



**April 22, 2009**  
**JTA-AIPLA Meeting**

# A Lost Decade of 3D Trademark Registration in Japan

## - Coca-Cola Bottle 3D TM case -

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This presentation is my own perspective, not one of the entity/organization I belong to.

# Agenda

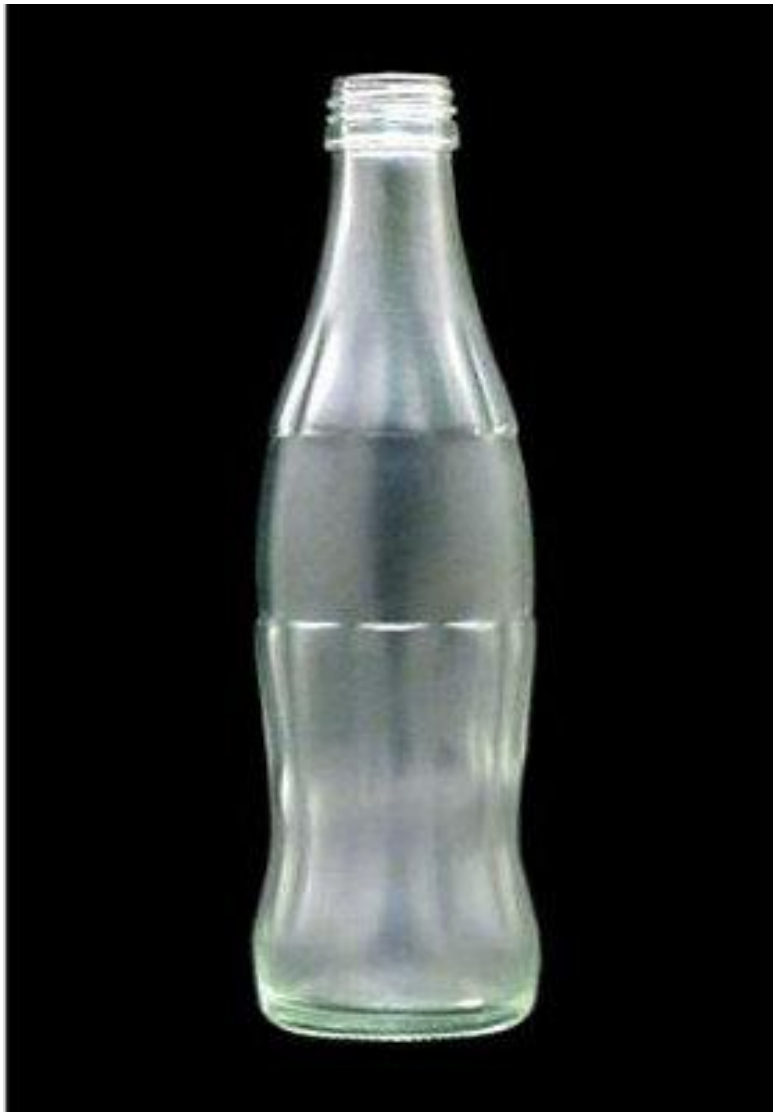
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1. Coca-Cola Bottle 3D TM case summary
2. 3D Trademark status in Japan
3. Issues in Coca-Cola Bottle 3D TM case
4. Trademark examination standard for 3D TM
5. Conclusion



# 1. **Coca-Cola Bottle 3D TM case summary**

# 1. Coca-Cola Bottle 3D TM case



- July 2003 Filed the application
- Oct. 2004 Preliminary rejection
- Feb. 2007 Final rejection by JPO
  
- Jun. 2007 Filed the suit
- May 29, 2008 Judgment at IP high court
  - “must be registered based on Article 3 Para 2 of Japan Trademark Act”

