

Latest Court Decisions

2021:

[August]

- [HIRUDOSOFT Case \(Cancellation Suit\)](#)

IP High Court 2021.8.30 R3(Gyo-Ke)10031

[SUMMARY/INTRODUCTION]

An Invalidation Trial against the registered trademark “**HIRUDOSOFT**” specifying “pharmaceutical preparations” in Class 5 was filed by the owner of the prior registered trademark “**Hirudoid**”.

The grounds for the invalidation were the similarity between the two trademarks (Article 4-1-11 of the TM Law) as well as the fear of the confusion (Article 4-1-15). However, the JPO issued the Trial Decision dismissing the petition for the invalidation.

Then, the Plaintiff (= the petitioner of the trial) brought the case before the IP High Court demanding cancellation of the JPO’s Trial Decision. What was the Court decision ?

[Court Decision]

The IP High Court also dismissed the Plaintiff’s demand upholding the Trial Decision because the two trademarks were not confusingly similar in appearance, pronunciation and meaning.

The Plaintiff insisted that any medical accidents might occur due to the commonality of the beginning word “hi-ru-do” of the two trademarks. However, the IP High Court ruled that if there was concern about medical accidents due to the similarity of names, it should be said that it was not a problem in the field of trademarks in the first place, but a problem of regulation in medical administration.

Then, the Plaintiff insisted that there was a fear of confusion between the two trademarks since the cited trademark “Hirudoid” was well-known for skin moisturizer as the German prescription drugs which were launched in Japan in 1954.

The IP High Court considered that even if the trademarks were dissimilar, there could be a risk of confusion between the sources when the cited trademark was well-known.

However, as a result, the IP High Court denied the fear of confusion saying as follows. The cited trademark was recognized as "Hirudoid", not as "Hirudo". It was not recognized that trademarks were abbreviated to the first three words in drug and medicine transactions.

Therefore, it could not be admitted that over-the-counter drugs or quasi-drugs bearing the trademarks might cause confusion as to the source of the products as if they were manufactured and sold by the Plaintiff who actually sold prescription drugs.

In the past, as to the prescription drugs, original drugs and generic drugs having somehow similar names used to be sold by the both parties. But now the generic drugs must be sold under the name consisting of active ingredient (general name).

Since it is a general rule for generic drugs to use a sales name mainly consisting of a generic name, the subject trademark "HIRUDOSOFT" will not be used for a generic drug for "Hirudoid". (However, for a mixture (combination) containing multiple medicinal ingredients, it is permitted to use a trademark name instead of a generic name.)

Then, the subject trademark "HIRUDODOFT" will be used for original drugs having different active ingredients from those of "Hildoid" or used for over-the-counter drugs that do not require a doctor's prescription. Therefore, the fear resulting in mismedication or medical accidents due to the similarity of names will occur very rarely.

However, considering that the Plaintiff has been selling a drug called "Hildoid Soft Ointment" that is somewhat similar to the subject trademark "Hirudosoft", it is fully understood that the Plaintiff filed an invalidation against "Hirudosoft" on the ground of likelihood of confusion aside from medical accidents.