



## EU IPO Board of Appeal Decisions and Judgments of the General Court

### Class 5 – Pharmaceutical Goods, January-August 2017

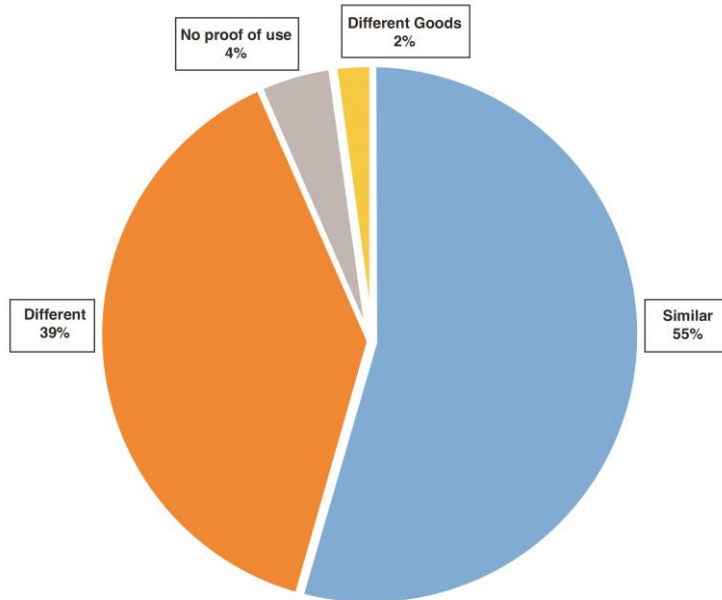
James Cornish, Chartered Trade Mark Attorney at Page White and Farrer reviews the EU IPO Appeal Board and General Court pharmaceutical case law, between January and August 2017 in advance of the Pharmaceutical Trade Mark Group “PTMG” Autumn conference, to provide concise guidance on recent legal principles to help win pharmaceutical cases

While difficult to draw firm conclusions from such a small sample of 46 cases:

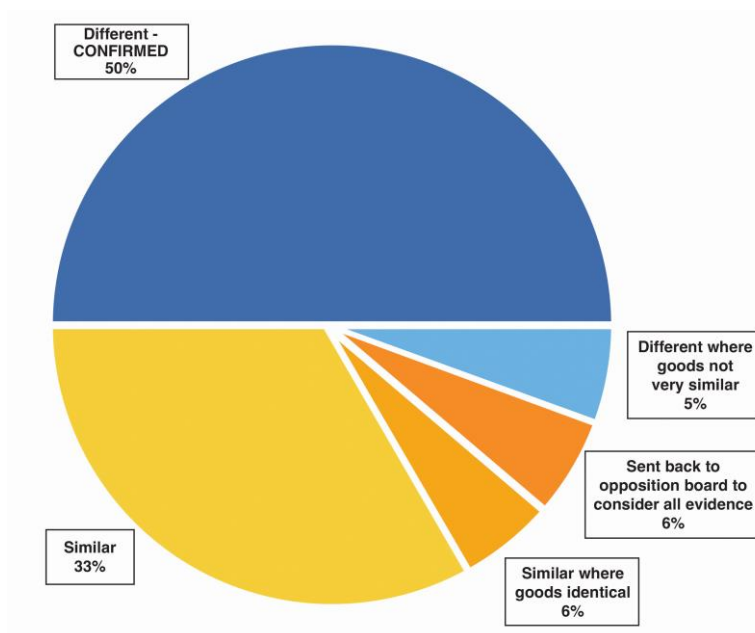
- 80 % of the EU IPO Opposition Division decisions were confirmed by the Appeal Board. Only one in five decisions were overturned on appeal.
- Parties that fail in the Opposition Division are not highly likely to succeed at the Appeal level.
- Based on the very limited statistics, Applicants do particularly badly in overturning Opposition decisions.
- The Board of Appeal has well established guidelines concerning similarity. This may explain why there are not high numbers of Appeal Board decisions involving the largest pharmaceutical companies, who are familiar with these principles, and who may be more interested in settling certain cases.