Applied mark: Shape of the Bottle as shown by the picture

Application #: 2003-55134

Class 32 : Cola drink

# TV news about Coca-Cola Bottle 3D TM case

date	time	TV satiation	TV program	Period
2008/5/29	5 PM	FUJI TV	“FNN Super News”	4’ 17”
2008/5/29	5 PM	Nippon TV	“NNN News real time”	3’ 58”
2008/5/29	6 PM	NHK	“NHK News”	1’ 27”
2008/5/29	5 PM	TV Tokyo	“Soku hou”	3’ 10”
2008/5/29	5 PM	TBS	“Evening News”	0’ 31”
2008/5/29	7 PM	NHK	“NHK News”	0’ 33”
2008/5/29	11 PM	Nippon TV	“News Zero”	0’ 30”
2008/5/29	11 PM	TV Tokyo	“World Business Satellite”	0’ 28”
2008/5/30	6 AM	Fuji TV	“Mezamashi TV”	2’ 48”
2008/5/30	6 AM	TBS	“MinoMonta no AsaZuba”	1’ 45”
2008/5/30	6 AM	Nippon TV	“Zoom in SUPER”	1’ 1”

# News Articles about Coca-Cola Bottle 3D TM case

[ English Translation ]

## Coca-Cola Contour Bottle Approved as Three-dimensional Trademark

### Intellectual Property High Court

#### First Container to be Approved in Japan

In a litigation regarding whether the shape of the Coca-Cola contour bottle could be approved and registered as a three-dimensional trademark, the Intellectual Property High Court accepted The Coca-Cola Company's claim on May 29, stating that "the shape of the bottle itself has been recognized as a symbol of the brand." The court repealed the decision of the Japan Patent Office, which had not permitted its registration as a three-dimensional trademark. According to the Patent Office, this is the first instance in Japan in which a container has been approved as a three-dimensional trademark. Chief Justice Toshiaki Iimura pointed out that, "Since its launch in Japan in 1957, The Coca-Cola Company has consistently used bottles of the same shape. Simply by looking at the shape of its bottle, many people can recognize the name of the product as Coca-Cola even if it is not labeled." He judged that the bottle could be registered as a three-dimensional trademark. He denied the inherent distinctiveness of the shape, however, saying that "it could potentially be a container for any cola beverage."

According to the Japanese subsidiary of The Coca-Cola Company, the contour bottle has been registered as a three-dimensional trademark in dozens of countries in Europe, North America, and other regions. In Japan, there have been legal disputes over whether Suntory Ltd.'s *Kashūin* (square) whiskey bottle, Yakult Honsha Co. Ltd.'s lactobacillus drink bottle, and other containers could be registered as three-dimensional trademarks, but none of these containers were approved.

Following *M&G-Lite*, a flashlight, *Coca-Cola* is the second product to obtain approval for its shape from the Intellectual Property High Court as a three-dimensional trademark because, despite the lack of distinctiveness in shape, it can be distinguished from similar products from other manufacturers due to its long-term use. *M&G-Lite* was registered as a trademark in June of last year.

[Photo caption]

The *Coca-Cola* bottle has been approved as a three-dimensional trademark

## コカ・コーラ瓶 立体商標認定

「コカ・コーラ」の瓶の形状が立体商標として登録が認められるなど、コカ・コーラが訴訟の判決で、知的財産高裁は二十九日、「瓶の形状自体がブランド・シンボルとして登録されるべき」として、

### 知財高裁

「コカ・コーラ」の瓶の形状が立体商標として登録が認められるなど、コカ・コーラが訴訟の判決で、知的財産高裁は二十九日、「瓶の形状自体がブランド・シンボルとして登録されるべき」として、

### 容器では国内初

「立体的商標」が認められたコカ・コーラの瓶



裁判長は「本日は一九五七年の瓶の形状が、一貫して同じ形状。多くの人は、その形状だけでも瓶の形状が、コカ・コーラを認める」と述べた。

「立体的商標」が認められたコカ・コーラの瓶

「立体的商標」が認められたコカ・コーラの瓶

May 30, 2008  
Nihon Keizai Shimbun



May 29  
FUJI TV  
“FNN Super News”

WORLD LEADERS: INTERNATIONAL IP AWARDS 2008



## Award for In-house Trademark Management

Asia Pacific



Host Adrian Faiglan of CNN presents the award to Mark Barfoot from Coca-Cola (Europe)

