

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**

**OPPOSITION DECISION**

**N° 2013254**

**of 11 June 2019**

**Opponent:** **Newpharma, société privée à responsabilité limitée**

Rue Basse Wez 315  
4020 Liège  
Belgium

**Representative:** **GEVERS**

Holidaystraat 5  
1831 Diegem  
Belgium

**1<sup>st</sup> right invoked:** **Benelux trademark 838080**



**2nd right invoked:** **European Union trademark 8242836**



*against*

**Defendant:** **NORTHEAST PHARMACEUTICAL GROUP CO., LTD.**

Kunminghu Street, Shenyang Economic and Technological Development Zone  
Liaoning Province  
China

**Representative:** **Office Freylinger S.A.**

route d'Arlon 234  
8010 Strassen  
Luxembourg

**Contested trademark: International trademark 1344408**



**NEPHARM**

## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 23 January 2017 the defendant filed an application for an International trademark with designation of the Benelux for the combined word/figurative mark **NEPHARM** for goods in class 5. This application was processed under number 1344408 and was published on 11 May 2017 in the WIPO Gazette of International Marks 2017/17.

2. On 11 July 2017 the opponent filed an opposition against the registration of the application in the Benelux. The opposition is based on the following earlier rights:

- Benelux trademark 838080 for the combined word/figurative mark , filed 18 January 2008 and registered 7 April 2008 for goods and services in classes 5, 35 and 44;
- EU trademark 8242836 for the combined word/figurative mark , filed 24 April 2009 and registered on 22 November 2009 for goods and services in classes 5, 35 and 44.

3. According to the registers the opponent is the actual holder of the registered trademarks invoked.

4. The opposition is directed against all goods of the contested application and is based on all goods and services of the registered trademarks invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) and (b) the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

6. The language of the proceedings is English.

### B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 12 July 2017. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant, the opponent filed proof of use. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 20 August 2018.

## II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 1 (a) BCIP, in accordance with the provisions of article 2.3 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

### A. Opponent's arguments

9. The opponent finds that the figurative element in the rights invoked should be considered to be less important, because consumers will refer to the signs by using the word element(s). The dominant element of the earlier rights is therefore the verbal element "newpharma".

10. Visually, the rights invoked and the contested sign are almost similar, according to the opponent. They consist of a single word with a nearly identical length and share seven letters placed in the same position. The only difference is found in the third and the last letter. Therefore, the opponent finds that the similarities outweigh the slight difference in the visual appearance.

11. Aurally, the opponent finds that the marks present a very high similarity due to their identical first letters, NE, and the presence of the common term PHARM. They share nearly identical length, rhythm and intonation. These similarities seem more important than the differences in the third and the last letter, according to the opponent (see paragraph 10).

12. As to the conceptual comparison, the opponent holds that the rights invoked and the contested sign coincide in the common element "PHARM", which will be perceived as a reference to the medical/healthcare sector. The opponent concludes that this shared element presents a strong conceptual similarity.

13. The opponent finds that the contested goods are partly identical and partly similar to the goods and services of the trademarks invoked.

14. Regarding the level of attention of the relevant consumer, the opponent stresses the fact that for the goods "non-prescription pharmaceuticals, veterinary preparations, sanitary preparations for medical use and dietetic substances adapted for medical use" an average level of attention should be taken into account.

15. The opponent concludes that the relevant public will assume that the goods designated by the contested sign originate from the same undertaking or economically connected ones. Therefore the opponent asks the Office to grant the opposition in its entirety, to reject the contested Benelux application and to have the defendant pay for the costs.

16. At the request of the defendant, the opponent filed proof of use.

## **B. Defendant's arguments**

17. The defendant filed his arguments on 16 February 2018, thereby requesting the opponent to provide proof of use. In his arguments the defendant also states that he will proceed with the comparison of the goods and services after analysis of the evidence of use to be provided by the opponent. However, after receiving the proof of use provided by the opponent, the defendant did not comment on the documents provided.

