November 2009

Review

Intellectual Property

Cases T-493/07, T-26/08 and T-27/08 GlaxoSmithKline SpA, Laboratórios Wellcome de Portugal, Lda and The Wellcome Foundation Ltd v OHIM (23 September 2009)

The likelihood of confusion refers to confusion as to the origin of goods and not consumers simply mistaking one product for another

The Court of First Instance has rejected a combined appeal by GlaxoSmithKline Spa ("GlaxoSmithKline"), Laboratórios Wellcome de Portugal, Lda ("Wellcome") and The Wellcome Foundation Ltd ("Wellcome Foundation") (together the "Applicants"), against decisions of the First Board of Appeal of OHIM for a declaration of invalidity of the Community Trade Mark FAMOXIN on the grounds there was no likelihood of confusion by the public with the earlier registered mark LANOXIN.

Background

On 30 November 2001, Serono Genetics Institute SA ("Serono") filed a CTM application for FAMOXIN. Registration was sought for 'pharmaceutical preparations for the treatment of metabolic disorders adapted for administration only by intravenous, intra-muscular or subcutaneous injection'. The mark was registered on 31 May 2005.

On 30 September 2005 the Applicants filed three applications at OHIM for declarations of invalidity of the registration of FAMOXIN, relying on earlier trade mark registrations of LANOXIN registered for 'pharmaceutical preparations with digoxin for human use' or 'medicinal and pharmaceutical products', or similar, depending on the country of registration. The applications were made under Article 52(1)(a) of the Community Trade Mark Regulation 40/94 on the ground that because of its identity with or similarity to LANOXIN and the identity or similarity of the goods covered by LANOXIN and FAMOXIN there existed a likelihood of confusion on the part of the public. On 30 October 2006, the Cancellation Division rejected the applications for declarations of invalidity.

The Applicants' previous appeal

The Applicants filed appeals, which were heard separately by the First Board of Appeal in 2007. The Board of Appeal rejected all three appeals essentially on the same reasoning.

Identity/similarity of goods

The Board stated that the earlier mark, LANOXIN, should be deemed to be registered for 'pharmaceutical preparations for cardiovascular illnesses' or 'pharmaceutical preparations with digoxin for human use for cardiovascular diseases', (depending on the country of use), a sub-category of goods covering only those goods in respect of which the earlier mark had been used. The Board of Appeal then stated that, following this reasoning, the goods covered by the earlier mark LANOXIN could be used in tablet or liquid form and be administered orally or by injection for the treatment of cardiovascular disease, while the goods covered by FAMOXIN were intended for injection only for treatment of metabolic disorders.

The Board went on to say that, as the goods intended to treat metabolic disorders would be administered by healthcare professionals, patients would probably not see the mark under which the goods were sold and even though a small number of patients may administer the injection themselves, the goods would nevertheless be used under the supervision of a professional. The Board of Appeal held that the goods for treatment of cardiovascular illness would also be administered under the supervision of healthcare professionals, due to the seriousness of the illness. Therefore the relevant public would be made up of professionals. So, although there was a certain similarity between the goods covered by LANOXIN and FAMOXIN, this similarity was offset by the fact that the goods had different therapeutic uses and that end users were treated by physicians who had a high degree of attentiveness.

Identity/similarity of marks

The Board of Appeal stated the two marks differed both aurally and visually and had a low level of conceptual similarity. Therefore they were only very slightly similar.

Likelihood of confusion

The Board of Appeal concluded there was no likelihood of confusion since the relevant public were professionals and the general public, under their guidance, would not be required to choose between the two marks.

The appeal

The Applicants appealed to the Court of First Instance. The Court of First Instance upheld the decision of the Board of Appeal.

Finding of sub-category of goods

The Applicants contested the finding of the Board of Appeal that the earlier marks were used for 'pharmaceutical preparations for cardiovascular illness', or 'pharmaceutical preparations with digoxin for human use for cardiovascular illnesses', depending on the country of use. The Applicants submitted that sub-categories for therapeutic areas were arbitrary.

The Court stated that pursuant to Article 56(2) and (3) of Regulation 40/94, the proprietor of a Community trade mark may require proof that, during the period of five years preceding the date of an application for a declaration of invalidity, the earlier mark has been put to genuine use in the territory for which it is protected. If the applicant for a declaration of invalidity cannot show the genuine use of the earlier mark in the market concerned, the earlier mark cannot be relied upon to show invalidity of the Community trade mark. Also, if the earlier mark has been used only in relation to

part of the goods or services for which it is registered, then it is deemed registered in respect only of that part of the goods or services. Therefore, if a trade mark has been registered for a broad category of goods or services but has in fact only been used for a narrow sub-category of those goods then only the registration covering that sub-category can be relied on in invalidity proceedings.

