

World Trademark Review Daily

CTM applicant fails to demonstrate weak distinctive character of common element
European Union - Casalunga & Associés

Examination/opposition
International procedures

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In *Rovi Pharmaceuticals GmbH v Office for Harmonisation in the Internal Market* (OHIM) (Case T-97/11, September 16 2013), the General Court has upheld a decision of the Second Board of Appeal of OHIM in which the latter had found that there was a likelihood of confusion between the word mark ROVI PHARMACEUTICALS on the one hand, and the earlier figurative mark ROVI and word mark ROVIFARMA on the other.

Rovi Pharmaceuticals GmbH filed a Community trademark (CTM) application for the word mark ROVI PHARMACEUTICALS for products and services in Classes 3, 5 and 44 of the [Nice Classification](#).

[Laboratorios Farmacéuticos Rovi SA](#) filed a notice of opposition on the basis of:

- its earlier CTM registration for the figurative mark ROVI (pictured below) for goods in Classes 3 and 5; and



- the Spanish word mark ROVIFARMA for goods and services in Classes 5, 39 and 44.

The Opposition Division of OHIM upheld the opposition in its entirety on the ground that there was a likelihood of confusion pursuant to Article 8(1)(b) of the [Community Trademark Regulation](#) (207/2009).

Rovi Pharmaceuticals filed a notice of appeal, which was dismissed by the Second Board of Appeal. The board found that there was an above-average degree of visual and phonetic similarity and a partial conceptual similarity between the signs, which covered identical and similar products and services. In view of the above, it concluded that there was a likelihood of confusion between the CTM application and the prior marks.

Rovi Pharmaceuticals appealed to the General Court, seeking the annulment of the board's decision and the registration of the mark for all the goods and services claimed.

In support of its action, the applicant relied on two pleas in law:

1. The applicant argued that the Board of Appeal had not examined its arguments designed to show the low distinctive character of the word element 'rovi' in the earlier figurative mark, even though it took into consideration [Laboratorios Farmacéuticos Rovi's](#) arguments relating to the allegedly high distinctive character of that word element in Spain and Portugal, and based its decision on the finding that the word element did not have such a high distinctive character. In doing so, the applicant claimed that the board had infringed the principle of equal treatment.
2. The applicant alleged that the board had breached Article 8(1)(b) of the regulation.

In respect of the first plea, the court considered that the Board of Appeal had expressly stated in its decision that the presence of the marks in the register did not establish the co-existence of the marks on the market. In view of the above, the applicant had not demonstrated that the word element 'rovi' had a low distinctive character.

The board further found that:

"without going into the specifics about the higher distinctiveness of the term 'Rovi' in Spain and Portugal as claimed by [Laboratorios Farmacéuticos Rovi], a risk of confusion between both the earlier trademarks and the mark applied for on the part of the public in the [European Union], and especially in [Spain], was highly likely."

Therefore, the first plea was rejected as it lacked factual basis.

Regarding the second plea, the court confirmed the Board of Appeal's finding that there was a likelihood of confusion.

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Comparing the prior figurative mark and the mark applied for, the court found that the figurative differences between the marks were not sufficiently significant to cancel out the similarity created by the presence of the word element 'rovi' in both marks.

Comparing the prior word mark and the mark applied for, it held that the word element 'rovi', which is common to both marks, would attract the attention of the consumers on account on its position at the beginning of the signs and the fact that it is written in capital letters. In this respect, the court confirmed that the Board of Appeal was right to find that there was an above-average degree of visual similarity between those marks.

Concerning the applicant's argument that there was no similarity between the marks, the court found that the fact that the mark applied for contained two word elements and that the earlier mark contained a single word was of little relevance, since both marks have the same sequence of letters.

With regards to the comparison of the goods, it found that the goods in Class 3 covered by the mark applied for were similar to the goods covered by the prior figurative mark. Further, the goods in Class 5 and the services in Class 44 covered by the mark applied for were identical and similar to the goods protected by the prior marks.

In view of the above, the court found that, in the present case, the CTM application should not be registered for the goods in Classes 3 and 5 due to the existence of a likelihood of confusion with the earlier figurative mark. In addition, the existence of a likelihood of confusion as regards the earlier word mark precluded registration of the mark applied for in respect of the goods and services in Classes 5 and 44.

Finally, concerning to applicant's argument invoking the co-existence of the prior marks with other marks containing the denomination 'rovi', the court noted that it must be borne in mind that the co-existence of earlier marks on the market may reduce the likelihood of confusion that the Opposition Division and the Board of Appeal find exists as between two conflicting marks. However, that possibility can be taken into consideration only if, at the very least, during proceedings before OHIM concerning relative grounds for refusal, the applicant for the CTM duly demonstrates that such co-existence was based on the absence of any likelihood of confusion on the part of the relevant public between the earlier mark on which it relies and the mark on which the opposition is based, and provided that the earlier mark concerned and the marks at issue are identical (see, by analogy, *Grupo Sada v OHIM* (Case T-31/03), Paragraph 86, and *Castell del Remei v OHIM* (Case T-101/06)).

In this respect, as the applicant had failed to provide such evidence, the court confirmed that the Board of Appeal had rightly found that the element 'rovi' did not have a weak distinctive character and that there was a likelihood of confusion between the marks.

The decision is as expected, since the signs both begin with the same element and are used in the same sector; it confirms the current criteria for establishing the existence of a likelihood of confusion.

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