18. According to the defendant, the relevant consumer will understand the word element of the rights invoked as composed of the words "new" and "pharma", which will undoubtedly be the case because of the fact that both words are written in (two) different colours, namely green and blue. The element "new" is laudatory as it alludes to the novel and innovative character of offered goods and services. The element

"pharma" constitutes a common abbreviation for the words "pharmaceutical" or "pharmacy", according to the defendant. The combined word elements of the rights invoked, taken as a whole, have to be considered to be devoid of distinctive character, or at the most weakly distinctive, for the relevant goods and services.

19. According to the defendant, the figurative element in the rights invoked consists of a slightly stylized (grey-blue) man, who carries a slightly stylized green medical box with a white cross depicted on it. The figurative element is a clear reference to the medical box, which usually contains medicines, pharmaceuticals and medical/pharmaceutical related apparatus and instruments. The white cross symbol appearing on the green box is a wilful reference to pharmacies. The defendant finds that the figurative element in the rights invoked should be considered to be devoid of distinctive character, or at most weakly distinctive, for the relevant goods and services.

20. The defendant concludes that the overall distinctiveness of the rights invoked must be considered as non-existent or at the upmost very low.

21. According to the defendant, the goods and services are directed at the public at large and at professionals, for example in the pharmaceutical sector. The degree of attention is high, considering the importance given to health matters.

22. Whereas the word element in the earlier rights is descriptive, the figurative element should undoubtedly be more easily retained by the relevant public as an indicator of the commercial origin of the goods and services at issue rather than the word element. Consequently, the defendant finds that the rights invoked and the contested sign are visually dissimilar.

23. From a phonetic point of view, the defendant is of the opinion that the rights invoked and the contested sign are different. The earlier trademarks contain three syllables, -new-phar-ma [pronounced as -nju:-fa:-mə], whereas the contested sign contains two syllables, -ne-pharm [pronounced as -ne-fa:m]. The length is different and they differ by their rhythm accordingly. Bearing in mind that the rights invoked have no, or a very low, distinctive character and considering the fact that the signs differ by their rhythm, the defendant concludes that the rights invoked and the contested sign are phonetically dissimilar.

24. Conceptually, the defendant finds that the rights invoked refer to the concept of innovation and novelty ('new') being linked to the concept of pharmaceutical industry and pharmacy ('pharma'). The contested sign is a coined word and has no meaning accordingly. According to the defendant they are therefore conceptually dissimilar.

25. Taking into account all the aforementioned considerations, the defendant concludes that there is no likelihood of confusion even for identical goods and services. This result is corroborated by the fact that descriptive or generic indications may not be monopolised.

26. The defendant requests that the Office rejects the opposition, accepts the contested sign for registration for all requested classes and that the opponent should bear the costs.

### **III. DECISION**

#### **A.1 Proof of use**

27. Articles 2.16, 3 (a) and 2.26, 2 (a) BCIP and rule 1.29 IR stipulate that the right invoked should be put to genuine use within the Benelux territory for a continuous period of five years prior to the publication date of the sign against which the opposition is lodged. The contested sign was published on 11 May 2017. Therefore the opponent was required to show use of the right invoked, during the period from 11 May 2012 to 11 May 2017 ('the relevant period').

28. Given the fact that the rights invoked are registered more than five years prior to the publication date of the contested sign, the defendant's request that proof of use is submitted is legitimate.

29. Following rule 1.29 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the earlier trademark for the goods and/or services on which the opposition is based.

30. The opponent filed proof of use of the rights invoked, which the Office forwarded to the defendant on 25 April 2018. The defendant was given two months to comment on the evidence provided. The defendant did not respond to the proof of use.

### **Conclusion**

31. Because of the fact that the defendant did not respond to the proof of use, the Office must conclude that the use of the rights invoked is not contested. Following rule 1.21 IR (b) 'facts to which the other party did not respond will be deemed undisputed'.

### **A.2 Likelihood of confusion**

32. In accordance with article 2.14, 1 BCIP, the applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.3 (a) and (b) BCIP.

