

Trial Decision

Revocation No. 2018-300156

Demandant	Bluen Leye Mumbae
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Demandee	Yard House USA, Inc.
Patent Attorney	INABA, Yoshiyuki
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A trial decision for revocation of the trademark with Registration No. 5377237 shall be made as follows.

Conclusion

The trademark registration No. 5377237 is cancelled.

The costs in connection with the trial shall be borne by the Demandee.

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 5377237 (hereinafter, referred to as "the Trademark") is configured as indicated in the attachment, the application for its registration was filed on July 20, 2010, and the trademark was registered on December 17, 2010 with "Provision of food and drink in restaurants and bars" of Class 43 as its designated services.

Then, a demand for trial of the case was submitted on April 2, 2018.

Further, in the trial of the case, "within three years prior to the registration of the request for the trial" stipulated in Article 50(2) of the Trademark Act is April 2, 2015 to April 1, 2018 (hereinafter, may be referred as "the period required to prove trademark

use").

No. 2 The Demandant's allegation

The Demandant requested a trial decision whose content is the same as the conclusion, summarized and mentioned reasons for request and rebuttal against a reply as follows, and submitted Evidences A No. 1 to A No. 2 as means of proof.

1 Reasons of the demand

The Trademark should be cancelled under the provision of Article 50(1) of the Trademark Act, because there is no fact that the Trademark had been used in Japan in connection with the designated services concerned for three consecutive years or longer.

2 Reasons for the request

From the facts alleged by the Demande, as described below, it cannot be said that the Demande used the Trademark or a trademark identical to the Trademark from generally accepted perspective in connection with the designated services in Japan in the period required to prove trademark use.

(1) Regarding the matter that the Demande has not proved the fact of use of the Trademark in Japan for the designated services of the Trademark

A Regarding a location to provide the designated services

"Use" of Article 50(2) of the Trademark Act is limited to use in Japan. Therefore, even when the designated services are provided using the registered trademark, if the action of providing is performed outside Japan, it does not fall under the use of Article 50(2) of the Trademark Act.

Then, when the designated services themselves are provided outside Japan, consumers cannot receive the provision of the services in Japan and it does not lead to the maintenance of business reputation in Japan of the holder of trademark right. Therefore, even if an action such as an advertisement with a registered trademark is performed for Japan for services provided outside Japan, the action does not fall under the use of the registered trademark for the designated services (Article 2(3) of the Trademark Act) (2005 (Gyo-Ke) 10095 "PAPA JOHN'S Court decision").

B Regarding the matter that the reservation page on the restaurant reservation site does not prove the fact of use

The Demande alleges use of the Trademark by the fact that consumers residing in Japan are making reservations for receiving the designated services "provision of food and drink in restaurants and bars" through the reservation page of "Yard House" Newport Beach store of the Demande which is set up on the restaurant reservation site "OpenTable". However, the store is located in the United States, and the designated

services are provided outside Japan (B No. 5). As described above, even if the reservation page containing the fact that the Trademark is used is displayed in Japanese and used by Japanese consumers, as long as the designated services are not provided in Japan, it does not fall under the use of the Trademark (including use of any of the items of Article 2(3) of the Trademark Act).

Therefore, Evidence B No. 5 does not show any use of the Trademark in Japan.

C Regarding the matter that articles posted on the Demandee's website and Facebook do not prove the fact of use

The Demandee alleges the fact of use of the Trademark, such that a mark that is identical to the Trademark from a generally accepted perspective is used on the Demandee's website (B No. 1 and B No. 6) and Facebook account (B No. 4).

However, all articles posted on the Demandee's website and Facebook are in English, and are not functioning for Japanese consumers. Even if one can access and use these sites from Japan, it is natural due to the nature of the Internet and does not show the fact of use of the Trademark in Japan (the above mentioned "PAPA JOHN'S Court decision").

Also, the restaurant bar "YARD HOUSE", which is operated by the Demandee, is chained to Honolulu, Hawaii, etc. mainly in the mainland of the United States. Therefore, the Demandee's website and Facebook account were opened in connection with the provision of the designated services outside Japan, and the use of the Trademark in these does not fall under the use of the designated service.

