

Review

Intellectual Property



CFI finds no likelihood of confusion between RNAiFect and RNActive

In *CureVac GmbH v OHIM* (Case T80/08), the CFI dismissed an action brought by CureVac GmbH against the First Board of Appeal's rejection of CureVac's opposition to Qiagen GmbH's CTM application for RNAiFect. The action was dismissed as it was held that there was no likelihood of confusion between CureVac's earlier trade mark, RNActive and RNAiFect.

Background

On 1 August 2003, Qiagen applied to register the mark RNAiFect in classes 1, 5 and 9. The application was published on 27 September 2004.

CureVac filed an opposition on the grounds that RNAiFect was similar to and therefore likely to be confused with CureVac's own earlier Community trade mark, RNActive, registered in classes 1 and 5.

The Opposition Division and OHIM's First Board of Appeal found that there was no likelihood of confusion between the two marks, RNAiFect and RNActive. CureVac appealed to the Court of First Instance to annul the contested decision.

CureVac's arguments

CureVac raised a single plea alleging infringement of Article 8(1)(b) of the Regulation (EC) 40/94 (now Article 8(1)(b) of Regulation (EC) No 207/2009) and used the following arguments in support of its action:

- some of the goods covered by CureVac's mark and the goods designated in Qiagen's application were identical;
- despite the Board of Appeal agreeing with the Opposition Division that the RNActive mark had a weak distinctive character, the mark in fact had at least an average distinctive character as it had been registered as a Community trade mark and the average consumer would not perceive the letters RNA as an abbreviation of ribonucleic acid;

The CFI provides useful guidance on the application of the global assessment of the likelihood of confusion

- the marks were visually similar on the basis that the beginnings of both marks were identical and their reproduction e.g. the upper and lower case letters was within the scope of protection afforded to CureVac's mark;
- the marks were phonetically similar with the first three letters being identical and the sounds of the endings being barely distinguishable;
- Conceptually, the marks were similar as the earlier mark RNActive contained the German word "aktiv" which could be perceived as a synonym for the German word "effektiv" or as meaning "having an effect" which is contained within the RNAiFect mark.

CureVac submitted that due to the above similarities the overall impression created by the two marks was sufficient to give rise to a likelihood of confusion. OHIM and Qiagen contended that the plea should be rejected.

Decision

Similarity of the goods

The CFI confirmed in accordance with case law that in assessing the similarity between the goods and services to which the marks are applied, all the relevant factors which characterise the relationship which may exist between them should be taken into account. Such factors include their nature, their intended purpose and whether they are in competition with each other or are complementary.

Taking all the factors into account the CFI held that the Board of Appeal's decision that the goods at issue were not identical must be upheld on the basis that although "kits for introducing molecules and molecule aggregates" and chemicals for medical uses are highly similar, they are not identical.

Similarity of the signs

The global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question be based on the overall impression which they create, bearing in mind their distinctive and dominant components. The CFI confirmed that where, from the perspective of the relevant public, two marks had identical parts as regards one or more relevant aspects then those marks could be similar.

However, it agreed with the Board of Appeal's decision that notwithstanding the existence of a similarity resulting from the fact that the first three letters of the words were identical, the difference between the terms "iFect" and "ctive" was so great that there could be no likelihood of confusion.

Visually the signs both consisted of a single word containing eight letters, the first three of which were written in upper case and were identical. However, this was strongly mitigated by the presence of the last five letters in each word which were visually very different. The Court agreed with the Board of Appeal that despite the common component "RNA", attention would be drawn to the more distinctive end of the word and so there was no visual similarity between the marks.

In relation to phonetic similarity the Court found that the endings of the word created a clear distinction between the pronunciations of the words.

Regarding the conceptual comparison it was found that the relevant public would be made up of consumers who had an interest in the goods in question. In respect of the goods in class 5, this would be pharmacists and end consumers who were reasonably well informed, observant and circumspect with a high level of attention and assisted in

their choice by highly qualified professionals. In respect of the goods in class 1, this would be chemists and laboratory staff and other highly specialised personnel with an even higher level of attention than the consumers of the class 5 goods.

It was therefore, highly likely that the relevant public would perceive the letters as referring to ribonucleic acid or, in relation to the general public, a component or chemical or medical term even if the exact meaning was not known. The Court also accepted that in the pharmaceutical industry it was not unusual for producers to refer to chemical or molecular compounds to emphasise the alleged effectiveness of a pharmaceutical product.

In respect to CureVac's arguments that a German consumer would be able to make a connection between "iFect" and "effect" and would then associate with the word "active" on the basis that the two terms referred to the notion of effectiveness or the word "effective", required the consumer in question to deconstruct the sign too much in order to make such an association between the two marks. Thus this was too improbable to be accepted by the Court.

Likelihood of confusion

The Court confirmed that the average consumer normally perceived a mark as a whole and did not proceed to analyse its various details. Account should also be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the marks and therefore had to place his trust in an imperfect picture of them which he had in his mind.

It confirmed that a likelihood of confusion would exist if, cumulatively, the degree of similarity between the signs in question and the degree of similarity between the goods covered by these marks was sufficiently high. However, in this case the fact that the goods in question were highly similar was offset by the weak degree of similarity between the signs and the weak distinctive character of the abbreviation "RNA". The Board of Appeal had been correct in finding that there would be no likelihood of confusion between RNAActive and RNAiFect by the relevant public.

Therefore the action was dismissed and CureVac ordered to pay costs.

Comment

In this decision, the CFI provides useful guidance on the application of the global assessment of the likelihood of confusion. The judgment confirms that it is the overall impression created by the whole mark which is relevant and therefore even marks which have identical components can be distinguishable where the other components offset the similarity between the marks.

FURTHER INFORMATION

For further information 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 2010.

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.