## FORTY-SIX APPEAL CASES January to August 2017

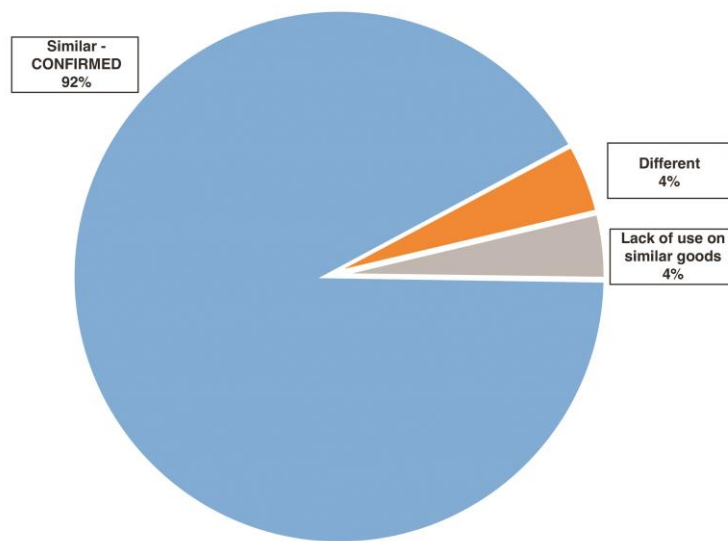
**Fig 1: Opposition Division Decision on Similarity**



**Fig 2: Appeal Board Decision on Similarity of Signs, where Opposition Division decided Signs were 'Different'**



**Fig 3: Appeal Board Decision on Similarity of Signs, where Opposition Division decided Signs were ‘Similar’**



## Parties

Novartis was an applicant in two of the cases and Opponent in two of the cases. There were no cases where GSK, Pfizer, Merck, Roche, Amgen, Sanofi, or Johnson & Johnson were named as the parties.

### Nationalities of the parties

Nationality	Opponent	Applicant
German	11	13
Spanish	7	5
Italian	7	2
Polish	1	5
British	0	2
American	2	2

## Legal principles demonstrated

### 1. Similarity of marks – visual, phonetic and conceptual issues

The visual, phonetic and conceptual aspects of signs may not always have the same weight and it can be appropriate to look at the conditions under which the marks will be used. If goods are sold in self-service stores, the visual appearance is more important than oral similarities, in comparing the marks' similarities.

IMPERIA R 2217/2016 – 2 paragraph 48. Oral similarities can be key, eg if OTC goods are kept in a place where the consumer has to ask for them by name.

### 2. Words and logos – which is more important?

When signs have word and logo elements, in principle, the words usually have a stronger impact than the logo.

DIETOX R 1611/2016 – 5 paragraph 27. DIETOR (stylised) was said to be similar to DIETOX & logo, as the figurative elements were not sufficient to prevent a likelihood of confusion.

### 3. Similarity of goods - categorising goods

When assessing the goods for which a pharmaceutical brand has been used following a non-use challenge, it should be categorised by the therapeutic indication and not by the method of administration.

DUOVA R 340/2016–1 paragraph 20. DUOVA had been used for pharmaceuticals for treating respiratory infections, and these goods should be compared with the applicant's goods, not pharmaceuticals for inhalers.

### 4. Similarity of goods - comparison factors

Whether the goods are over-the-counter, or prescription goods is not of particular relevance in assessing the similarity of goods, because how goods are sold may change depending upon pharmaceutical laws and regulations.

MABION R 2356/2016 – 4 paragraph 38.

How goods in the pharma field are administered is not sufficient to prevent goods being declared dissimilar.

MABION R 2056/2016 – 4 paragraph 36. In MABION, oral tablets/close treatment into veins were involved.

The assessment of differing therapeutic indications is of importance. Pharma goods cannot be declared to be highly similar, if their therapeutic indications are different.

BELLAVIAR R 1199/2016 – 5 paragraph 25.

In MABION, the EU IPO pointed out that there was a link between gastrointestinal preparations and oncological preparations and also with auto-immune disorders, because the gastrointestinal tract may be affected by oncological disease, the goods may be used simultaneously or have a complementary connection. Gastrointestinal preparations may be needed to deal with side-effects, due to oncological preparations.

