

Latest Court Decisions

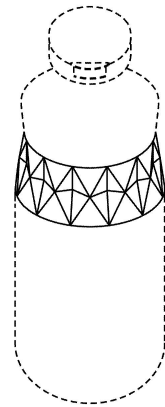
2020:

[December]

- BARBECUE SAUCE BOTTLE Case... Position Mark (Cancellation Suit)
IP High Court 2020.12.15 R2(Gyo-Ke)10076

[SUMMARY/INTRODUCTION]

A Japanese corporation, Ebara Foods Industry, Inc., well-known for meat seasonings, filed a trademark application for the position trademark (figure on the right), which was a vertically long three-dimensional shape applied to the barbecue sauce bottles.



However, the JPO denied its distinctiveness, and the acquired distinctiveness through use was not recognized, too.

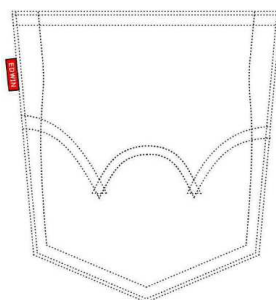
Ebara's barbecue sauces were hit products as its market share until 2012 was 54.2% and their sales of seasonings around meat accounted for 17.1 billion yen. Of course, Ebara conducted a huge amount of advertising such as TV commercials, radio commercials, pamphlets, leaflets, and product information.

These facts meant that Ebara's barbecue sauces were well-known in Japan. Then, Ebara brought the case before the IP High Court demanding cancellation of the JPO's Trial decision. What was the Court decision ?

[Court Decision]

In Japan, trademark registrations for position marks as well as sound marks, color marks, hologram marks and movement marks, have been accepted since April 1, 2015. Examples of registered position marks in Japan are follows.

Reg. No. 5807881



Reg. No. 6034112



No. 5807881 is a red rectangular tag figure with the letters "EDWIN" attached to the upper left of the back pocket of jeans.

No. 6034112 is a figure that is a combination of a figure attached to the peripheral edge of the upper part of the food container and a figure attached to the peripheral edge of the lower part of the food container. You will see that the containers are for the famous Nissin CUP NOODLES.

At first, the Court ruled regarding the inherent distinctiveness of the vertically long three-dimensional diamond shape applied to the barbecue sauce bottles as follows.

There were container shapes such as Otsuka Pharmaceutical's ORONAMIN C and KOIWAI DAIRY's yogurt for the continuous vertically long diamond shape (DIACUT) attached to the packaging container of liquid products. Such diamond shapes were adopted from the viewpoint of functions such as ease of holding and aesthetics.

In addition, regarding the packaging containers for barbecue sauces, the Court pointed out that there were similar shapes to the subject trademark in the barbecue sauces even for the continuous three-dimensional diamond shapes such as COSMO FOOD barbecue sauce, FOOD LABEL barbecue sauce, TORAJI barbecue sauce and SEIJO ISHII barbecue sauce.

In view of these facts, the Court determined that the continuous vertical diamond shapes on the upper or lower surface of the barbecue sauce packaging container had been adopted and used normally in business and thus, its inherent distinctiveness was denied.

Next, the Court examined the acquired distinctiveness through use. The Court also recognized that Ebara's barbecue sauces were well-known to Japanese consumers for their large sales and huge amount of advertising.

However, the bottle actually sold dressed the label from the middle to the bottom, just below the three-dimensional diamond shape of the subject trademark, and the Plaintiff's house mark "EBARA" and the product name mark "GOLDEN TASTE" were displayed on the front. The Court found that these marks made a strong impression on consumers and were noted as the identification of origin.

On the other hand, the subject position trademark consisted of a continuous vertically long rhombic three-dimensional shape, which was one of the three-dimensional decorations commonly adopted and used in business as contributing to the function and aesthetics, and

the subject position mark was placed close to the label. Therefore, the label gave the consumers stronger impression than the position mark.

In view of the above facts, the Court also denied the acquired distinctiveness through use since the three-dimensional shape constituting the subject position trademark was not recognized as a trademark for identifying the origin of the goods.

Not limited to three-dimensional trademarks and position trademarks, labels with the main trademarks are always affixed to the containers of goods. Therefore, in order to prove its well-known fact, it would be necessary to have a situation where such a three-dimensional shape has been used by only one corporation.