

Yakult Container 3D Trademark Case
IP High Court Decision
Case H22 (Gyoke) No. 10169 (November 16, 2010)

FACTS

The plaintiff filed an application for registration of the trademark shown below (hereinafter referred to as the “Subject Trademark Application”) as a three-dimensional (3D) trademark on September 3, 2008. The JPO rejected the application, and in response, the plaintiff filed an appeal against the decision of rejection. The JPO, however, issued a decision dismissing the appeal. The plaintiff then appealed to the IP High Court for revocation of this appeal decision.



Subject Trademark Application

ISSUE

Whether a container is eligible for trademark registration as a 3D trademark pursuant to Article 3(2) of the Japanese Trademark Law?

HOLDING

It is undisputed that Article 3(1)(iii) of the Japanese Trademark Law (trademark consisting solely of a mark indicating, in a common manner, the shape of goods) is applicable to the Subject Trademark Application, pursuant to which the container would

not be eligible for registration. However, the question now is, can the container itself still be registered as a trademark pursuant to Article 3(2) (“As a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person”)?

The plaintiff’s product packaged in the container of the Subject Trademark Application is a lactic acid drink. The product has recorded a remarkable sales performance with a significant market share since its release in 1968. Huge sums have been spent on advertising every year with particular emphasis on the 3D shape of the subject container in order to make a strong impression on consumers. The product has been sold without changing the shape of the container for more than 40 years, since sales started.

In the meantime, various lactic acid drinks packaged in containers with a similar shape to the subject container have been on the market. Nonetheless, according to a recent survey, over 98 percent of respondents answered that the subject container reminds them of “Yakult”.

Considering the above facts comprehensively, the 3D shape of the subject container must have been recognized by consumers as a reference for identifying and distinguishing the plaintiff’s product from the other companies’ products as of April 12, 2010, the date on which the appeal decision was made in connection with the application for the Subject Trademark Application filed on September 3, 2008.

In addition, the plaintiff’s product has large printed red or blue pattern and the famous word mark “Yakult” on the subject container, as mentioned above. Yet according to the surveys conducted in 2008 and 2009, most respondents answered that the 3D shape of the subject container alone can remind them of the plaintiff’s product “Yakult”. Also, there are consumers who recognize other products packaged in containers with a distinctly different name printed on them but with a shape very similar to the 3D shape of the subject container as “Yakult imitations”.

In view of the above, the 3D shape of the subject container is recognized by consumers as readily as, or more readily than, the pattern and the plane mark attached to the subject container, and makes a strong impression on consumers. Therefore, the 3D shape itself has acquired the capability of identifying and distinguishing goods or

services independently.

Accordingly, the appeal decision denying the applicability of the Article 3(2) of the Trademark Law to the Subject Trademark Application of the application dated September 3, 2008 is incorrect.

cf. Article 3(1)(iii) of the Japanese Trademark Law

Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

(iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision.

Article 3(2) of the Japanese Trademark Law

Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.