

Trademark Right	Date	September 16, 2020	Court	Intellectual Property High Court, Fourth Division
	Case number	2019 (Gyo-Ke) 10170		
<p>- A case in which the court determined that the registered trademark held by the Defendant (the characters, "BULLPULU TAPIOCA," with a design) is not similar to the Cited Trademark held by the Plaintiff (the characters, "STARBUCKS COFFEE," with a design) and therefor it does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act, and also determined that the Defendant's registered trademark is not a trademark that is likely to cause confusion with the goods and services pertaining to the Plaintiff's business (for which the same trademark as the Cited Trademark is used) and therefore it also does not fall under Article 4, paragraph (1), item (xv) of the Trademark Act.</p> <p>- A case in which the court did not adopt the results of the internet questionnaire survey submitted as proof of the well-knownness of the components of the Cited Trademark, on the grounds that the investigation method applied to conduct the survey was inappropriate.</p>				

Case type: Rescission of Trial Decision to Maintain

Result: Dismissed

References: Article 4, paragraph (1), items (xi) and (xv) of the Trademark Act

Related rights, etc.: Registration No. 5903256, Registration No. 4806987

Decision of JPO: Invalidation Trial No. 2017-890065

### Summary of the Judgment

1. The Plaintiff that engages in the coffee chain business filed a request for a trial for invalidation of the registration of the trademark shown left below, which is held by the Defendant that engages in the business of sale, etc. of beverages with tapioca, etc. (the "Trademark"; designated goods, etc.: Class 29 "milk products with tapioca," etc.), while presenting the trademark shown right below (the "Cited Trademark"; designated goods, etc.: Class 30, "coffee-based beverages," etc.) as the cited trademark and the trademark as used. In response to the Plaintiff's request, the JPO rendered a decision to maintain the registration of the Trademark.

[Trademark]



[Cited Trademark]



2. In this judgment, the court dismissed the Plaintiff's claim, holding as follows. [i] Although the Cited Trademark was famous as a mark indicating the goods and services pertaining to the Plaintiff's business at the time of the filing of the application for registration and at the time of the decision of registration of the Trademark, the Composition with the Green Ring (the "composition with a green double ring with characters and figures written in white in a belt-like area of the inner ring"), which is a component of the Cited Trademark, cannot itself be found to have been well-known and famous. [ii] According to the results of the internet questionnaire survey (the "Questionnaire Survey") conducted to investigate the percentage of people who would be reminded of the Plaintiff upon seeing the Mark, those who were reminded of the Plaintiff accounted for a large percentage; however, the explanation attached to the questions was inappropriate as an investigation method for reasons such as that it leads consumers, by means of texts, into recognizing what they would not be able to visually recognize or think of upon seeing the Mark, and therefore the results of the Questionnaire Survey cannot be adopted. [iii] Given the above, the Composition with the Green Ring cannot be found to be capable of independently functioning as a mark that can distinguish the trademark holder's goods and services from those of others. [iv] The set of characters, "BULLPULU," which serves as the primary part of the Trademark, and the set of characters, "STARBUCKS," which serves as the primary part of the Cited Trademark, are different in all of the aspects of appearance, pronunciation, and concept, and therefore, these trademarks are not similar to each other and the Trademark does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act. [v] Since the set of characters, "BULLPULU," which serves as the primary part of the Trademark, and

the set of characters, "STARBUCKS," which serves as the primary part of the Cited Trademark, are different in all of the aspects of appearance, pronunciation, and concept, it cannot be found that there is a likelihood that consumers would pay attention to the Composition with the Green Ring and think of the Cited Trademark, and that they then would be confused as to the source of the goods or services, by considering the goods or services carrying the Trademark to be the Plaintiff's goods or services or the goods or services related to the business of a party that has some economic or organizational relationship with the Plaintiff, and therefore the Trademark also does not fall under Article 4, paragraph (1), item (xv) of the Trademark Act.

[Mark]



Judgment rendered on September 16, 2020

2019 (Gyo-Ke) 10170 Case of seeking rescission of the JPO decision

Date of conclusion of oral argument: August 5, 2020

### Judgment

Appellant: Starbucks Corporation

Appellee: Kabushiki Kaisha Bull Pulu

(Name used at the time of the JPO decision: Kabushiki Kaisha J • J)

### Main text

1. The Plaintiff's claim shall be dismissed.
2. The Plaintiff shall bear the court costs.
3. The additional period for filing a final appeal and a petition for acceptance of final appeal against this judgment shall be set as 30 days.

### Facts and reasons

#### No. 1 Claim

The decision made by the JPO on August 21, 2019, for the case of Invalidation Trial No. 2017-890065 shall be rescinded.

#### No. 2 Outline of the case

##### 1. Outline of procedures at the JPO

(1) The Defendant is the holder of the trademark right for the trademark indicated below, with Trademark Registration No. 5903256 (hereinafter referred to as the "Trademark") (Exhibits Ko. 1, 63 and 64).

