

Law Lore & Practice

PTMG



Pharmaceutical
Trade Marks Group

Dec 2011



Editorial: Christmas ...

Why is it that the time of year which should be synonymous with hope and new beginnings each year becomes more and more of a headache? Massive media advertising to harass youngsters into the latest craze purchase, playground peer group pressure for that must-have stocking filler, how many mince pies to

worries about travel conditions and whether there will be that last minute panic in the office which will mean that you won't get away as planned. All around the world people are packing nice clothes and squashing toys into suitcases and hoping that check-in attendants will be more lenient at this time of the year.

As 2011 draws to a close, with the ever present economic situation underpinning every news bulletin, I am led to wonder what this great commercial frenzy is truly about. For shopkeepers it is a critical time and one where stress levels are at their maximum if the end-of-day figures don't look good. For food producers, continuous long hours of preparation to ensure that fresh produce reach all the relevant points of sale in a timely fashion. Not forgetting those professions, especially health care

workers, who will be on duty throughout the season, often working long hours to cover for colleagues.

Herein lies some of the message of this time of year – looking out for each other, be it colleagues, elderly neighbours who live alone, friends who face sad anniversaries to get through. After all, time is money and giving some of one's time is as good as giving an expensive present.

Please forgive me for sounding a little like Scrooge; it must be that hard hitting moment in the kitchen a fortnight ago when my youngest child announced "I don't believe in Father Christmas anymore. Everyone knows it's the parents who leave the presents". That's it, the magic has gone. Ah well, at least that means I can keep him occupied writing proper thank you letters this year before school starts again!!

I trust that every one of you will find a true reason to celebrate Christmas this year, surrounded by those you care for and looking forward to 2012. The PTMG Board and Committee join me in wishing you and your families a very happy and healthy festive season.

Vanessa

Members News

New members

We are delighted to welcome the following new members to the Group:

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Moves and Mergers

My sincere apologies to **Paola Ruggiero** who left Barzano & Zanardo to join Bird & Bird in Milan, Italy and not the other way around, as stated in our previous issue. Paola can be contacted at
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David Bancroft can now be found at Dabias in Gauting, Germany. His new e-mail address is (webemail@dabias.com)

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Please remember to let us know of any changes to your contact details. You can notify me either via the PTMG website www.ptmg.org or directly to Lesley@ptmg.org or by writing to me at Tillingbourne House, 115 Gregories Road, Beaconsfield, Bucks, HP9 1HZ

Lesley Edwards

PTMG Secretary

Thank you

The PTMG Board and editors past and present take this opportunity to thank Dee Drinkwater, formerly of Double Dees Ltd., for the professionalism and efficiency with which she has assisted in the publishing of LL&P over the past 12 years. We all wish you well in your retirement.

International Update

European Union: OHIM introduces free of charge mediation service

Michael Hawkins, Noerr, Alicante

The Office for the Harmonization of the Internal Market (OHIM) now offers a free of charge mediation service for parties engaged in contentious proceedings before its Boards of Appeal. The service, which is entirely voluntary, is available at the joint request of the parties. The decision to mediate has the effect of suspending the underlying appeal proceedings.

Interested parties are invited to choose a mediator from a list of OHIM's staff with specific training in mediation. The mediation is held at OHIM's premises in Alicante or, for a fee of EUR 750 to cover travel and accommodation expenses, at OHIM's satellite office in Brussels.

Unless otherwise agreed, the mediation will be conducted in the language of the appeal proceedings. It will normally be scheduled for one day, will be subject to confidentiality obligations and will involve a mixture of individual and joint sessions with the mediator. Mediation is not limited to the subject matter of the appeal proceedings, and may embrace additional disputes between the parties. As the service is entirely voluntary, any party is free to withdraw at any time.

Currently, this service is only available in Boards of Appeal proceedings, and only after the Statement of Grounds of Appeal has been filed. However, if it proves to be successful, it may be extended to first instance proceedings before OHIM.

Greece: changes to trade mark law

Eleni Lappa, ip work, Athens

The Greek Trade Mark Law is changing. A Green Paper has been discussed in a public consultation procedure and is currently being finalised. The highlights of the new law include the incorporation of the Enforcement Directive (previously only a small portion concerning copyright was implemented) with the tougher and faster relief against infringements that this entails, as well as particular provisions of the Community Trade Mark Regulation of 207/2009 EC.

