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Authors
Franck Soutoul and **Jean-Philippe Bresson**

Similarities between pharmaceutical trademarks

Similarities between products and services are a central concern of trademark strategies at various stages (eg, trademark availability searches, recitation of products and services in the application, trademark watches and, of course, administrative and legal proceedings).

This is no different when it comes to pharmaceutical trademarks. As in any particular field of activity, having an overall view of the tendencies that apply can be a difficult task, especially at the EU level, given the various divisions and levels within jurisdictions.

This chapter examines the situation with regard to similarities for pharmaceutical trademarks – examining the most recent and significant cases and taking a closer look at both the most likely and the most unusual scenarios.

Enlarging Class 5

When dealing with pharmaceutical trademarks, Class 5 naturally comes to mind. Assessing the similarity between pharmaceutical products is rather set in stone. However, difficulties can arise when the comparison involves pharmaceuticals and other Class 5 products.

Similarities between pharmaceuticals

While pharmaceutical trademarks with identical claims are absolutely prohibited, comparisons are more likely to arise between a trademark registered for a pharmaceutical specified in broad terms and another trademark covering a pharmaceutical with specific properties, features or aims. In such circumstances, the Community practice is well established: the Office for Harmonisation in the Internal Market (OHIM) considers these products to be similar. That was the position adopted by the Division of Opposition on May 22 2008, in a matter involving the marks NOVALUNA and NOVALAR, which covered "pharmaceutical preparations" and "pharmaceutical preparations and devices for use in the care and treatment of oral health and reversal agents to counteract the effects of other pharmaceutical agents such as anesthetics" respectively.

Where two trademarks cover pharmaceuticals with different properties, features or aims, the tendency is to regard them as having "the same function or intended purpose: treatment of human health problems, are directed at the same consumers: professionals in the health sector and patients, use the same distribution channels and can be complementary" (Board of Appeal, *NOZIN v NOZINAN,* March 31 2008).

However, some decisions still refuse to apply this similarity. This was the case in *LASA v LASATO* of March 25 2008, which involved "anti acid medicaments" and "pharmaceutical preparations acting on the central nervous system, pharmaceutical preparations against sleep disorders, all being available on prescription only". For OHIM, even if the products had the same general purpose (ie, to treat and cure) they

were used in completely different fields and thus were neither complementary nor in competition with each other.

Specific exclusions do not affect pharmaceutical similarities

Specifically excluding some properties, features or aims of the pharmaceutical is not the correct way to distance a trademark application from an earlier mark, as was made clear by the Board of Appeal on February 16 2009. An opposition had been lodged on the basis of the marks VEPRAMA, which covers "pharmaceutical products for treating cancer", and the Community trademark application for VETPHARMA, which was filed for "pharmaceutical, veterinary and dietetic preparations adapted for medical use, with the exception of pharmaceutical preparations for the treatment of cancer".

The board ruled that in limiting the scope of its goods in Class 5, the VETPHARMA applicant intended only artificially to remove the similarity between its goods and those covered by the earlier mark. However, this similarity still existed under trademark law. The limitation did not have the consequence of defining a specific type of product and did not affect the overall products' similarity. The board considered that there was no modification of the market in which all the products at hand were found, as they did not constitute a separate subcategory of general pharmaceutical products.

Similarity of pharmaceuticals to other Class 5 products

While this chapter cannot cover all situations that might be encountered in Class 5, it can examine the most frequent comparison cases for conflicting products and examine some of the more striking changes in EU practice.

Veterinary products are similar to pharmaceuticals in the eyes of OHIM. These products are composed of the same active agents or ingredients, and have identical therapeutic actions and purposes: they all contribute to increasing and preserving health, all come from the same industry or manufacturers, and all are traded by chemists. Some decisions have even found veterinary and pharmaceutical products to be identical.

EU case law considers that there is a similarity between pharmaceuticals and "dietary substances, food supplements". Some decisions are short on reasoning and simply point out that these products all belong to Class 5 (Opposition Division, *ISOPRO v ISOPROTIL,* April 17 2009). Others apply a deeper analysis to find a similarity. The (former) Court of First Instance (CFI) has held that there is a similarity between "dietary supplements" and "healing salves", because both are supplied without prescription, have the same nature, function and intended purposes (ie, to treat human health problems) and are sold in pharmacies (*CICATRAL v CITRACAL,* November 11 2009).

Products with a direct relation to health (eg, plasters) are regarded as being similar to pharmaceuticals, as they serve to cure, are used complementarily during medical or surgical treatment, are sold in the same shops and are aimed at the same public (*DERMATESS v DERMATEX,* August 3 2007).