Further, concerning the page for signing up for the mailing list "e-Club" in the membership system provided on the Demandee's website, although the Demandee states that customers with Japanese domains are also registered as members (B. No. 7), it is considered that information provision related to events, etc. provided on the mailing list is also related to information at stores outside Japan.

Therefore, it cannot be said that the information provision is an action performed for providing the designated services in Japan.

Consequently, Evidence B No. 1, Evidence B No. 4, and Evidence B No. 6 do not show the use of the Trademark in Japan.

D Regarding the website of a third party

Concerning the websites (B No. 8 to B No. 10) operated by the travel agencies JTB, HIS, and the Japan Beer Journalists Association, the Demandee alleges that information provided on these websites is influential and reliable for travelers and the Trademarks used on these websites can be substantially regarded as exerting the function of distinguishing its services from those of others in Japan.

However, Article 50(2) of the Trademark Act prescribes that it should be used by "any of the holder of trademark right, exclusive right to use or non-exclusive right to use" and the above-mentioned companies and organizations are not the holder of trademark right of the Trademark, and a relationship with the Demandee is also unclear. Even in such a case, it is not permissible to admit the fact of use of the Trademark in Japan in consideration of the influence on consumers of the information provided by third parties.

Further, in the first place, Evidence B No. 8 to Evidence B No. 10 also cover stores outside Japan, so that those do not fall under the use of the Trademark in Japan.

Therefore, Evidence B No. 8 to Evidence B No. 10 have no effect on the determination of the presence/absence of the fact of use of the Trademark by the Demandee.

E Consequently, the use of the designated services of the Trademark alleged by the Demandee does not fall under the use of the Trademark for the designated services in Japan.

In addition, in the evidences submitted by the Demandee, there is no fact that the Trademark is used for the designated services.

No. 3 The Demandee's allegation

The Demandee replied that the Demandee demands the decision that the demand for trial of the case was groundless, and the costs in connection with the trial shall be borne by the Demandant, summarized and mentioned reasons for request as follows, and submitted Evidence B No. 1 to B No. 10 as means of evidence.

1 Outline of the fact of use

"YARD HOUSE" related to the Trademark was adopted as the name of a restaurant bar chain operated by the holder of trademark right in destination cities popular with Japanese people, such as Honolulu, Hawaii, etc. mainly in the mainland of the United States (B No. 1). The restaurant bar "YARD HOUSE" was established in 1996 in Long Beach, California. The holder of trademark right was acquired by Darden Restaurants in 2012, and which became a subsidiary of the company (B No. 2 and B No. 3).

"YARD HOUSE" offers a variety of dishes, mainly original cuisine, and there are more than 100 kinds of beer centered on craft beer. It is a popular restaurant bar where customers can sample various kinds of beer.

From 2016, since the parent company Darden Restaurants has signed a contract with the operating company of the restaurant reservation site "OpenTable" to use the company's reservation system using the Internet, the restaurant bar "YARD HOUSE" has

accepted reservations for restaurant seats through the reservation site "OpenTable" (B No. 4), and reservation from outside the United States has become extremely convenient, which contributes to an increase in users.

The reservation site "OpenTable" also operates a Japanese site targeting Japanese consumers; consumers residing in Japan can easily make reservations for the restaurant bar "YARD HOUSE" through the site and enjoy the services related to the provision of food and drink at their destinations (B No. 5).

As the information provided by "OpenTable," there is shown an example (6 cases from July 2016 to March 2018) where customers residing in Japan actually made reservations during the period required to prove trademark use.

The restaurant bar "YARD HOUSE" has a membership system on the Internet called "e-Club" (B No. 6), and there are many Japanese consumers among those who have signed up to join the mailing list. In the restaurant bar "YARD HOUSE," there have been more than 200 registrants in the past few years (B No. 7).

The restaurant bar "YARD HOUSE" in Honolulu, Hawaii is very popular with Japanese tourists, so that Japanese menus are set up in the store. In addition, since the Honolulu store is located in Hawaii, which is a popular destination for overseas travelers from Japan, it is also introduced on the websites of famous Japanese travel agencies (B No. 8 and B No. 9), and furthermore, since it is a restaurant bar famous for its beer selection, it is also introduced on the website of the Japan Beer Journalists Association (B No. 10).

