

MAGLITE CASE

Tokyo High Court

Case H18 (Gyo-Ke) 10555, Judgment on June 27, 2007 (H19)

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FACTS

The plaintiff was an applicant having filed the trademark registration application No. 2001-3358 with a three-dimensional (3D) mark on January 19, 2001. The application was finally rejected under the Trademark Law, Article 3, Paragraph 1, Item 3, for consisting solely of a mark indicating a shape of goods in a common manner and for being not applicable to the provision of Article 3, Paragraph 2 (exception of Paragraph 1) by the board of appeal of the JPO on August 21, 2006. Then, the appeal was filed at the Intellectual Property Court (Tokyo High Court).

ISSUE

The issue was (1) whether the mark consists solely of a mark indicating a shape of goods in a common manner and (2) whether to apply Article 3, Paragraph 2, a provision of which stipulates exception of Paragraph 1 if the mark is recognizable with respect to the designated goods or services.

HOLDING

The shape of goods is generally to be selected for the purpose of having the goods perform more effectively an expected function thereof and showing the goods in a more attractive manner, but it is rare to utilize the shape as the mark with which a consumer can distinguish the goods from other goods. In a view of the consumer, it is rare for the consumer to recognize that the shape of goods is selected for the purpose of showing an origin or a producer of the goods.

With respect to the present trademark application, it is evaluated that the shape of the mark is within the scope of a necessary shape of a flash light for performing basic functions and an attractive appearance, such that the consumer seeing it for the first time would not recognize that the shape is a mark indicating the origin. Thus, it is held that Article 3, Paragraph 1, Item 3 should apply to the present mark (contention (1)).

The Trademark Law, Article 3, Paragraph 2 stipulates that the mark can be registered if it acquires discrimination power (i.e., capacity to be identified) as a result of use thereof such that consumers can recognize the goods or services as those pertaining to the business of a particular person (excluding the trademark consisting solely of a 3D structure indispensable to secure a function of goods or services).

Thus, it is concluded that Article 3, Paragraph 2 applies based on the following facts.

(a) The products of the goods with respect to the present trademark have kept the same shape as the mark of the present trademark application from 1984 in the United States and 1986 in Japan.

(b) In Japan, the annual sales were 508 million Japanese yen and the number of the products was 551,000 in 2001, and the number of retail stores reached about 2,700.

(c) Huge advertising expenditures have been spent for many advertisements in newspapers and magazines since 1985.

(d) The shape with regard to the products of the goods has been evaluated highly and received design awards in Germany and Japan.

(e) Advertisements to make strong impressions of the shape of the products on consumers are conducted.

(f) No products with a similar shape of the product of the goods are sold, as a result of legal actions such as injunction.

(g) Trademarks consisting of diagrams and letters are attached to the product of the goods, but they are not conspicuous.

Therefore, it is held that the mark has acquired the discrimination power (i.e., capacity to be identified) as a result of use thereof such that Article 3, Paragraph 2 should apply to the present trademark registration application (contention (2)). It is also held that the trial decision of refusal has an error, and is reversed.

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Original document (Japanese):

http://www.ip.courts.go.jp/app/files/hanrei_jp/855/034855_hanrei.pdf

English Translation:

N/A