A striking development has taken place with regard to the similarity of pharmaceuticals to insecticides, pesticides and fungicides. OHIM usually considers these products to be dissimilar because of their different destinations, public and place of retail (Second Board of Appeal, *ZYDUS v ZIMBUS*, May 7 2008). However, on September 10 2008, the CFI ruled in *ASTEX v ASTEX TECHNOLOGY* that "pharmaceuticals" and "insecticides for killing dust mites" were similar, as they shared the same purpose in preventing or treating a respiratory illness. They were also regarded as complementary, insofar as pharmaceutical preparations taken by persons suffering from respiratory problems are more effective if they are used while said insecticides kill the dust mites. The solution must be analysed in light of the fact that the signs at issue were almost identical, which offset the low level of similarity between the products. This remains an aspect to consider in strategies for pharmaceutical trademarks.

Other classes of product to consider

Of course, holders of pharmaceutical trademarks should consider other classes of product, which may also potentially include similar products. The difficulty lies in identifying prevailing trends, as things can move quickly in this area.

Similarities to products in Class 1

With regard to chemical products belonging to Class 1, the dominant tendency of EU case law is to regard them as similar to pharmaceuticals if they are specified as being destined for the pharmaceutical industry.

However, on January 4 2010 OHIM's Opposition Division moved backwards by rejecting an opposition involving the marks DROSETUX and DROSETIL because of the lack of similarity between "chemicals used in the pharmaceutical and medical industry" and "pharmaceutical, veterinary and dietetic preparations adapted for medical use".

OHIM stated that chemicals are normally bought wholesale by pharmaceutical companies in large quantities to become part of pharmaceuticals, which are packaged and sold as units over the counter in pharmacies or drugstores. The commercial channels involved were regarded as being different and the products at issue were not marketed alongside one another. Chemicals are manufactured in chemical production plants and processed in chemical laboratories or pharmaceutical companies, where the finished products are made. Pharmaceuticals, on the other hand, move from the pharmaceutical companies to pharmacies, hospitals, clinics and other healthcare institutions.

OHIM consequently took the view that consumers of pharmaceutical products had no interest in the large-scale purchase of the applicant's chemicals and were not concerned with the origin of the pharmaceutical's ingredients. Equally, customers of the chemical undertaking had no interest in buying the final pharmaceutical products. Additionally, although the chemical products were indeed used to manufacture the pharmaceuticals at issue, this connection was tenuous.

This (dis)similarity situation will have to be monitored continuously to see whether this remains an isolated case or whether there is a new turn as to the comparison of the products at issue.

Similarities to products in Class 3

The diversification of laboratories and corresponding extension of activities to para-pharmaceutical products gives clues about how to handle similarities to Class 3 products.

EU case law used to be quite radical in this regard. For OHIM, products such as "soaps, perfumery, essential oils, cosmetics, hair lotions, shampoos, dentifrices, bath salts, cosmetic preparations for slimming purposes" could not, by any definition, be considered to be medicinal and thus similar to pharmaceutical products. The sole fact that they could be found in pharmacies was not sufficient for examiners to find these goods to be similar.

However, since last year a number of decisions have admitted a certain similarity. For instance, on October 30 2009 (*LACPURE v LACTOPURUM*) OHIM stated that "articles for body care and beauty" and "pharmaceutical products" are frequently produced by the

same companies and that their places of sale and distribution networks often coincide. As a result, the limit between what is medical and what is not is hardly perceivable to the public, considering that some cosmetics may contain active products with therapeutic features.

Similarities to products in Class 10

Products aimed at the preservation and recovery of health are likely to apply to Class 10 products, such as "surgical, medical, dental and veterinary apparatus and instruments".

When specified under broadly worded descriptions, OHIM generally admits a similarity between Class 10 products and pharmaceuticals. For examiners, surgical, medical and veterinary apparatus and instruments may actually contain pharmaceutical delivery systems, such as pre-filled syringes or insufflators used to insert a powder or gas into a bodily cavity. Consequently, their purpose may be closely linked to pharmaceuticals. Some decisions rejecting a similarity have at least considered these products as complementary, as they all relate to the medical field and originate from the same undertakings.

However, when any of the products are specified under strict wordings itemising the properties, features and/or destination of pharmaceuticals and/or of surgical, medical or veterinary apparatus and instruments, the similarity is assessed as being at a low level (Opposition Division, *CALTEX v CALPEX,* April 30 2009).

Classes of service to consider

Those dealing with pharmaceuticals also need to consider classes likely to contain similar and/or complementary services. The situation proves to be quite stable with regards to Classes 35, 42 and 44. However, there are services that might emerge from unexpected classes.