2 Use evidence

(1) Evidence B No. 1 is a screenshot of the Internet Archive site saved on February 17, 2017 on the top page of the Demandee's website, and on the signboard of the store, the Alphabetic characters "Yard House" and the mark in which a horizontally long elliptical contour figure is arranged on the periphery thereof are used. The site introduces menus provided at stores, provides a search function for store search, has the Internet membership system called "e-Club" (B No. 5) to join the mailing list, and provides a sign-up function etc. for joining a mailing list.

(2) Evidence B No. 4 is a copy of the article posted on April 11, 2016 in the official account on the SNS site "Facebook" owned by the Demandee, and shows a posted article stating that they have started accepting seat reservations through the reservation site "OpenTable" along with the trademark of "Yard House".

(3) Evidence B No. 5 is a copy of the reservation page for "Yard House-Newport Beach (Yard House, Newport Beach)" in the Japanese version of "OpenTable," which is a restaurant reservation site used by the Demandee and its parent company Darden

Restaurants. Since the evidence relates to a web page displayed by using the search function on the website, it is not possible to present stored information on the Internet archive site. However, as dates of comments from users posted at the bottom of the web page, for example, many dates of September 24, 2017 can be seen, which are within the period required to prove trademark use, it can be easily inferred that it existed even during the period required to prove trademark use.

(4) Evidence No. 6 is a screenshot of the Internet Archive site saved on February 17, 2017 on the top page of the Demandee's website, which is a page for signing up to join the mailing list in the Internet membership system called "e-Club" provided by the Demandee. The mark of "Yard House Restaurant" is shown, and it is shown that the Demandee provided information on various events held at the store in addition to the services of providing food and drink.

(5) Evidence B No. 7 is a list of customers who have a Japanese domain in the Internet membership system called "e-Club" provided by the Demandee.

(6) Evidence B No. 6 is a copy of the introduction page of the restaurant bar "Yard House" in Honolulu, which published on the homepage of JTB, which is a major travel agency in Japan. Since there is a description of "latest update date and time May 12, 2017" on the website, it is clear that access was possible on the Internet at least on May 12, 2017, which is within the period required to prove trademark use.

(7) Evidence B No. 9 is a copy of the introductory article dated February 21, 2018 of the restaurant bar "Yard House," which is published on the homepage of HIS, which is a major travel agency in Japan.

(8) Evidence B No. 10 is a copy of the introductory article dated April 28, 2016 of the restaurant bar "Yard House," which is published on the website of the Japan Beer Journalists Association.

Also, the respective websites according to Evidence B No. 8 to Evidence B No. 10 are the websites operated by the travel agencies "JTB," "HIS," and "Japan Beer Journalists Association," and are not operated by the Demandee himself.

Incidentally, when traveling, "which restaurant or bar to eat at" is one of the important decisions for travelers, and although when making a selection, it is common to refer to travel guidebooks, pamphlets provided by travel agencies, and information on the Internet, in particular, it is thought that the Internet, where information can be easily collected, is often used. Among the vast amount of information on the Internet, tourist information provided by travel agencies that have a wealth of local information is influential and highly reliable information for travelers. Therefore, formally, although it cannot be said to be the action of the Demandee, who is the holder of trademark right,

essentially, this kind of information provision to Japanese consumers is carried out through Japanese travel agencies, etc. so that popularity among Japanese consumers is increased, and in fact, seat reservations are made through the Internet reservation site, and the Japanese travelers actually visit the store and receive services related to the provision of food and drink.

In view of the above, the Trademarks can be substantially regarded as exerting the function of distinguishing its services from those of others in Japan, and it is no exaggeration to say that protecting such the Trademark protects the interests of Japanese consumers and, in turn, contributes to the purpose of the Trademark Act.

3 Regarding similarity from common sense perspective of the trademark

For Evidence B No. 1, Evidence B No. 3 to Evidence B No. 10, the Alphabetic characters "Yard House," the mark in which a horizontally long elliptical contour figure is arranged on the periphery thereof, characters "Yard House" and "YARD HOUSE" which are normally used are used.

