Appeal decision

Appeal No. 2012-5098

Aichi, Japan
Appellant KAWAGUCHI Co., Ltd.

Patent Attorney Okada Patent and Trademark Office

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2010-100464 has resulted in the following appeal decision:

Conclusion

The appeal of the case was groundless.

Reason

No. 1 The trademark in the Application

The trademark in the Application is configured as indicated in the Attachment, and the application for its registration was filed on December 27, 2010 as a three-dimensional trademark by setting goods and services that belong to Classes 9 and 35 and stated in the application as the designated goods and services. Then, the designated goods and services are set to Class 9 "Joint box" as a result of correction by the written amendment dated on August 19, 2011 in the original examination.

No. 2 Gist of reasons for refusal stated in the examiner's decision

The examiner's decision acknowledges and determines that "It is acknowledged that a three-dimensional shape of the trademark in the Application is employed to improve a function or aesthetic property of a cover of a coupling portion such as wirings; that is, a joint box. Then, the shape of the trademark is within a range that can be predicted as a shape used to improve the function or aesthetic property, as the shape of the joint box. Therefore, it is only recognized that a shape of a product and the like is used in a common way, and it is acknowledged that the trademark in the Application does not function as a mark for distinguishing relevant products from others. Therefore, the trademark in the Application falls under Article 3(1)(iii) of the Trademark Act. Furthermore, although Appellant insisted the application of the provision of Article 3(2) of the same Act, it cannot be acknowledged that the trademark

in the Application has distinguishing function vis-a-vis other marks through use of only its shape", and this application was rejected.

No. 3 Judgment by the body

1 Regarding Article 3(1)(iii) of the Trademark Act

The trademark in the Application is configured of the three-dimensional shape as indicated in the Attachment, and a box portion having a cylindrical shape has a structure in which a cover portion housing a coupling portion of electric wiring, that includes 13 triangular valves that are bonded to an entrance of the box portion and of which front ends are oriented inward, has a circular hole at the center.

Then, it can be said that the circular cover portion for housing the coupling portion of the electric wiring is the most common shape as the shape of the product (Evidence A No. 4 and A No. 5). Furthermore, it can be said that the 13 triangular valves bonded to the entrance of the box portion have a functional structure that is devised to cover the coupling portion of the electric wiring with a single touch.

Accordingly, it is reasonable to understand that the three-dimensional shape represents one embodiment of the shape as a functional structure of the "joint box" (box for connection portion of indoor wiring) that is the designated goods of the present application.

Then, regarding the shape of the "joint box" (box for connection portion of indoor wiring) that is the designated goods of the present application, various shapes are devised according to various shapes described in the design bulletin search document (Evidence A No. 3) submitted by the Appellant or according to internet information (Evidence A No. 5 to A No. 7).

Therefore, it is reasonable to determine that, even if the trademark in the Application is used for its designated goods "joint box", traders and consumers only understand that the trademark in the Application simply indicates the shape of the product and do not recognize the trademark in the Application as a mark for distinguishing relevant products from others.

Therefore, the trademark in the Application falls under Article 3(1)(iii) of the Trademark Act.

Note that the Appellant insists that "the shape of the joint box of the trademark in the Application employs a very unique shape that is a valve that cannot be predicted from a conventional joint box. The shape has a functionality of the joint box, and at the same time, has designability that a joint box made by another company does not have. The joint box of the trademark in the Application makes a deep impression on

consumers or traders coming into contact with the trademark in the Application. There are countless numbers of shapes that have the function as the joint box, and the present application should not be rejected on grounds that the shape of the trademark in the Application improves the function and a sense of beauty. It is obvious that only the shape of the trademark in the Application has a function for distinguishing relevant products from others. The trademark in the Application does not fall under Article 3(1)(iii) of the Trademark Act and should be registered".

However, the three-dimensional trademark includes a shape of an object used for a product or a package of a product or provision of a service, and the shape of the product and the like is selected to allow effective fulfillment of the original function of the product or pursuit of a sense of beauty of the shape of the product. The three-dimensional trademark originally (primarily) indicates the sources of the products and the services and is not chosen as a mark for distinguishing relevant products and services (referred to as "relevant products and the like" below) from others.