Composition of the trademark: As indicated in Attachment 1

Date of application for registration: March 9, 2016

Date of decision of registration: November 1, 2016

Date of registration of establishment: December 9, 2016

Designated goods

Class 29: Milk products with tapioca

Class 30: Coffee with tapioca, cocoa with tapioca, confectionary with tapioca, tapioca, tapioca flour for food

Designated services

Class 43: Providing foods and beverages

(2) On September 15, 2017, the Plaintiff filed a request for a trial for invalidation of the registration of the Trademark.

The JPO conducted the trial proceedings in response to this request as the case of Invalidation Trial No. 2017-890065, and rendered a decision on August 21, 2019, to the effect that the trademark registration shall be maintained (giving the statute of limitations of 90 days; hereinafter referred to as the "JPO Decision"). The certified copy of the JPO Decision was served upon the Plaintiff on August 29, 2019.

(3) On December 19, 2019, the Plaintiff filed this lawsuit to seek the rescission of the JPO Decision.

## 2. Summary of the reasons for the JPO Decision

The reasons for the JPO Decision are as stated in the attached written decision (copy).

The summary of the reasons is as follows. [i] The trademark (hereinafter the trademark may be referred to as the "Trademark Used by the Plaintiff") which has the same composition as the trademark with Registration No. 4806987 indicated in Attachment 2 (hereinafter referred to as the "Cited Trademark"; Exhibit Ko 2) had been used in Japan as the Plaintiff's house mark since 1996 until when it was changed in April 2011, and at that time, it had been widely recognized among traders and consumers as a mark indicating the Plaintiff's goods such as coffee, cocoa, milk products, and confectionary and its service of providing these goods (hereinafter these goods and service may be referred to as the "Plaintiff's goods and services"). However, the Trademark Used by the Plaintiff cannot be deemed to have maintained its well-knownness at the time when the application for registration was filed and at the time when the decision to register was made with regard to the Trademark about five years after the change of that house mark, and the Trademark Used by the Plaintiff and the "composition with a green double ring with characters and figures written in white in a belt-like area of the inner ring" adopted for the trademark used by the Plaintiff cannot be found to have been widely recognized among traders and consumers in Japan as a mark indicating the goods and services pertaining to the Plaintiff's business at each of those points in time. [ii] The Trademark and the Cited Trademark have in common that they both have a figure of a green double ring, but in light of their respective compositions and conditions, it should be said that in either of these trademarks, this figure part is not indicated in a manner that it alone is particularly emphasized and therefore it is not seen or understood with a visually strong impression. It can hardly be said that said figure part independently functions as a mark which can distinguish the trademark holder's goods and services from those of others and contributes to trading, and both trademarks should be regarded as trademarks that are not similar to each other in that they are unlikely to be confused with

each other in any of the aspects of appearance, pronunciation, and concept. Consequently, the Trademark does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act. [iii] As mentioned in [i] above, it cannot be said that the Trademark Used by the Plaintiff and the "composition with a green double ring with characters and figures written in white in a belt-like area of the inner ring" adopted for the Trademark Used by the Plaintiff were widely recognized among consumers as a mark indicating the goods and services pertaining to the Plaintiff's business at the time of the filing of the application for registration or the time of the decision of registration of the Trademark. Further as mentioned in [ii] above, the Trademark and the Cited Trademark are not similar to each other, and similarly, the Trademark and the Trademark Used by the Plaintiff are not similar to each other and the degree of similarity between them is low. Therefore, even when the Trademark is used for its designated goods and services, it would not make consumers, upon seeing it, associate it with the Trademark Used by the Plaintiff or remind them of the Trademark Used by the Plaintiff, and there is no likelihood that the Trademark would cause confusion as to the source of the goods or services, as if indicating that the goods or services carrying the Trademark are the Plaintiff's goods or services or the goods or services related to the business of a party that has some economic or organizational relationship with the Plaintiff. Consequently, the Trademark does not fall under item (xv) of that paragraph.

(omitted)

No. 4 Judgment of this court

1. Regarding Ground for Rescission 1 (Error in the determination on whether the Trademark falls under Article 4, paragraph (1), item (xi) of the Trademark Act)

(1) Facts found

Based on the facts and evidence (Exhibits Ko 3, 4, 6, 7, 11, 13, 18, 65 and 66 (including evidence with branch numbers)) mentioned in No. 2, 1. above and the entire import of oral arguments, the following facts can be found.

A. Status of use of the Trademark Used by the Plaintiff

(A) The Plaintiff is a US corporation that opened the first "Starbucks Coffee" store in Seattle, the State of Washington, the United States, in 1971.

In October 1995, the Plaintiff's subsidiary and a food and drink service company in Japan founded Starbucks Coffee Japan, Ltd. (hereinafter referred to as "Starbucks Coffee Japan") as a venture business.

