



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2011622

21 July 2017

Opponent: **KELA PHARMA, naamloze vennootschap**
Industriepark West 68
9100 Sint-Niklaas
Belgium

Representative: **GEVERS**
Holidaystraat 5
1831 Diegem
Belgium

Invoked right: **Benelux registration 713336**

FOLAVIT

against

Defendant: **Laboratoires Surveal SPRL**
Avenue Louise 149/24
1050 Brussel
Belgium

Representative: **Hortis Legal**
Veraartlaan 8
2288 GM Rijswijk
Netherlands

Contested trademark: **Benelux application 1321442**

FOLADIN DHA

I. FACTS AND PROCEEDINGS

A. Facts

1. On 18 November 2015 the defendant filed an application for a trademark in the Benelux for the word mark FOLADIN DHA for goods in class 5. This application was processed under number 1321442 and was published on 25 November 2015.

2. On 22 January 2016 the opponent filed an opposition against the registration of the application. The opposition is based on Benelux registration 713336 of the word mark FOLAVIT, filed on 28 January 2002 and registered on 24 October 2002 for goods in class 5.

3. According to the register the opponent is the actual holder of the trademark invoked.

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

5. The grounds for opposition are those laid down in article 2.14, 1 (a) 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 27 January 2016. During the administrative phase of the proceedings both parties filed arguments. Together with the filing of his arguments, the defendant requested a limitation of the goods in class 5 of the contested sign. 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 18 July 2016.

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. With regard to the comparison of the goods, the opponent states that the term "*especiallly*", included in the list of goods in class 5, only indicates an example of an item and he points out that protection is not restricted to these specific goods. The opponent further argues that the goods are identical or (highly) similar.

10. The opponent states that due to its length and position at the beginning of the sign, the element FOLADIN constitutes the dominant element of the contested sign. Furthermore, according to the opponent, the second part

of the contested sign DHA is an abbreviation referring to the Omega-3 acid "docosahexaenoic acid" and therefore the public will not give much attention to this element.

11. The opponent argues that the signs are visually highly similar, because the first part of the contested sign (FOLADIN) includes five letters which are reproduced in exactly the same order as in the trademark invoked (FOLAVIT). The opponent states that the small differences are not sufficient to outweigh the visual similarities.

12. With regard to the aural comparison, the opponent states that the signs contain the identical first part FOLA and also share the letter "i" in the third syllable. Furthermore, the trademark invoked and the dominant part of the contested sign have the same number of letters and syllables, resulting in the same rhythm and intonation. For this reason the opponent concludes that the signs are aurally highly similar, despite the last part DHA, whose presence cannot counteract the strong phonetic similarity resulting from the identity situated at the beginning of the signs.

13. According to the opponent, neither mark, considered as a whole, has a (clear) meaning and for this reason a conceptual comparison is not possible.

14. The opponent argues that the consumer's level of attention will not be higher than average, because the goods concern pharmaceutical preparations with a preventive effect and will not be used to treat a "serious disorder".

15. Furthermore, the opponent refers to prior decisions from the Opposition Division and the Boards of Appeal of the European Union Intellectual Property Office (EUIPO) concerning opposition proceedings in, according to the opponent, similar cases, in which it was decided that there is a likelihood of confusion.

16. The opponent concludes that there is a likelihood of confusion and requests that the Office refuses the contested sign and orders the defendant to bear the costs of the proceedings.

B. Defendant's arguments

17. With regard to the comparison of the goods, the defendant argues that the opponent's folic acid goods are not solely or specifically destined for pregnant women. These goods have multiple health effects and are mostly recommended for women whom are trying to conceive. Furthermore, these goods could also be intended for veterinary purposes. Therefore these goods neither are identical nor similar to the goods "food supplement for pregnant women" of the contested sign. After limitation of the list of goods, the defendant argues that the other goods in class 5 of the contested sign are also not similar to the goods of the trademark invoked.

18. The defendant argues that the signs are visually different, because the trademark invoked is much shorter. Furthermore, the last part of the contested sign differs and this helps to distinguish it clearly from the trademark invoked. The defendant points out that the signs contain five corresponding letters as well as five differing letters and that the signs also differ by three letters in length, which is significant in the light of the fact that the trademark invoked only consists of seven letters. Therefore, the defendant concludes that the signs are visually different. In order to substantiate this argument, the defendant also refers to prior decisions of the EUIPO.

19. With regard to the aural comparison, the defendant states that the pronunciation of both signs is different, because the signs have a different ending.