33. Article 2.3 (a) and (b) BCIP stipulates that *"In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: a. identical trademarks filed for identical goods or services; b. identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark."*

34. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June

2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

### **Comparison of the goods and services**

35. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

36. With the comparison of the goods and services of the rights invoked and the goods against which the opposition is filed, the goods and services are only considered on the basis of what is expressed in the register or the goods or services for which genuine use has been proven on the one hand and the goods as indicated in the trademark application on the other hand.

37. The goods and services to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
CI Pharmaceutical preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants.	CI 5 Disinfectants; medicines for veterinary purposes; food for babies; medicines for human purposes; raw material drug; traditional Chinese medicinal preparations; medicine cases, portable, filled; diagnostic preparations for medical purposes; chemical reagents for medical or veterinary purposes; dietetic substances adapted for medical use; nutritional supplements.
CI 35 Advertising; business management; business administration; office functions; retailing of pharmaceutical preparations, in particular via the Internet.	
CI 44 Medical services; pharmacy advice.	

38. The defendant has chosen explicitly to await the analysis of the evidence use, before proceeding with the comparison of the goods and services (see paragraph 17). However, the defendant did not respond to the proof of use provided by the opponent and (consequently) did not provide any observations involving the comparison of the goods and services. Following rule 1.21 IR (b) the identity and similarity of the goods and services should therefore be deemed *in confesso* (see paragraphs 13 and 31).

### **Conclusion**

39. The identity and similarity of the relevant goods and services is undisputed.



### **Comparison of the signs**

40. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) "there exists a likelihood of confusion on the part of the public" shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, *Sabel*, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

41. Global assessment of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (CJEU, *Sabel* and *Lloyd*, already cited).

42. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, *Limonchello*, C-334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, *Matratzen*, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and *El Charcutero Artesano*, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

43. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

44. The rights invoked are identical combined word/figurative signs. The representation in the registers only shows a slight difference in the colour green as used in both trademarks. They both consist of the word element "newpharma". The word "new" is depicted in a green colour and the word "pharma" is made up of (dark) blue letters. A figurative element is placed at the right hand side of the word element. It consists of a stylized (moving) figure in a (dark) blue colour, carrying a green package or box with a white cross depicted on it. The contested sign solely consists of the word NEPHARM in a bold typeface.

#### *Conceptual comparison*

45. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd*, already cited), the fact remains that, when perceiving a verbal sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words

known to him (EGC, Respicur, T-256/04, 13 February 2007, ECLI:EU:T:2007:46; Aturion, T-146/06, 13 February 2008, ECLI:EU:T:2008:33; Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and Ecoblue, T-281/07, 12 November 2008, ECLI:EU:T:2008:489).

46. The word element of the rights invoked is depicted in two different colours. This strengthens the assumption that the relevant consumer will break down the word element in two separate elements, namely "new" and "pharma". In view of the level of understanding of the English language amongst the relevant public in the Benelux, the Office is of the opinion that both elements will be effortlessly recognized as such. The first element will be interpreted by the public as non-distinctive, whereas it describes a characteristic of the relevant goods and services (namely indicating their newness). The same reasoning applies to the element "pharma" which will be perceived as the common abbreviation for 'pharmaceuticals/pharmacy'. The juxtaposition of both elements will result in the perception of the word element as referring to 'new pharmaceutical' products and services. The rights invoked therefore have a clear meaning from a conceptual point of view.

47. Although the (descriptive) element –PHARM could be recognized in the contested sign, the sign as a whole is without any meaning.

48. The rights invoked have a clear meaning, whereas this is not the case for the contested sign. Therefore they differ conceptually.

#### *Visual comparison*

49. The rights invoked consist of nine letters, "newpharma". The contested sign consists of one word of seven letters, "NEPHARM". Both share the first two letters, "NE" in an identical position and the visually striking combination of letters "PHARM". They differ in the third letter of the rights invoked, namely the "W" and the last letter, "A" versus "M". Furthermore, the rights invoked contain a figurative element which will not go unnoticed when visually perceiving the signs.

50. Normally the consumer attaches more value to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). However, this analysis does not automatically apply, when the first part of a sign is found to be non-distinctive and therefore not considered to be dominant. In this particular case the first element of the rights invoked consists of a non-distinctive word, "New" (see paragraph 46).

