsu-mi-no-o-hi-na-kko-ya" is interpreted to mean "o-hi-na-kko-ya" of "tsu-tsu-mi". Japanese Old Class 28. In addition, there was a history that the prior-registered trademark, "堤"("tsu-tsu-mi)", had been judged by the JPO to be qualified for registration due to its distinctiveness acquired through continued use pursuant to Trademark Law Art.3(2).

ISSUE

Whether a compound word mark, that is, a trademark consisting of a combination of words one of which is a registered mark, is confusingly similar to that registered word mark that is one the words of the combination.

DECISION

The Supreme Court followed precedent and vacated the judgment of the IP High Court. The Supreme Court found that the marks in question are not considered similar, based on its finding that the "tsu-tsu-mi" part does not give a strong impression as an indication of the source of the goods and that the remaining part "no-o-hi-na-kko-ya" (once a common noun but now archaic) is distinctive, even though the word "tsu-tsu-mi" constitutes a part of the mark in question.

The point is this: In principle, the trademark as a whole shall be compared with

another. However, in a case in which (a) one part of the trademark gives a strong impression as an indication of the source of the goods or services AND (b) the remaining part is not distinctive, the parts can be separately compared.