Here, in "Registered Trademark" in Article 50 of the Trademark Act, there are included "including a trademark deemed identical from common sense perspective with the registered trademark, including a trademark consisting of characters identical with the registered trademark but in different fonts, a trademark that is written in different characters, Hiragana characters, Katakana characters, or Latin alphabetic characters, from the registered trademark but identical with the registered trademark in terms of pronunciation and concept, and a trademark consisting of figures that are considered identical in terms of appearance as those of the registered trademark". The used trademark of the case is as described above, and thus is recognized as a trademark identical to the Trademark or deemed identical to the Trademark from common sense perspective.

4 Regarding similarity of the services of the used trademark of the case and the designated services of the Trademark

In Evidence B No. 1, Evidence B No. 4 to Evidence B No. 6, it is posted that the trademark of the case is attached to a website that provides information on contents or locations of food and drink provided, or events, etc., in association with the food and drink provided by the restaurant has provided by the Demande, and that the trademark of the case is used on an information input screen for reservation, etc., on the reservation website by a company that has a business connection with the holder of trademark right who accessed to receive the provision of the services.

It is obvious that the service regarding the used trademark of the case of "provision of food and drink in restaurants and bars," and it is the same as the designated

services regarding the trial decision for revocation of the case.

5 Applicability to Article 2(3) of the Trademark Act

Evidence B No. 1, Evidence B No. 4 to Evidence B No. 6 are printouts of a website that provides a transaction document related to services with the mark attached by an electromagnetic method.

Therefore, it was proved that the action of attaching the mark to the information including the transaction document related to the services "provision of food and drink in restaurants and bars" and providing it by an electromagnetic method was performed.

Then, such a use mode at least falls under the use of the trademark stipulated in Article 2(3)(viii) of the Trademark Act.

6 Conclusion

As described above, it is obvious that the holder of trademark right had used the trademark identical to the Trademark from generally accepted perspective for "provision of food and drink in restaurants and bars," within three years before the registration of the trial of the case.

No. 4 Inquiry by the body

The body presented a tentative view and issued an interrogation about the evidence of the Demandeé under the provisions of Article 50(2) of the Trademark Act, on March 3, 2020, as follows.

1 Regarding a tentative view about respective items of Evidence B submitted by the Demandeé

Against the demand for trial of the case, the Demandeé alleges in the written reply of trial case dated July 17, 2018 that the holder of trademark right had used a trademark identical to the Trademark from generally accepted perspective for "provision of food and drink in restaurants and bars," within three years before the registration of the trial of the case, and submitted Evidence B No. 1 to Evidence B No. 10 as means of proof.

However, depending on the respective items of Evidence B submitted by the Demandeé and the Demandeé's allegation, the fact of use in Japan cannot be found, so that it cannot be said that it was proved that the holder of trademark right had used the Trademark (including a trademark deemed identical from common sense perspective with the registered trademark) for the designated service pertaining to the request during the period required to prove trademark use in Japan.

Then, it cannot be admitted that the Demandeé has given the proof stipulated in Article 50(2) of the Trademark Act.

2 Content of inquiry

(1) The Demandee is requested to submit evidence that can confirm the fact in order to clarify that there are legitimate reasons for not using the Trademark for the three years in the period required to prove trademark use.

(2) If the Demandee proves the use of the Trademark by new evidence, it is requested to submit evidence that can confirm the fact that the holder of trademark right had used the Trademark in any designated service during the period required to prove trademark use, in Japan. If the evidence is in a foreign language, attachment of a translation as well is requested.

No. 5 Respond by the Demandee

The Demandee has not responded to the above inquiry.

No. 6 Judgment by the body

1 Depending to the Demandee's allegation and the submitted evidence, it is as follows.

(1) The holder of trademark right operates a restaurant bar chain in cities including Honolulu, Hawaii, etc. mainly in the mainland of the United States.

On the Internet Archive site (saved on February 17, 2017) related to the website "Yard House Restaurant" of the holder of trademark right, the Alphabetic characters "Yard House" and the mark in which a horizontally long elliptical contour figure is arranged on the periphery thereof are posted (B No. 1).