After opening Japan's first "Starbucks Coffee" store in Tokyo in 1996, Starbucks

Coffee Japan launched stores nationwide, and the number of its stores in Japan as of the end of March 2011 reached 912 (Exhibit Ko 3-2). By around that time, "Starbucks Coffee" had become a nationwide coffee chain in Japan. After that, Starbucks Coffee Japan continued the launch of "Starbucks Coffee" stores, and the number of its stores in Japan as of the end of June 2016 reached 1198 (Exhibit Ko 3-2).

"Starbucks Coffee" sells and offers various kinds of beverage, mainly coffee, and confectionary, bread, and other goods (Exhibits Ko 3-3 and 4).

(B) The Trademark Used by the Plaintiff, which has the same composition as the Cited Trademark indicated in Attachment 2, was adopted as the Plaintiff's house mark in 1992 (Exhibit Ko 18). In Japan, it had been used since the time of the opening of the first "Starbucks Coffee" store in 1996, in such manner as putting it on the store signs and information boards at each chain store and on the containers and the like used to offer goods at the store, such as coffee cups and plastic containers (Exhibit Ko 4, etc.).

Furthermore, from September 2005, the chilled cup coffee drinks in the containers carrying the Trademark Used by the Plaintiff started to be sold at convenience stores in Tokyo, Kanagawa, Chiba and Saitama (Exhibit Ko 6-17, etc.), and subsequently, in June 2011, the new lines of chilled cup coffee drinks in the containers carrying the Trademark Used by the Plaintiff started to be sold at convenience stores nationwide except for Okinawa Prefecture (Exhibit Ko 3-2).

During this period, the Plaintiff filed an application for registration of trademark regarding the Cited Trademark on March 8, 2002, and had the establishment of the trademark right for that trademark registered on October 1, 2004.

(C) In April 2011, the Plaintiff changed its house mark from the Trademark Used by the Plaintiff to the mark indicating a figure of a woman wearing a crown depicted in white on the background of a green circle (hereinafter this may be referred to as the "Plaintiff's New Mark"; Exhibit Ko 18). The figure in the Plaintiff's New Mark has the same composition as the figure of a woman wearing a crown depicted in white on the background of a black circle at the center of the Cited Trademark, except for being colored in green.

Since around April 2011, each "Starbucks Coffee" chain store has used the Plaintiff's New Mark by putting it on the store signs and containers and the like such as coffee cups and plastic containers (Exhibits Ko 3-3 to 5, etc.).

On the other hand, even after the change of the Plaintiff's house mark, the store signs carrying the Cited Trademark (Exhibit Ko 13) were used at Starbucks Coffee Musashisakai Ito Yokado (as of March 2015), Juntendo University Hospital (as of January 2016), Kobe Kitano Ijinkan (as of April 2016), Naogoya Fushimi AT Bldg. (as of April

2016), and Kokusai Shin-Akasaka Bldg. (as of July 2016).

At the event for celebrating the 20th anniversary of the launch of the Plaintiff's business in Japan, which was held in Tokyo in August 2016 (Exhibit Ko 65), goods such as coffee cups, bottles, and tote bags carrying the Cited Trademark were displayed and sold.

#### B. Questionnaire Survey

(A) The Questionnaire Survey (Exhibit Ko 11) was conducted in the following manner. For the purpose of verifying the famousness of the Mark, which constitutes the "green ring part" (with the characters and signs rendered illegible) contained in the Cited Trademark, the Plaintiff requested "NERA Economic Consulting" to conduct a survey on the internet for two days on Friday, July 21 and Saturday, July 22, 2017, targeting 552 men and women aged 20 to 69 living in Japan. The survey aimed at investigating the percentage of people who would be reminded of "Starbucks" upon seeing the image of the Mark, thereby investigating the degree of recognition of the Mark.

The Questionnaire Survey asked questions in the following manner to 552 persons who were selected at random from among members of the survey panel maintained and managed by GMO Research, Inc., after being grouped by gender, age, and residential area: [i] The Questionnaire Survey first showed the image of the Mark indicated in Attachment 3, attaching the explanatory texts, "This image is created by processing a part of the design used for the facilities at the stores operated by a company and for the goods sold at these stores," and "The original design had a picture at the center of the circle and the white characters indicating the company's name were displayed on the green ring part, but in the image shown below, the picture is painted out in white and the characters are pixelated so that the company's name cannot be read," and then the Questionnaire Survey asked, "Upon seeing this image, what company or store did you think of? Please write the name of the company or store you thought of in the answer column below. If you are not sure, please write 'Not sure' in the column" (hereinafter referred to as the "first question"); [ii] next, the Questionnaire Survey showed the image of the Mark, attaching the explanatory texts, "This image is actually created by processing a part of the design used for the facilities at the stores operated by a company in the food service industry and for the goods sold at these stores," "As mentioned earlier, the original design had a picture at the center of the circle and the white characters indicating the company's name were displayed on the green ring part, but also in the image shown below, the picture is painted out in white and the characters are pixelated so that the company's name cannot be read," and then the Questionnaire Survey asked, "Upon seeing this image, what company or store in the food service industry did you think of? Please write the name of the company