Then, even if characteristic changes, ornaments, and the like are applied to the shape of the product and the like, these are made to further improve the function or the sense of beauty of the product and the like as described above and are not originally chosen as a mark for distinguishing relevant products and the like from others. In a case where the shape of the product has a shape necessary for fulfilling the function and the sense of beauty of the product and the like as a whole, traders and consumers coming into contact with this only recognize the entire shape as indication of the shape of the product and the like.

Accordingly, regarding the trademark in the Application, even if the shape related to the function or the sense of beauty of the product and the like indicated by the Appellant is unique to a certain extent, it is reasonable to understand that the shape is within a range of the indication of the shape of the product and the like in a common way. It is reasonable to understand that the trademark in the Application configured by the three-dimensional shape having a shape recognized as the shape of the product and the like falls under Article 3(1)(iii) of the Trademark Act as a trademark consisting solely of a mark indicating the shape of the product and the like in a common way and cannot be registered.

Furthermore, the Appellant alleges that "Joint boxes having various shapes are made, and the unique and characteristic shape of the trademark in the Application is the portion of the valve. Therefore, even if the applicant monopolizes the shape of the trademark in the Application, this does not mean that the applicant monopolizes a circular or a rectangular shape that protects the coupling portion of the wiring as the

joint box and a shape based on functions for fixing the joint box and making the joint box unlikely to come off. Therefore, there is no problem even if the monopoly of the joint box of the trademark in the Application by the applicant is approved. The purpose of the Trademark Act is to ensure the maintenance of business confidence of persons who use trademarks and to protect the interests of consumers, and the purpose of the Trademark Act is different from those of the Patent Act and the Design Act. ...Business reputation embodied by the trademark in the Application through long-time sales of the joint box of the trademark in the Application by the Appellant should be protected by the Trademark Act".

However, the three-dimensional trademark, which cannot be registered under Article 3(1)(iii) of the Trademark Act, has a three-dimensional shape including a shape recognized as the shape of the product and the like.

That is, where goods, etc. have a unique shape that is not seen in goods, etc. of the same kind, an exclusive right for the shape may be granted as an invention or device from the perspective of function of goods, etc. or as a design from the perspective of attractive appearance of goods, etc., as long as it fulfills the requirements under the Patent Act, the Utility Model Act or the Design Act, respectively. However, granting protection based on a trademark right to a shape that may become subject to protection under these laws leads to granting to a particular person a semi-permanent exclusive right for a shape of goods, etc. beyond the duration of right under the Patent Act, the Design Act, etc., taking into account that a trademark right is semi-permanently held through repeated renewal of its duration. This falls under unjust restriction on free competition and goes against public interest.

Moreover, the Appellant alleges that "A large number of trademarks, for which the function for distinguishing relevant products from others is approved, exist as the following registered examples; for example, a registered example that designates goods different from a product that can be recalled from an appearance of a three-dimensional trademark, a registered example to which design is applied even though the product can be recalled from the appearance of the three-dimensional trademark, a registered example having a close relationship with the designated goods, and the like. ...Therefore, the trademark in the Application should be registered as the registered examples". However, the trademarks of the registered examples alleged by the Appellant have configurations and the like different from that of the trademark in the Application and are cases different from the present application, and whether or not a trademark claimed in an application falls under the provision of Article 3(1) of the Trademark Act should be individually and specifically determined upon the decision for

registration or appeal decision of the trademark. Therefore, the acknowledgement should not be made depending on these registered examples.

Therefore, the allegation of the Appellant cannot be accepted

2 Regarding applicability of Article 3(2) of the Trademark Act for the trademark in the Application

The Appellant submitted Evidence A No. 1 and A No. 2, A No. 8 to A No. 22 as means of evidence and alleges that, since the Appellant has continuously sold the joint box of the trademark in the Application for many years, the trademark in the Application is well-known and prominent among traders who carry the joint box and should be registered according to Article 3(2) of the Trademark Act.

Therefore, whether or not the trademark in the Application meets the requirements of the Article will be examined below.

(1) Regarding Article 3(2) of the Trademark Act

In a case where the trademark claimed in an application falls under Articles 3(1)(iii) to 3(1)(v) of the Trademark Act as a mark indicating the quality and the like of the designated goods, whether or not the trademark falls under the Articles 3(2) of the same Act and is registered should be determined according to whether or not the trademark can be recognized as a trademark by which consumers are able to recognize the goods (services) as being connected with a certain person's business as a result of usage of the trademark in the Application in comprehensive consideration of the trademark in use and the goods (services), a usage start time and a use period of the trademark, a region of use, the sales volume of the goods (services), and the method and the number of times of advertisements. In this case, it should be said that the used trademark and goods (services) need to be the same as the trademark claimed in the application and the designated goods (designated services) in principle.

