

## Latest Court Decisions

**2021:**

[September]

• **HIRUDOMILD Case (Cancellation Suit)**

**IP High Court 2021.9.21 R3(Gyo-Ke)10028**

**[SUMMARY/INTRODUCTION]**

An Invalidation Trial was filed against the registered trademark "HIRUDOMILD" specifying "pharmaceutical preparations" in Class 5 on the basis of the prior registered trademark "Hirudoid".

The reason for the invalidation was the similarity between the two trademarks (Article 4-1-11 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 trademarks "HIRUDOSOFT" was not confusingly similar to the cited trademark "Hirudoid".

What was this time Court decision ?

**[Court Decision]**

As the result, the IP High Court issued a decision contrary to the August decision on the trademark "HIRUDOSOFT" that the trademark "HIRUDOMILD" was confusingly similar to the cited trademark "Hirudoid" (Article 4-1-11 of the TM Law).

The IP High Court considered that it was permissible to extract only the part "HIRUDO" from the subject trademark "HIRUDOMILD" and to make a similarity judgment with the cited trademark "Hirudoid" because of the following reasons.

- ① The identification function of the part "MILD" in "HIRUDOMILD" was extremely weak because the word "mild" was often used in the product names together with the brand names of the drugs in order to show that the effect or irritation of the drug was weak.
- ② On the other hand, the word "HIRUDO" was not a dictionary word and it was not a common name for drugs. Furthermore, it had not been used for a long period of time for other companies' drugs than the Plaintiff's drugs. Therefore, the word "HIRUDO" had strong distinguishing power.

As to the cited trademark "Hirudoid", the IP High Court admitted that the Plaintiff's drug "Hirudoid" was well-known for skin moisturizer, the German prescription drugs which were launched in Japan in 1954. Since then, with a few exceptions in a limited period, there was no drug beginning with the word "Hirudo" other than the Plaintiff's.

The Plaintiff's drug was widely known as a heparinoid-containing preparation, which was a moisturizing ingredient. In a questionnaire survey conducted in 2021, 44% of the total, 60% of women recalled moisturizers from the word "Hirudoid".

As a result, the Court admitted that "Hirudo" was recognized by consumers as a word meaning "Hirudoid".

Under these reasons, the IP High Court considered that the trademarks "HIRUDOMILD" was somewhat confusingly similar to the cited trademark "Hirudoid" in their appearances and pronunciations.

Furthermore, the Court admitted that the two trademarks were also similar in their meanings saying that if the subject trademark "HIRUDOMILD" was used for a drug, it should be associated with "Hirudo with a mild medicinal effect or irritation".

And since "Hirudo" was recognized by consumers as a word meaning "Hirudoid", both the subject trademark and the cited trademark were reminiscent of "Hirudoid, a moisturizer containing heparinoids."

As the result, the IP High Court judged that since the subject trademark "HIRUDOMILD" and the cited trademark "Hirudoid" had some parts in common in appearance, pronunciations and meanings, if they were used for the same or similar products, there was a fear of confusion about the origin of the products.

Therefore, the subject trademark should be invalidated under Article 4-1-11 of the Trademark Law.

In fact, the Court Decision did not clearly state that the subject trademark and the cited trademark were similar in appearance, pronunciation and meaning. Therefore, we do not think that the judgement on Article 4-1-11 was reasonable. However, it might be reasonable if the judgement was concern about the fear of confusion under Article 4-1-15 of the TM Law.

For your information, the judges of the IP High Court were different in the August and September cases.