

Latest Court Decisions

2014:

[November]

- **Skull & Crossbones Device Case** (Cancellation Suit against Trial Decision)
IP High Court 2014.11.26 H26(Gyo-Ke)10127

[SUMMARY/INTRODUCTION]

In the past invalidation trial procedures, the IP High Court partially invalidated the subject registration for the Skull and Crossbones device mark (right upper) for the goods in Class 25 among three classes due to similarity to the cited trademark for the Skull and Crossbones device mark (right lower).



After that, another Invalidation Trial was filed against the subject trademark (right upper) for the remaining goods in Classes 14 and 18 on the basis of the same prior mark (right lower).



The JPO issued the Trial Decision invalidating the subject trademark registration for the remaining goods in Classes 14 and 18. Then, the Plaintiff (Trademark Proprietor) filed the Cancellation Suit against the Trial Decision with the IP High Court.

What was the IP High Court decision ?

[CASE]

The subject trademark for the skull and crossbones device was registered on July 3, 2009 for the goods in Classes 14, 18 and 25. The cited trademark for the skull and crossbones device was registered on August 1, 2008 for the goods in Classes 14, 18 and 25 as well.

The proprietor (the Defendant) of the cited trademark filed an Invalidation Trial against the subject trademark on August 6, 2012 demanding the partial invalidation for the goods in Class 25. The JPO issued the Trial Decision partially invalidating the subject registration because of the similarity of the two trademarks and the Trial Decision was confirmed by the IP High Court on June 27, 2013.

Then, the Defendant filed another Invalidation Trial on August 5, 2013 demanding the invalidation of the remaining goods in Classes 14 and 18 of the subject trademark. The JPO issued the Trial Decision invalidating the goods in Classes 14 and 18 of the subject trademark.

The Plaintiff (the proprietor of the subject trademark) filed the cancellation suit against the Trial Decision with the IP High Court by alleging that the two trademarks were not confusingly similar.

We could expect an IP High Court decision that the Plaintiff's petition should have been dismissed as well as in the previous IP High Court decision because the similarity of the two trademarks were already confirmed in the previous case.

However, the IP High Court issued the Decision of Dismissal of Action because the Plaintiff's cancellation suit was not permitted as unlawful against the principle of good faith and trust of the lawsuits. The Plaintiff's action was to try to overturn the final and binding judgment in the prior IP High Court decision regarding the similarity of the two trademarks despite the fact that there were no differences of the main basic facts of the two trademarks such as the appearances of the trademarks.

It seems that the IP High Court admitted "**the Res Judicata**" in the prior IP High Court decision. However, the IP High Court clearly said in its reasons that the subject-matters of the present and previous lawsuits were different because the Trial Decisions to be required cancellation were different. Therefore, this IP High Court decision does not mean to admit the "the Res Judicata" in the previous IP High Court decisions.

You will see that the specified goods of the subject registration were in Classes 14 and 18 while in the previous case, the goods at issue were only in Class 25. Therefore, if there were any substantial reasons regarding the difference of the goods that might change or effect the similarity of the two trademarks, the IP High Court would have to make examinations on the similarity of the two trademarks regarding the goods in Classes 14 and 18, without dismissing the action itself.

Res Judicata:

A doctrine whereby the court's decision is binding upon the parties in any and all subsequent litigation concerning the same case; a principle or doctrine that generally bars relitigation or reconsideration of matters determined in adjudication.

【Article 114-1 of Code of Civil Procedure】

A final and binding judgment, only for the contents thereof that are included in the main text, shall have the res judicata.