## The Coca-Cola Company and Yuasa & Hara

### About the winner

The Coca-Cola trademark team of Dan Greif, Masaru Adachi and Aysako Harada successfully managed to get The Coca-Cola Company's 'Three Dimensional Coca-Cola Contour Bottle' per se, that is, without the well-known word trademark 'Coca-Cola' approved for registration in Japan after a five-year battle. Together with the law firm of Yuasa & Hara, Coca-Cola's Asia Pacific Trademark Team submitted carefully crafted comprehensive, creative and effective arguments to the Tokyo High Court Intellectual Property Division. In addition, they presented the Court with a highly persuasive consumer survey, and effectively worked with a range of experts in varying fields to create powerful and persuasive evidence in support of the registration of the 'Contour Bottle'. On May 29, 2008, the Tokyo High Court found the 'Contour Bottle' distinctive and that it acts as an indicator of source. Although the Japan Trademark Office could have appealed the decision to the Japan Supreme Court, it did not do so. The 'Contour Bottle' will now be registered. For the first time in the history of Japan, a three-dimensional bottle configuration has been recognised as a trademark.

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# JPO's decision

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## ■ Article 3 Para 1 Item 3

- The mark constitutes only the shape of a container ordinarily used in the trade. Should fall under Article 3 Para 1 Item 3. (not registered)

## ■ Article 3 Para 2

- Since the bottle used in the trade consists of the shape of the container and 2D mark (word mark), JPO can not recognize that the applied mark (w/o 2D mark) has acquired the distinctiveness.
- The survey is not trustworthy.

## ■ JPO's Conclusion: Rejection

# IP High Court Judgment

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## ■ Article 3 Para 1 Item 3

- The mark constitutes only the shape of a container ordinarily used in the trade. Should fall under Article 3 Para 1 Item 3. (not registered)

## ■ Article 3 Para 2

- The applied mark has acquired distinctiveness through the extensive use in the market, although the bottle used in the market bears 2D mark (word mark) prominently.
- The survey is one of the factors for IP Court to consider that the applied 3D mark be registered.

## ■ Court's conclusion: Shall Be Registered.



## 2. 3D Trademark status in Japan

## 2. 3DTM status in Japan

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### ■ Number of the registered 3DTM

- Japan introduced 3DTM effective from April, 1997.
- 1502 marks as of end of 2007 (source: Mainichi Shimbun, others)
- Reference: 1332 marks as of Dec. 20, 2005  
(source: Masaru Adachi, 'Three Dimensional trademark ,*Kakubin* case' in "Practice of the Trademark Law based on the recent precedents" (SeirinShoin, 2006))

### ■ Major types of Registered 3D Trademarks

- Advertising figures (e.g., a doll in front of the store)
  - Doll at KFC
  - Doll at the restaurant "Fujiya"
  - Statue of Waseda University
- 3D shape of the goods bearing 2D mark (word mark and/or graphic mark)

# Registered 3DTMs (e.g., advertising figures)



Reg. #: 4253602  
Class: 42



Reg. #: 4157614  
Class: 29, 30, 32, 42



Reg. #: 4164983  
Class: 16, 41

Source : JPO IPDL Homepage



Reg. #: 4487460  
Class: 29, 42

# Registered 3DTM (e.g., 3D shape w/ 2D TM )

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Reg. #: 5009334  
Class: 30



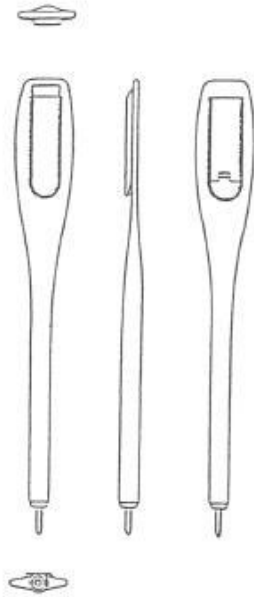
Reg. #: 4175123  
Class: 33

Source : JPO IPDL Homepage

# Lawsuits in regard to 3DTM

Judgment date	Case	Applicant	Case result
2000/12/21	Pencil for golf score card case	Okaya	X
2001/7/17	Lactic drink container case	Yakult	X
2001/12/28	Fishing tackle parts (9 cases)	Fuji Kogyo	X
2002/7/18	Bag accessory cases (2 cases)	Ferragamo	X
2002/7/18	Goldkenn Chocolate case	Goldkenn	X
	2003/7 Coca-Cola Bottle application		
2003/8/29	Whisky Bottle case	Suntory	X
2003/10/15	Cellophane Tape case	Nichi ban	X
2006/11/29	Hiyoko (Japanese cake) case	Hiyoko	X
	2007/6 Coca-Cola Bottle lawsuit filing		
2007/6/27	Mini maglite case	Mag Instrument	O
2008/5/29	Coca-Cola Bottle case	Coca-Cola	O
2008/6/30	Guylian Sea Shell Chocolate bar case	Guylian	O

