



Pharmaceutical trade mark confusion and the relevant consumer: Some case law considerations

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Chairperson of the EUIPO First Board of Appeal
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Relative grounds for refusal – Article 8(1) (b) EUTMR

Article 8(1)(b) EUTMR – Likelihood of confusion

...the trade mark applied for shall not be registered

(b) if because of its **identity** with, or **similarity** to, the **earlier trade mark** and the identity or similarity of the **goods or services** covered by the trade marks there exists a **likelihood of confusion** on the part of the **public** in the **territory** in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark

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Relative grounds of refusal - Article 8(1) (b) EUTMR

Likelihood of confusion (LoC)

- To be assessed **globally** taken into account all relevant factors
- Based on the degree of similarity of the **G&S** and the **overall impression** given by the **marks** (visual, phonetic and conceptual) from the perspective of the relevant public
- Taking into account the **distinctiveness** of the **earlier mark**
- **Interdependence** principle: the more distinctive the earlier mark the more likely is the likelihood of confusion

C-251/95, Sabèl / Puma, §§ 22 - 24

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Relative grounds of refusal - Article 8(1) (b) EUTMR – The relevant public

In the global assessment of the likelihood of confusion, account should be taken of the **average consumer** of the category of goods concerned, who is **reasonably well informed and reasonably observant and circumspect**. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question

T-256/04, Respicur, § 42

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Relative grounds of refusal - Article 8(1) (b) EUTMR – The relevant Territory

Article 8(1)(b) EUTMR

.. . if there exists a likelihood of confusion on the part of the public **in the territory in which the earlier mark is protected**

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Relative grounds of refusal – Article 8 (1) (b) EUTMR – Similarity between goods and services (G+S)

Factors to be taken into account in assessing similarity:

- Nature
- Intended purpose
- Method of use
- Competition or complementarity

C-39/97, *Canon*, § 17

- Distribution channels of the goods concerned (T-164/03, *Ampafrance v OHIM — Johnson & Johnson (monBeBé)* [2005] ECR II-1401, § 53)

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WHAT FACTORS ARE TO BE CONSIDERED AND WHEN?

04/03/2020, C-328/18 P, *Black Label by Equivalenza*

- Faint similarity** between signs is **enough** to trigger the need for a **global assessment** that factors-in criteria such as reputation or recognition of the earlier mark into the LoC equation [§ 60]
- The **circumstances** under which trademarked goods are **marketed** "are to be taken into account at the stage of the **global assessment** of the likelihood of confusion and not at that of the assessment of the similarity of the signs at issue" [§ 70];
- Counteraction** of **visual and phonetic similarities** can only occur where "at least one of the signs at issue has, from the perspective of the relevant public, a **clear and specific meaning** which can be grasped immediately by that public" [§ 75] – T-441/16, *Sebotherm/SeboCalm*
- Instances of **counteraction** are limited to the "**exceptional case**" [§ 75]. - 17/09/20, C-449/18 P, *Messi/Massi*

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WHAT FACTORS ARE TO BE CONSIDERED AND WHEN?

- The **circumstances** under which trademarked goods are **marketed** "are to be taken into account at the stage of the **global assessment** of the likelihood of confusion and not at that of the assessment of the similarity of the signs at issue" [par. 70];
- Counteraction** of **visual and phonetic similarities** can only occur where "at least one of the signs at issue has, from the perspective of the relevant public, a **clear and specific meaning** which can be grasped immediately by that public" [par. 75]; and
- Instances of **counteraction** are limited to the "**exceptional case**" [par. 75].

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Comparison of goods: Therapeutic indications

20/01/21, T-261/19, Mar (DE)/ 

- ❑ **BoA** found ‘**medicated nasal sprays (PoU)** similar or identical to the ‘pharmaceuticals; medicinal sprays; antibacterial sprays; anti-inflammatory sprays; collyrium; ophthalmologic preparations’ (Cl. 5) and the ‘medical apparatus and instruments’ (Cl. 10) BUT not ‘**medicated dental rinses**’
- ❑ **GC** held:
 - **medicated nasal sprays and medicated dental rinses similar to a low degree**
 - **The purposes of these goods are similar: treating the respiratory system**

Cf. 28/05/2020, T-724/18 & T-184/19, AUREA BIOLABS (fig.) / Aurea et al., § 75

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Comparison of signs: Weakly distinctive elements

20/01/21, T-261/19, Mar (DE)/ 

BoA found **no LoC**, despite conceptual similarity and a low degree of visual and phonetic similarity, because earlier mark weak and the relevant public’s attention high

GC upheld contested decision:

- **German** public understands ‘**mar**’ refers to the **sea** and it is **well known** that nasal sprays are mainly manufactured from salt water or sea water (para. 41)
- **® symbol** is **negligible** in the overall impression and the **figurative elements** of the **EUTMA** are ‘**relatively simple**’.
- **Opti** is either **laudatory** or refers to the **eye**
- The relevant public’s level of **attention** is **high**

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Goods versus services: Complementarity

25/11/2020, T-802/19, KISS et al. /



KISS COLOR

EUTMA
 for pharmaceuticals; sanitary products for medical use, dietetic preparations adapted for medical use, disinfectants (Cl. 5) and cosmetic services, hygienic and beauty care for human beings (Cl. 44)

Earlier TM: sterile implantable products for filling wrinkles, fine lines, cutaneous depressions and for adding volume to the lips in Class 5.

GC upheld contested decision:

- **Relevant public: beauty sector pros (Cl. 5) & gen. pub. of EU (Cl. 44)**
- **Attention level: average to above average (health and beauty)**

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Goods versus services: Complementarity

GC's findings (cont'd):

- **Average similarity** between 'Cosmetic services, hygienic and beauty care for human beings' (cl. 44) and 'sterile implantable products for filling wrinkles, fine lines, cutaneous depressions and for adding volume to the lips' (Cl. 5) due **to complementarity**
- **'Certain impression of similarity'** in the mind of the relevant public because the **sole component** of the **earlier mark** entirely is **reproduced in** the EUTMA
- Normal degree of distinctive character of the earlier trade mark

=> LoC

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Limits to Complementarity

EUTM application	Earlier trade mark
	APIRETAL

05/10/2020, T 51/19, apiheal (fig.) / APIRETAL

GC's findings:

- 'Perfumery; cosmetics; fragrances; deodorants for personal use and animals; soaps; bath herbs, not for medical purposes' (Class 3) are dissimilar to the opponent's 'antipyretics' (Class 5).
- Although these products are sometimes used together, they are not complementary since one is not indispensable or important for the use of the other and they can be used independently from each other (§ 48).

=> No LoC

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THANK YOU FOR YOUR ATTENTION!

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