51. The Office finds that the rights invoked and the contested sign are visually similar to a certain degree.

#### *Aural comparison*

52. The rights invoked consist of three syllables, NEW-PHAR-MA which will be pronounced as [-nju:-fa:-mə]. The contested sign consist of two syllables, NE-PHARM, which will be pronounced as [-ne-fa:m]. The pronunciation coincides in the middle part [fa:] but differs in the beginning and the end. The fact that the letter "W" is missing in the contested sign results in a different pronunciation of the first (identical) letters "NE" (closed versus open syllable). The difference in the closing syllable is also clearly noticeable. Therefore, the signs are characterized by an overall different rhythm despite their similarities.



53. The rights invoked and the contested sign are aurally similar to a low degree.

#### *Conclusion*

54. The rights invoked and the contested sign are visually similar to a certain degree, aurally they are similar to a low degree. The rights invoked have a conceptual meaning, whereas this is not the case for the contested sign.

### **A.2 Global assessment**

55. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the signs are important factors.

56. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

57. The goods and services concerned are targeted at both the public in general as well as at medical professionals. The Office considers that a part of the goods concern pharmaceutical products for which it has been established that the level of attention is high, regardless of the fact that they could be sold with or without a medical prescription. It must be pointed out that medical professionals display a high degree of attentiveness when prescribing, providing or preparing medicines and, with regard to end consumers, it can be assumed that the consumers have a high level of interest in those products, since those products affect their state of health, and that they are less likely to confuse different products (reference is made to the EGC cases, T-331/09, 15 December 2010, Tolposan, ECLI:EU:T:2010:520; T-288/08, 15 March 2012, Zydus, ECLI:EU:T:2012:124 and T-605/11, 10 December 2014, BIOCERT, ECLI:EU:T:2014:1050).

58. With regard to nutritional supplements, nowadays, discussions concerning nutrition and eating habits are very popular and also involve questions regarding the necessary level of vitamins and minerals that a person should consume on a daily basis. Although the level of attention could be deemed higher than average for a part of the public purchasing these products, because it concerns a person's health, another part of the public will however simply purchase these products on a regular basis in order to complete their daily nutrition, without concerning themselves more than they would with regular foodstuffs. Therefore the lowest level of attention must be taken into account, which means that for these goods, the public is deemed to have an average level of attention (see also BOIP opposition decision 2011622, 21 July 2017, FOLAVIT/FOLADIN DHA).

59. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken into account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

60. The identity and similarity of the contested goods is undisputed (see paragraphs 38-39). The signs are visually similar to a certain degree and aurally similar to a low degree. Conceptually they are different, due to the clear meaning of the rights invoked (see paragraph 54). The level of attention varies between high and average.

61. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). As stated above, the rights invoked consist of the word elements "new" and "pharma". Due to the presentation in two colours, the consumer will break down the word element in two separate ones (see paragraph 46). Both words have a clear and descriptive meaning to the Benelux consumers indicating kind ('pharmaceutic(al)s') and quality ('newness') of the relevant goods and services. Therefore, the Office is of the opinion that the figurative element in the rights invoked has an independent distinctive role in the composite sign, without necessarily constituting the dominant element. A figurative element is not present in the contested sign. The Office finds that the clear meaning of the word elements and the figurative element in the rights invoked have the effect of causing a significant difference between the signs. According to the Office, this difference is sufficient to neutralize the (limited) visual and aural similarities, even when taking into account an average level of attention.

#### *Conclusion*

62. Based on the abovementioned circumstances, the Office concludes that the differences between the signs suffice to neutralize their similarities.

#### **B. Conclusion**

63. Based on the foregoing the Office is of the opinion that there is no likelihood of confusion.

#### **IV. DECISION**

64. The opposition with number 2013254 is rejected.

65. International registration 1344408 with designation Benelux will be registered.

66. The opponent shall pay the defendant 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 Implementing Regulations, as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 11 June 2019

Tomas Westenbroek  
(*rapporteur*)

Eline Schiebroek

Willy Neys



Administrative officer: Paul Vink