or store you thought of in the answer column below. The previous question did not provide information that the company or store is 'in the food service industry,' so you can give an answer that is different from your answer to the previous question. Please write the name of the company or store you think of as it is. If you are not sure, please write 'Not sure' in the column" (hereinafter referred to as the "second question"); [iii] then, the Questionnaire Survey further showed the image of the Mark, attaching the explanatory texts, "This image is actually created by processing a part of the design used for the facilities at the stores operated by a coffee shop company and for the goods sold at these stores," "As mentioned earlier, the original design had a picture at the center of the circle and the white characters indicating the company's name were displayed on the green ring part, but also in the image shown below, the picture is painted out in white and the characters are pixelated so that the company's name cannot be read," and then the Questionnaire Survey asked, "Upon seeing this image, what coffee shop company or store did you think of? Please write the name of the company or store you thought of in the answer column below. The previous two questions did not provide information that the company or store is a 'coffee shop company or store,' so you can give an answer that is different from your answers to the previous questions. Please write the name of the company or store you think of as it is. If you are not sure, please write 'Not sure' in the column" (hereinafter referred to as the "third question"). Following the third question, the survey asked questions, "Have you used coffee shops in the past one year?" and "Will you use coffee shops for the coming one year?" which were supposed to be answered by selecting options.

(B) The results of the Questionnaire Survey were as follows. In response to the first question asked without limiting the type of business of the company that uses the Mark, 429 respondents (77.72%) answered "Starbucks." In response to the second question asked by having the respondents given an answer stating the name of the company that uses the Mark from among companies in the food service industry, 393 respondents (71.20%) answered "Starbucks." In response to the third question asked by having the respondents give an answer stating the name of the company that uses the Mark from among coffee shops, 463 respondents (83.88%) answered "Starbucks." The percentage of respondents who answered "Starbucks" was the largest for all of these questions.

When limiting the Questionnaire Survey answers to be tallied to those given by coffee shop users (the respondents to the survey: except for those who have not used coffee shops over the past one year and those who are not expected to use coffee shops in the coming one year), the percentage of those who answered "Starbucks" was 81.99% in the first question, 76.34% in the second question, and 88.44% in the third question,

respectively.

(2) Regarding whether there was an error in the determination on the well-knownness of the Cited Trademark

The Plaintiff alleges as follows. The Cited Trademark maintained its well-knownness at the time when the application for registration was filed and at the time when the decision to register was made with regard to the Trademark after the change of the Plaintiff's house mark in April 2011. According to the results of the Questionnaire Survey, it can be said that the Composition with the Green Ring (the "composition with a green double ring with characters and figures written in white in a belt-like area of the inner ring") in the Cited Trademark was widely recognized among consumers as a mark indicating the goods and services pertaining to the Plaintiff's business at the time of the filing of the application for registration and the time of the decision of registration of the Trademark, and thus said composition was well-known and famous. Therefore, the JPO Decision that determined to the contrary was erroneous. Based on these allegations, the court makes determination below.

A. Regarding the composition and condition of the Cited Trademark

As indicated in Attachment 2, the Cited Trademark is a composite trademark which is composed of a thin green ring, a thin white ring, a thick green belt-like ring, and a thin white ring arranged in this order from the outside to the inside, and which consists of: [i] the ring part, in which white stars are placed left and right inside the thick green belt-like ring, with the white alphabetic characters "STARBUCKS" written in the upper part and "COFFEE" written in the lower part along the circular arcs (hereinafter this part may be referred to as the "Ring Part"); and [ii] the figure part, in which a woman wearing a crown with a star at the top is depicted in white inside the black circle at the center of the inside of the Ring Part (hereinafter referred to as the "Figure Part").

The Composition with the Green Ring (the "composition with a green double ring with characters and figures written in white in a belt-like area of the inner ring") in the Cited Trademark argued by the Plaintiff is not regarded as specific components of the Cited Trademark but it is regarded as the composition and layout of the elements extracted from the Ring Part as generic concepts.

B. Regarding the status of use of the Trademark Used by the Plaintiff

(A) According to the facts found as mentioned in (1) A. above, it is found that: [i] "Starbucks Coffee" is a coffee chain brand operated by the Plaintiff, which originated in the United States; [ii] during the period from 1992 to March 2011, the Plaintiff used the Trademark Used by the Plaintiff which has the same composition as the Cited Trademark (hereinafter both the Trademark Used by the Plaintiff and the Cited Trademark are

referred to as the "Cited Trademark" without distinction) as the Plaintiff's house mark; [iii] Starbucks Coffee Japan, which was founded by the Plaintiff's subsidiary, etc., launched coffee chain stores under the "Starbucks Coffee" brand in Japan from 1996, and the number of these stores nationwide was 912 as of the end of March 2011; [iv] the Cited Trademark was put on the store signs and information boards at these stores and on the containers and the like used to offer goods at the stores, such as coffee cups and plastic containers, and in June 2011, the chilled cup coffee drinks in the containers carrying the Cited Trademark were being sold at convenience stores nationwide except for Okinawa Prefecture.

