

General Court: no likelihood of confusion between BIOLARK and BIOPLAK

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- An opposition was filed against the international registration for BIOLARK in Class 10 based on the earlier Spanish word mark BIOPLAK in Class 5
- The court refused the EUIPO's application for a declaration that there was no need to adjudicate as the international registration had not been renewed
- The court concluded that the goods at issue were similar to a low degree, and that the marks had a low degree of visual, phonetic and conceptual similarity

On 3 May 2023 the General Court issued its decision in [Laboratorios Ern SA v European Union Intellectual Property Office](#) (EUIPO) (Case T-459/22).

Background

The international registration designating the European Union No 1 453 505 (depicted below) for goods in Class 10 was opposed on the basis of the earlier Spanish trademark registration BIOPLAK, protected for pharmaceutical products in Class 5, pursuant to Article 8(1)(b) of [Regulation 2017/1001](#).



The opposition was rejected, and the decision was confirmed by the Board of Appeal of the EUIPO on the ground that there was no likelihood of confusion.

The holder of the prior Spanish trademark filed an appeal before the General Court requesting that the board's decision be annulled.

Decision

Application for a declaration that there was no need to adjudicate

The EUIPO informed the General Court that the international registration designating the European Union had not been renewed and that, therefore, the action had become devoid of purpose.

The court disagreed. It held that, given that the application for registration was filed with effect from 6 January 2019 and that the non-renewal of the mark applied for did not take place until 24 November 2022, the board's decision, if it were to become final, would have the effect of rejecting the opposition and thus removing the obstacle to registration of the application for the period claimed, until its expiry. The mark applied for would thus be regarded as eligible for registration between the application date, namely 6 January 2019, and the date of its expiry, namely 24 November 2022. Therefore, the lapse of the international registration at issue, which occurred after the appeal was lodged, did not deprive the board's decision of its object or its effects, and the decision was not revoked. Accordingly, the application for a declaration that there was no need to adjudicate was refused.

Substance

The appeal was based on a single plea in law alleging infringement of Article 8(1)(b) of Regulation 2017/1001, disputing the Board of Appeal's findings concerning the comparison of the goods, the comparison of the marks and the global assessment of the likelihood of confusion.

Regarding the similarity between the goods, it was held that the earlier trademark was registered for "pharmaceutical products" in Class 5 and that it was not disputed that proof of genuine use of the earlier mark was adduced only in respect of "pharmaceutical products, namely platelet antiaggregant, in particular for the prevention of the formation of thrombi and for reducing the risk of obstruction of the arteries".

The court noted that the similarities between the goods at issue resulted from their common purpose - namely, to preserve or stimulate human health. It also considered, however, that such general category included a variety of products. Moreover, it held that the nature of the goods at issue was different, since the goods covered by the application consisted of various medical devices and instruments, whereas those covered by the earlier mark consisted of pharmaceutical products. As the Board of Appeal noted, it is not well known that an undertaking that produces devices allowing for the administration of pharmaceutical products also produces said pharmaceutical products. Therefore, the complementarity of the goods at issue was not established. In the light of the above, the court found that the Board of Appeal had rightly concluded that there was a low degree of similarity between the goods covered by the marks.

Regarding the comparison between the signs, the court noted that the signs had the common prefix 'bio'; however, while it is true that the first part of a mark tends to have a greater visual impact than the final part, such a consideration cannot be valid in all cases. The court held that the weak degree of distinctiveness of the element 'bio' considerably lessened the similarity arising from that sequence of letters in common. Therefore, the attention of the relevant public would be directed at the suffixes 'plak' and 'lark' of the marks, which constituted their distinctive elements. It further noted that the mark applied for also included a figurative element representing a black circle with the white silhouette of a flying bird inside, which would not go unnoticed by the relevant public. The court thus concluded that the Board of Appeal had rightly concluded that there was a low degree of visual and phonetic similarity between the marks.

On a conceptual basis, the court confirmed the board's holding that the marks were conceptually similar only to a low degree as they only shared an allusion to the biological nature of the goods covered.

In light of the above, the court confirmed the Board of Appeal's decision that there was no likelihood of confusion.

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