## 7. Comparison of the Goods

The key is whether the relevant public would perceive the relevant products as having a common commercial origin.

CELLUVITE R 2159/2016 – 4 paragraph 14. All relevant factors should be taken into account, including their nature, purpose, method of use, whether they are in competition with each other, or complementary, and distribution channels. Would consumers consider it normal that the goods are marketed under the same trademark, which normally implies that a large number of producers of these products are the same. In CELLUVITE, dietary supplements were similar to pharmaceutical products with fibre.

## 8. Degree of care of consumers

When assessing the likelihood of confusion and the level of attention of consumers, both medical professionals and public users are deemed to take extra care and have a higher level of attention when dealing with pharmaceuticals, even if they are non-prescription.

NIAGEN and AGEN paragraph 18 R 1585/2016–5. The public also have a higher degree of care when dealing with dietary supplements to ensure they get the right product, even though they may not be sold on medical prescription. Paragraph 19. Both marks in the case covered wide class 5 lists. In principle, a higher degree of care and attention is taken, when health-related goods are involved.

## 9. Significance of weakness in a shared word element

A weak element that is in conflicting trademarks may be sufficient for there to be a likelihood of confusion, in the absence of any extra distinctive element. Just because the element is weak does not automatically mean that it cannot dominate a complex mark. For example, if the other elements are even weaker, the shared element can dominate the global impression.

NATURA R1310/2016 – 4 paragraph 16 where both marks shared the letters NATURA.

## 10. What if opponent's mark has low distinctiveness?

Likewise, the EU IPO will not give excessive importance to the fact that the opponents mark has only a weak distinctive character, as otherwise a likelihood of confusion would only arise if there was a complete reproduction of that mark in the later mark whatever the degree of similarity. What matters is whether there is a likelihood of confusion due to similarity, and this is more important than factors based on distinctive character. A global assessment of the similarity must be carried out.

NAILICIN R2359/2016 – 5 paragraph 60. The element NAIL was not disregarded.

## 11. Relevance of the fact that marks contain a known English word

When assessing the likelihood of confusion in overseas jurisdictions such as Poland, where the shared element is derived from an English word, you cannot assume that the local (e.g. Polish) public knows English, especially if the corresponding word in the local language is very different from the English term. Survey evidence to show that average, relevant consumers would have a sufficient level of English to understand the shared term could help.

GARDENIC & logo R1582/2016-5 paragraph 32. was said to be similar to GARDEN FEELINGS & logo, despite the fact GARDEN is a common English term.



## 12. The relevance of the fact that the earlier mark is wholly contained in a later mark

When an earlier mark is wholly contained in the later mark, that is an indication that the two marks are similar to a certain extent.

THE LAD BUDDY R 1886/2016 – 2 paragraph 34. This argument failed in that case, as one mark was THE LAD BUDDY and the other BRUDY.

## 13. Similarity of marks – Earlier mark contained in later mark that also contains a company name

Where the earlier mark is used to oppose a mark containing the same word with the company name of another party and (1) the earlier mark has normal distinctiveness, (2) the goods are identical and (3) it still plays an independent distinctive role in the later mark, it can create a likelihood of confusion.

DR JACOBS ESSENTIALS R 2067/2016 – 5. In the ESSENTIALS case, the shared element ESSEN-IAL was not of a normal distinctiveness and there was a different concept in the later mark, so there was no likelihood of confusion.

