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3D Trademark of "Hiyoko" Invalidated as Too Common a Shape: IP-High Court

The Intellectual Property High Court (IP-High Court), on November 29, gave its decision on a case filed by a Japanese confectionary company Nikakudou (Fukuoka City) against HIYOKO Co., Ltd. (Fukuoka City), seeking to invalidate the 3D trademark of "Hiyoko (baby chick)", a confection produced and sold by HIYOKO.

A 3D trademark is a trademark of a three dimensional figure such as a doll displayed at a storefront. HIYOKO applied for registration of its leading product "Hiyoko" as a 3D trademark. The application was approved in 2003.

After the registration, HIYOKO filed a complaint with the Fukuoka District Court in March 2004, demanding Nikakudou to cease its production and marketing of "Nikakuno Oyako (Nikaku Family)", alleging that the resembling shape of the confection infringes the Trademark of "Hiyoko". In response to this, Nikakudou requested JPO to invalidate the registered trademark, asserting that the shape of "Hiyoko" lacks originality and uniqueness. JPO, however, ruled against Nikakudou in August 2005, noting that, despite its unoriginal shape, the past achievement in advertisement and marketing of "Hiyoko" allows the consumers and the trading partners to distinguish "Hiyoko" from the other confections, and the registration of "Hiyoko" is therefore valid. This ruling lead Nikakudou to filing of an appeal for invalidation of the trademark registration with the IP- High Court.

The presiding judge Mr. Nakano overturned JPO's decision, saying that "the shape of 'Hiyoko' is simple, and there are 23 confectionary companies throughout Japan who produce and market closely-resembling products that are hardly distinguishable from 'Hiyoko'. The past achievement of 'Hiyoko' in advertisement and marketing is attributed to not only the shape of the cake, but also to the accompanied character trademark. Thus, it is not acknowledged that the shape of 'Hiyoko' alone could make the confection distinguishable from the other resembling products."

Governmental Task Force for IP Strategy Establishes General Scheme for Promoting Activities for International Standards

The governmental task force of IP-Strategy held its Head Quarters meeting on December 6, at the office of Prime Minister, to officially determine "General Scheme for International Standards" for enhancing Japan's activities regarding international standard from the view point of: promotion of innovations, strengthening the nation's global competitiveness, and contribution to establishment of worldwide rules.

Listed below are five specific activities for contributing to establishment of fair rules in international standardization:

- (1) Encouraging businesses to autonomously participate in establishing of international standards, by (i) raising awareness of business owners regarding international standards, (ii) strengthening organization control of businesses, (iii) encouraging businesses to strategically utilize various international standardization schemes;
- (2) Promoting the nation's activities in international standardization, by (i) proactively undertaking the role as a chairperson in an international standardization organization, and (ii) promoting activities regarding the environment, security, and social welfare;
- (3) Developing human resources for international standardization by (i) utilizing the knowledge and know-how of those experienced in the past international standardization activities, and (ii) supporting universities and the like to provide education on standardization;
- (4) Establishing "Asia Pacific Standardization Initiatives" in cooperation with Asian nations such as China and S. Korea; and
- (5) Contribution to realization of a fair and open system, and clarification of rules for handling intellectual property.

Road Map to Mutual Use of Patent Information Amongst Japan, China, and S. Korea, List of Collaborative Activities Announced

Patent offices of Japan, China, and S. Korea drafted a road map of their collaborative activities to allow mutual use of information regarding prior art search and patent examinations amongst these three nations. Listed as the activities are establishment of a system that allows the three nations to exchange electronic data of examination result and the like, and interchanges of the Examiners of the three nations.

As to the exchanging of electronic data of prior art search and examination results, documents written in the respective languages will be translated into English via machine translation, for the purpose of sharing information amongst the three nations. This is already realized in November 2006 between Japan and S. Korea who are now to cooperate with China to establish a system to translate Chinese documents into English. In regard to interchanges of the Examiners, the Examiners of three nations will all participate in an examination of a single case, to confirm the differences in their examination results.

In addition to the drafting of the road map, the three nations also agreed to implement, for each technical field, an investigation into the nationality of applicants. This is to find out, on a field-by-field basis, which nation is more proactively filing patent applications. Moreover, the items of disclosed patent-related information pieces will be uniformalized to allow easier comparison of conditions amongst the three nations. In order to achieve this, China will be urged to disclose information regarding patent examination results and the like.

These collaborative activities will allow mutual use of the examination results amongst the patent offices of the three nations, and are expected to bring forth an advantageous effect of streamlining work needed for processing an increasing number of applications. The activities are also expected to yield advantageous effect for Japanese businesses that an invention patented in Japan will be promptly examined in China and S. Korea.

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Please acknowledge that the purpose of our column is to provide general information on the field of intellectual property, and that the description here does not represent our legal opinion on a specific theme.

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