# Rejected 3D marks (examples)



Pencil for Golf score card



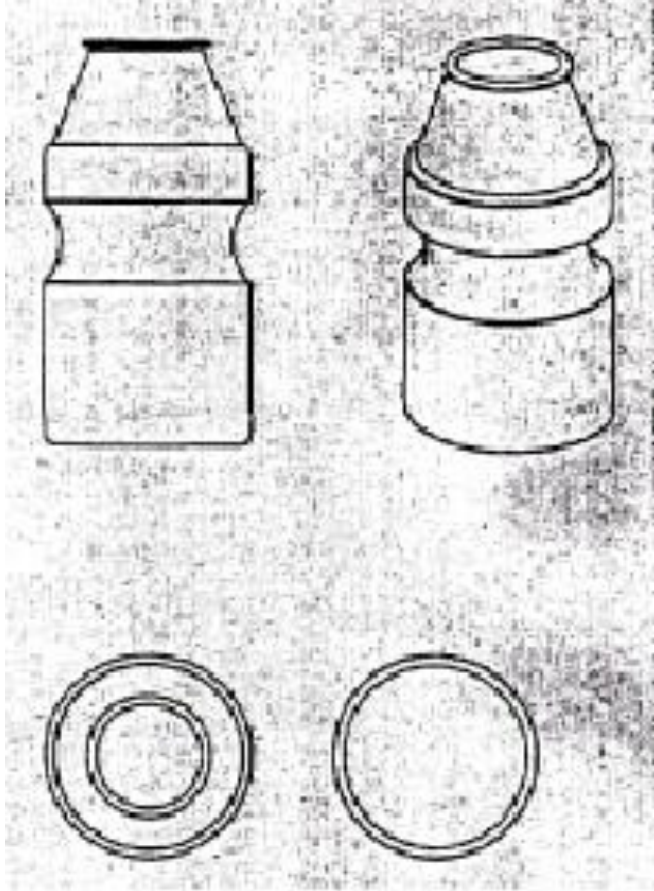
Hiyoko (Japanese cake)

Once registered at JPO based on Article 3--2,  
But then, the court judged to erase such registration

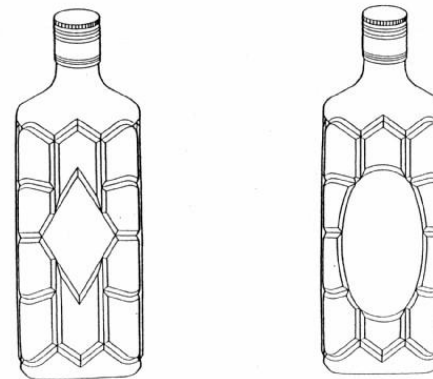
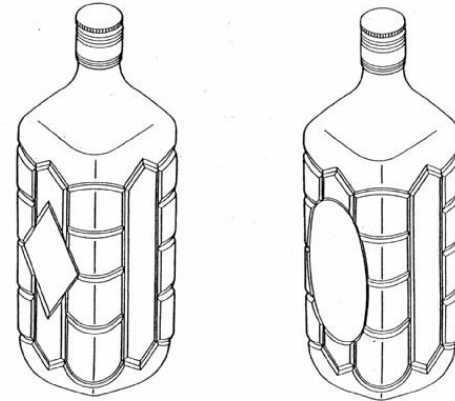


