Bugnion SpA

One swallow doesn't make a summer

A UIBM Opposition Division decision advocates greater caution in protecting direct consumers of pharmaceutical products. However, future rulings may well take the opposite approach

Opposition proceedings against trademark applications filed in Italy and against Italian designations for registration of international trademarks reveal the methods used to examine possible likelihood of confusion based on the different products or services claimed and on the different characteristics of target consumers.

A recent decision of the Opposition Division of the Italian Patent and Trademark Office (UIBM) provides an opportunity to identify, describe and compare the assessment process nationally and at EU level, taking into account the particular dynamics of opposition disputes involving pharmaceutical products, which differ from those involving almost all other goods.

UIBM Opposition Division decision

The decision issued by the Italian examiner on July 25 2013 in Opposition Procedure 448/2011 confirmed a risk of confusion between the mark ALSAMED (Application RM2011C003864) and the earlier ALSA BOLOGNA registration (Trademark 1295589).

The opposition was only partially successful and the later trademark was refused only for products in Classes 5 and 10, which had been claimed by citing the headings of their respective goods classes.

The earlier trademark on which opposition was based did not claim Class 5 products, but exclusively a detailed list of products in Class 10, such as apparatuses and appliances for medical, surgical, dental and veterinary purposes, ophthalmic and electro-medical therapy, mechanical-therapeutic, massage and psycho-technical purposes, ozone and oxygen therapy, intensive care breathing and aerosol therapy.

The upholding of the opposition – solely for products in Classes 5 and 10 – led the examiner to focus on a couple of landmark points.

In assessing the likelihood of confusion, the examiner rejected the applicant's claims arguing that allegations of risk of confusion should not be admitted in view of the special characteristics of the target consumers of the products. The applicant argued – based on considerable doctrine and case law – that medical professionals are careful when purchasing products and are thus exposed only to a slight risk of confusion.

With regard to the similarity between the products, the examiner first underlined that the relevant factors for comparison of the products included the nature and purpose of the products, distribution channels, retail outlets, manufacturers, modes of use and whether they were competing or complementary. A comparative examination of the products thus determined that some of them were identical (Class 10), and that the opposed products in Class 5 (eg, pharmaceutical and veterinary products) were moderately similar to apparatuses and appliances for medical, surgical, dental and veterinary purposes.

In assessing the likelihood of confusion based on the level of care exercised by the target consumer, the examiner underlined that, although the products on which the opposition was based were intended for a specialised target group, the opposed products were aimed both at a specialised target group and the general public, which nevertheless were informed and reasonably attentive and aware. Therefore, the examiner did not agree with the applicant that likelihood of confusion could be ruled out, given the type of customer at whom the products were aimed. The examiner determined that some products (eg, baby food, plasters and bandages) were aimed at a non-specialised target group, and that the similarity between the signs and the similarity or identity of the products might cause confusion even in attentive consumers.

The examiner went on to comment on possible negative determinations for likelihood of confusion in cases of coexistence on the market of trademarks with identical beginnings. The examiner seemed to suggest that had the applicant provided in-depth arguments on coexistence in the target market (pharmaceutical products) which were sufficient to provide further grounds for the examiner's assessment, the outcome might have been different, to the extent of denying the likelihood of confusion that was affirmed in the decision.

In this regard, the only element identified as a criterion for assessing likelihood of confusion by the parties for the trademarks was the common first parts of their names: the four letters ALSA in sequence.

Since it is well-established procedure in the pharmaceutical sector for the main players to adopt trademarks consisting of generic prefixes that allude to the product's characteristics or to the illness which it treats, and there is settled case law for assessing the likelihood of confusion in such cases, the request to provide in-depth arguments on the alleged absence of likelihood of confusion in cases of co-existence on the market of trademarks with the same initial letters should be considered an important indication on how to plan defensive (and obviously also offensive) strategies in future cases.

The tougher approach adopted by the UIBM seems to reflect changing conditions in the pharmaceuticals sector and is a response to heightened demand for the protection of end consumers who – more so than previously – find themselves

purchasing pharmaceutical products without the intermediation of highly qualified figures, such as pharmacists and pharmacy sales staff.

This greater need for protection informs both the case at hand and the reply to the follow-up question on the similarity between the Class 10 products claimed and most Class 5 products – surprising not so much for what it states as for the lack of detailed grounds provided.

What seems groundbreaking is the assessment of moderate similarity between products such as apparatuses and appliances for medical, surgical, dental and veterinary purposes and pharmaceutical and veterinary products.

To argue such similarity based merely on the fact that both cases deal with 'elements' used to treat or cure illnesses or health problems would appear vague, leaving itself open to the objection that it seems to be a mere assumption made without providing the necessary proof.

Indeed, if the line taken in this statement were followed, similarity in almost all cases involving administrative or jurisdictional disputes could be detected, given that in all actions there is always a relationship of competitiveness between the parties.

OHIM policy

The policy of the Office for Harmonisation in the Internal Market (OHIM) for assessing likelihood of confusion between trademarks and similarity between products in the pharmaceutical area is quite different.

In particular, Decision 148C 000825372/1 of the OHIM Cancellation Division (on the CEREBRESP trademark and its lack of novelty in view of the priority of the CELEBREX mark) outlines OHIM policy in the pharmaceutical trademarks area, providing a useful summary of the opposing positions in doctrine and jurisprudence in most EU member states.This should have encouraged the Italian examiner to provide more thorough grounds for her own decision.

In this decision, in particular, OHIM's policy on pharmaceutical trademarks was described as differing from that applied in from other sectors; specifically, it was stated in relation to trademarks for pharmaceutical products that "even if the average consumer does not have any specialized knowledge in the field of medicine, he is somewhat cautious regarding the nature of these products as they involve health".

Nicola Tarantini
Associate
tarantini@bugnion.it

Nicola Tarantini is an Italian and Community trademark professional representative with a legal background. He graduated from the Law University of Milan. He focuses on advisory services, filing and prosecution in the field of trademarks, domain names and designs. He is adept in helping clients to add competitive value to their business.

Conclusion

The UIBM Opposition Division's decision, which advocates greater caution in protecting direct consumers of pharmaceutical products, is therefore noteworthy. Further decisions confirming (hopefully with more substantial arguments and grounds) this harder line taken in the pharmaceutical trademarks area are awaited.

However, as the saying goes, one swallow does not a summer make. Future rulings may well take the opposite approach to that expressed in this decision. WTR