The Court stated that the category of pharmaceutical preparations covered by LANOXIN was sufficiently broad for it to be possible to identify within it various sub-categories. One sub-category that could be identified related to the particular therapeutic use of the pharmaceutical preparations concerned. The Board of Appeal had been entitled to identify the sub-category of 'preparations for use for cardiovascular illnesses' and had not acted arbitrarily.

Relevant public for the purposes of assessing confusion

The Court upheld the Board of Appeal's decision that the relevant public for the purposes of assessing confusion is comprised of medical professionals (doctors and pharmacists) and end consumers under the supervision of professionals. These individuals had a higher than average degree of attentiveness. These preparations were prescribed and so patients generally (with a normal degree of attentiveness) would not normally have to see and choose between trade marked products.

Identity/similarity of goods

The Court upheld the Board of Appeal's decision that there was a certain degree of similarity between the goods concerned. The goods were of the same type (pharmaceutical preparations), had the same intended purpose (to treat human health problems) and used the same distribution channels (health centres and pharmacies). However they had different therapeutic indications.

Comparison of the marks

The Applicants also submitted that taken as a whole, the visual and aural similarities were high between LANOXIN and FAMOXIN. The Court held that although both marks contained the suffix 'oxin', a common ending for words in the pharmaceutical field, the elements at the beginning of the conflicting signs 'lan' and 'fam' were visually different. These prefixes had a greater overall visual impact than the final element 'oxin'. Also, consumers generally took more note of a mark's beginning than its ending.

The Court held that the initial syllable of the signs, 'fa' and 'la' had similarities in vowel sounds, however the second syllables 'mo' and 'no' produced differing sounds, with little weight given to the final element 'oxin', as it was relatively common in pharmaceutical preparations and often perceived as descriptive of them. Therefore it was the first syllables that were likely to give greater impact aurally. The Court upheld the Board of Appeal's decision that the trade marks were only very slightly similar.

Likelihood of confusion

The Court conducted a global assessment of the likelihood of confusion. It stressed that the relevant likelihood of confusion was as to the commercial origin of the goods. The risk that consumers might confuse one medicinal product for another was not relevant. In light of the fact that the conflicting signs were only slightly similar, the public's degree of attentiveness was higher than average and that there was some similarity between the goods, the court held that there was no risk that the public would believe that the goods bearing the word mark FAMOXIN come from an undertaking which held the earlier words marks LANOXIN or from an undertaking economically linked to them. It found, therefore, that there was no likelihood of confusion and the Applicants action must be dismissed.

Comment

The decision reinforces a number of important points that parties should bear in mind when considering an appeal. It confirms the Board of Appeal's ability to limit the scope of protection to sub-categories of goods that the mark has been used for. This ensures that trade marks do not benefit from a wide scope of protection just because they have been registered for a broad category of goods if use has been in relation to a more limited specification and the registration on which a proprietor relies is potentially vulnerable to revocation for non-use.

Also of significance is the court's view of what is important when assessing the likelihood of confusion for consumers. The court held that rather than consumers confusing the goods and taking one product instead of another, it is confusion as to the origin of the goods that is of greater significance, at least where the goods were used by healthcare professionals.

FURTHER INFORMATION

For further information on any of the issues raised in this article, please contact:

Chris McLeod
Director of Trade Marks for the UK, London
T: +44 (0)20 7655 1590
E: chris.mcleod@hammonds.com

WWW.HAMMONDS.COM

If you do not wish to receive further legal updates or information about our products and services, please write to: Richard Green, Hammonds LLP, Freepost, 2 Park Lane, Leeds, LS3 2YY or email richard.green@hammonds.com.

These brief articles and summaries should not be applied to any particular set of facts without seeking legal advice. © Hammonds LLP 2009.

Hammonds LLP is a limited liability partnership registered in England and Wales with registered number OC 335584 and is regulated by the Solicitors Regulation Authority of England and Wales. A list of the members of Hammonds LLP and their professional qualifications is open to inspection at the registered office of Hammonds LLP, 7 Devonshire Square, London, EC2M 4YH. Use of the word "Partner" by Hammonds LLP refers to a member of hammonds LLP or an employee or consultant with equivalent standing and qualification.