JUDGMENT OF THE COURT OF FIRST INSTANCE (Eighth Chamber)

28 October 2009 *

In Case T-80/08,

CureVac GmbH, established in Tübingen (Germany), represented by F. Graf von Stosch, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by M. Kicia, and subsequently by S. Schäffner, acting as Agents,

defendant,

* Language of the case: German.

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court of First Instance, being

Qiagen GmbH, established in Hilden (Germany), represented initially by E. Krings, and subsequently by V. von Bomhard, A. Renck and T. Dolde, lawyers,

ACTION brought against the decision of the First Board of Appeal of OHIM of 11 December 2007 (Case R 1219/2006-1) relating to opposition proceedings between CureVac GmbH and Qiagen GmbH,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Eighth Chamber),

composed of M.E. Martins Ribeiro (Rapporteur), President, N. Wahl and A. Dittrich, Judges,

Registrar: T. Weiler, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 19 February 2008,

having regard to OHIM's response lodged at the Registry of the Court on 4 June 2008,

having regard to the intervener's response lodged at the Registry of the Court on 28 May 2008,

further to the hearing on 6 May 2009,

gives the following

Judgment

Background to the dispute

1 On 1 August 2003 the intervener, Qiagen GmbH, filed an application for a Community trade mark at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 The trade mark for which registration was sought is the word sign RNAiFect.

3 The goods in respect of which registration was sought are in Classes 1, 5 and 9 under the Nice Agreement concerning the International Classification of Goods and Services for

the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

— Class 1: 'Chemicals used in industry and science; chemicals used in industry and science for treating biopolymers; active biological substances for laboratories for use in science and research, namely buffers and reagents, namely for the introduction of molecules and molecule aggregates, namely peptides and/or nucleic acids, into cells, namely prokaryotic or eukaryotic cells; chromatographic materials for use in the separation, cleaning, and isolation of biopolymers and reagents and solutions for conducting the chromatographic separation, cleaning and/or isolation of biopolymers; kits for introducing molecules and molecule aggregates, namely peptides and/or nucleic acids into cells, namely prokaryotic or eukaryotic cells; transfection reagents';

— Class 5: 'Pharmaceutical, veterinary and sanitary preparations';

— Class 9: 'Scientific apparatus and instruments, in particular instruments and apparatus for laboratory research and test purposes'.

4 That application was published in *Community Trade Marks Bulletin* No 39/2004 on 27 September 2004.

5 On 17 December 2004 the applicant, CureVac GmbH, lodged a notice of opposition against the mark applied for, alleging a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (now Article 8(1)(b) of Regulation No 207/2009).

6 The opposition was based on a number of the goods covered by Community registration No 2953768 for the word mark RNActive, lodged on 29 November 2002 and registered on 28 October 2004, namely the following goods in Classes 1 and 5:

— Class 1: 'Chemicals used in industry and science; reagents for research';

— Class 5: 'Chemicals for medical usage; pharmaceutical and veterinary preparations, in particular chemotherapy preparations for the treatment of tumours, cardiac remedies and preparations for the treatment of asthma, receptor agonists and antagonists, pharmaceutical products for the treatment of neurological conditions, for the treatment of infectious diseases; hygienic products; dietetic substances for medical usage, in particular, substances for food supplements; disinfectants; fungicides; herbicides'.

7 The opposition was directed solely against the goods covered by the mark applied for in Classes 1 and 5, and did not include those in Class 9.

8 By decision of 7 August 2006, the Opposition Division rejected the opposition on the ground that there was no likelihood of confusion in Community territory.

9 On 15 September 2006, the applicant lodged an appeal against the Opposition Division's decision.

10 By decision of 11 December 2007 ('the contested decision'), the First Board of Appeal dismissed the appeal. The Board of Appeal concurred with the Opposition Division's finding that the goods to be compared were identical or similar to a high degree. As regards the two signs at issue, the Board of Appeal found, although they were of weak distinctive character because the component 'rna' corresponds to the abbreviation of the English word 'ribonucleid acid', the two marks were distinct and no trade mark proprietor could monopolise the RNA abbreviation, or prevent other undertakings from using it or incorporating it into their marks, in particular in the pharmaceutical goods sector. Consumers understand perfectly well the meaning of the RNA abbreviation, and will not assume that all marks beginning with that abbreviation indicate the same origin. Their attention will be drawn to, rather, the end of the word which is more distinctive. The differences between the component 'ifect', and the component 'ctive', allow for any likelihood of confusion to be ruled out.

Forms of order sought

11 The applicant claims that the Court should:

— annul the contested decision;

— refuse to register the trade mark applied for RNAiFect;

— order OHIM to pay the costs.

