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General Court again supports weak opponent in pharma mark case

European Union - MAQS Law Firm

Examination/opposition
International procedures

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In *Farmaceutisk Laboratorium Ferring A/S v Office for Harmonisation in the Internal Market* (OHIM) (Case T-501/12) and *Ferring BV v OHIM* (Case T-502/12), the General Court has annulled decisions of the Fourth Board of Appeal of OHIM in which the latter had held that the marks PENTASA and OCTASA were not similar.

The background of the disputes is as follows. In 2009 applicant Tillots Pharma AG filed an application for the registration of the word mark OCTASA for "preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract" in Class 5 of the Nice Classification. Ferring BV and Farmaceutisk Laboratorium Ferring A/S filed notices of opposition based on the earlier word mark PENTASA, registered in Austria, Benelux, Hungary, Italy, Poland, Slovakia, Sweden, France, Ireland and the Czech Republic. The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) of the Community Trademark Regulation (207/2009) (as well as Article 8(5) of the regulation, but this was not relevant for the decisions).

The opponents furnished proof of use of the registrations, and the opponents' list of goods was deemed to cover "a pharmaceutical product prescribed for the treatment of diseases of the gastro-intestinal tract". In other words, there was identity of the goods.

Despite the identity of the goods, the Opposition Division of OHIM ruled in favour of the applicant, finding that, even though the marks were visually, aurally and conceptually similar to the extent that they both referred to the concept embodied in the suffix 'asa', this suffix was common in the pharmaceutical field in relation to the goods at issue. The relevant goods were directed at end consumers and specialists in the medical field and the attentiveness of both would be high. Consumers generally pay greater attention to the beginning of a mark and, in this regard, 'penta' and 'oct' were dissimilar. The second common element, 'asa', was less distinctive. Accordingly, a likelihood of confusion could be ruled out in the sense of Article 8(1)(b) of the regulation.

The opponents appealed. The Fourth Board of Appeal of OHIM dismissed the appeals and upheld the Opposition Division's decisions. The board held, among other things:

- The opposition was based on a number of national marks, all consisting of the word 'Pentasa' and covering pharmaceutical preparations in general or in specific terms. The relevant public consisted of medical professionals and patients as the end users of the goods in question.
- The comparison of two marks must be based on the perception, pronunciation and meaning of the conflicting signs in the languages of the member states where the earlier mark is protected, and by reference to the target public of the goods and services at issue.
- For the relevant pharmaceutical products that can be obtained only with a medical prescription, the suffix 'asa' of the earlier mark, which described part of the active ingredient, was descriptive. The same applied to the suffix 'asa' in the contested mark, as this mark sought protection for pharmaceutical products for the treatment of the gastro-intestinal tract, the functioning of which depends on the active ingredient 5-aminosalicylic acid (acronym: 5-ASA).
- The conflicting marks PENTASA and OCTASA coincided in the descriptive element 'asa' which, in both marks, formed the last part. The marks differed in their first parts, 'pent' and 'oct'. They were visually and aurally dissimilar. Conceptually, in Greek 'penta' means 'five' and 'octa' means 'eight'. In this respect, the marks were conceptually dissimilar. The mere fact that the marks coincided in the descriptive element 'asa' could not render the marks similar from a conceptual point of view.
- As there was no visual or aural similarity resulting from the fact that the contested marks shared the element 'asa', the level of conceptual similarity resulting from that common element was necessarily of the same degree.

The opponents appealed to the General Court and fared better. The court emphasised that, for pharmaceutical preparations in Class 5, the relevant public consisted of both medical professionals and end users - that is to say, patients (for prescribed pharmaceuticals) and consumers (for over-the-counter medication). While the Board of Appeal might have established that the suffix 'asa' was descriptive for medical professionals, it had not established that patients and consumers in all the relevant member states (Austria, Benelux, Hungary, Italy, Poland, Slovakia, Sweden, France, Ireland and the Czech Republic) would also understand the suffix 'asa' as descriptive.

The court further held that the end users for whom there existed a certain degree of visual and phonetic

similarity between the signs constituted a significant part of the relevant public. For that part of the public, either the conceptual comparison was neutral, or there was a weak conceptual similarity between those signs. The Board of Appeal had thus erred in a manner liable to entail the annulment of its decisions by:

- finding that the signs at issue were dissimilar;
- holding that, as a result, one of the necessary conditions for finding that there was a likelihood of confusion had not been met; and
- refraining from carrying out a global assessment of the likelihood of confusion, taking into account all factors relevant to the circumstances of the case.

This is one of the rare cases in which the General Court has overruled a unanimous Opposition Division and Board of Appeal of OHIM. Both had refused to grant broad protection to what they perceived to be weak trademark elements. The General Court is thus sending a signal to the Opposition Division and Board of Appeal that, in such cases, they must ensure that not only medical professionals, but also end users, find a weak mark to be descriptive.

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