

Estoppel – Non-Use Cancellation

November 1, 2011
Kazuhiro NAKATA (Mr.)
YUASA AND HARA

Intellectual Property High Court
Hei-22(Gyo-Ke)10083 decided on July 28, 2010

Registered Mark: ECOPAC in Alphabet
Goods: Class 20 - Plastic packaging containers, etc.

Mark in actual use: ECOPAC in Katakana (Local transliteration for ECOPAC)

Despite that the trademark right holder filed evidence of use of ECOPAC in Katakana, the Trial Board of the JPO issued a decision for cancellation of ECOPAC in Alphabet for non-use, finding inter alia that ECOPAC in Katakana in use was not tantamount to use of the registered ECOPAC in Alphabet.

The trademark right holder (plaintiff) brought an appeal to the IP High Court and argued that the registered mark should be regarded as having been in use since ECOPAC in Katakana is considered as virtually the same as the registered ECOPAC in Alphabet because:

- (i) The registered ECOPAC in Alphabet gives rise to the connotation of "environment-conscious containers" nowadays; and
- (ii) ECOPAC in Katakana in use is associated not only with the English word ECOPACK (with a "K") but also with ECOPAC in Alphabet (without a "K"), where "pack" and "pac" both regarded as a short form of "package".

The Court agreed with the plaintiff's argument that the registered ECOPAC (in Alphabet) gives rise to the connotation "environment-conscious containers" but rejected their argument that the mark as used was virtually the same as the registered mark.

It particularly noted that in the process of registration (application filed in 1988), especially in the appeal against the refusal of the application and in the opposition proceeding against their trademark registration (decisions both rendered in 1997), the plaintiff had argued that ECOPAC (in Alphabet) did not mean "environment-conscious containers" but was devised by them and thus should have

been registered. The Court thus emphasized that the plaintiff's argument in this trial should be dismissed since it contradicted the argument that the plaintiff had submitted during the registration process.

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