Based on these facts, it is found that at the end of March 2011, the Cited Trademark was widely recognized among general consumers in Japan as a mark indicating the goods and services pertaining to the Plaintiff's business (coffee, cocoa, milk products, confectionary, etc. and providing these goods; the same applies hereinafter), and that its recognition reached the level of being famous, and thus, the Cited Trademark is found to have become famous at that time.

Meanwhile, [i] in the composition of the Cited Trademark, the Ring Part and the Figure Part can be observed separately, and [ii] the whole set of the characters, "STARBUCKS" and "COFFEE," written in white inside the thick green belt-like ring in the Ring Part produces the sound, "sutābakkusu kōhī," and the entire area of the Ring Part is clearly demarcated by the outer thin green ring and the inner thin white ring, and it is found that the appearance of the Ring Part as a whole would easily remain in people's memory. Accordingly, it can be said that the Ring Part, which is in the composition of the Cited Trademark, can as a whole give a strong impression to consumers.

However, the Composition with the Green Ring (the "composition with a green double ring with characters and figures written in white in a belt-like area of the inner ring") in the Cited Trademark argued by the Plaintiff is not the specific components of the Cited Trademark but it is the composition and layout of the elements extracted from the Ring Part as generic concepts. In that case, compositions in which the white characters written inside the green belt-like ring are not "STARBUCKS" and "COFFEE" or the white figures are not stars would also be regarded as the Composition with the Green Ring. However, it is difficult to find that consumers, upon seeing the Cited Trademark, would form an image of the composition and layout of these elements extracted as generic concepts and such image would remain in their memory.

(B) It follows that the Composition with the Green Ring in the Cited Trademark cannot be found to have been widely recognized among consumers as a mark indicating the goods and services pertaining to the Plaintiff's business immediately because the Cited

Trademark was famous at the end of March 2011.

Nor can the Composition with the Green Ring be found to have been widely recognized among consumers as a mark indicating the goods and services pertaining to the Plaintiff's business at the time when the application for registration was filed (the date of application for registration: March 9, 2016) and at the time when the decision to register was made (the date of decision of registration: November 1, 2016) with regard to the Trademark, which are dates about four years after the aforementioned point in time.

#### C. Regarding the Questionnaire Survey

(A) The Plaintiff alleges as follows. [i] The respondents of the Questionnaire Survey were selected by an appropriate method. [ii] The Questionnaire Survey was conducted on the internet on two days at the weekend and the survey period was not particularly short. [iii] The number of samples in the Questionnaire Survey, 552, was reasonable for ensuring the reliability of a questionnaire survey. [iv] Even if the survey was conducted by showing a green double ring, the results obtained from the survey would not reflect the actual recognition of consumers, who see the Plaintiff's trademarks including the Cited Trademark in their daily lives, and therefore, in order to properly assess consumers' recognition of the Composition with the Green Ring, it was necessary to ask questions about the Mark and indicate the aforementioned instructions, and hence, the questions asked in the Questionnaire Survey were appropriate. [v] The Questionnaire Survey was conducted in 2017, one year after the time of the filing of the application for registration and the time of the decision of registration of the Trademark, and the results of the Questionnaire Survey can be deemed to reflect consumers' recognition at each of these points in time, and thus, the Questionnaire Survey was conducted appropriately and the results of the Questionnaire Survey demonstrate that the Composition with the Green Ring was well-known and famous at each of those points in time.

(B) According to the facts found as mentioned in (1) B. above, it is found that: the Questionnaire Survey was conducted for the purpose of verifying the famousness of the Mark, which constitutes the "green ring part" (with the characters and signs rendered illegible) contained in the Cited Trademark by way of showing the image of the Mark to the respondents, while attaching the explanatory texts representing that the image was created by processing a part of the design used for the facilities at the stores operated by "a company," "a company in the food service industry," or "a coffee shop company" and for the goods sold at these stores and that the original design had a picture at the center of the circle and the white characters indicating the company's name were displayed on the green ring part, but in the image of the Mark, the picture is painted out in white and the characters are pixelated so that the company's name cannot be read, and then asking,

"Upon seeing this image, what company or store did you think of? Please write the name of the company or store you thought of in the answer column below. If you are not sure, please write 'Not sure' in the column."

As mentioned in B. (A) above, the Composition with the Green Ring in the Cited Trademark argued by the Plaintiff is the composition and layout of the elements extracted from the Ring Part as generic concepts. In light of the fact that it is difficult to find that consumers, upon seeing the Cited Trademark, would form an image of the composition and layout of these elements extracted as generic concepts and such image would remain in their memory, it would be difficult in nature to appropriately investigate the degree of recognition or famousness of the Composition with the Green Ring.

