“GEORGIA” Case

(Article 3(1)3 of the Trademark Law)

Supreme Court

Syowa 60 (*Gyo-Tsu*) No. 68 (January 23, 1986)

FACTS

Applicant filed a trademark application for “GEORGIA” designating the goods “tea, coffee, cocoa etc.” on May 10, 1975. However, the Examiner made a final decision of rejection of the application as falling under Article 3(1)3 of the Trademark Law, on the grounds that the trademark “GEORGIA” indicates solely the place of origin or place of sale.

Applicant appealed the final rejection to the Japan Patent Office’s Trial Board, which rejected the appeal and upheld the final rejection by the Examiner.

DISPOSITION IN THE LOWER COURT

Applicant then appealed to the Tokyo High Court, arguing that the trademark application should be registered because the trademark does not fall under Article 3(1)3 but instead falls under 3(2) of the Trademark Law as admissible for the goods “coffee, cocoa etc.” That is, Applicant argued that, as a result of past use of the mark “GEORGIA” for these goods, consumers were able to recognize the above goods as being connected with the Applicant’s business. Although the Tokyo High Court accepted Applicants arguments regarding Article 3(2) it dismissed Applicant’s arguments regarding Article 3(1)3 and rejected the appeal.

On September 28, 1984, Applicant then filed a fresh trademark application for

“GEORGIA” designating goods “coffee, cocoa etc.” under Article 3(2) based on the judgment of the Tokyo High Court. The trademark “GEORGIA” was registered for “coffee and cocoa” on June 24, 1988.

Applicant also appealed the case to the Supreme Court, alleging errors of law in the Tokyo High Court’s decision, specifically mistakes of interpretation and application of Article 3(1)3.

ISSUE

Under Article 3(1)3 of the Trademark Law, do designated goods need to be actually produced or sold in the place of origin or place of sale indicated by the trademark for which registration is sought?

COURT DECISION AND REASONING

In order to register a trademark consisting solely of a trademark indicating the origin or place of sale of the designated goods in a common manner, the designated goods do not need to be actually produced or sold in the place of origin indicated by the trademark for which a registration is sought. Rather, all that is required is that consumers or dealers generally understand that designated goods would have been produced or sold in the place of origin or place of sale indicated in the trademark for which registration is sought.

In this case, consumers or dealers in contact with the trademark "GEORGIA", for which registration is sought, would generally understand that the designated goods “coffee, coffee drink” to have been produced in the area of the State of Georgia, United States of America.

Accordingly, since the goods in question are not produced or sold in the State of Georgia, the Supreme Court dismissed the Applicant’s arguments, rejected the appeal, and upheld Japan Patent Office’s decision.