

Evocative parts of pharma trademarks can prevail!

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It is most likely that judges from the 5th and 6th Chambers of the General Court of the European Union took their breakfast or lunch together on last June 6!

Indeed both these Chambers had to judge this day similar cases with quite the same history and shared their argumentation and conclusions in two judgments dated June 6, 2013 that depart from most of the previous French and European case-law and in any case do not follow the usual trend.

Similar proceedings and main questionable assessment

The two actions concerned opposition cases regarding, for the first one, the prior CTM NICORETTE against the CTM application for NICORONO, both for smoking cessation products and, for the second, the prior French trademark PHARMASEE against the CTM application for PHARMASTREET, both for pharmaceuticals.

The Opposition Division upheld the oppositions on the basis of Article 8(1)(b) of Regulation No 207/2009 for all the contested goods on the ground that there was a likelihood of confusion on the part of the relevant public due to the identity of the goods in question and the similarity of the signs at issue.

The two decisions were appealed and the Second Board of Appeal of OHIM annulled the Opposition Division's decisions and rejected the oppositions in their entirety.

In both cases, it was noticed that the activities were identical and that considering the products in case properties that affect the state of health of consumers, the public concerned was having a high or at least higher than average level of attention.

In fact, the main questionable assessment in these two cases was focused on the question of likelihood of confusion between signs:

- only composed of one wording
- sharing the same identified prefix
- when this prefix is very evocative of the activities of concerned

In other words, **how trademarks should be compared when the only part they share is not (or not very) distinctive?** What level should be given to a part which is not distinctive or very evocative when similarity of signs and likelihood of confusion are to be assessed?

Usual trend

Even if it is true that otherwise decisions exist, stating that even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion (see Case T-134/06 Xentral vs. OHMI in 2007; Case T-260/08 Indo International SA vs. OHMI in 2012; Case T-273/10 Olive Line International SL vs. OHMI in 2012), most of the French and Community judgments in such cases are

used to state that short trademarks beginning with an evocative wording have a weak distinctive character and enjoy only very limited protection, which conveys to the absence of likelihood of confusion.

Most often and since many years, the fact that the distinctive character and the dominant element(s) of trademarks have to be taken into account when the likelihood of confusion is assessed (Case C-39/97 Canon in 1997) led to reject the likelihood of confusion when the only part that is replicated has a low degree of inherent distinctiveness.

Indeed, it regularly happens that signs are considered as sharing a certain degree of similarity on the phonetic, visual and intellectual points of view but that no likelihood of confusion is found considering that the shared elements will not attract the public attention and will not be memorized (see Case T-60/11 Kraft Foods Global Brands LLC vs. OHMI in 2012).

How judges have appreciated the signs in case

It may not be useful to review the arguments, mainly developed for the prefix NICO, confirming that PHARMA is evocative of pharmaceuticals and NICO of nicotine.

The interesting part of each decision is the way these two evocative parts have been assessed by judges in appreciating the likelihood of confusion.

The traditional European Case-Law considers of course that ***a weak distinctive element cannot just be excluded from the comparison, as far as the overall impression should be taken in to account.***

In points 61 of the decision NICORONO, judges remind that “according to the case-law, when the element placed in the initial part has a weak distinctive character in relation to the goods covered by the marks at issue, the relevant public will attach more importance to their final part, which is ***the most distinctive*** (see, to that effect, Case T-117/02 Grupo El Prado Cervera v OHIM –Debuschewitz’s heirs (CHUFADIT) [2004] ECR II-2073, paragraph 54, and COR, paragraph 56)”.

Nevertheless, the light distinctive character of a trademark component ***does not implicate that this component cannot be dominant.*** Its position and dimension in the mark should be analyzed to check whether it will be imposed to the consumer perception and memorized.

As regard NICORETTE vs NICORONO, judges considered that the element ***“nico” makes a significant contribution to the overall impression*** produced by the marks at issue so that the relevant public will attribute at least as much importance to it as to the final part of the marks. Its weak distinctive character is offset by the fact that it represents two of the three syllables of the earlier mark and two of the four syllables of the mark applied for. It is therefore longer than the final part of the earlier mark and as long as the final part of the mark applied for.

As regard PHARMASEE vs. PHARMASTREET, judges also found a similar overall impression stating that the ***element “pharma” is to be considered as dominant*** knowing that the beginning of a mark is usually more impacting for consumers and that “street” and “see” are shorter and ending.

In the two cases, the overall impression was completed by the fact that the incorporation of the same prefix was not the only similar point, i-e that the marks were composed of only one word with quite the same length and rhythm, they shared the same sounds “r” after “nico” and the ending sounds “s” and “i” (ee) after “pharma”.

In our view the comparison on the intellectual point of view is also to be pointed out in particular.

Indeed, the suffixes “rono” and “rette” have no meaning and the “relevant public will be able to distinguish the element ‘nico’ in the marks at issue and understand its conceptual content, which refers to nicotine” so that the trademarks NICORONO and NICORETTE are conceptually similar, considering that the weak distinctive element cannot be excluded from the comparison.

This is understandable, considering that the marks meanings are not far from each other, but more arguable regarding the other case.

Indeed, the first mark PHARMASEE is made of a phonetic pun with the french word “pharmacie” and the english verb “to see” when PHARMASTREET is a fantasy word built with the prefix “pharma” and the english word “street”.

Even if they noticed that these two evocations were not the same, judges considered that the english words “see” and “street” were not sufficient to avoid the similarity given by the same evocative meaning PHARMA, which will be memorized by the public at stake.

Consequently, also ***on the conceptual point of view the weak element was considered as dominant against distinctive parts of the mark having another signification.***

Impact on trademarks strategy

A weakly distinctive element of a mark is not generally considered to be the distinctive and dominant element of the overall impression conveyed by it and is often considered as negligible when comparing the marks at issue.

Nevertheless, ***this is not a general rule*** and when comparing trademarks, it is of most importance to study the overall impression given by the marks in case, and in particular to determine on which part of the signs the attention of the relevant public is to be drawn, which is ***not necessarily the most distinctive element.***

These decisions should clearly have consequences on the strategy in the field of trademarks, especially since marketing teams very often tend to choose new trade names having an evocative meaning to easily touch the mind and memory of their public.

In availability searches matters, the selection of relevant signs to be studied should be broader keeping in mind the overall impression given by prior rights to be compared with the projected name.

For trademark watches, the defense policy should be reviewed in order to decide whether actions should be taken or not against trademarks sharing a weak distinctive element but that could be considered as close as a whole.

Finally, in case of litigations, the good point should be that chances of success against trademarks sharing the same evocative element could be higher than previously.

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Documentation:

Case T-580/11, *NICORETTE* vs. *NICORONO*

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=138103&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=1701480>

Case T-411/12, *PHARMASEE* vs *PHARMASTREET*

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=138082&pageIndex=0&doclang=FR&mode=lst&dir=&occ=first&part=1&cid=1701480>