

BIOCERT does not collide with BIOCEF

(Judgment of the General Court of 10 December 2014, T-605/11)

Dr Organic Ltd filed an application for registration as a Community trade mark of the word sign BIOCERT for goods within Class 5. Novartis AG filed a notice of opposition in respect of all of the goods, based on its earlier Austrian verbal mark BIOCEF, also for goods within Class 5. The opposition was dismissed by the Opposition Division in its entirety. It considered that the relevant public would distinguish between the signs at issue in view of the difference between the elements 'cef' and 'cert'. This decision was confirmed by the Fourth Board of Appeal of OHIM. It judged inter alia that in view of the average distinctiveness of the BIOCEF mark, the low visual and phonetic similarities between the signs at issue and the heightened degree of attentiveness of the relevant public, there is no likelihood of confusion, even in respect of identical goods. Important element of the two decisions is the consideration that the element 'bio' is descriptive for pharmaceutical products. The General Court annuls this decision on the basis of infringement of Article 8(1)(b) of Regulation No 207/2009. The court considers that the visual and phonetic similarities between the marks at issue do not arise only from the presence of the element 'bio' in the marks at issue, but also from other factors, such as the almost identical length of the signs and the fact that their first five letters match. The same letters appear in the initial part of each of those marks. Given the identical or similar nature of the products and the average degree of distinctiveness of the earlier mark as a whole, there is a likelihood of confusion between the marks at issue, even if the public has an heightened level of attention. Although the element 'bio' is descriptive in respect of goods covered by the marks at issue, it remains a fact that the weak distinctive character of an element of a mark does not necessarily mean that it will not be taken into consideration by the relevant public. Thus, it cannot be excluded that, because, in particular, of its position in the sign or its size, such an element holds an autonomous position in the overall impression conveyed by the mark involved in the relevant public's perception. The element 'bio' must also be taken into account when assessing the phonetic and conceptual similarity.

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