

Latest Court Decisions

2021:

[October]

• **HIRUDOPREMIUM Case (Cancellation Suit)**

IP High Court 2021.10.6 R3(Gyo-Ke)10032

[SUMMARY/INTRODUCTION]

An Invalidation Trial was filed against the registered trademark "HIRUDOPREMIUM" specifying "cosmetics" in Class 3 on the basis of the prior registered trademarks "Hirudoid" specifying "cosmetics, soaps" in Class 3 and "pharmaceutical preparations" in Class 5.

The reasons for the invalidation were the similarity between the two trademarks (Article 4-1-11 of the TM Law) as well as a liability to confusion between the goods bearing both trademarks (Article 4-1-15 of the TM Law). 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. In this August case regarding the trademark "HIRUDOSOFT", the IP High Court issued a decision that the trademark "HIRUDOSOFT" was not confusingly similar to the cited trademark "Hirudoid".

However, in this September case regarding the trademark "HIRUDOMILD", the IP High Court issued a decision that the trademarks "HIRUDOMILD" was confusingly similar to the cited trademark "Hirudoid" (Article 4-1-11).

What was the Court decision this time ?

[Court Decision]

The IP High Court considered that it should be allowed to extract only the part "HIRUDO" from the subject trademark "HIRUDOPREMIUM" since the word "premium" was used to indicate that it was an excellent product by blending a special ingredient with an existing product, its distinguishing function as a trademark in relation to "cosmetics" was low.

However, the IP High Court decided regarding the similarity under Article 4-1-11 of the TM Law that the subject trademark "HIRUDOPREMIUM" or its extract "HIRUDO" was not confusingly similar to the cited trademark "Hirudoid".

As to the liability to confusion under Article 4-1-15, the IP High Court admitted that the Plaintiff's drug "Hirudoid" was well-known for skin moisturizer in Class 5.

However, the Plaintiff's trademark "Hirudoid" was not used for the specified goods "cosmetics" in Class 3. Moreover, as emphasized in the Plaintiff's own advertisements, the Plaintiff's goods were sold as prescription drugs that required a doctor's prescription.

In view of these facts, due to the well-known prominence of the cited trademark "Hirudoid" for "pharmaceuticals", even if the subject trademark "HIRUDOPREMIUM" was used for "cosmetics", the source of the goods would not be confused between both goods.

Therefore, the invalidation reason under Article 4-1-15 was not also affirmed and the trial decision by the JPO was maintained.