20. Conceptually, the defendant argues that the part FOLA refers to an abbreviation of the English word 'folate', which is a commonly known composition for folic acid, which is a vitamin B. The defendant states that the element FOLA is commonly used in other trademarks in relation to the goods in class 5. With regard to the trademark invoked, the defendant argues that the second part VIT is a commonly known abbreviation of the word vitamin or vital. Therefore, the defendant states that the trademark invoked is a combination of descriptive terms. Although both signs could refer to folic acid, the defendant argues that the word FOLADIN, considered as a whole, has no meaning and that the contested sign also contains an abbreviation of a very specific chemical aid molecule. For this reason, the defendant concludes that the signs are conceptually dissimilar.

21. According to the defendant, the average consumers are pregnant women, veterinarian professionals or people suffering from or risking serious conditions, who will take great care if they choose certain supplements, medicaments or other pharmaceutical products. Therefore, the defendant argues that the level of attention of the average consumer will be high.

22. The defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition and awards a reimbursement of all costs to the defendant.

III. DECISION

A.1 Likelihood of confusion

23. 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.

24. 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."*

25. 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, Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999; 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; Brussels, N-20060227-1, 27 February 2006).

Comparison of the goods

26. 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).

27. With the comparison of the goods of the trademark invoked and the goods against which the opposition is filed, the goods are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

28. After the limitation of the goods of the contested sign, the goods to be compared are the following:

Opposition based on:	Opposition directed against:
<p>KL 5 Farmaceutische, diergeneeskundige en hygiënische producten, in het bijzonder tabletten bevattende foliumzuur; diëtische substanties voor medisch gebruik, voedingsmiddelen voor baby's; pleisters, verbandmiddelen; tandvulmiddelen en afdrukmetaal voor tandartsen; ontsmettingsmiddelen; middelen ter verdelging van ongedierte; schimmeldodende en onkruidverdelgende middelen.</p> <p><i>Cl 5 Pharmaceutical, veterinary and sanitary products, especially tablets containing folic acid; dietetic substances adapted for medical use; food for babies; plasters, bandage; tooth fillings and dental impressions; disinfectants; preparations for destroying vermin, fungicides, herbicides.</i></p>	<p>Cl 5 Food supplements; food supplement for pregnant women; nutritional supplements; vitamin and mineral preparations and supplements; rubbing compounds for medical and therapeutic purposes.</p>
<p>N.B. The original language of this registration is Dutch. The translation is only added to improve the readability of this decision.</p>	

29. The Office agrees with the opponent (paragraph 9) that the word “*especially*” does not mean that the goods that are mentioned before are excluded from the list of goods (GEA, TUFFRIDE/NU-TRIDE, T-224/01, 9 April 2003).

30. The goods “*rubbing compounds for medical and therapeutic purposes*” fall under the opponent's broad term “*pharmaceutical products*”. According to established case law, if the goods and services of the earlier trademark also contain goods and services that are mentioned in the application for the contested sign, these goods and services are considered identical (see EGC, Fifties, T-104/01, 23 October 2002; Arthur et Félicie, T-346/04, 24 November 2005 and Prazol, T-95/07, 21 October 2008).

31. The Office is of the opinion that the goods “*food supplements; food supplements for pregnant women; nutritional supplements; vitamin and mineral preparations and supplements*” are products that are used for special dietary or nutritional requirements, with the purpose of improving a person's health. For this reason, their purpose is similar to that of the opponent's pharmaceutical products and dietetic substances for medical use, which are products that are used to treat diseases. Although the use of these goods could be different, either for medical or for nutritional purposes, these goods are all chemical compounds used to improve a person's health. These products can have the same distribution channels and end-users. Therefore, these goods are similar.

Conclusion

32. The goods are either identical or similar.

Comparison of the signs

33. 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).

34. 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).

35. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
FOLAVIT	FOLADIN DHA

Conceptual comparison

36. 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; Aturion, T-146/06, 13 February 2008 and Galvalloy, T-189/05, 14 February 2008). In this case, both signs share the prefix FOLA. Consumers of pharmaceutical preparations are used to the fact that many trademarks in this sector of industry partly consist of a descriptive prefix or suffix, which indicates the active substance, combined with another (fantasy or referring) element. For this reason, the Office is of the opinion that in the light of the goods concerned, part of the public could perceive this prefix as a reference to “*folic acid*” or “*folate*”, which is a type of vitamin B. However, part of the relevant public also consists of non-professional (end)users (see paragraph 45). This part may not recognize the element FOLA as a reference to ‘folic acid’ or ‘folate’.

37. The public may understand the element VIT as an abbreviation of the word ‘vitamin’. With regard to the contested sign, the Office considers that the element DIN has no meaning and that the public could understand the abbreviation DHA, which refers to ‘docosahexaenoic acid’, an omega-3 fatty acid.¹

38. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003). For this reason, the Office considers that part of the public will find that the element FOLA has a weak distinctive character and will therefore also pay attention to the ending of the signs, which is conceptually different.

¹ https://en.wikipedia.org/wiki/Docosahexaenoic_acid; <http://www.voedingscentrum.nl/encyclopedie/dha.aspx>.