# Analysis of EU IPO Board of Appeal Decisions

## Class 5 – Pharmaceutical Goods

January-August 2017

Trade Mark Applied For	Earlier Trade Mark	Opposition Division Decision on Similarity	Appeal Board Decision on Similarity	Notes
ILLUMINA	ILLINA	Different	Similar	Appealed to GC
ENTEROFLORA	ENTROGERMINA	Similar	Different	
HEALTHIE (stylised)	HEALTH-IX (stylised)	Similar	Similar	
CYBELLE	CYBELE SANTE	Similar	Similar	
VEGA ONE (stylised) and logo	VEGAS	Similar	Similar	Appealed to GC
AKANTO	KANTOS	Different	Similar	Appealed to GC

DUOVA	DUOVENT	Similar	Similar	
TROPICAL & logo	TROPICAL	No proof of use	Similar	Appealed to GC
SALOSPIR & logo	ASPIRIN and also logo registrations	Different	Different	Appealed to GC
UROAKUT	UroCys	Similar	Similar	Appealed to GC
Dayli my shop (stylised)	Dayly	Similar	Similar	
Mayla (stylised)	MYLAN	Similar	Lack of use on similar goods	
T (stylised)	T (stylised)	Different	Similar	Appealed to GC. Class 5 not relevant to dispute
SANTE VERTE Laboratoires & logo	SANTAVERDE	Similar	Similar	
DOC FIDDLERS & logo	DOC	Similar	Similar	
RMS Asconex	ASCONEX	No Proof of use	No Proof of use	
Triangle Logo	Triangle Logo	Different	Similar where goods identical	
NIAGEN	AGEN	Different	Different	
BELLAVIAR	BELIVIAN	Different	Different where goods not very similar	
DOM logo	DOMPE	Different	Different	
NATURA & logo	NATTURA (stylised)	Similar	Similar	Class 5 not relevant to dispute
LABORATORIES MAJORELLE	MAJORELLE	Similar	Similar	Appealed to GC
DIETOX (stylised & logos)	DIETOR (stylised)	Different	Similar	Appealed to GC
ENAMIC	ENA CARE	Similar	Similar	
CHANDOR	CHANDON logo	Similar	Similar	Class 5 not relevant to dispute
MILAC	MILLAC	Different goods	Different goods	



EVELINE COSMETICS MEN X-TREME	XTREME	Different	Different	Class 5 not relevant to dispute
ALBEA (stylised)	BALEA	Different	Different	Appealed to GC
ASTHENODEX	ASTENOLIT	Similar	Similar	
CELLUVITE	CELLULINE PRO KAZDY DEN (for every day)	Similar	Similar	
GARDEN FEELINGS logo/stylised	GARDENIC logo/stylised	Similar	Similar in Poland	
THE LAD BUDDY	BRUDY	Different	Different	
IMPERIA	IMPRIDA	Different	Similar	
BAD ASS	BADASS	Similar	Similar	Class 5 not relevant to dispute
DERMAPHARM & logo	DERMAPHARM AG & logo	Similar	Similar	
NAILICIN	NAILCLIN	Similar	Similar	Appealed to GC
SUPERCORE INSIDE logo	SUPER COR (stylised)	Similar	Similar	
MEDISEPT	MEDIS	Different	Sent back to Opposition Board to consider all evidence	
Circular Logo	Circular/G Logo	Different	Different	
DR. JACOBS ESSENTIALS (stylised)	ESSENCIAL FRUTA (stylised)	Different	Different	
GN LABORATORIES	GNC	Similar	Similar	
CINFINI	CINFA	Different	Different	
MABION	MAGION	Similar	Similar	
NASOLAXTEN	NASODREN	Similar	Similar	
APOFOX	APO	Different	Similar	
MAM & logo	MAM & logo	Similar	Similar	

## Judgments of the General Court – Class 5 – Pharmaceutical Goods

### January – August 2017

Some parties are notably keen to persist in their actions, sometimes even if they have lost both in the Opposition Board and Appeal Board already. About one third of the above Appeal Board decisions are being appealed to the General Court. Below are the General Court class 5 decisions so far in 2017

Trade Mark Applied For	Case Number	Earlier Trade Mark	Opposition Division Decision	Appeal Board Decision	General Court Decision
OCTASA	T632/15	PENTASA	Different	Similar	Similar
YLOELIS	T85/15	YONDELIS	Similar	Similar	Similar
NIMORAL	T49/16	NEORAL	Similar	Similar	Similar
ALPHAREN	T88/16	ALPHA D3	Similar	Similar	Similar

#### 1. PENTASA/OCTASA - Marks declared similar

The suffix ASA is not descriptive for the relevant pharmaceutical goods in class 5.

