

EU: Pharmaceutical and cosmetic trademarks - confusion on account of weak elements

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Three recent General Court judgments concerning oppositions between trademark in the pharmaceutical and cosmetic fields have caught our attention. In all three cases, the marks were found similar essentially on account of common rather descriptive elements.

MUNDIPHARMA/MULTIPHARMA - T-144/16 of 7 November 2017: the EUTM application MULTIPHARMA in classes 5, 35, 42 was refused based on likelihood of confusion with MUNDIPHARMA. The Boards of Appeal had denied confusing similarity but the General Court found otherwise. The similarities arising from the common elements outweighed the conceptual differences between MUNDI and MULTI. In fact, the Court held that neither mark conveyed a clear and concise meaning. The Court drew support from an earlier finding by a German national court, also holding MUNDIPHARMA and MULTIPHARMA too similar to exclude any likelihood of confusion.

IMMUNOSTIM/IMMUNOSTAD - T-403/16 of 23 October 2017: The French mark IMMUNOSTIM was held against the EUTM IMMUNOSTAD for goods in class 3 and 5. This time, already the Boards of Appeal had concluded that there was likelihood of confusion. While the Court agreed that "immuno" was of low distinctiveness, because of its length and position at the beginnings of the words, this element was

found likely to attract the attention of the relevant (French) public. The allusive character of “stim” (from “stimuler” = stimulate) was not considered to be obvious – and even if the conceptual difference were perceived, it would still not counteract the conceptual similarity resulting from the first element, “immuno”.

Sebotherm/SeboCalm – T-441/16 of 23 October 2017. Like the Board of Appeal, the Court found that there was likelihood of confusion between “Sebotherm” and “SeboCalm” in class 3. As the earlier mark was an EUTM, the Court first assessed the likelihood of confusion with a view to the average consumer in Estonia, Slovakia and Bulgaria (although it later confirmed its findings also for the English-speaking public). For the consumers, the common element “sebo” was of average distinctiveness. Even though consumers were exposed to the use of the word “sebo” for skin care products, that did not mean that they were able to understand its precise meaning. This element, which refers to the secretion of the sebaceous glands, is found in words such as seborrhea. As the initial part “Sebo-“ was held to be distinctive, the different endings -therm and -Calm did not sufficiently differentiate the marks, in spite of their different meanings.

Comments

The judgments are in line with other General Court case law relating to pharmaceutical and cosmetic marks (e.g. T-109/16 – RESPIMAT/RESPIMER; T-312/15 – MIVACHRON/MITOCHRON; T-441/12 – PHARMA SEE/PHARMA STREET). In all these cases, pharmaceutical/cosmetic trademarks that contain common denominators combined with other elements were considered similar to marks that followed the same pattern, but had different meanings on account of the different additional elements.

The main problem is that the “need to keep descriptive terms free” for other traders is disregarded in the comparison of the marks. The emphasis should be less on what consumers in remote areas of the EU think than whether a trademark owner can be allowed, on account of combination marks, to monopolize descriptive beginnings or endings of words. There is no statutory or policy reason impeding such monopolies only to avoid “confusion”. The legislation itself allows, or in fact orders, coexistence even of identical marks on a number of occasions (for example, in the case of intervening rights). Trademarks should be given the protection they deserve. Apart from that, consumers are smarter than is often assumed. After all, the relevant public here, at least for the pharmaceutical marks,

is either a health care professional, or a consumer with a high degree of attentiveness.