This will at least bring the legal framework for trade mark protection on the same level as Greece's European Union counterparts and this work in progress will be bound to bring good news for trade mark owners. After all, the much needed development of the Greek economy may only be achieved when intellectual property rights may be effectively secured thus providing comfort to foreign entities to enter the market without taking risks.

India: Delhi High Court refuses grant of interim relief

Sonal Madan, Ranjan Narula Associates
Ranbaxy Laboratories Limited challenged the

use of Intas Pharmaceuticals Limited's mark NIFTAS for treatment of urinary tract infection alleging similarity with their registered trade mark NIFTRAN used for similar drugs. Intas defended their case claiming difference in the trade marks, established use and registered rights in the trade mark NIFTAS.

The court held that since both parties were registered owners of their respective marks, no case of trade mark infringement was made out and that the matter had to be decided solely on the principles of passing off. The court observed that the rival marks were neither phonetically nor visually similar. In view of the dissimilarities between the marks, packaging, price and form of the rival products and the fact that the mark in question was used on a "prescription drug", the court denied an interim relief to Ranbaxy.

Iraq: April 2012 deadline to avoid cancellation

Edward Hardcastle & Mona Saleh, Rouse

The Iraqi Trade Mark Office issued a notice on 11 October 2011 setting out details of trade mark records which have gone missing during the various recent conflicts.

During the various conflicts over recent years the Iraqi Trade Mark Office has struggled to operate. The TMO was shut a number of times, records and physical files were destroyed and at one point the Registrar was kidnapped.

The TMO is now functioning normally but historical records are being rebuilt, with data being manually entered. On 11 October 2011, the Iraqi TMO issued a notice with details of the files that are missing between application numbers 1 and 34999. Details can be found at www.iq-tmo.com/pdf/Burned%20Files.pdf.

Registrants may provide the missing information to the TMO. Registrants are requested to submit documents showing that they are the owners of the rights. Information must be supplied to the TMO by 6 months from the date of the publication of the Declaration; i.e. by 10 April 2012. Failure to provide the information will result in the registrations being cancelled.

Rights holders with registrations in Iraq should instruct their agents to review the Iraqi TMO website to confirm whether any of their rights are on the list in the Declaration. If rights are listed, then the agents should be instructed to file the necessary information with the Iraqi TMO. If information is not available or rights owners are concerned that rights may lapse, then new applications should be filed.

Kosovo: new trade mark law

Gordana Pavlovic, Cabinet Pavlovic, Brussels and Belgrade

A new trade mark law came into force in Kosovo on 8 September 2011. The law is a

result of Kosovo's efforts to harmonize its legislation with European Union law. Some notions typical for the United States legal system – such as the need to specify in the trade mark application whether the trade mark is used or whether there is intent to use – have been abandoned.

Trade mark protection is granted to a mark that (i) serves to distinguish goods and services in commercial circulation, and (ii) can be graphically represented. This includes words, personal names, devices, letters, numbers, the shape of goods or their packaging, colours and any combinations of the above.

Rights arise from registration, not from use. Prior use gives rights to the trade mark owner only if the trade mark is well-known. The law provides for opposition within three months of publication, which takes place after examination on absolute grounds. If the applicant does not respond to the opposition, it is accepted automatically. Bad faith trade marks cannot be challenged in opposition proceedings, but only by way of an invalidation action. The same applies in case of a conflict with a personal name or image, copyright and other intellectual property right.

In addition, interested parties can file observations, pointing out reasons for the refusal on absolute grounds. The decisions of the IP Office can be appealed to the Board of Appeals, a body which is still to be established by the Ministry of Trade and Industry. A decision of the Board of Appeals can be challenged in an administrative action before the Court.

A trade mark registration lasts 10 years from the application date (under the old Trade mark Law the term was calculated from the registration date). Use is mandatory. If the trade mark is not used for 5 years, it can be cancelled at the request of an interested party. Cancellation has effect as of the date of filing the request for cancellation. Competence for trade mark cancellation cases is placed on the IP Office (not the Courts, as was the case in the past).

The law provides for preliminary injunctions. At the request of the rights holder who proves that his trade mark has been infringed or threatened to be infringed, the Court may order the seizure and/or removal from the market of the infringing goods. Such a measure can be ordered ex-parte. In case of an infringement on a large scale for the purpose of acquiring commercial benefit, and where such infringement may cause the trade mark owner irreparable damage, the Court may order the seizure of movable and immovable property from the infringer, or block bank accounts and other assets.

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Romania: Customs participate in international anti-counterfeiting operation

PETOSEVIC

During September 2011, the Romanian customs authorities participated in an international operation known as Pangea IV, which targeted the online sale of counterfeit and otherwise illegal medicine.