Fishing tackle parts

# Rejected 3D marks (Container cases)



Lactic drink container case



Whisky Bottle case



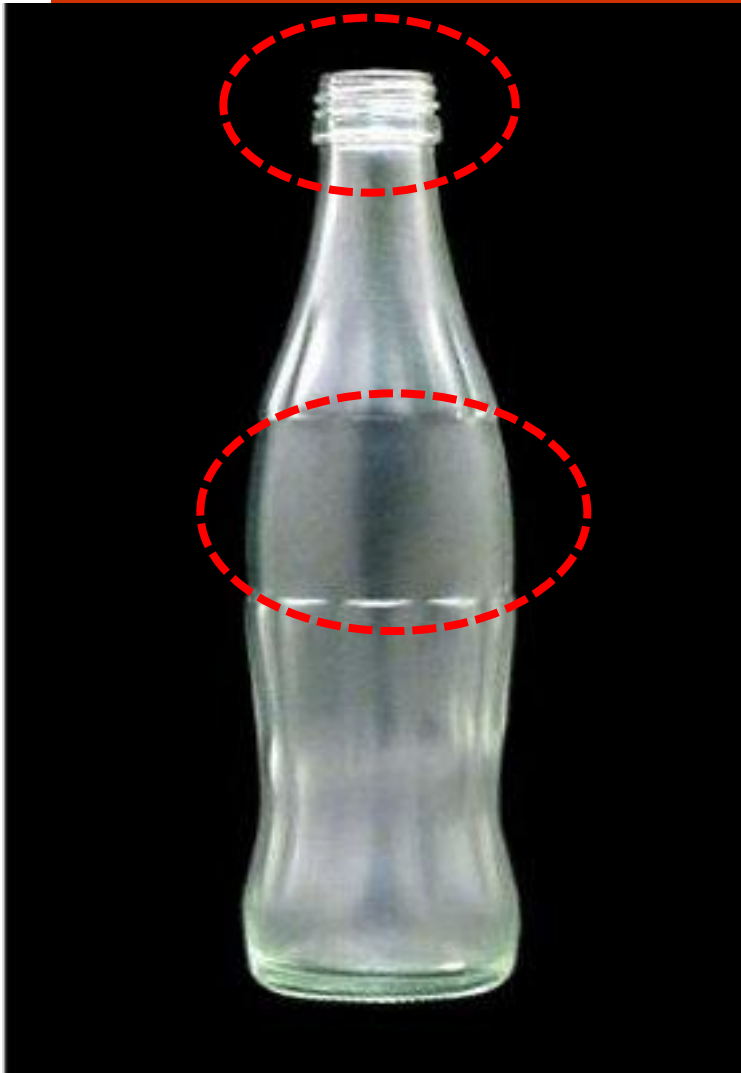
# **3. Issues in Coca-Cola Bottle 3D TM case**

# JPO's argument in regard to Article 3-1-3

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- Applied mark (Coca-Cola bottle) constitutes only the shape of a container ordinarily used in the trade, since there are waisted bottles or some decorated ones in the market.

# JPO's argument in regard to Article 3 Para 2



Applied Mark



The bottle in the market (sample)

# Evidence submitted

- Coca-Cola annual sales reports, advertising materials, titles and reproductions of TV commercials;
- Books, e.g.,
  - “Commentary of Unfair Competition Law” and “Commentary of Trademark Law” (Dr. Shoen Ono),
  - “Overview of Unfair Competition Law” (Prof. Yoshiyuki Tamura),
  - “Paris Convention Kowa (Lecture on Paris Convention)” (Prof. Haruo Goto);
- Publications, e.g.,
  - Study on Coca-Cola” (Kodansha Publishing),
  - “50 Years of Upheaval: Visual History of Showa Era” (Coca-Cola Bottlers),
  - “Creation of Business: Japanization of Soft Drinks” (Bunshindo),
  - “True Histories of Hit Brands” (Tokyu Agency),
  - Legendary Management: Business History of Coca-Cola” (Mahoroba shobo),
  - “Open and You’ll Find it America” (Ohbunsha),
  - “Stories of American Brands” (Hannah Campbell), “Rise and Fall of Coca-Cola Empire”;
- statements
  - university professors (Law Professor, Marketing Professor),
  - Japan Soft Drink Association,
  - Japan Foods & Biotechnology IP Rights Center;
- consumer survey reports (2003 and 2007);
- registration certificates of foreign countries



