

Decision of the Fourth Board of Appeal of the OHIM, issued on 24 July 2006

Case No. R1048/2005-4

1. Reversal/Recourse
2. OHIM Board of Appeal procedures

PRECIS: The Fourth Board of Appeal of the Office for the Harmonization of the Internal Market, has confirmed the validity of the Community Trademark SINOMAR in the name of the Greek company P. N. Gerolymatos A.E.V.E. and affirmed the first instance decision which had denied the request for invalidity of the latter mark. The relevant cancellation petition was filed by the German company Boehringer Ingelheim Pharma GmbH & Co. KG on the basis of its prior registered mark SILOMAT, which covered goods in the same class.

SINOMAR's cancellation denied

The German company Boehringer Ingelheim Pharma GmbH & Co. KG ("Boehringer") filed an invalidity action against the Community Trademark SINOMAR on the basis of its prior registered mark SILOMAT, covering "pharmaceutical preparations" in class 5.

The Greek company's trademark SINOMAR covered "medicinal preparation, namely a seawater solution for relief of nasal cavity congestion" in class 5.

The German company's original request for a declaration of invalidity of SINOMAR, on the basis of the alleged likelihood of confusion between SILOMAT and SINOMAR, was initially rejected by the Cancellation Division of the OHIM.

On Appeal, the Board was able to revisit the issue of brand awareness when it comes to pharmaceuticals, and came to some interesting conclusions regarding considerations concerning a national target group, when it comes to pronunciations, etc.

After hearing the parties' respective contentions, the Board first expressed its conviction that the respective goods covered are virtually identical, as it considered that the "pharmaceutical preparations of the earlier mark" clearly encompass any kind of "medicinal preparations" covered by the subsequent mark.

Following the above, the Board went on to examine the alleged similarity of the trademarks at issue, in order to decipher whether a risk of confusion was likely or not.

After dissecting the respective marks and focusing in on each letter component, the Board was not convinced that the respective marks were similar. Namely, although 5 out of the 7 letters of the respective marks were identical, the remaining 2 (L instead of N and T instead of R) were found to be quite different in terms of the sounds they produce and their pronunciation in the context of the words they are integral parts of.

The argument put forward by the German company that the word SINOMAR would in practice probably be used in conjunction with the word Tabletten, (i.e. tablets) with the effect that the pronunciation of the phrase SINOMAR TABLETTEN would in practice bring a replacement of the letter R with the letter T, was dismissed as irrelevant. The Board held that the manner in which the particular medicine will be referred to is not the issue, but rather the comparison of the respective marks per se.

As far as the conceptual aspect of the comparison is concerned, the Board found that the German consuming public, given its linguistic particularities, in fact would understand the word SINO-MAR to be: a) referring to SINUS and b) referring to the sea (mar). As there were no such elements in the SILOMAT trademark, a sufficient conceptual difference was also found to exist between the two marks, which further confirmed the court's finding that the two marks are not similar.

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