

Latest Court Decisions

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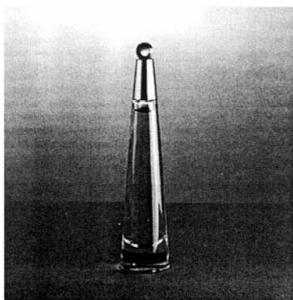
● 3 Three Dimensional Trademark Cases (Cancellation Cases of Trial Decisions)

The IP High Court 2011.4.21 H22(Gyo-Ke) 10386, 10366 & 10406

The JPO rejected the 3 International registrations for the three dimensional trademarks for the perfume bottles specifying the goods in Class 3 in the name of Beaute Prestige International (SA), Paris. The applicant brought the cases before the IP High Court requesting the cancellation of these Trial Decisions.

The IP High Court cancelled the Trial Decision by accepting IR No. 600167 on the basis of the secondary meaning acquired by use while it rejected IR No. 626145 and No. 652943 as the Trial Decisions issued.

本願商標



(1) IR No. 626145

This perfume bottle was designed by Issei MIYAKE. The bottle is the long and thin cone shape with the ball cap on the top.

Basically, the bottle shape is designed for aesthetic and functional purposes, not for indicating the origin of goods as a trademark.

Therefore, the three dimensional trademark for the bottle design can not be registered without a secondary meaning acquired by use under Article 3-2 of the Trademark Law.

This bottle perfume was firstly sold in 1992 in Japan and in the past, the annual sales were more than 100 million Yen. However, recently it was about 17 million Yen in 2009 and about 30 million Yen in 2010.

However, this bottle shape was simple and not so distinctive. In addition, there were similar shape bottle perfumes by other companies.

Therefore, the IP High Court decided that this bottle shape did not acquire the secondary meaning as a trademark by use.

Furthermore, the IP High Court said that the application contained the goods unrelated to "perfumes" such as "bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations" for which the IR trademark was not used in the past.

In Japan, it is necessary to limit the goods for which the trademark has been used, in order to claim the secondary meaning by use under Article 3-2 of the Trademark Law.



(2) IR No. 600167

This perfume bottle was designed by Jean Paul GAULTIER. The first sales in Japan were 1994 and its annual sales were 45 million Yen – 58 million Yen.

This bottle shape design was rather unique in comparison with other bottle shape design featuring women's body. It was announced in many books and magazines many times.

Therefore, the IP High Court accepted the secondary meaning by use for trademark registration.

As the specified goods, the IR registration contained the goods other than "perfumes" in use such as "beauty products, soaps, perfumery, essential oils, cosmetics" while the goods "bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; essential oils, hair lotions; dentifrices" were deleted.

The Court said that the limited goods were all related to "perfumes" and if the subject bottle shape trademark was used for these goods, the consumers would understand that these goods were also sold under the "Jean Paul GAULTIER" brand.

This seems the first case where the secondary meaning was accepted for the goods for which the applied-for trademark has not been used.



(3) IR No. 652943

This perfume bottle was also designed by Jean Paul GAULTIER.

The IP High Court also admitted that the bottle shape was rather unique. However, the applicant did not claim the secondary meaning by use.

Therefore, the Court sustained the Trial Decision denying the distinctiveness as the trademark.

The specified goods were "bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery goods, essential oils, cosmetics, hair lotions; dentifrices" in Class 3.

● Gold Loan Cases (Cancellation Cases of Trial Decisions)

The IP High Court 2011.4.27 H22(Gyo-Ke) 10326 & 10327

The applications for the trademarks "Gold Loan" and "MITSUI SUMITOMO CARD/Gold Loan" were rejected by the JOP due to the cited trademark "*CitiGold Loan*" in the name of Citibank, N.A., USA.

MITSUI SUMITOMO CARD
Gold Loan
Gold Loan
CitiGold Loan

The Trial Decision decided that the subject trademark were similar to the cited trademark with respect to the parts "Gold Loan" in common.

However, the IP High Court decided that they were not confusingly similar because the cited trademark should be separated into the parts "CitiGold" and "Loan" because the word "Loan" described the nature of the specified services "loan" and could be disregarded.

In addition, the Japanese company, Citibank KK, has provided with the services in Japan under the trademark "Citigold" since 2009 and Citibank, N.A. registered in Japan the trademarks such as "CITIGOLD PREMIUM", "CITIGOLD SELECT" and "CITIGOLD PRIVATE CLIENT".

Therefore, the main part of the cited trademark was "CitiGold" that was not similar to the part "Gold Loan" of the subject trademarks. Thus, the applied-for trademarks by Mitsui Sumitomo Card KK were decided for registration.

We do not know how Citibank, N.A. would feel about these Court Decisions.