

MULTIPHARMA held to be similar to MUNDIPHARMA
European Union - **Casalonga & Associés**

Examination/opposition
Confusion

December 13 2017

- **Mundipharma opposed MULTIPHARMA mark for likelihood of confusion**
- **EU General Court found that a conceptual difference could not be assessed and the marks had high degree of visual and phonetic similarity**
- **Court reversed EUIPO First Board of Appeal's decision that there was no likelihood of confusion**

Background

In November 2010, Multipharma SA filed an EU trademark application for the word mark MULTIPHARMA in connection with goods and services in Classes 5, 35 and 42 of the Nice Classification. Mundipharma AG filed a notice of opposition in March 2011 pursuant to Article 8(1)(b) of Regulation 207/2009 asserting a likelihood of confusion with its earlier EU trademark MUNDIPHARMA protected for "pharmaceutical preparations" in Class 5. In 2015, the EUIPO upheld the opposition and rejected the EU trademark application in its entirety.

Multipharma filed an appeal and in January 2016 the EUIPO First Board of Appeal reversed the Opposition Division's decision, holding that there was no likelihood of confusion between the signs, particularly in light of the relevant public's high level of attention, the clear conceptual differences between the signs and the weak distinctive character of both signs.

Mundipharma AG appealed that decision before the EU General Court, claiming an infringement of Article 8 (1)(b). It argued that the board of appeal was wrong to conclude that there was no likelihood of confusion. In particular, it asserted that there were no clear conceptual differences between the conflicting signs that would neutralise their visual and phonetic similarities.

EU General Court

The court confirmed the board of appeal's findings that the relevant public comprised health professionals and consumers with a high level of attention.

The court also confirmed the board of appeal's specific findings on the identity and similarity of the relevant goods in Class 5.

In respect of the visual similarity, the court upheld the board of appeal's finding that the signs had a high degree of visual similarity, with nine letters in common placed in the same order and differing only by two consonants, including 'l' and 't' which are visually similar.

Further, it was noted that although the term 'pharma' was descriptive, it should not be neglected when comparing the marks from a visual point of view.

Concerning the phonetic comparison, the court confirmed that the signs were phonetically similar to the extent that they shared nine letters placed in the same order differing only by the two consonants 'l' and 't' (multi) instead of the 'n' and 'd' (mundi).

However, the court reversed the board of appeal's finding regarding the conceptual comparison. The board of appeal had considered that the signs under comparison were conceptually clearly different. Nevertheless, while confirming that the term 'multi' would be understood by EU consumers, the court found that the term 'multipharma' did not have a clear and definite meaning. In this respect, it was noted that the term 'multi' had several possible meanings. In particular, it could be understood as 'much or many' but also as 'variety or range'. In view of the above, it concluded that the sign MULTIPHARMA may be understood as 'many medicines' or 'a large range or variety of medicines'.

Further, it found that the term 'mundi' would be understood in some member states as 'world'. Consequently, the sign MUNDIPHARMA could be understood as referring to a 'worldwide pharmaceuticals', 'a world of pharmaceutical products' but also 'a very large pharmaceutical company, including many pharmaceutical products'.

For these reasons, the court concluded that since neither of the signs had a clear and definite meaning for

the relevant public that would allow them to be directly understood, a conceptual difference between the signs could not be assessed.

Further, the court added that even if MULTIPHARMA had a clear meaning for the relevant public, such conceptual difference would not suffice to compensate for the high degree of visual and phonetic similarity between the signs.

In this respect, reference was made to the parallel national proceeding in which the Higher Regional Court of Berlin concluded, in its judgment of September 2 2016 regarding the German public, that the conceptual difference between the EU mark MUNDIPHARMA and the German word and figurative mark MULTIPHARMA was not sufficiently obvious to exclude any likelihood of confusion.

The court noted that national court decisions, although not invoked in the course of the proceedings before the EUIPO, may be taken into account by the EU General Court. In fact, neither the parties nor the court can be prevented from taking inspiration from national or international case law in the interpretation of EU law.

Comment

The EU General Court found that in light of the partial similarity of the goods and services, the high degree of visual and phonetic similarity and the fact that a conceptual difference could not be assessed, the board of appeal had wrongly annulled the opposition decision.

This decision, which may be too strict, confirms that it will be difficult to overcome a conflict with a prior trademark registration based solely on conceptual differences if the signs are visually and phonetically similar.

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