

# **AIPLA Annual Meeting IP Practice in Japan Committee – Pre-meeting**

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**Washington DC**

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# **1 . Protection of 3D mark**

Introducing new I.P. High Court Decisions



# **2 . Designation in Class Heading**

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# **3 . Letter of Consent**

(Japanese Version)

# 1. Chocolate cake Case

Mark Applied for:



Class 30: Chocolate,

# **Case Overview**

**Case Number: 2007 (Gyo-ke) 10293 I.P. High Court**

**Decision Date: June 30, 2008**

**Plaintiff (Applicant): Chocolaterie Guylian N. V.**

**Defendant: Japan Patent Office**

**International Reg. No: 803104, Appeal No. 2004-65058**

## **Brief Summary**

**The subject three-dimensional trademark has an inherent distinctiveness and thus doesn't fall in Article 3, Para. 1, Item 3 of the TM Law.**

# Fact Summary of Final Rejection

In the final Decision of Rejection and Decision of Appeal, the mark was judged not registrable because the mark was a shape **ordinarily used** in the trade and had no distinctiveness. The applicant also **failed to establish acquired distinctiveness** through extensive use in the market.

## Issue

Former decisions, three-dimensional trademarks can only be registrable in case the mark establishes **acquired distinctiveness** by the extensive use in the market.

## I.P. High Court's Decision

Supreme Court decision made on April 10, 1979

- (1) a configuration potentially used by someone should **not be monopolized**,
- (2) a configuration commonly used has **lack of distinctiveness**,  
are mentioned.

In the Chocolate decision it is noted :

- (1) non monopolizing nature, the mark in question has been used **since 1958** and will be considered that there is **no need to stop monopolization** of the mark.
- (2) distinguishability, the configuration is a combination of chocolate bar and solid (sculpture) chocolate which has no novelty, but the shape is not commonly used, having **four vertical grooves** with **four different designs** on the top by which consumer can recognize and ***continue to buy the same product based on the configuration*** where the existence of distinctiveness cannot be denied.

## Our Comments

Since 1997 the protection of three-dimensional marks was strictly limited to the ones which could establish acquired distinctiveness.

The court judged the existence of ***inherent distinctiveness*** by evaluating the configuration itself and not going into Article 3, Para. 2, acquired distinctiveness.

## 2. Coca Cola (contour bottle)

Mark Applied for:



Class 32: Beer, Soft Drinks, Juice, etc.

# Case Overview

Case Number: 2007 (Gyo-ke) 10215 I.P. High Court

Decision Date: May 29, 2008

Plaintiff (Applicant): The Coca Cola Company

Defendant: Japan Patent Office

Appeal No. 2005-1651, Appln. No. 2003-55134

## Brief Summary

The subject three-dimensional trademark has acquired distinctiveness based on Article 3, Para. 2 of the Trademark Law and doesn't fall in Article 3, Para. 1, Item 3.

## Fact Summary of Final Rejection

In the final Decision of Rejection and Decision of Appeal, the mark was judged not registrable because the mark was the shape of a container ordinarily used in the trade and had no distinctiveness. The applicant also failed to establish acquired distinctiveness through extensive use in the market.

# Issue

The shape of the container has no distinctiveness and should not be monopolized but kept free to use someone who wants to use. Long term use, since 1957 in the Japanese market, can enjoy the acquired distinctiveness in the normal sense but not admitted as a 3D trademark.

## I.P. High Court's Decision

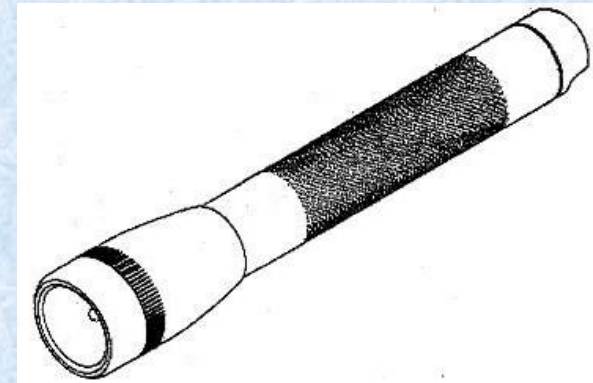
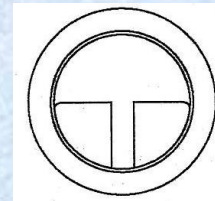
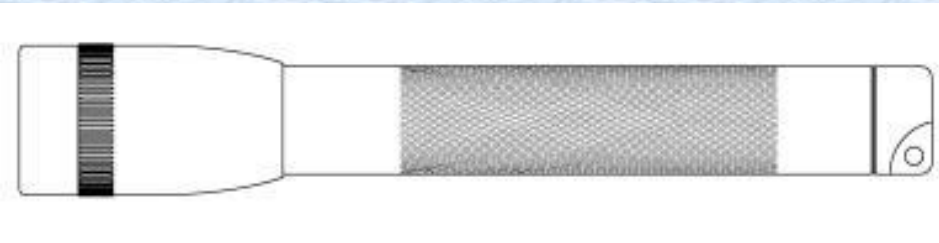
In the decision, **acquired distinctiveness** is admitted on the base of long term extensive use of the mark in the market.

## Our Comments

The configuration of the container of Coca Cola is so famous that protection must be given even to the shape of the container, but a long period was needed to obtain registration based on acquired distinctiveness.

# 3. MAG-LITE

Mark Applied for:



Class 11: Flashlights

# Case Overview

Case Number: 2006 (Gyo-ke) 10555 I.P. High Court

Decision Date: June 27, 2007

Plaintiff (Applicant): Mag Instrument, Inc.

