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General Court denies likelihood of confusion between pharmaceutical marks containing 'mar' element

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- **The General Court has confirmed that there was no likelihood of confusion between the figurative sign OPTIMAR and the earlier word mark MAR**
- **The inherent distinctiveness of the comment element 'mar' was low with regard to medicated nasal sprays**
- **There was a low degree of visual similarity and a low or, at most, average degree of phonetic and conceptual similarity between the marks**

In [Stada Arzneimittel AG v European Union Intellectual Property Office](#) (EUIPO) (Case T-261/19, 20 January 2021), the General Court (Fifth Chamber) has upheld a decision of the First Board of Appeal of the EUIPO rejecting an opposition against the registration of the figurative sign OPTIMAR for pharmaceuticals and medical apparatus based on the prior word mark MAR, for which proof of genuine use had been established for medical nasal sprays only.

Background

Italian company Optima Naturals Srl filed an application for registration of the figurative sign depicted below as an EU trademark (EUTM) for goods in Classes 3, 5 and 10, including "pharmaceuticals; collyrium; hygienic lubricants; ophthalmologic preparations; medicinal sprays; antibacterial sprays; anti-inflammatory sprays; medicated dental rinses" in Class 5 and "medical apparatus and instruments" in Class 10.



German pharmaceutical company Stada Arzneimittel AG filed an opposition based on various prior word marks for MAR, including a German mark covering, among other things, "pharmaceutical products; sanitary products for medical purposes" in Class 5.

The Opposition Division of the EUIPO found that proof of genuine use of the prior MAR marks had been established only for "medical nasal sprays" in Class 5 and only for Germany. It found that there was a likelihood of confusion with regard to most of the Class 5 goods, including medical sprays and pharmaceuticals, as well as with regard to medical apparatus and instruments in Class 10.

Upon appeal by Optima, the Board of Appeal of the EUIPO annulled the Opposition Division's decision and rejected the opposition in its entirety. Genuine use of the prior mark had only been proved in connection with medicated nasal sprays. There was no likelihood of confusion given the high level of attention of the relevant German public, the weak distinctive character of the earlier mark and the low degree of visual and phonetical similarity between the conflicting signs. This outweighed the conceptual similarity and the fact that medical nasal sprays were similar or identical to most of the Class 5 and Class 10 goods covered by the contested EUTM application.

General Court decision

In its action before the General Court, Stada Arzneimittel unsuccessfully raised a single plea in law, alleging infringement of Article 8(1)(b) of Regulation 2017/1001 (the predecessor of the regulation in force at the time, Regulation 207/2009, which has an identical wording in the relevant provision) - that is, that the Board of Appeal had erred in denying a likelihood of confusion.

As regards the comparison of the goods, the General Court considered that nasal sprays and medicated dental rinses were similar to a low degree as they both treated infections of the respiratory system - contrary to the Board of Appeal, which had found them to be dissimilar.

Further, the General Court sided with the conclusions of the Board of Appeal concerning the visual similarity between the MAR word mark and the OPTIMAR device mark, finding that it was only low, and that the phonetic similarity was low or, at most, average. The composite mark contained non-negligible figurative elements and the additional word element 'opti' at the beginning of the mark. The conceptual similarity was also low or, at most, average. Although the conflicting signs contained the identical element 'mar', the inherent distinctiveness of this element was low with regard to medicated nasal sprays. The term referred to the sea ('Meer' in German) and it is well known that nasal sprays are mainly manufactured from salt water or sea water.

Overall, the low or average degree of similarity of the signs, the high level of attention of the relevant German public and the weakly distinctive character of the earlier mark MAR excluded a likelihood of confusion, despite the identity or similarity of the conflicting goods.

Comment

The reasoning of the General Court seems convincing, with the decisive factors being the high level of attention of the relevant public and the weakly distinctive character of the common constituent 'mar' for the only goods - medicated nasal sprays - for which genuine use had been established.

Florian Schwab

Boehmert & Boehmert

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