12 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

13 The intervener contends that the Court should:

— dismiss the action;

— order the applicant to pay all of the costs.

14 At the hearing, the applicant abandoned its second head of claim, formal note of which was taken in the minutes of the hearing.

Law

Arguments of the parties

15 The applicant raises a single plea alleging infringement of Article 8(1)(b) of Regulation No 40/94.

16 The applicant claims, first, that some of the goods covered by the earlier mark and the goods designated in the trade mark application should not be considered to be, in part, similar to a high degree. Rather, on the contrary, they are identical because those goods are included in the applicant's own goods and therefore covered in an identical way by the marks at issue.

17 The applicant considers, next, that the mark RNActive should be considered to have, in any event, average distinctive character, since it has been registered as a Community trade mark. In so far as the two marks are aimed at the average consumer, who is not aware of the meaning of the initials RNA, the earlier mark has an, at least, average distinctive character.

18 The applicant points out, in addition, that the signs at issue are visually similar because the beginnings of the words are identical and, for word marks, apart from the registered mark, any other common type of reproduction — in particular reproduction in upper and lower case letters — is covered by the scope of the protection. The applicant adds that the signs are phonetically extremely similar, because the first three letters are identical and the sounds of the endings are only barely distinguishable. As regards the conceptual comparison of the signs, they are also highly similar inasmuch as the earlier mark RNActive contains the German word 'aktiv' which can be perceived as a synonym

for the German word 'effektiv', or as meaning 'having an effect', which is contained in the mark applied for RNAiFect.

19 Lastly, the applicant takes the view that, owing to the identity of the goods, the average distinctive character of the earlier mark and the degree of visual, phonetic and conceptual similarity, there is a likelihood of confusion on the part of the public.

20 OHIM and the intervener contend that that plea should be rejected.

Findings of the Court

21 Under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered where 'because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark'.

22 In addition, under Article 8(2)(a)(ii) of Regulation No 40/94 (now Article 8(2)(a)(ii) of Regulation No 207/2009), earlier trade marks means Community trade marks and marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

23 According to settled case-law, 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, constitutes a likelihood of confusion (see judgment of 10 September 2008 in Case T-325/06 *Boston Scientific* v *OHIM — Terumo (CAPIO)*, not published in the ECR, paragraph 70 and the case-law cited; see also, by analogy, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17).

24 In addition, the likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see *CAPIO*, paragraph 23 above, paragraph 71 and the case-law cited; see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22, and Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40).

25 That global assessment entails a certain interdependence between the factors taken into account and, in particular, between the similarity of the trade marks and the similarity of the goods or services covered. Accordingly, a low degree of similarity between those goods or services may be offset by a high degree of similarity between the marks, and vice versa (Case C-234/06 P *Il Ponte Finanziaria* v *OHIM* [2007] ECR I-7333, paragraph 48, and Case T-6/01 *Matratzen Concord* v *OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 25). The interdependence of those factors is expressly referred to in the seventh recital in the preamble to Regulation No 40/94, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the mark and the sign and between the goods or services identified (see *CAPIO*, paragraph 23 above, paragraph 72 and the case-law cited).

26 Furthermore, the global assessment of the visual, aural or conceptual similarity of the signs at issue must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 8(1)(b) of Regulation No 40/94 — '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 (see *CAPIO*, paragraph 23 above, paragraph 73 and the case-law cited; see also, by analogy, *SABEL,* paragraph 24 above, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 23 above, paragraph 25).

27 For the purposes of the global assessment of the likelihood of confusion, the average consumer of the goods concerned is deemed to be reasonably well informed, and reasonably observant and circumspect. Furthermore, account should be taken of the fact 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. 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 (Case T-104/01 *Oberhauser* v *OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 28, and Case T-186/02 *BMI Bertollo* v *OHIM — Diesel (DIESELIT)* [2004] ECR II-1887, paragraph 38; see, by analogy, *Lloyd Schuhfabrik Meyer*, paragraph 23 above, paragraph 26).

28 In the present case, the mark on which the opposition was based is a Community trade mark. Therefore, as the Board of Appeal stated in paragraph 14 of the contested decision, the assessment must be extended to the European Union.

29 As regards the relevant public, as the Opposition Division pointed out in page 4 of its decision of 7 August 2006, and as is apparent from paragraph 17 of the contested decision, it is made up of consumers with an interest in the goods in question. In particular, goods in Class 5 are aimed at pharmacists and end consumers who are reasonably well informed, observant and circumspect (Case T-202/04 *Madaus* v *OHIM — Optima Healthcare (ECHINAID)* [2006] ECR II-1115, paragraph 23), who nevertheless have a high level of attention and are assisted in their choice by highly qualified professionals (see, to that effect, Case C-412/05 P *Alcon* v *OHIM* [2007] ECR I-3569, paragraph 61, and *ECHINAID*, paragraph 33). As regards the chemicals in Class 1, they are aimed at a specialised public (in particular, chemists and laboratory personnel) who will thus have an even higher level of attention.

