

Latest Court Decisions

2020:

[September]

- **BULLPULU TAPIOCA Case (Cancellation Suit)**

IP High Court 2020.9.16 R1(Gyo-Ke)10170

[SUMMARY/INTRODUCTION]

A Japanese corporation in Tokyo, **K.K. Bull Pulu** (Defendant), is the proprietor of the Japanese trademark registration for “**BULLPULU/TAPIOCA**” & Dog device (right upper) for the goods and services “coffee containing tapioca etc.” in Class 30 and “providing foods and beverages” in Class 43.



A US corporation, **Starbucks Corp.** (Plaintiff) filed an invalidation trial against the BULLPULU trademark registration on the basis of the similarity to their prior registration for the well-known trademark “**STARBUCKS/COFFEE**” (right middle) (Article 4-1-11 of the TM Law) and the likelihood of confusion between the two trademarks (Article 4-1-15). Starbucks submitted the questioner survey result citing the mark in green without the words and the device in their trademark (right lower) for proving the likelihood of confusion.



However, the JPO dismissed the Starbucks’ petition because the trademarks were not similar. Then, Starbucks appealed to the IP High Court demanding cancellation of the JPO’s trial decision. What was the IP High Court decision ?

[Court Decision]

The IP High Court firstly admitted that the Starbucks’ trademark was well known in Japan as of March 2011. The Starbucks 1st shop in Japan opened in 1996 in Tokyo and at the end of March 2011, there were 912 shops. Their trademark was registered in Japan on October 1, 2004 in Classes 18, 25, 30 and 43.

On the other hand, the subject trademark “BULL PULU” was applied for registration on March 9, 2016 and was registered on December 9, 2016.

According to the questioner survey result, Starbucks insisted that the out-side green double circle component and a structure in which letters and figures were arranged in the band-shaped part of the inner circle in the Starbucks trademark were well known as well.

However, the IP High Court understood that Starbucks allegation was only about the abstract configuration and placement as extracted from the Starbucks trademark and that such configuration and placement were not actual concrete component parts of the Starbucks trademark itself. Therefore, consumers would not image such configuration and placement as a higher-level conceptualized element extracted from the Starbucks trademark when seeing the Starbucks trademark. Thus, the IP High Court denied the Starbucks' allegation.

As to the similarity between the two trademarks, the IP High Court judged that the main pronunciation of the subject trademark was "BULL PULU" while that of the Starbucks trademark was "STARBUCKS" and that these pronunciations were not confusingly similar and therefore, there was no fear of confusion.

As the result, the IP High Court dismissed the Starbucks' petition.