

In re **SIDAMO**
(Trademark consisting solely of a mark indicating the place of origin and likely to
mislead as to the quality of the goods or services)
IP High Court
Case H21 (Gyo-Ke) No. 10226 (March 29, 2010)

FACTS

The plaintiff, the Federal Democratic Republic of Ethiopia, obtained a trademark registration for “SIDAMO” for the goods “coffee, unroasted coffee” on May 26, 2010 (Registration No. 4955561). The defendant filed a request for a trial for invalidation of the trademark registration on January 29, 2007.

DISPOSITION IN THE JPO

The Japan Patent Office rendered a trial decision on March 30, 2009 to invalidate the registration on the following grounds:

The mark “SIDAMO” indicates the name of coffee beans produced in the Sidamo region of Ethiopia.

Thus, when the mark is used for the goods “coffee produced in the Sidamo region of Ethiopia, unroasted coffee produced in the Sidamo region of Ethiopia”, it falls under Article 3, paragraph 1, item 3 (a trademark consisting solely of a mark indicating the place of origin and quality of goods in a common manner).

However, when the mark is used for goods other than those described above, it falls under Article 4, paragraph 1, item 16 (a trademark likely to mislead as to the quality of the goods or services).

ISSUE

Is the mark “SIDAMO” a trademark consisting solely of a mark indicating the place of origin and quality of goods in a common manner which is stipulated in Article 3, paragraph 1, item 3 of the Trademark Law?

HOLDING AND REASONING

“SIDAMO” is rarely recognized in Japan as the name of a place, and when it is used for “coffee, unroasted coffee”, it is mostly recognized as a brand of coffee. Also, since the registrant is the producing country, its exclusive use of the mark is not contrary to the public interest. Thus, this registration does not fall under Article 3, paragraph 1, item 3 of the Trademark Law. Therefore, there are no grounds for invalidation of this mark for “coffee produced in the Sidamo region of Ethiopia, unroasted coffee produced in the Sidamo region of Ethiopia”.

On the other hand, since the flavor of coffee differs according to the region in Ethiopia where it is produced, if the mark “SIDAMO”, which is derived from the name of one such region, is used for goods other than “coffee produced in the Sidamo region of Ethiopia, unroasted coffee produced in the Sidamo region of Ethiopia”, it is likely to mislead as to the quality of the goods. Thus, for goods other than “coffee produced in the Sidamo region of Ethiopia, unroasted coffee produced in the Sidamo region of

Ethiopia”, the registration must be invalidated pursuant to Article 4, paragraph 1, item 16.