(2) Evidence B No. 5 is the Japanese version of the restaurant reservation site "OpenTable" output on July 17, 2018, and a copy of the reservation page for "Yard House-Newport Beach" located in the United States. Comments from visitors on September 24, 2017 are posted in one of the "evaluation/word-of-mouth" columns of the reservation site.

(3) Evidence B No. 7, according to the Demandee's allegation, is a list of customers who have a Japanese domain in the Internet membership system called "e-Club" provided by the Demandee.

(4) Evidence B No. 8 is a copy of the introduction page of the restaurant bar "Yard House" in Honolulu, which is published on the homepage of the travel agency JTB, which was output on April 3, 2018, and under the heading "Yard House," in the "Basic information" column, there is a description of "May 12, 2017" as the "latest update date and time" along with the description of the address, business hours, etc.

(5) Evidence B No. 9 is the "Los Angeles Sightseeing Blog" dated February 21, 2018, which is published on the website of the travel agency HIS, which was output on May 10,

2018, and "YARD HOUSE" located in the United States is introduced.

(6) In Evidence B No. 10, as "[Column, Beer Bar] 2016.4.28" published on the website of the Japan Beer Journalists Association, "Yard House WAIKIKI" located in Hawaii is introduced, and the photograph is posted, in which the Alphabetic characters "Yard House" and the mark in which a horizontally long elliptical contour figure is arranged on the periphery thereof are used on the signboard of the store.

2 According to 1 above, the judgement by the body is as follows.

(1) The holder of trademark right (the Demandee) operates a chain of restaurant bars "YARD HOUSE" mainly in the continental United States, and it can be inferred that the Alphabetic characters "Yard House" and the mark in which a horizontally long elliptical contour figure is arranged on the periphery thereof (hereinafter, "the used mark") had been used on the signboard of the store in the United States, during the period required to prove trademark use of the trial of the case.

(2) Although it can be said that the restaurant reservation site had a Japanese version page for reserving the restaurant "Yard House-Newport Beach" during the period required to prove trademark use, the store is located in the United States.

(3) Although on the websites of Japanese travel agencies and "Japan Beer Journalists Association," the introductions of the restaurant bar "Yard House" are found (B No. 8 to B No. 10), all of these are stores located in the United States, and there is no description of stores in Japan.

Therefore, although it can be inferred that the holder of trademark right had used the used mark at the restaurant bars located in the United States during the period required to prove trademark use, neither is evidence of use in Japan, so that the fact of use of the Trademark in Japan cannot be confirmed.

3 Regarding the Demandee's allegation

Although the Demandee, on the basis of Evidence B No. 1, and Evidence B No. 4 to Evidence B No. 6, alleges that the action of attaching the mark to the information including the transaction document related to providing food and drink in restaurants and bars and providing it by an electromagnetic method was performed, these are all Internet web pages written in English, and even if it is accessible in Japan and can be searched by Japanese search engines, this is natural as long as it is a web page on the Internet, and it cannot be said that it falls under use in Japan based on this matter.

Further, although the Demandee alleges that there are many Japanese consumers in the Internet membership system "e-Club" provided by the Demandee (B No. 7), even if Japanese are included in the members of the restaurants and bars in the United States, it is related to the services provided in the United States, and it cannot be

said that the Trademark is used in Japan from this matter.

Thus, the Demandee's allegation mentioned above is groundless.

4 Summary

According to the above, the Demandee does not prove the fact of use of the Trademark in Japan.

In addition, depending on the evidence submitted by the Demandee, no facts sufficient to admit that the Trademark (including a trademark deemed identical from common sense perspective with the registered trademark) had been used as stipulated in Article 2(3) of the Trademark Act in Japan can be found.

5 Closing

As described above, it cannot be said that the Demandee proved that either of the holder of trademark right, exclusive right to use, or non-exclusive right to use had used the Trademark for the designated services pertaining to the request within three years prior to the registration of the trial of the case, in Japan.

Further, the Demandee did not reveal that there are legitimate reasons for not using the Trademark.

Consequently, the registration of the Trademark must be invalidated in accordance with Article 50 of the Trademark Act.

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

June 16, 2020

Chief administrative judge: HANDA, Masato

Administrative judge: KOMATSU, Satomi

Administrative judge: OMATA, Katsumi

Attachment

The Trademark (See original for colors)