As indicated in Attachment 3, the Mark consists of a doughnut-shaped figure composed of a thin green ring, a thin white ring, and a thick green belt-like ring with white mosaic patterns arranged in this order from the outside to the inside, and the Mark and the Ring Part in the Cited Trademark have in common that they both have a doughnut shape having a thin green ring, a thin white ring, and a thick green belt-like ring, but they are different marks in terms of the composition and condition of the inside of the thick green belt-like ring and the presence or absence of the inner thin white ring. In light of these aspects, it cannot be found that the Mark would remind people of the Ring Part, nor can it be found that people would recognize the Composition with the Green Ring from the Mark. In this respect, the Questionnaire Survey attached the explanatory texts representing that the original design had a picture at the center of the circle and that the white characters indicating the company's name were displayed on the green ring part, but in the image of the Mark, the picture is painted out in white and the characters are pixelated so that the company's name cannot be read. This explanation is inappropriate because it leads consumers, by means of texts, into recognizing what they would not be able to visually recognize or think of upon seeing the Mark.

It follows that the Questionnaire Survey cannot be found to be an appropriate method for investigating the degree of recognition or famousness of the Composition with the Green Ring, and therefore, the Plaintiff's allegations mentioned above are groundless.

#### D. Conclusion

According to the above, it can be found that the Cited Trademark was famous as a mark indicating the goods and services pertaining to the Plaintiff's business at the end of March 2011, and that the Ring Part, which is in the composition of the Cited Trademark, could as a whole give a strong impression to consumers; however, despite this fact and the results of the Questionnaire Survey, it cannot be found that the Composition with the Green Ring in the Cited Trademark was widely recognized among consumers as a mark

indicating the goods and services pertaining to the Plaintiff's business at the time of the filing of the application for registration and the time of the decision of registration of the Trademark and that it was well-known and famous. There is no other evidence sufficient to find such fact.

Consequently, the Plaintiff's allegations mentioned above are unacceptable.

(3) Regarding whether there was an error in the determination on the similarity between the Trademark and the Cited Trademark

A. Regarding the Trademark

As indicated in Attachment 1, the Trademark is a composite trademark which is composed of a thin green ring, a thin white ring, and a thick green belt-like ring arranged in this order from the outside to the inside, and which consists of: [i] the ring part, in which white circles are placed left and right inside the thick green belt-like ring, with the white alphabetic characters "BULLPULU" written in the upper part and "TAPIOCA" written in the lower part along the circular arcs; and [ii] the figure part, in which a figure of a dog is placed at the center of the inside of the ring part and the shadow of the dog is placed to the left of the dog.

In the composition of the Trademark, the set of characters, "BULLPULU" and "TAPIOCA," which are written inside the thick green belt-like ring, can be observed separately from other components. The Trademark produces the sound, "burupurutapioka," corresponding to this set of characters as a whole, and it also produces the sound, "burupuru," corresponding to the characters "BULLPULU."

The set of characters, "BULLPULU," represents a word that is not found in a dictionary or the like. Furthermore, the set of characters, "TAPIOCA," represents a word that is familiar in Japan as a word meaning "tapioca" (a starch made of cassava roots, used for food or glue), and in connection with the designated goods and services of the Trademark, the set of characters, "TAPIOCA," indicates the quality of the goods and services and it does not function as a mark that can distinguish the trademark holder's goods and services from those of others, or its function as such mark is extremely weak. Hence, it is appropriate to find that the set of characters, "BULLPULU," is capable of independently functioning as a mark that can distinguish the trademark holder's goods and services from those of others.

Accordingly, it is allowable to extract the set of characters, "BULLPULU," from the composition of the Trademark as its primary part and compare this part with the Cited Trademark to determine whether the Trademark is similar to the Cited Trademark.

B. Regarding the Cited Trademark

As mentioned in (2) A. above, the Cited Trademark is a composite trademark

consisting of the Ring Part and the Figure Part.

In the composition of the Cited Trademark, the set of characters, "STARBUCKS" and "COFFEE," which are written inside the thick green belt-like ring in the Ring Part, can be observed separately from other components. The Cited Trademark produces the sound, "sutābakkusu kōhī," corresponding to this set of characters as a whole, and it also produces the sound, "sutābakkusu," corresponding to the characters, "STARBUCKS," and gives rise to the concept of "Starbucks Coffee (as the Plaintiff's brand name)."

While the set of characters, "STARBUCKS," represents a word that is not found in a dictionary or the like, the set of characters, "COFFEE," represents a word that is familiar in Japan as a word meaning "coffee," and in connection with some of the designated goods and services of the Cited Trademark, the set of characters, "COFFEE," indicates the quality of the goods and services and it does not function as a mark that can distinguish the trademark holder's goods and services from those of others, or its function as such mark is extremely weak. Hence, it is appropriate to find that the set of characters, "STARBUCKS," are capable of independently functioning as a mark that can distinguish the trademark holder's goods and services from those of others.

Accordingly, it is allowable to extract the characters, "STARBUCKS," from the composition of the Cited Trademark as its primary part and compare this part with the Trademark to determine whether the Cited Trademark is similar to the Trademark.