## **4. Trademark Examination Standard for 3D TM**

# Examination Standard in regard to Art. 3 Para 1 Item 3

- A three-dimensional trademark that is comprised of a shape that is acknowledged by the consumer as a shape that does not go beyond the shape of the designated goods etc. itself, is deemed as lacking the capability of being distinguished. In this case, in relation to the designated goods etc., even though the three-dimensional shape that can be adopted by the same type of “goods (including the packing) or the goods used for providing services” (hereinafter “goods etc.”) may be uniquely changed or decorated uniquely, if on the whole as long as the shape is acknowledged as being a representation of the designated goods etc., such a three-dimensional trademark will be deemed to lack the capability to be distinguished.
- A three-dimensional trademark consisting solely of a shape that can only be acknowledged as being within the scope of a simple and common three-dimensional shape will be deemed to lack the capability to be distinguished.

(source: JPO’s decision in several 3DTM cases, including Coca-Cola bottle case)  
This is prepared based on JPO’s English translation.

## Examination Standard in regard to Art. 3 Para 2 (Principle)

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When a claim is based on Article 3 Para 2, it is the rule that for trademark to be deemed to have the capability of being distinguished in use, the trademark must be identical to the pertinent trademark, and must be identical to the goods which use that trademark.

Therefore, when the trademark of the application is comprised solely of a three-dimensional shape, but the trademark related to the use contained in the submitted evidence shows a three-dimensional shape attached with letters and figures and other two dimensional marks, since the whole composition of the two trademarks are not identical, in principle, that trademark cannot be deemed to have the capability to be distinguished by use based on that evidence.

(source: JPO's decision in several 3DTM cases, including Coca-Cola bottle case )

This is prepared based on JPO's English translation.

# Examination Standard in regard to Art. 3 Para 2(Exception Rule)

When an observation of the whole shape of the trademark in use shows that:

- i) the three-dimensional shaped portion and the trademark of the application are identical;
- ii) for that three-dimensional shape to function as an identification sign, it is not indispensable to have a two dimensional mark attached, but rather, it is deemed that by rendering changes or attaching decorations to the three-dimensional shape, the trademark can be strongly impressed upon the minds and memory of the consumers more than the two dimensional mark; and
- iii) whole objective evidence has been submitted which proves that the trademark is now acknowledged by the consumers as being goods that are connected to peoples' business (for example, a certificate of proof from an association of a similar industrial group, or similar businesses, or a third party organization),

in these cases, rather than dismissing the claim based on Article 3 Para 2 on the ground that the whole trademark composition is not identical, a ruling will be made to determine whether a three-dimensional shaped portion of the trademark can be deemed to independently function as a representation which differentiates the source of one's own and another's goods or services.

(source: JPO's decision in several 3DTM cases, including Coca-Cola bottle case)  
This is prepared based on JPO's English translation.

**Reference:** JPO's Examination Manual (English version) is confusing.

When an observation of the whole shape of the trademark in use shows that:

- i) the three-dimensional shaped portion and the trademark of the application are identical;
- ii) for that three-dimensional shape to function as an identification sign, it is not indispensable to have a two dimensional mark attached, but rather, it is deemed that by rendering changes or attaching decorations to the three-dimensional shape, the trademark can be strongly impressed upon the minds and memory of the consumers even without the two dimensional mark; and
- iii) whole objective evidence has been submitted which proves that the trademark is now acknowledged by the consumers as being goods that are connected to peoples' business (for example, a certificate of proof from an association of a similar industrial group, or similar businesses, or a third party organization),

in these cases, rather than dismissing the claim based on Article 3 Para 2 on the ground that the whole trademark composition is not identical, a ruling will be made to determine whether a three-dimensional shaped portion of the trademark can be deemed to independently function as a representation which differentiates the source of one's own and another's goods or services.

