

World Trademark Review Daily

Merck prevents registration of 'meta' mark for dietary supplements
Israel - Gilat, Baret & Co, Reinhold Cohn Group

Examination/opposition
National procedures

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In *Merck KGaA v Schreiber* (opposition to the registration of trademark No 222275, January 19 2014), the [Israeli Trademark Office](#) has upheld [Merck KGaA's](#) opposition to the registration of the trademark METABOLIN for dietary supplements on the ground that it was confusingly similar to Merck's registered trademark METAFOLIN.

The applicant, who is engaged in the marketing nutritional supplements, applied for the registration of the trademark METABOLIN (in English and in Hebrew) in Class 5 of the [Nice Classification](#) for nutritional supplements promoting weight loss and metabolism.

Multinational pharmaceutical company Merck opposed the registration on several grounds under the [Trademarks Ordinance \[New Version\] 5732-1972](#). Merck manufactures a dietary supplement ingredient based on folic acid, which is marketed under the brand Metafolin as a raw material to manufacturers of dietary supplements. These manufacturers are licensed to indicate that they use Metafolin® as an ingredient on the packaging of their dietary supplements. Merck holds Israeli registrations for the METAFOLIN word mark in Class 1 (in respect of chemicals for use in industry and science, especially raw materials for the chemical, pharmaceutical and dietary supplement industries) and in Class 5 (for dietary supplements).

Merck's grounds of opposition to the registration of METABOLIN were as follows:

- the mark lacked distinctive character under Section 8(a) of the ordinance;
- it was confusingly similar to Merck's registered mark and was thus ineligible for registration under Section 11(9) of the ordinance;
- the applicant had chosen the mark in bad faith in an attempt to free-ride on Merck's goodwill; the mark was thus ineligible for registration under Section 11(6) of the ordinance; and
- registration of the mark would be contrary to public policy (and was thus ineligible for registration under Section 11(5) of the ordinance), in that therapeutic effects were attributed to foodstuff in contravention of the consumer protection and public health laws.

The applicant argued, among other things, that the marks were sufficiently different visually and phonetically, and that the opponent's product was not marketed to end consumers and thus targeted a different audience. In addition, according to the applicant, there were no public policy objections given that registration of the name Metabolin for a dietary supplement had been approved by the Ministry of Health. He also argued that his mark was suggestive in that it simply hinted that the product could improve metabolism.

The opponent adduced evidence showing that the METAFOLIN mark appeared prominently on the packaging of dietary supplements that contained its product.

The IP adjudicator examined the mark applied for and the opponent's mark in Class 5 in accordance with the three-fold test of confusing similarity. She held that, as the marks differed only in one letter, they were sufficiently similar, both visually and phonetically, so as to be confusing. The risk of confusion was enhanced by the fact that the products covered by both marks (ie, dietary supplements) are sold without prescription and often off the shelf. It was further held that the marks were intended to be used for the same type of products, targeted the same consumers and were to be sold in the same commercial venues.

Applying the 'common sense' prong of the test, the IP adjudicator accepted Merck's argument that trademarks intended for dietary supplements should be examined with particular caution, as is the case for pharmaceutical trademarks, so that the slightest indication of consumer confusion should tip the balance towards the refusal of the mark.

In determining confusing similarity, the IP adjudicator noted that the mark applied for lacked inherent distinctiveness and had not been proven to have acquired a secondary meaning.

Accordingly, the IP adjudicator upheld the opposition on the ground of confusing similarity and did not address the other grounds of opposition.

The application for METABOLIN was thus rejected.

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Orit Gonen and Sonia Shnyder, Gilat Bareket & Co, Reinhold Cohn Group, Tel Aviv

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