

Greece - Dr Helen Papaconstantinou John Filias & Associates

In Decision No 3178/2013, the Athens Three-Member Administrative Court of First Instance, Division 28, has reversed a decision of the Administrative Trademark Committee in which the latter had found that there was no likelihood of confusion between the marks BETADINE and BETASID.

In January 2004 Greek company Phoenix Pharm applied for the registration in Greece of the word mark BETASID for pharmaceutical products in Class 5 of the Nice Classification.

Swiss company Mundipharma AG filed an opposition against the registration of the mark based on:

- its prior Greek trademark BETADINE, which was filed as early as 1960 and covered antiseptic preparations and preparations comprising iodine; and
- its Community trademark (CTM) BETADINE, covering medicated preparations, pharmaceutical preparations, antiseptic preparations, disinfectants and surgical scrub preparations in Class 5, as well as various goods in Class 3.

It also relied on the following series of CTMs, which all contained the prefix 'beta' and covered, among others, goods in Class 5:

- ISO BETADINE;
- BETADERMYL;
- BETAISODONA;
- BETASEPT; and
- BETASEPTIC.

Finally, Mundipharma AG relied on the following international trademark registrations:

- BETADINE; and
- BETADINE SP.

The Administrative Trademark Committee rejected the opposition. It found that, although the contested mark and the opponent's marks shared the common prefix 'beta', which refers to the pharmaceutical substance betamethasone, there was no visual and aural similarity between them. Therefore, there was no risk of confusion among consumers.

In August 2006 Mundipharma filed a recourse against the decision of the committee before the Administrative Court of First Instance, claiming that:

- the committee had not taken into consideration that, in the case of a series of marks, there is a higher risk of confusion; and
- when assessing the risk of confusion, the committee should have taken into account the common 'root' of the trademarks as a factor indicating the origin of the goods, rather than the similarities or dissimilarities between the marks.

Mundipharma also pointed out that there was a risk that consumers could associate the parties' trademarks by believing that they originated from the same company or from economically linked companies.

Upon ruling on the recourse, the court held as follows:

- The earlier trademark BETADINE and the contested mark BETASID both covered pharmaceutical goods in the same class.
- Both trademarks shared the prefix 'beta', which was the prefix used by Mundipharma in a series of CTMs.
- The only visual and aural difference between the trademarks under comparison was their suffixes. The degree of similarity between them was very high, so that there was a risk of confusion among consumers as to the origin of the goods.

The court further stressed that Mundipharma, as the owner of the earlier trademark BETADINE, was entitled to apply for the registration of variations of that mark.

Consequently, the court concluded that the committee had erred in rejecting the opposition. It reversed the committee's decision and rejected the application.

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