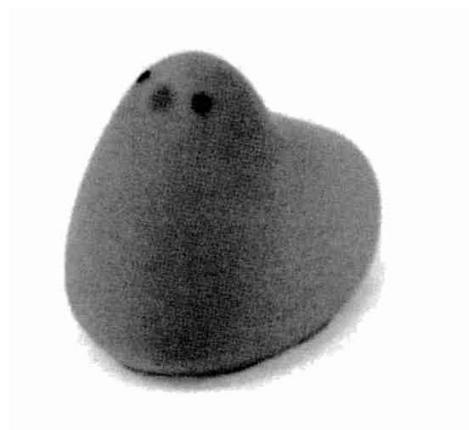
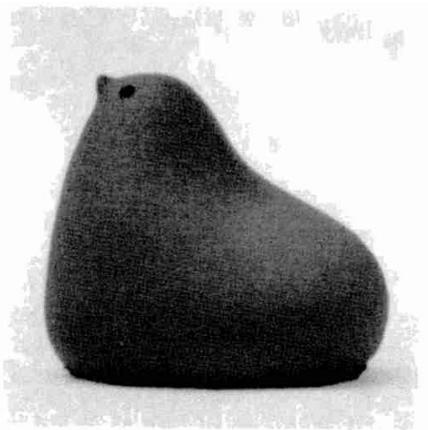


Trade Mark Act Sec. 3(1), (2) – “Hiyoko”

Registration of a three-dimensional mark requires proof that the three-dimensional shape is perceived as an indication of origin by consumers all over Japan, not just in parts of the country.

Tokyo High Court, 29 November 2006

Nikakudô v. Hiyoko



Facts

Three-dimensional marks have become registrable in Japan since 1 April 1997. Yet trade marks that consist solely of the shape of the goods in question are capable of registration only “where, as a result of the use of such mark, consumers are able to recognise the goods as those from a certain business”, Sec. 3(1)(iii) and (2) Trade Mark Act. Thus, for three-dimensional marks, there are no absolute grounds of refusal as those under Art. 7(1)(e) European Trade Mark Regulation. In the case at issue, the defendant on 24 July 2003 had obtained registration of a trade mark consisting of the shape of a sitting young bird for *manjû* (buns with a sweet bean curd filling). The defendant, previously trading under the name of Yoshinodô, has been selling bird buns in such a

shape since 1911 and has about 270 sales outlets primarily in the Kantô and in Kyûshû areas. The little bird buns are also sold by other companies, *inter alia* the plaintiff, are known as specialties of either Tokyo or Kyûshû, and make popular *omiyage* (presents). Already back in 1970, the plaintiff had accused the defendant of engaging in unfair competition by selling little bird buns, yet the public prosecution had refused to take up the case under the old Unfair Competition Prevention Act of 1934. The plaintiff now requests invalidation of the mark, as the three-dimensional shape was nothing more than the ordinary shape of the goods themselves. The Patent Office rejected the request, as it thought the lack of distinctiveness had been overcome by widespread use. In what is considered the leading case for the registrability of three-dimensional marks, the Tokyo High Court held that the use was insufficient to prove secondary meaning.

Decision

In the current case, it is in dispute whether the three-dimensional mark at issue meets the requirements of Sec. 3(2) Trade Mark Act. ... According to this provision, where a trade mark falls under one of the provisions (iii) – (v) of the preceding subsection, registration can be obtained where due to the use of such marks the consumer recognises the goods or services as belonging to a certain business enterprise. ... Sec. 3(2) thus allows for the exceptional registration of trade marks devoid of distinctive character where [in the case of three-dimensional marks] the specific shape of the goods through a long period of consecutive or monopolistic use and corresponding advertising is widely recognised as an indication of origin, in other words has obtained distinctiveness. This is what can be understood from the legislation that since 1 April 1997 has allowed the registration of three-dimensional marks. Yet one should be careful when establishing the requirements of Sec. 3(2) to take into account only the three-dimensional element alone without the word or character elements that go with it. Whether a three-dimensional mark has become distinctive must further be established for the country as a whole. ... This court is convinced that the defendant's word mark "Hiyoko" has become widely known amongst consumers in the Kantô and Kyûshû areas, yet the shape of the three-dimensional mark as such has not yet obtained widespread recognition in the whole country. Certainly, the defendant has sold "Hiyoko" sweets since 1911, and particularly since 1957, annual sales and advertising in journals, newspapers and on television have been substantial. ... Yet, the Hiyoko sweets have been sold in a wrapped condition and always accompanied by the word "Hiyoko" on the boxes ..., and the television advertisements have always been accompanied by the pronounced phrase "famous Hiyoko" or "Hiyoko". ... In addition, there are ... a total of 23 competitors all over Japan producing and selling bird-shaped sweets ... that are difficult to distinguish from those of the defendant. ... The defendant has most of its shops in the areas of Kyûshû and Kantô, yet not everywhere in Japan. The sale and advertisement of the "Hiyoko" sweets to the con-

sumer is accompanied by the word “Hiyoko”, a good number of bird-shaped sweets similar to the mark registered by the defendant have been sold all over Japan and are identified as Japanese-style sweets, ... and therefore the three-dimensional mark at issue has not yet received a nationwide distinctiveness. Thus, as a result of the use made of the three-dimensional mark, the consumer at the time of registration was not able to identify the goods as those of a particular business enterprise, and the three-dimensional mark has not yet achieved a distinctive character ... as required by Sec. 3(2) Trade Mark Act. ... Thus, the Patent Office’s reasoning with respect to Sec. 3(2) Trade Mark Act is faulty and the plaintiff’s appeal must be allowed.

Japanese Original in Hanrei Jihô 1950 (2007) 3 - 26

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ZUSAMMENFASSUNG

Der Autor des Beitrags übersetzt auszugsweise die Entscheidung des Obergerichts Tokyo vom 29. November 2006 im Fall Hiyoko. Das Gericht entschied, dass die Registrierung einer dreidimensionalen Marke gemäß Art. 3 Abs. 1, 2 Warenzeichengesetz den Beweis voraussetzt, dass die dreidimensionale Marke in ganz Japan und nicht nur in einzelnen Landesteilen von Verbrauchern als Herkunftsbezeichnung wahrgenommen wird.

(Zusammenfassung durch die Red.)