

Latest Court Decisions

2010:

[November]

● **YAKULT Three Dimensional Trademark Case**

(Cancellation Case of Trial Decision)

The IP High Court 2010.11.16 H22(Gyo-Ke)10169

This is the 2nd case where the three dimensional trademarks for drink bottles have been accepted by the IP High Court.

The 1st case was the "Coca Cola" bottle trademark that was accepted by the IP High Court on May 29, 2008 by admitting the secondary meaning by the long and wide use as the trademark.

The three dimensional trademark registration system started in Japan in 1997. KK Yakult Honsha, the leading lactic acid bacteria drink company in Japan, filed a trademark application for their drink bottles as a three dimensional trademark in 1997.

However, that application was rejected by the Tokyo High Court in 2001 because of the two main reasons, i.e.

- 1) the bottles without the word mark "YAKULT" had not been used, and
- 2) there had been similar bottles for similar goods by other companies.

According to this Court decision, three dimensional trademark registrations for drink bottles are almost impossible since every drink bottles always bear word marks and manufacturers' names in the actual trade.

However, the IP High Court admitted the three dimensional trademark registration for the Coca Cola bottles without the word marks on May 29, 2008. Then, on September 3, 2008 KK Yakult Honsha re-filed the three dimensional trademark application for the YAKULT drink bottle.

The JPO rejected again the YAKULT bottle application by the same reasons as the Tokyo High Court decision stated in 2001. Then, KK Yakult Honsha filed this Cancellation Suit of the Trial Decision before the IP High Court.



KK Yakult Honsha has been selling the YAKULT drinks for more than 40 years since 1968. Their bottle shape has not been changed. The sales amount in 2008 was 45,900,000,000 Yen and their market share in 2008 was 64.8%. They spend more than 9,000,000,000 Yen on advertising every year.

In addition to these facts, Yakult Honsha submitted as evidence the results of the questionnaire survey conducted in 2008. The questionnaire results show that 98.8% of the questionees reminded of "YAKULT" from the empty bottle of the YAKULT drinks without any words and devices. This means that the YAKULT bottles themselves are well admitted by the consumers as the trademark of KK Yakult Honsha.

As to the similar bottles by the other companies, the IP High Court says that the consumers recognized that such similar drinks were counterfeit goods of the YAKULT drinks. Therefore, the existence of similar bottles by the other companies has no impact on the distinctiveness of the YAKULT bottle as the trademark.

Accordingly, the YAKULT drink bottle will be registered in the near future as the three dimensional trademark of KK Yakult Honsha. Although KK Yakult Honsha has not taken any legal actions against other companies that uses similar bottle shapes to the YAKULT drinks, it is expected that KK Yakult will take legal actions against such companies after the trademark registration.