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Inconsistencies in approach to the test of likelihood of confusion make it difficult to evaluate in advance the risks associated with adopting a pharmaceutical trademark in Italy

No specific trademark laws pertaining to the pharmaceutical industry exist in Italy. Therefore, any analysis in this area must focus on general trademark legislation (pursuant to the Italian Code of Industrial Property 30/2005) and the case law that has developed over the years. The tests for evaluating actual confusion and any likelihood of confusion between pharmaceutical trademarks are governed by the standard provisions of the code; however, the courts have adjusted their approach in certain circumstances to adapt to the pharmaceutical industry's needs.

Likelihood of confusion and case law

Pharmaceutical trademarks tend to be relatively weak because the wording used commonly describes or suggests the pharmaceutical's active ingredient or therapeutic effects. Attempts to register such marks may fall foul of Article 13 of the code, which states that "designations merely consisting of generic denominations of products or descriptive indications may not obtain registration".

The inherent weakness of pharmaceutical trademarks means that they may be subject to a slightly different test to ascertain whether there exists a likelihood of confusion. In the majority of cases, the courts have concluded that where the two marks under consideration are both weak, small differences can be enough to render such marks distinguishable and eliminate the risk of a likelihood of confusion.

This approach was perhaps first established in the case of *Ibi v Magis Farmaceutic* (May 8 1989). However, having stated that small differences between weak marks may suffice to prevent a likelihood of confusion, the court concluded that the CEFAM and CEPAN marks at issue, both used in connection with cephalosporin antibiotics, were confusingly similar. Since then some courts have slowly started to take a less conservative approach to the

likelihood of confusion test for weak marks.

For instance, in a decision dated December 31 2004 the Court of Rome stated that "when the trademarks at issue are objectively weak, limited differences suffice to avoid a declaration that the latter mark is counterfeit at least in such case that the marks under assessment include elements or names which are commonly used in the particular channel of trade and lack a higher degree of distinctive character". In the same way, the Court of Milan confirmed that the trademarks RIACEN and RIAVEN were not confusingly similar in the case of *Easytech Srl v Doc Medica Srl* (March 28 2005).

Despite the increasing number of court decisions allowing pharmaceutical marks to coexist even where there are slight differences only, there are still plenty of examples where the courts have applied a more conservative approach to the test, meaning that practice is far from harmonized. For example, the Court of Rome has found the marks AZELAC/AZELAIC to be confusingly similar (November 10 1996), while the Court of Trieste came to a similar finding in a case involving the marks CARBON DIFER and EUCABON (September 24 1999).

Italy is not alone in having seemingly inconsistent case law on the test for likelihood of confusion in relation to pharmaceutical marks, EU jurisprudence follows a similar pattern. Decisions appear to be taken on a case-by-case basis. For instance, in one ruling the Office for Harmonization in the Internal Market (OHIM) held that there was no likelihood of confusion between CALCITEC and CALCITAB, stating that while the prefix 'CALCI', common to both marks, lacked a high degree of distinctive character, the differing 'TEC' and 'TAB' suffixes meant that the marks could be distinguished from each other (Case 000902512, September 9 2008). In contrast, in an earlier decision, OHIM found the marks CALCITAB and CALCI TAD to be confusingly similar (Case 001963404, July 25 2007).

Relevant public

The main reason for such divergence between decisions is that the courts are not

in agreement as to the relevant public when it comes to pharmaceuticals. Depending on which public is selected the standards of evaluation will differ. Some courts consider the relevant public for pharmaceuticals to be the average consumer while others believe it to be made up of specialist consumers with a higher than average level of knowledge in the field of pharmaceuticals (ie, physicians, pharmacists and other experienced persons). Because of the varying levels of knowledge and expertise between average and specialist consumers it follows that they will not pay the same level of attention when making a purchasing decision.

Before any determination on the relevant public can be made for the purposes of the likelihood of confusion test, it is crucial to assess whether the drugs bearing the trademark at issue are prescription or over-the-counter drugs. The case law on this issue has been consistent since 1986 when the courts issued a number of decisions confirming that if no proof is submitted that the drug is sold under prescription only, the average consumer (with an average level of attention) represents the relevant public.

In *Soc Ist Tosi v Soc Ausonia Farmaceutici* (April 17 1986) the Court of Milan, ruling on this issue, stated: "Physicians, pharmacists and operators in this field of expertise have a high capability of distinguishing pharmaceutical trademarks ... when the medicines at issue are prescription drugs". Most decisions since that time have followed similar reasoning. In 2006, for example, the Court of Rome held that: "If the evaluation is relating to trademarks used in connection with pharmaceuticals prescribed by qualified operators, even small differences will suffice to overcome confusing similarities between trademarks" (*Johnson & Johnson Medical SpA v Mediolanum Farmaceutici SpA* (February 10 2006)). The trademarks at issue in the above case were PRISMA and PROMOGRAN PRISMA.

Identifying whether the pharmaceutical is a prescription-only drug clearly helps the courts to determine the target consumers. However, it is often

difficult to understand the criteria adopted when the drug's mode of sale is not taken into account. EU case law does not provide much assistance here either. Indeed, the European courts have issued a number of seemingly contrasting decisions. In some cases the courts have held that the relevant public for certain types of pharmaceutical comprises experts only; in other rulings the courts have concluded that both specialist and end consumers may be viewed as the relevant public.

In a decision issued on November 7 2002 OHIM's Board of Appeal stated that, in general, the relevant public is very careful when buying pharmaceutical products and pays particular attention to drug names and professional advice (Case RO281/2001-2 *FITOVIT/VITAFIT*). A few years later, the Court of First Instance held that "when evaluating likelihood of confusion between trademarks relating to pharmaceuticals, the relevant public is represented both by professionals in the field of medicine and patients as final consumers" (Case T-483/04, October 17 2006). By the same token, the European Court of Justice ruling in the *TRAVATAN/TRIVASTAN Case* (C-412/05 P, April 26 2007) declared that although experts, by necessity, are involved in the sale of pharmaceuticals, the role of such experts has to be balanced with the degree of attention and needs and choices of the final consumer who has to be considered in evaluating the likelihood of confusion (with no mention as to whether this approach relates to prescription or over-the-counter drugs, or both).

As the above summary highlights, the protection and enforceability of pharmaceutical trademarks are not clearly defined. The lack of consistency as regards the protection available to 'weak' marks in Italy makes it difficult to evaluate in advance the risk associated with adopting a pharmaceutical trademark. [WTR](#)



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