#### C. Regarding the similarity between the Trademark and the Cited Trademark

(A) Comparing the set of characters, "BULLPULU," which serves as the primary part of the Trademark, and the set of characters, "STARBUCKS," which serves as the primary part of the Cited Trademark, in light of the facts found as mentioned in A. and B. above, these sets of characters are different in all of the aspects of appearance, pronunciation, and concept.

It follows that, even when the Trademark and the Cited Trademark are used for the designated goods or services of the Trademark, they are not found to be likely to mislead people or cause confusion as to the source of the goods or services, and therefore, the Trademark and the Cited Trademark as a whole cannot be found to be similar to each other.

(B) Contrary to this, the Plaintiff alleges that the Trademark and the Cited Trademark as a whole are similar to each other, on the following grounds: [i] the fact that in the Questionnaire Survey, more than 80% of the respondents were reminded of the Plaintiff by the Mark demonstrates that in the Cited Trademark, not only the set of characters, "STARBUCKS," but also the Composition with the Green Ring (the "composition with a green double ring with characters and figures written in white in a belt-like area of the

inner ring") is capable of functioning as a mark that can distinguish the trademark holder's goods and services from those of others; [ii] in view of the fact that the Trademark has appearance in common with the Cited Trademark in that they both have the Composition with the Green Ring, and that with regard to the Trademark as well, not only the set of characters, "BULLPULU," but also the Composition with the Green Ring is capable of functioning as a mark that can distinguish the trademark holder's goods and services from those of others; and [iii] considering that the Trademark and the Cited Trademark have common appearance in that they both have the Composition with the Green Ring and they are also identical with or similar to each other in terms of concept, and that the overall visual composition of each trademark gives a stronger impact on consumers than the difference in details, such as the difference in the characters and the figure at the center part, it can be said that when the Trademark and the Cited Trademark are used for the designated goods or services of the Trademark, they are likely to cause confusion as to the source of the goods or services.

However, as explained in (2) D. above, the Composition with the Green Ring in the Cited Trademark cannot be found to have been widely recognized among consumers as a mark indicating the goods and services pertaining to the Plaintiff's business at the time of the filing of the application for registration or the time of the decision of registration of the Trademark, and therefore the Composition with the Green Ring cannot be found to be capable of independently functioning as a mark that can distinguish the trademark holder's goods and services from those of others.

Consequently, the Plaintiff's allegations mentioned above are unacceptable due to the premise they are based on.

#### (4) Summary

As described above, the Trademark cannot be found to be a trademark that is similar to the Cited Trademark, and therefore it cannot be found to fall under Article 4, paragraph (1), item (xi) of the Trademark Act.

Consequently, there is no error in the JPO Decision that determined to the same effect as above, and there is no ground regarding Ground for Rescission 1 argued by the Plaintiff.

2. Regarding Ground for Rescission 2 (Error in the determination on whether the Trademark falls under Article 4, paragraph (1), item (xv) of the Trademark Act)

(1) The Plaintiff alleges as follows. In consideration of factors such as the originality, well-knownness, and famousness of the Cited Trademark and the Composition with the Green Ring contained therein, the similarity between the Trademark and the Cited Trademark, the status of the Plaintiff's business deployment, the relevance between the goods or services, and the commonality in terms of traders, when the Trademark is used



for its designated goods or services, there is a likelihood that consumers would pay attention to the Composition with the Green Ring and think of the Cited Trademark, and that they then would be confused as to the source of the goods or services, by considering the goods or services carrying the Trademark to be the Plaintiff's goods or services or the goods or services related to the business of a party that has some economic or organizational relationship with the Plaintiff. Therefore, the Trademark falls under Article 4, paragraph (1), item (xv) of the Trademark Act, and the JPO Decision that determined to the contrary was erroneous.

However, [i] as mentioned in 1. (2) D. above, the Composition with the Green Ring in the Cited Trademark cannot be found to have been widely recognized among consumers as a mark indicating the goods and services pertaining to the Plaintiff's business at the time of the filing of the application for registration or the time of the decision of registration of the Trademark, and [ii] as explained in 1. (3) C. (A) above, the set of characters, "BULLPULU," which serves as the primary part of the Trademark, and the set of characters, "STARBUCKS," which serves as the primary part of the Cited Trademark, are different in all of the aspects of appearance, pronunciation, and concept, and even when the Trademark and the Cited Trademark are used for the designated goods or services of the Trademark, they are not found to be likely to mislead people or cause confusion as to the source of the goods or services, and therefore, the Trademark and the Cited Trademark as a whole cannot be found to be similar to each other. In light of these facts, it cannot be found that when the Trademark is used for its designated goods or services, there is a likelihood that consumers would pay attention to the Composition with the Green Ring and think of the Cited Trademark, and that they then would be confused as to the source of the goods or services, by considering the goods or services carrying the Trademark to be the Plaintiff's goods or services or the goods or services related to the business of a party that has some economic or organizational relationship with the Plaintiff.