(Source: JPO homepage)



# 5. Conclusion

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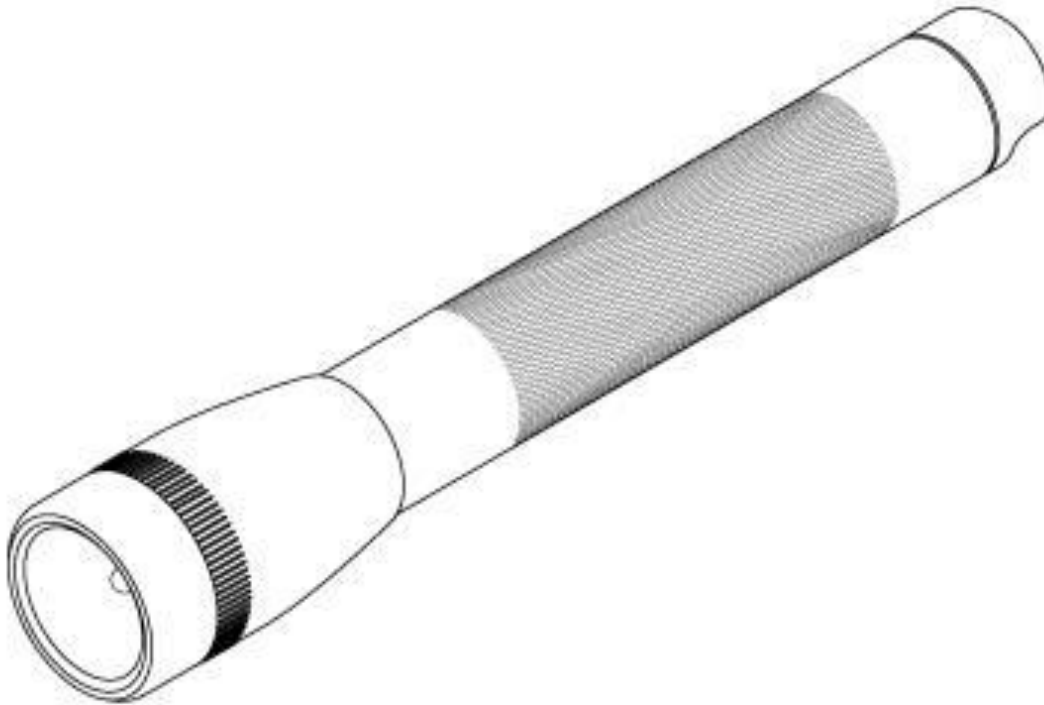
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- Coca-Cola Bottle is the first container to be registered as 3D TM in Japan.
- This is the first case that the court refused to apply JPO's examination standard in regard to Article 3 Para 2.

# Mini Maglite case

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In this case, the Court basically followed JPO's examination standard.



Mini Maglite applied mark

# Impact of Coca-Cola Bottle case

## Examination standard (Article 3 Para 2)

- i) the three-dimensional shaped portion and the trademark of the application are identical;
- ii) for that three-dimensional shape to function as an identification sign, it is not indispensable to have a two dimensional mark attached, but rather, it is deemed that by rendering changes or attaching decorations to the three-dimensional shape, the trademark can be strongly impressed upon the minds and memory of the consumers more than the two dimensional mark; and
- iii) whole objective evidence has been submitted which proves that the trademark is now acknowledged by the consumers as being goods that are connected to peoples' business (for example, a certificate of proof from an association of a similar industrial group, or similar businesses, or a third party organization),



- a) the three-dimensional shaped portion and the trademark of the application are substantially identical;
- b) whole objective evidence has been submitted which proves that the trademark is now acknowledged by the consumers as being goods that are connected to peoples' business (for example, a certificate of proof from an association of a similar industrial group, or similar businesses, or a third party organization),

## Same treatment in examination as applied for 2D TM

(reference: Word mark “Kakubin”(H13(Gyo-ke)265)、Lego Block (H12(Gyo-Ke)101))

## 5. Conclusion

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- It took more than 10 years after introduction of 3DTM in 1997, until the same standard applied for 2DTM would be used for 3DTM.
- New types of the trademarks (color, sound, position, etc.) will be introduced in the near future.  
We might have the same challenge for those new types of trademarks.

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# Thank you

For more information, please refer to the below.  
Masaru Adachi, Registration of the trademark consisting only of the  
three dimensional shape, 42 Law & Technology 59, (2008)  
(available only in Japanese)