Pharmaceuticals for gastrointestinal diseases may involve a verbal request, even where a medical prescription is necessary and may involve the assistance of a professional. Therefore, the oral similarity of marks can be taken into account.

A likelihood of confusion amongst final, public consumers can be taken into account, even where pharmaceuticals are chosen, or influenced by medical practitioners and pharmacists, since the end user is likely to be faced with a product.

The distinctive character of an earlier mark is only one factor involved in an assessment. A likelihood of confusion might exist, even where the distinctive character of the earlier mark is weak.

Comment: Many factors can be considered in deciding if confusion is likely and the distinctiveness, or otherwise, of shared elements may not be the key factor.

## 2. YLOELIS/YONDELIS - Marks declared similar

Where the earlier mark covers pharmaceuticals for use in oncology and the mark applied for covers pharmaceuticals not for use in oncology, the goods can be similar. The goods have the same nature, consumers, distribution channels and same general purpose of treating health. Certain pharmaceuticals might be used for treating side-effects connected with cancer patients. Simply excluding identical pharmaceuticals was not sufficient.

A high level of attention of the relevant public is not enough to exclude a likelihood of confusion in the medical sector.

What matters is whether someone might think the goods were marketed by the same undertaking and not whether they might confuse the two goods. The Applicant argued unsuccessfully that someone ordering YLOELIS in a pharmacy would not be given YONDELIS.

Comment: Simply excluding identical goods is never going to succeed, as rights extend to similar goods.

## 3. NIMORAL/NEORAL - Marks declared similar.

Two marks are similar when they are at least partially identical as regards one, or more relevant aspects and average consumers normally perceive marks as a whole. Relevant public comprises health professionals, as well as end-user patients.

What matters in assessing the visual similarity of two word marks is the presence of several letters in the same order. The two brands were visually similar.

Slight differences in the middle will not attract a consumer's attention, more than the beginning and end, even though in short words central elements are as important, as the beginning and end.

Conceptual differences may counteract, to a large extent, visual and phonetic similarities, but one of the marks must have a clear meaning, not shared by the other mark. NEO did not have a meaning in any of the relevant languages. Consumers would not perceive the word Oral from the mark as the letter O was included in the prefix NEO, so the marks did not have different concepts.

Comment: Trying to dissect descriptive connotations out of invented words may not succeed as an argument.

#### 4. ALPHAREN/ALPHA D3 - Marks declared similar.

When comparing medicinal goods, consider if the goods are in competition, complementary, their purpose, specific intended use and, in particular, the therapeutic indication is of decisive importance.

ALPHA D3 and ALPHAREN were visually similar to a low degree, had a certain degree of phonetic similarity, and ALPHA was distinctive for the goods applied for.

This case took many years and there were many procedural stages to reach a decision. Opposition Division upheld the Opposition. Appeal Board upheld the Opposition. General Court sent case back to Appeal Board to give a new decision. Board of Appeal upheld the Opposition again. General Court annulled the decision on procedural grounds and sent the case back to the Appeal Board. Appeal Board upheld the Opposition. Appeal Board revoked its decision. General Court asked Appeal Board to make a further decision. Appeal Board upheld the Opposition. Applicant appealed to the General Court.

When assessing the goods, the list of goods in the mark applied for should be taken into account and not the goods actually marketed under the mark.

Comment: Given that Alpha has connotations of a biochemical term and is not highly distinctive, some IPOs could have decided this case differently.

## James Cornish

James has attended the PTMG conference for many years, and has been responsible for over 2000 pharmaceutical registrations in the UK and EU, including:

- attention deficit disorders
- cancer
- depression
- diabetes
- dietary supplements for hospital patients
- insecticides for companion animals
- psychotic disorders
- sexual health

One notable registration is a royal embrocation for horses and cattle of 1886 to help “sprains, cuts and bruises in dogs, sore mouths in sheep, rheumatism in horses, broken knees, wounds, sprains, splints, sore throat, foot rot, chapped heels”, and much else besides, priced in 1886 at 10 pence.

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