Similarities to services in Classes 42 and 44

With regard to services in the pharmaceutical field, Classes 42 and 44 are most commonly associated with pharmaceutical products. Chemistry or chemist services in Class 42 are usually regarded as complementary to pharmaceuticals on the basis that said products are bought from chemist shops, often after obtaining pharmaceutical advice (eg, Opposition Division, *AXIOS v AXIOS,* January 22 2008).

As to Class 44, a similarity is usually perceived between medical services and pharmaceutical products of Class 5, as they share human health and curative purposes, have identical channels of distribution to the same end consumers and have a clear complementary relationship (see, among others, OHIM, *COPAXONE v SUBOXONE,* July 30 2009).

Similarity/complementary with services in Class 35

Is there still any need to say that pharmaceutical trademark strategies should include retail services that fall within Class 35? The point that particularly needs to be made is that some trademarks cover retail services without mentioning which products are covered by those services, while others cover retail services but clearly indicate the products to which they apply.

Unsurprisingly, the similarity or at least the complementary character between pharmaceutical products in Class 5 and retail services of the same products in Class 35 is admitted by EU case law, given that consumers are liable to believe that the manufacturer of such products also handles the retail services relating to them (OHIM, *PHARMACIA v FARMACIA URBAN HEALING,* June 8 2005).

It is more difficult to resolve the similarity or complementary character of retail services that feature no indicated products with those that do specify particular products. The CFI decided on September 24 2008 (*O STORE v THE O STORE*) that "retail and wholesale services, including on-line retail store services on account of the very general wording can include all goods, including those covered by the earlier trademark so that they display similarities to the goods concerned". Applied to pharmaceuticals, this means that "retail services" specified in broad terms under a trademark in Class 35 are regarded as being similar to pharmaceuticals claimed in Class 5.

Other classes of service to take into account

There are, of course, other similarity cases to consider in pharmaceutical trademark strategies. On November 24 2008 the OHIM Board of Appeal issued a decision (*PROCAPS v PROCAPTAN*), which is instructive with regard to classes in which potential similar services can emerge.

The board ruled that "distribution of consumer goods and products of all kinds, in particular pharmaceutical, veterinary and sanitary preparations" (Class 39) and "manufacture of consumer goods and products of all kinds, in particular pharmaceutical, veterinary and sanitary preparations" (in Class 40) were highly similar to pharmaceuticals.

Would Classes 39 and 40 have been naturally associated with pharmaceuticals? It is unlikely, but the board's decision makes clear that these two classes should be included in pharmaceutical trademark strategies.

Conclusion

The scope of similarities for pharmaceuticals requires trademark searches to be performed in at least Classes 5, 10, 35, 39, 40, 42 and 44. However, the classes to consider also depend on whether a house mark or product mark is involved, and the product's estimated life.

Obstacles that arise in trademark searches dictate the products likely to be specified in Class 5 and in the other classes. However, a balance must also be struck with a view to increasing the interaction between the signs and the products/services and gaining a larger scope of protection towards third parties.

The similarity of pharmaceuticals these days goes beyond the strict consumer approach and instead follows the logic of the pharmaceutical market and the new possible developments in the distribution of products by expanding the scope of conflicting products, but also by integrating services. WTR

Biographies
Inlex IP Expertise

Inlex IP Expertise
68, Rue Pierre Charron
75008 Paris
France
Tel +33 1 56 59 70 90
Fax +33 1 56 59 70 91
Web www.inlex.com

Franck Soutoul
Partner
fsoutoul@inlex.com

Franck Soutoul is the co-founder of Inlex, which was established in 1995. He is a European trademark attorney before the Office for Harmonisation in the Internal Market (OHIM), and is involved in trademark law, industrial designs, domain names, EU IP matters and unfair competition. Mr Soutoul is also an active participant in the world of industrial property and regularly shares his knowledge and experience in this sphere by giving courses on marketing and advertising awareness to young lawyers and professionals. He is a member of the French Association of Trademark Law and Industrial Design, as well as the PTMG, ECTA, INTA and MARQUES, and is an observer at APAA. Mr Soutoul is a regular contributor to French and English-language publications. He founded the blog IP Talk (www.ip-talk.eu) and heads its Pharminlex section.

Jean-Philippe Bresson
Senior legal expert
jpbresson@inlex.com

Jean-Philippe Bresson is a European trademark attorney before OHIM, a senior legal expert for Inlex since 1998 and president of the Trademarks Commission of French Attorneys. He specialises in trademark, design and copyright laws and, in particular, provides strategic counselling and advice on OHIM practice on highly sensitive matters. Mr Bresson is the author of numerous articles on IP matters in various well-known magazines. He is a member of the Association of Trademark Law and Industrial Design, PTMG and INTA, as well as being editor in chief of the blog IP Talk and co-supervising its Pharminlex section.