30 It is in the light of the foregoing considerations that the Board of Appeal's assessment of the likelihood of confusion between the signs in dispute should be examined.

— The similarity of the goods

31 According to settled case-law, in assessing the similarity between goods or services, all the relevant factors which characterise the relationship which may exist between them should be taken into account. Those factors include in particular their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (see *CAPIO*, paragraph 23 above, paragraph 77 and the case-law cited).

32 In that regard, contrary to what the applicant claims, the goods at issue are not all identical, but in part identical and in part similar, as the Board of Appeal, in referring to the decision of the Opposition Division, correctly found in paragraph 15 of the contested decision: thus, it is sufficient to point out, by way of example, that 'kits for introducing molecules and molecule aggregates' and chemicals for medical usage are highly similar, but cannot for that reason be considered to be identical.

33 It follows that the contested decision must be upheld as regards its analysis of the similarity of the goods at issue.

— The similarity of the signs

34 As has already been stated in paragraph 26 above, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression which they create, bearing in mind, in particular, their distinctive and dominant components (see Case T-292/01 *Phillips-Van Heusen* v *OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 47, and *CAPIO*, paragraph 23 above, paragraph 88 and the case-law cited; see, by analogy, *SABEL*, paragraph 24 above, paragraph 23).

35 It is also clear from the case-law that two marks are similar where, from the point of view of the relevant public, they are at least in part identical as regards one or more relevant aspects (*MATRATZEN*, paragraph 25 above, paragraph 30, and *CAPIO*, paragraph 23 above, paragraph 89).

36 The Board of Appeal found, in paragraph 17 of the contested decision, that, notwithstanding the existence of a similarity resulting from the fact that the first three letters of the signs at issue are identical, the differences between the terms 'iFect' and 'ctive' were so great that a likelihood of confusion could be ruled out.

37 In that regard, the signs to be compared are the following:

Earlier Mark	Mark applied for
RNActive	RNAiFect

38 As regards, first, the visual comparison, the signs at issue both consist of a single word each containing eight letters, the first three of which, written in upper case, are identical. The five subsequent letters of the earlier mark are written in lower case, as are those of the mark applied for, except for the fifth letter 'f'.

39 The similarities resulting from the identical nature of the first three letters is, however, strongly mitigated by the presence of the last five letters of the signs at issue, which, although four of them appear in both signs, do not occur in the same order, which gives rise to a very different visual perception for the two signs at issue. Thus, the overall impression created by the signs at issue shows visual differences.

40 Contrary to what the applicant alleges, it is not apparent from the contested decision that the Board of Appeal restricted itself to deconstructing the signs at issue without carrying out an overall visual assessment. Even if it is regrettable that the contested decision is not very explicit on that point, the Board of Appeal — when finding at paragraph 17 of the contested decision, that, despite the common component 'rna', attention would be drawn to, rather, the end of the word, which is more distinctive — did carry out a global analysis of the signs at issue, by concluding that that marked difference allowed for a likelihood of confusion to be ruled out.

41 Moreover, even assuming that, as the applicant claims, the signs were both written in upper case or lower case letters, it must be pointed out that, in any event, the visual similarity would not be more pronounced, since the difference owing to the positioning of the last five letters would always offset the similarity owing to the identity of the first three letters.

42 As regards, second, the phonetic comparison, it should be noted that, while the two signs begin with the three letters 'r', 'n' and 'a', their endings create a fairly clear distinction between them. The two signs are thus pronounced very differently, so that if there is a similarity, it must be regarded as, at the very least, extremely weak. In addition, in the event that the relevant public linked the vowels 'a' and 'i' in the mark applied for,

the phonetic difference would be even more noticeable. On the other hand, in a normal situation it is unlikely, first, that the consumer will double the vowel 'a' in the earlier mark and pronounce the sign 'r-n-a-active', even though that sign contains only a single 'a' and, second, that that same consumer will elide the pronunciation of the 'i' in the mark applied for and pronounce it 'r-n-a-fect'. All the same, even in such a situation, that would not in any event make those signs phonetically similar.

