

Pharmaceutical products in Class 5 held to be similar to surgical devices in Class 10 European Union - MAQS Law Firm

Examination/opposition International procedures

September 19 2014

In *Micrus Endovascular v Office for Harmonisation in the Internal Market* (OHIM) (Case T-218/12, September 10 2014), the General Court has upheld a decision of the Second Board of Appeal of OHIM in which the latter had held that there was a likelihood of confusion between the opponent's trademark DELTA PORTUGAL for "pharmaceutical products" in Class 5 of the [Nice Classification](#) and the applicant's mark DELTA for "microcoils used for endovascular surgery for the treatment of aneurysms" in Class 10.

The dispute goes back to 2008, when Micrus Endovascular Corporation filed an application for the word mark DELTA. The goods for which registration was sought fell within Class 10. After amendment, the goods were described as follows: "medical and surgical devices, namely, microcoils used for endovascular surgery for the treatment of aneurysms".

Laboratorios Delta Lda filed an opposition based on the figurative mark DELTA PORTUGAL, which was registered in Portugal in 1947 in respect of "pharmaceutical, veterinary and hygienic products and dietetic products for children and patients" in Class 5.



The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) and Article 8(4) of the [Community Trademark Regulation](#) (207/2009).

Following the applicant's request for proof of use of the earlier mark, the Opposition Division first found, as regards the goods for which the mark was in use, that the opponent had documented proof of use for a broad range of pharmaceutical products. The range of pharmaceutical products documented was so wide and covered so many fields of therapy that it was impossible to describe that range as being limited exclusively to certain sub-categories of pharmaceutical products. Accordingly, taking into consideration the amount of evidence and the characteristics of that evidence, the Opposition Division (and all instances subsequently) found that genuine use of the mark had been established in respect of "pharmaceutical products".

Second, as regards the mark as used, the Opposition Division (and all instances subsequently) ignored the element 'Portugal' in the opponent's mark because, at the time the mark was applied for, the Portuguese Industrial Property Code of 1940 - Decree-Law No 30679 of August 24 1940 required the inclusion of the element 'Portugal' to indicate that the applicant was domiciled in Portugal; consequently, it was a descriptive term. Further, the Opposition Division (and all instances subsequently) held that, although the mark as used (depicted below) was "slightly different from the earlier Portuguese trademark as registered", this did not alter the distinctive character of the mark.



As regards the other elements of the mark, the Opposition Division found that they remained secondary to the word 'delta', "owing to their stylisation, size and informative meaning". Accordingly, it held that the opponent's Portuguese registration had been put to genuine use in relation to "pharmaceutical products", and that the sole distinctive element of that mark was the word 'delta'.

The Opposition Division thus upheld the opposition in its entirety and ruled in favour of the opponent. The applicant appealed, and by a decision of March 6 2012, the Second Board of Appeal rejected the appeal. Among others things, the board held as follows:

- Although the Class 5 goods covered by the earlier Portuguese trademark included products intended both for healthcare professionals - such as doctors, pharmacists and nurses - and for the general public (ie, patients), and the applicant's Class 10 goods were intended for professionals in endovascular surgery only, the level of attention of a public composed of both professionals and end consumers would be higher than usual, owing to the fact that the goods involved have an impact on consumers' health.

- Inasmuch as the relevant public, for the purposes of assessing the likelihood of confusion, consisted of persons likely to use both the goods covered by the earlier Portuguese trademark and the goods referred to in the trademark application, it was appropriate to define that public as being a restricted and specialised public consisting of professionals for whom the latter set of goods were intended.
- Although the goods covered by the marks were different in nature, since the goods protected by the earlier Portuguese mark were “pharmaceutical products” and the goods referred to in the trademark application were medical devices, they could be intended for the same public and distributed through the same distribution channels. The Board of Appeal agreed with the applicant that the specialists involved in the process of manufacturing the goods in question differed according to the category of goods concerned. However, that did not alter the fact that pharmaceutical companies could cover a number of areas within the healthcare sector. Therefore, according to the board, a single pharmaceutical company could consist of a number of different business divisions or units focusing on, for example, pharmaceutical products or medical devices/diagnostic appliances. Accordingly, it was not beyond the bounds of possibility for goods in Class 5 and goods in Class 10 to be produced by the same company and, as a result, to have the same commercial origin.

There were specific surgical operations with which specific pharmaceutical products were associated, given that it was necessary to administer those products before, during or after such operations. In particular, the Board of Appeal drew attention to the fact that there were cases where a medical treatment was complementary to the surgical operation and where it could continue for a certain period after that operation or even for the rest of a patient’s life. In that regard, prescriptions of medicines would be issued by professionals who were specialised in the medical area involved in each particular case.

- Since it had been established that the earlier Portuguese trademark had been put to genuine use in respect of “pharmaceutical products”, that term encompassed the complementary goods described above. In addition, according to the Board of Appeal, some of the products in respect of which genuine use had been established were specifically recommended in the treatment of cardiac or vascular diseases, that is, in areas connected with the field of endovascular surgery, for which the goods referred to in the trademark application were used.
- The goods in question were - at least to a certain extent - similar, given that they coincided with regard to their relevant public, distribution channels and commercial origin, and that they were complementary in terms of their use.
- Regarding the comparison of the signs in question, the Board of Appeal stated that it was aware that the obligation which existed on March 14 1945 (the date of filing of the earlier Portuguese trademark) to include the word element ‘Portugal’ in marks filed by applicants having their seat in Portugal had subsequently been abolished and that the opponent’s trademark right related only to the word ‘delta’, such that the marks at issue were identical.

The applicant appealed to the General Court, criticising the Board of Appeal’s finding that there was a likelihood of confusion. Among other things, the applicant argued that the category of relevant consumers was very narrow - namely, the brain surgeons who purchased the products of both parties.

The General Court held that, while the opponent’s Class 5 goods included articles normally handled by pharmacists and the goods covered by the application in Class 10 were specific products used in particular surgical circumstances, taking into account the complexity of the surgery and the organisation of clinics and hospitals, the products covered by both classes could be purchased through a “common central purchasing department” in hospitals, and not just by (very sophisticated and attentive) brain surgeons.

Concerning the complementarity of the goods, the court held that, as the goods in question had a “common intended purpose” in different contexts, there was a certain connection between the goods covered by the application in Class 10 and by the opponent’s mark in Class 5. Thus, even though some of the products in Class 10 constituted separate categories, there was still a “certain similarity” between them.

Finally, the General Court ruled that the Board of Appeal had been correct in concluding that the possibility of a likelihood of confusion between the marks could not be excluded, even though the level of attention of the relevant public was high.

It seems that all instances assumed the existence of a hospital procurement structure that is not readily apparent from the evidence submitted by the parties. This case thus shows, first, that it is possible to influence OHIM and the appellate instances with ‘raw’ arguments. Second, this case confirms the

proposition that OHIM is quite opponent-friendly, both as regards the similarity of marks and the similarity of goods/services.

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