39. As considered above, part of the public will understand that both signs refer to folic acid or folate, which causes a conceptual similarity to a certain extent. With regard to the part of the public for which the element FOLA has no meaning, a conceptual comparison is not relevant.

Visual comparison

40. The trademark invoked as well as the contested sign are both purely verbal marks, consisting of the words FOLAVIT and FOLADIN DHA.

41. Visually both signs share the first four identical letters. Furthermore, the signs also contain the identical letter I in the second part of the first word element. The signs contain several visual differences at the end. However, normally the consumer attaches more importance to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004). Therefore, the Office is of the opinion that the signs are visually similar to a certain extent.

Aural comparison

42. With regard to the aural comparison, the Office finds that the trademark invoked consists of one word and three syllables and the contested sign consists of a word of three syllables and a word which will be pronounced as an abbreviation, because of its sequence of letters. The beginning of both signs will be pronounced identically and both signs also share the identical 'l'-sound in the third syllable. However, the consonants in the third syllable are pronounced differently. Furthermore, if the public pronounced the second word of the contested sign, this would be pronounced as an abbreviation which also causes an aural difference. Therefore, the Office is of the opinion that the signs are aurally similar to a certain extent.

Conclusion

43. Trademark and sign are visually and aurally similar to a certain extent. Conceptually, the signs are either similar to a certain extent or the conceptual comparison is not relevant.

A.2 Global assessment

44. 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.

45. 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. The relevant goods consist of pharmaceutical products and various nutritional supplements, including supplements intended for babies and pregnant women. The relevant public consists of professionals from the medical and pharmaceutical field, as well as the general end consumers.

46. The Office considers that part of the goods of the trademark invoked 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; T-288/08, 15 March 2012, Zydus and T-605/11, 10 December 2014, BIOCERT). With regard to the food supplements, nowadays, discussions concerning nutrition and eating habits are very popular and also involve questions regarding the correct level of vitamins and minerals a person should consume on a daily basis. Although the level of attention could be higher than normal with a part of the public purchasing these products, because it concerns a person's health, the other 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 about them than they would with regular food products. Therefore the lowest level of attention must be taken into account, which means that for these goods, the public is deemed to have a normal level of attention.

47. 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). In this case, the goods are either identical or similar.

48. 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). In the present case, depending on the conceptual interpretation (paragraph 36) of the element FOLA, the first part of the trademark invoked has either a weak or normal level of distinctiveness. However, even if the trademark invoked has a weak distinctive character, it is of importance that, according to European case law, a weak distinctive character does not, by definition, mean that there is no likelihood of confusion. Although the distinctive character of the marks must be taken into account with the assessment of the likelihood of confusion, it is only one of a number of elements concerning that assessment (CJEU, Ferromix, C-579/08, 15 January 2010).

49. As mentioned above, both elements share the identical element FOLA, which part of the public could consider descriptive. However, the Office is of the opinion that part of the public will not recognize the descriptive meaning of this element. Furthermore, visually and aurally, the first word element of the contested sign also contains other similarities, including number of letters, syllables and the identical letter I in the third syllable. The Office also points out that risk of confusion with part of the public is sufficient to justify the opposition (see EGC, Hai/Shark, T-33/03, 9 March 2005)

50. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.

51. In the light of the abovementioned circumstances, the Office is of the opinion, notwithstanding the high level of attention of the public with regard to some of the goods, that the relevant public might believe that these goods come from the same undertaking or from economically-linked undertakings.

B. Other factors

52. Regarding the parties' references to decisions from EUIPO concerning, in the parties' view, similar oppositions (paragraph 15 and 18), the Office points out that it is obliged to render a decision based on regulation and case law applicable in the Benelux. The Office is not bound by decisions from other offices, whether they refer to similar cases or not (see, by analogy with, GEU, Curon, T- 353/04, 13 February 2007).

53. Regarding the defendant's observation concerning the fact that many other trademark registrations contain the word FOLA (see paragraph 20), the Office admits that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between the two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings, the defendant has duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC, Top iX, T-57/06, 7 November 2007 and LIFE BLOG, T-460/07, 20 January 2010). In this case, however, no evidence of such a kind has been provided by the defendant.

54. With reference to the parties' requests that the opposite party should bear all costs of the proceedings (paragraph 16 and 22), the Office considers that opposition proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP, as well as rule 1.32, 3 IR, only stipulates in this respect that an amount equaling the basic opposition fee shall be borne by the losing party.

C. Conclusion

55. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

IV. DECISION

56. The opposition with number 2011622 is justified.

57. Benelux application with number 1321442 will not be registered.

58. The defendant shall pay the opponent 1,000 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 21 July 2017

Eline Schiebroek
(*rapporteur*)

Saskia Smits

Camille Janssen

Administrative officer: Rémy Kohlsaet