Defendant: Japan Patent Office

Appeal No. 2003-2070, Appln. No. 2001-3358

## Brief Summary

### Issue

The products usually bear the trademark “MAG INSTRUMENT” “MINI MAGLITE” and there is no evidence showing actual sales of the products without such word marks, and thus, the applicant’s argument for acquired a secondary meaning is rejected.

## Fact Summary on Final Rejection

The mark is considered esthetic features normally employed for a flashlight. The applicant failed to establish acquired distinctiveness through use in the market.

## I.P. High Court’s Decision

In the decision, while sustaining the lack of inherent distinctiveness, **acquired distinctiveness** is admitted since the three-dimensional shape itself acquired secondary meaning apart from the word marks co-existing on the outer surface of the products. The products has been long sold in the Japanese market **since 1985** with the shape unchanged.

Designation by **Class Heading** is amended

( to Minimize Non-Use Registration )

As of **April 1st, 2007**, wide identification of goods/services need **proof of actual use** or filing statement of an **intention to use** and a **business plan**.

a) **Example of Proof of Use**

b) **Intent To Use** statement and a **Business Plan**

c) Amend to **seven(7) Similarity Groups**

**Guideline 41.100.03** (English version available as below) for Article 3 (Principal paragraph of Article 3, Para. 1) stated in 2. (2)(English Version) as justifiable doubt presumed,

“Where there is a doubt as to the use or intention of use of a trademark in regard to the designated goods/services, since the designation of goods/services ranges widely in one classification.”

The following rule is added in the Japanese version of the guideline, though English translation is not completely prepared, in which it is stated that **eight (8) or more similarity groups** (Ruijigun), the range is considered **too wide in one classification**, need proof of the intention to use the mark for all the listed goods/services.

Data: JPO ([www.jpo.go.jp/indexj.htm](http://www.jpo.go.jp/indexj.htm) English Version of Examination Guideline for Trademarks)

# Article 6 (1) and Article 3 (1)

It has often happened in the Preliminary Notice of Rejection for the application filed from foreign countries, in which the designated goods/services are not the wording commonly used in the Japanese practice, to receive rejection on the basis of Article 6 (1) and Article 3 (1) as a pair or combination. Article 6 (1) requesting the applicant to clarify the nature of the goods and Article 3 (1) requesting proof of use or proof of an intention to use with business plan.

# a) Example of Proof of Use

- i) Printed matter (newspapers, magazines, catalogs, leaflets, etc.)
- ii) Photographs of the exterior and interior of the store
- iii) Business documents (order forms, delivery statements, invoices, receipts, etc.)
- iv) Certificates issued by public organizations (government, local governments, foreign embassies in Japan, Chamber of Commerce and Industry)
- v) Certificate issued by others in the same trade, trade client, consumers, etc.
- vi) Articles on the internet
- vii) Documents stating the sales amount of goods in relation to retail services

b) Document specifying an **Intent To Use** and a **Business Plan** (preparation status)

The applicant will be requested to submit documents specifying his intention to use the trademark and stating his preparation status (business plan).

The applicant is required to show his intention of starting to use the trademark within three to four (3 ~ 4) years from the filing date and within three (3) years following the registration date.

The document specifying his **intention to use** must include the following description;

- (i) Intention to use the trademark applied for ;
- (ii) Manner of conducting the business (produce of sale);
- (iii) When he will start using the mark

**Business Plan** must include his preparation status, start of use, construction of factories or stores.

Examples affixed to the guideline but only Japanese.

## c) Limiting the goods/services to **Select 7 Similarity Groups** (Ruijigun)

Since the guideline regulated that designating an excess seven (7) similarity groups (Ruijigun) will make the range too wide in one classification, then limit it to seven (7) similarity groups so that ground of rejection can be avoided. The designated goods/services, in one class, **within seven (7) similarity groups** can avoid the need to submit any document concerning intent to use or business plan. Even after receipt of the preliminary notice of rejection, we can recommend the applicant to correct the wording and restrict the goods/services in appropriate seven (7) groups.

Proper scope of **Similarity Group** is found and published in 類似商品役務審査基準 and obtainable through Data: [www.jpo.go.jp/indexj.htm](http://www.jpo.go.jp/indexj.htm), though partially only in Japanese.

## Letter of Consent vs Written Explanation (Japanese)

A new guideline issued in 2007 providing for the evaluation of a “**Written Explanation**” executed by the owner of a cited registration, which is **not equal to a “Letter of Consent”** but is given some consideration in evaluating the intention of the owner of cited trademark.

Data obtainable ; [www.jpo.go.jp/indexj.htm](http://www.jpo.go.jp/indexj.htm) JPO (jpo.go.jp) (English) → TRADEMARKS → Examination Guideline for Trademarks → Examination Guideline for Trademarks → INDEX → Chapter III Article 4(1)(3) → Part 9. Article 4(1)(xi) → 3

Written Explanation is evaluated :

During examination, evidence submitted by the applicant will be taken into consideration as part of the overall evidence **material to the examination** and the Examiner will have full discretion as to the weight he will give to such evidence.

However the following cases will be excluded.

- i) Goods/services are identical or obviously similar
- ii) Where the submitted documents describe not an objective explanation or evidence of the actual status of transaction but an **approval** by the owner of the cited trademark concerning the registration of the trademark related to the application for trademark registration.

**In other words, a “Consent” will still not be accepted.**

Japanese Trial No. 2007-33362[POLA]

Thank you for your attention.

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