(2) Whether or not the trademark in the Application falls under Article 3(2) of the Trademark Act

By comprehensively considering the evidences submitted by the Appellant, it can be understood that the three-dimensional shape of the trademark in the Application is used for the product "joint box". However, the evidences that clearly indicate the 13 triangular valves bonded to the box portion entrance that is the characteristic point of the trademark in the Application are only photographs in the newspaper in Evidence A No. 8 and the magazine in Evidence A No. 16.

Then, a product using the three-dimensional shape of the trademark in the Application (referred to as "use product" below) uses a word mark of "ナイスハット

(nice hat)" (Evidence A No. 1 and A No. 2, A No. 8, A No. 16, and A No. 18).

Moreover, according to the table entitled "nice hat H type production, sales, and market share by year" in Evidence A No. 9, the sales volume and the sales revenue are 4.55 million and about 77 million yen in 1996, and the largest sales volume and sales revenue are 9.2 million and about 157 million yen in 2004 to 2006. In 2010, the sales volume and the sales revenue are 7.1 million and about 128 million yen.

In addition, the market share is 30.5% in 1996, 87.0% in 2007 that is the largest, and 76.5% in 2010.

However, the use period of the trademark in the Application is about 15 years. Furthermore, although the used product has been described in an article and the like in newspapers and magazines according to the submitted evidences, no evidence regarding the advertisements of the use product is submitted. In addition, no evidence objectively confirms the sales volume of the use product according to the trademark in the Application, and the number of trading partners and sales shops, a sales area, and the like are not obvious.

Then, the market share concerns only the number of wooden houses among new housing starts. Furthermore, although it is described that "it is said that the average number of joint boxes used for one house is about 20, ...the market share was calculated", a specific evidence of "about 20" is unclear. Therefore, it should be said that the market share lacks credibility and cannot be employed.

Furthermore, the Appellant submitted "Report - investigation regarding well-known character of electric wiring device" (Evidence A No. 19) as a questionnaire result. However, the targets only include electric facility companies and electric material distributors. Only 556 companies from among 1893 companies provided replied, and the collection rate is small at 29.4%, and the report has poor credibility. In addition, the target of the questionnaire is limited to a person who provides electric equipment work in a case of the electric facility company and to a person who knows the content of the electric wiring device in a case of the electric material distributors. Accordingly, it is considered that the targets are experts who regularly use the joint box and are familiar with a large number of joint boxes. However, a recognition rate of "Kawaguchi" or "Nice hat" from the shape of the joint box of the trademark in the Application is 69.1% in [13] in "Section 3 spreadsheet", and it cannot be acknowledged that this rate is high.

In addition, since the target of the questionnaire is an expert in the field, it is considered that the target psychologically tends to feel difficulty in answering that the target does not know the product, and it may be estimated that the answer is made based

on an investigation in the company in many cases.

Accordingly, although it is recognized that the joint box of the trademark in the Application has a certain degree of awareness, it cannot be said that the joint box of the trademark in the Application is well known.

Therefore, according to the evidences submitted by the Appellant, it cannot be acknowledged that the trademark in the Application is widely recognized by consumers as the mark related to the business of the Appellant as a result of the usage of the trademark in the Application in the designated goods.

(3) Summary

Therefore, according to the evidences submitted by the Appellant, it cannot be acknowledged that the trademark in the Application is a trademark by which traders and consumers are able to recognize the goods as being connected with a certain person's business as a result of the usage of the trademark in the Application in the designated goods.

No. 4 Conclusion

As described above, the trademark in the Application falls under Article 3(1)(iii) of the Trademark Act and does not meet the requirements of Article 3(2). Therefore, the trademark in the Application cannot be registered.

Therefore, the appeal decision shall be made as described in the conclusion.

August 27, 2012

Chief administrative judge: MIZUGUKI, Wataru
Administrative judge: IDE, Eiichiro
Administrative judge: MATSUDA, Noriko

Attachment (the trademark in the Application)

FIG. 1

FIG. 2

FIG. 3

FIG. 4

FIG. 5