

German drugmaker Stada wins appeal in trademark dispute with Spanish rival in EU court ruling

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Stada Arzneimittel has won a trademark dispute with Spanish rival Bioiberica. Annuling the EUIPO's Board of Appeal decision, the General Court said the board erred in finding that the signs had a low, rather than an average, degree of visual and phonetic similarity and there was no likelihood of confusion.

German pharmaceuticals maker Stada Arzneimittel won a trademark dispute with Spanish rival Bioiberica SAU at the EU's General Court in Luxembourg.

The General Court on Wednesday annulled an April 2023 decision of the Second Board of Appeal of the EU Intellectual Property Office, or EUIPO, (see [here](#)) which held in 2023 that the mark "DAOgest," for which Bioiberica sought registration, differed significantly from Stada's earlier EU trademark "DAOSIN" and that there was no likelihood of confusion.

"DAOSIN" was registered for goods under classes 5, 10, 29 and 32, pharmaceuticals, medical apparatus, meats and processed foods, and light beverages under the Nice Agreement for the International Classification of Goods and Services. "DAOgest" sought registration for goods under classes 1 and 5, chemicals and pharmaceuticals.

Ruling that the Board of Appeal erred in concluding that there was no likelihood of confusion on the part of the relevant public, the General Court found that the signs had an average, not low, degree of visual similarity and that the public would perceive the marks as being almost identical in length.

The court rejected Bioiberica's argument that the trademarks were significantly different because the elements 'SIN' and 'gest' were the dominant elements of the two trademarks and could not be ignored in comparing them. The Spanish drugmaker had also argued that because 'DAO' was a weak element referring to the enzyme 'diamine oxidase,' attention should be paid to other elements of the marks in deciding the case.

"In conclusion, the signs at issue consist of six and seven letters respectively, the first three of which, representing half of the earlier marks and almost half of the mark applied for, are identical. They also share the letter 's', in fourth position in the earlier marks and sixth position in the mark applied for," the court said.

In addition, the General Court found that the signs had an average, not low, degree of phonetic similarity.

"[T]he signs at issue coincide in two of their three syllables, the first of which, in the absence of elements that are dominant or more distinctive than others, is likely to attract the most attention from the relevant public," the court said.

In addressing Stada's argument that the Board of Appeal erred in not considering the identity of the goods or the enhanced distinctiveness of Stada's earlier mark, the General Court noted that the Board of Appeal found no likelihood of confusion based on the relevant public's high degree of attention and its inaccurate finding that the signs had a low degree of similarity.

Because the Board of Appeal did not assess the merits of the identity of goods and enhanced distinctiveness, "the Court is not in a position to rule on the existence of a likelihood of confusion on the part of the relevant public" based on those factors, the court said.

The court ordered that Bioiberica SAU bear its own costs and the EUIPO bear its own costs and also pay costs incurred by Stada.

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Areas of Interest: Intellectual Property

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Geographies: Europe, European Union Member States

Topics:

Trademarks