43 As regards, third, the conceptual comparison, it is true that, in relation to the goods in question, the relevant public will either, particularly concerning the specialist public, perceive the first three letters as referring to the English abbreviation for ribonucleid acid or, concerning the general public, assume that those initials refer, at the very least, to a component of a chemical or medical nature, even if they do not know the exact meaning of it. As both OHIM and the intervener contended at the hearing, it is not unusual, in the sector in question, for producers to refer to chemical or molecular compounds in order to emphasise the alleged effectiveness of a pharmaceutical product which is for sale.

44 However, the respective endings of the signs ('ctive' for one and 'ifect' for the other), which have different meanings, offset the similarity resulting from the common component 'rna'. The applicant's line of argument — which it particularly developed at the hearing — that the German consumer is able to make a connection between 'ifect' and the English word 'effect', which he will therefore associate with the word 'active' because the two terms refer to the notion of effectiveness or the word 'effective', requires the consumer in question to deconstruct the sign too much in order to make an association between the two signs at issue, and thus seems too improbable to be accepted.

45 If there is a certain conceptual similarity between the signs at issue, that results from the fact that the component 'rna' is common to both signs at issue, but it is offset by the different meanings owing to the respective endings.

— Likelihood of confusion

46 It should be borne in mind that a likelihood of confusion exists if, cumulatively, the degree of similarity between the trade marks in question and the degree of similarity between the goods or services covered by those marks are sufficiently high (*MATRATZEN*, paragraph 25 above, paragraph 45).

47 In the present case, it has already been stated in paragraph 32 above that the goods in question are, in part, identical and, in part, highly similar.

48 The two signs are indeed constructed around the common component 'rna'. However, it must be held — as the Opposition Division found, without the Board of Appeal casting any doubt on that finding in paragraphs 16 and 17 of the contested decision — that that component has at the very most limited distinctive character, even if a section of the consumers do not know exactly the meaning of the abbreviation in question, but assume that there is an indirect reference, in particular to a chemical or molecular compound.

49 In addition, while it is true that the consumer normally attaches more importance to the first part of words where it is more pronounced (see, to that effect, judgment of 27 February 2008 in Case T-325/04 *Citigroup* v *OHIM — Link Interchange Network (WORLDLINK)*, not published in the ECR, paragraph 82), it remains the case that the public will not generally consider a descriptive or weakly distinctive element forming part of a complex mark to be the distinctive and dominant element of the overall impression conveyed by that mark (see *ECHINAID*, paragraph 29 above, paragraph 54 and the case-law cited).

50 As has been stated, since the common component of the two signs at issue, namely 'rna', has at the most limited distinctive character, it does not enable the commercial origin of the goods to be distinguished. The Board of Appeal was therefore fully entitled to find,

in paragraph 17 of the contested decision, that the endings of the signs at issue, namely 'ctive' and 'ifect', were to be regarded as the distinctive and dominant elements which attract the attention of consumers, as they are more distinctive than the initial component 'rna' (see, to that effect, *ECHINAID*, paragraph 29 above, paragraph 55).

51 Moreover, as was pointed out in paragraph 44 above, and as OHIM correctly observed, it is wrong to claim that the endings of the signs would be perceived as identical by way of association, as the German word 'aktiv' is in no way a synonym for 'effektiv', which allows for a distinction to be made between the marks. Accordingly, those differences in meaning are such as to enable the relevant consumers to distinguish between the signs at issue.

52 Thus, although the common component of the two signs, namely 'rna', appears first, the fact that it is identical does not lead to a likelihood of confusion because that component has limited distinctive character, so that the public's attention will be drawn to the endings of the two signs which are, in the context of an overall assessment, visually, phonetically and conceptually distinct. The two signs thus give different impressions.

53 It follows that, in the present case, the degree of identity or very great similarity of the goods covered is offset by the weak degree of similarity of the signs and the weak distinctive, even descriptive, character of the abbreviation 'RNA', with the result that any likelihood of confusion on the part of the relevant public can be ruled out. Therefore, the Board of Appeal was fully entitled to find that there was not, in relation to the relevant public, a likelihood of confusion between the marks at issue.

54 Moreover, even assuming that all of the goods in question were, as the applicant claims, identical, the analysis carried out in paragraphs 34 to 53 above would not lead to a different conclusion in relation to the absence of a likelihood of confusion.

55 It follows from all of the foregoing that the single plea cannot be upheld, and the action must therefore be dismissed.

Costs

56 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. As the applicant has been unsuccessful, it must be ordered to pay the costs in accordance with the form of order sought by OHIM and the intervener.

On those grounds,

THE COURT OF FIRST INSTANCE (Eighth Chamber)

hereby:

1. Dismisses the action;

2. Orders CureVac GmbH to pay the costs.

Martins Ribeiro Wahl Dittrich

Delivered in open court in Luxembourg on 28 October 2009.

[Signatures]