

## **France and OHIM differ on similarity of pharmaceuticals with food supplements**

*Summary : on April 17, 2009, in Laboratorios Azevedos-Industria Farmaceutica S.A. v. Orchid Healthcare Ltd, the Opposition Division of the OHIM upheld that pharmaceuticals and food supplements were similar because they both pertained to class 5. This decision eludes the usual similarity criteria and contradicts with the French law which rules the same situation differently. It also takes opposite direction with what the French case law.*

British company Orchid Healthcare Ltd sought to register the word Community trademark ISOPRO in respect of “*dietetic substances adapted for pharmaceutical use, food supplements, food supplements containing soy isoflavonoids*” in class 5. An opposition was lodged by Portuguese company Laboratorios Azevedos-Industria Farmaceutica on the basis of the Portuguese trademark for ISOPROTIL covering “*preparations destined to pharmaceutical, chemical-pharmaceutical preparations, pharmaceutical preparations and medicaments for humans and animals*” in class 5. The Opposition Division regarded the signs as highly similar. The interest of the decision lied in the comparison of the products involved.

For the Examiner, food supplements and food supplements containing soy isoflavonoids were preparations intended to supply nutrients such as vitamins, minerals, fatty acids or amino acids that are missing or not consumed in sufficient quantity in a person’s diet. Whereas there was no explicit precision that these products were adapted for pharmaceutical use, their sole classification in class 5 brought the Division to uphold these products as similar with the products of the earlier mark by just pointing out that class 5 is mainly devoted to medical substances.

The justification of the OHIM is indeed quite surprising as the analysis is only focused on the identity of class between two products whereas it is long established in trademark practice that classes cannot be regarded as a relevant and exclusive criterion for the assessment of products similarity. The OHIM indeed completely eluded to compare the nature, purpose, function, destination, origin and distribution networks of the products to properly justify its decision.

The position of the OHIM indeed appears constant in its justification and solution. On May 22, 2009, the Opposition Division for instance reiterated the same approach while comparing “*pharmaceutical products*” and “*nutritional supplements*” in a matter concerning the marks NULCEX and NUFLEX. These products were ruled as similar on the sole basis of their pertaining to class 5.

This approach is in contradiction with the position of the French case law. On March 18, 2009, the Court of Appeal of Paris for instance decided that pharmaceutical products and food supplements have a different nature and fulfill a different function. The French Court pointed out that:

- pharmaceutical products may include any substance whereas food supplement necessarily contain element for nutrition purpose;
- pharmaceuticals aim to fight illness whereas food supplements are destined to preserve physical fitness and appearance.

This difference of practice between the OHIM and French Courts and the French Trademarks Office is consequently a factor to consider for trademark searches, watches and oppositions and other defense proceedings as the issue must be considered differently depending on where the question arises.

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