Consequently, the plaintiff's allegations mentioned above are groundless.

(2) For the reasons stated above, the Trademark cannot be found to fall under Article 4, paragraph (1), item (xv) of the Trademark Act.

Consequently, there is no error in the JPO Decision that determined to the same effect as above, and there is no ground regarding Ground for Rescission 2 argued by the Plaintiff.

### 3. Conclusion

As described above, the grounds for rescission argued by the Plaintiff are unfounded, and the JPO Decision is not found to contain any illegality due to which it should be rescinded.

Consequently, the Plaintiff's claim shall be dismissed.

Intellectual Property High Court, Fourth Division

Presiding judge: OTAKA Ichiro

Judge: MOTOYOSHI Hiroyuki

Judge: NAKAMURA Kyo

(Attachment 1) Trademark



(Attachment 2) Cited Trademark

Registration No. 4806987

Composition of the trademark



Date of application for registration: March 8, 2002

Date of registration of establishment: October 1, 2004

Date of registration of renewal: May 20, 2014

Designated goods

Class 18: Metal fittings for bags, purse frames, industrial packaging containers of leather, clothing for domestic pets, pocket wallets, tote bags, wallets, coin purses, briefcases, bags for books, briefcase-type bags for documents, other bags, other pouches, vanity cases not fitted, umbrellas and their parts, walking sticks, canes, metal parts of canes and walking-sticks, handles for canes and walking sticks, saddlery, leather straps, rawhides, raw skins, tanned leather, fur

Class 25: Jackets, other non-Japanese style outerclothing, coats, sweaters, T-shirts, polo shirts, sweat shirts, other shirts, nightwear, shorts, other underwear, swimwear, swimming caps, Japanese traditional clothing, aprons, neck scarves, socks and stockings other than special sportswear, puttees and gaiters, fur stoles, shawls, scarves, Japanese style socks [Tabi], Japanese style socks covers [Tabi covers], gloves and mittens, babies' diapers of textile, neckties, neckerchieves, bandanas, thermal supporters, mufflers, ear muffs, hoods, sedge hat [Suge-gasa], nightcaps, helmets, headgear for wear, garters, sock suspenders, suspenders, waistbands, belts, shoes and boots (other than shoe dowels, shoe pegs, tongue or pull strap for shoes and boots, hobnails, and protective members for shoes and boots),

shoe dowels, shoe pegs, tongue or pull strap for shoes and boots, hobnails, and protective members for shoes and boots, Japanese style wooden clogs [Geta], Japanese style sandals [Zori], masquerade costumes, clothes for sports, special footwear for sports (other than horse-riding boots), horse-riding boots

Class 30: Binding agents for ice cream, meat tenderizers for household purposes, preparations for stiffening whipped cream, other aromatic preparations for food not from essential oils, tea made of herb, other tea, cocoa-based beverages, coffee-based beverages, espresso-based beverages, other coffee and cocoa, ice, muffins, scones, cookies, pastries and other baked confectionery and bread, instant confectionery mixes, instant bread mixes, chocolate, candies, ice cream, frozen confectionary, other confectionary and bread, miso, worcester sauce, meat gravies, ketchup, soy sauce, vinegar, vinegar mixes, seasoning soy sauce [Sobatsuyu], salad dressings, white sauce, mayonnaise, sauces for barbecued meat, cube sugar, fructose for culinary purposes, crystal sugar, sugar, maltose for culinary purposes, honey, glucose for culinary purposes, powdered starch syrup for culinary purposes, starch syrup for culinary purposes, table salt mixed with sesame seeds, cooking salt, roasted and ground sesame seeds, celery salt, chemical seasonings, spices, ice cream mixes, sherbet mixes, unroasted coffee beans, cereal preparations, almond paste, Chinese stuffed dumplings [Gyoza, cooked], sandwiches, Chinese steamed dumplings [Shumai, cooked], sushi, fried balls of batter mix with small pieces of octopus [Takoyaki], steamed buns stuffed with minced meat [Niku-manjuh], hamburgers, pizzas, boxed lunches consisting of rice with added meat, fish or vegetables, hot dog sandwiches, meat pies, ravioli, yeast powder, Koji [fermented malted rice], yeast, baking powder, by-product of rice [Sake lees], rice, husked oats, husked barley, flour, gluten for food

Designated services

Class 43: Providing temporary accommodation, accommodation bureaux services [hotels, boarding houses], providing food service, providing other foods and beverages, boarding for animals, preschooler and infant care at daycare centers, providing care for the elderly, rental of meeting rooms, rental of facilities for exhibitions, rental of Futon and quilts, rental of cooking equipment for industrial purposes, rental of dish drying machines for restaurants, rental of dish washing machines for industrial purposes, rental of cooking heaters, rental of kitchen worktops with integrated sinks, rental of kitchen sinks, rental of curtains, rental of furniture, rental of wall hangings, rental of floor coverings, rental of towels

(Attachment 3)