The operation was coordinated by the International Criminal Police Organization (INTERPOL), in cooperation with the International Medical Products Anti-Counterfeiting Taskforce (IMPACT) and the World Customs Organization (WCO).

Authorities from 81 countries took part in the operation, the aim of which was to disrupt the online criminal networks and activities connected with the sale of illegal medicine and to raise public awareness about the health risks involved in purchasing medicine online.

During the operation, 55 people were arrested, 13,495 websites closed, 45,419 medicine packages inspected, 7,901 packages confiscated, 2,422,636 drugs seized, including 304 tablets by the Romanian customs officials.

Ukraine: 2.5 million packages of counterfeit medicine sold in Ukraine in 2010

PETOSEVIC

According to Ukraine's State Inspectorate for the Quality Control of Medicines, a total of 1.2 billion packages of medicine were sold in Ukraine last year. Out of this amount, 2.5 million packages, (worth approximately USD 2.5 million EUR 1.8 million) were substandard, non-registered or counterfeit.

The counterfeit medicine mostly consisted of antibiotics and hormone drugs bearing the marks of well-known drug makers. Almost 50 percent of the fake drugs were obtained through the Internet.

According to the Ukrainian authorities, during the last two years more than 300 cases related to misleading consumers in terms of medicine and foods for special medical purposes have been considered.

Saudi Arabia : changes to Trade Mark Office practice

Edward Hardcastle, Rouse

The Saudi Arabian Trade Mark Office has recently announced two changes in practice which will affect all those who wish to obtain or maintain rights in the Kingdom. The changes came into force on 1 Muharram 1433 (26 November 2011).

The first is to formalise the requirement

for the original legalised Power of Attorney to be available at the time of filing the application. The Implementing Regulations of the Trade Mark Law are clear that the original Power of Attorney is required at the time of filing, although only a copy needs to be submitted to the TMO with the application documents. For some years the TMO has accepted applications without the original Power of Attorney being produced provided the original document was produced later. This discretionary late filing will no longer be allowed. In practice the TMO had been requiring the original Power of Attorney with all applications for the last few months.

Powers of Attorney are clearly problematic for the Saudi TMO as the second change also relates to them. The Saudi TMO will no longer accept any Power of Attorney which is more than 10 years old. Rights holders will have to execute a new Power of Attorney to replace any existing document.

Rights holders need to be aware of these changes to ensure that the Power of Attorney required for use in Saudi Arabia is executed, notarised and legalised in good time. The entire process can take some weeks in some countries, with fees for expedited services adding to the cost.

Yemen: new trade marks implementing regulations

Saba & Co. IP

The implementing regulations of Trademark Law no. 23 of 2010 in Yemen were issued on 27 July 2011, according to Ministerial Decision No. 213 of 2011. The new salient features of these regulations include:

1. The 8th edition of the Nice classification is adopted with no local sub-classification.
2. The Registrar is expected to complete substantive examination (examination on absolute and relative grounds) within 30 days from submission of all required documents.
3. Applications for renewal of trade marks will be published in the Official Gazette.
4. In the event that an owner of a trade mark desires to secure provisional protection to a mark which is used on products or services displayed in national or international exhibitions held in the country, it shall notify the competent authority one month before the opening of the exhibition. The trade mark owner shall be granted a certificate of provisional protection of

his trade mark within a period that does not exceed 3 months after the end of the exhibition.

5. The Trade mark Office will no longer issue any certificates of renewal, change of name or change of address. Only official receipts to this effect will be granted to applicants attesting to any change of title.
6. The Trade Mark Office has cancelled all surcharges imposed on late filing of documents.
7. There is a grace period of 1 year for late renewals without payment of a surcharge.
8. The registration number will remain the same as the filing number once an application matures to registration.
9. A new schedule of official fees is introduced. The fees have increased substantially in comparison with their current level.

Also to note that on 3 October 2011, implementing regulations related to Industrial Designs Law No. 28 of 2010 in Yemen were issued according to Ministerial Decision No. 212.

PTMG

2012 Spring Conference

19th and 20th March 2012
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For more details visit the
website
www.itma.org.uk/events

Send me no flowers? CJEU decides in INTERFLORA AdWords case

Dr Birgit Clark, Senior Trade Mark Practitioner, Baker & McKenzie LLP, London

On 22 September 2011, the Court of Justice of the European Union (CJEU) handed down its eagerly awaited decision in the Interflora case, a referral from the High Court of England and Wales concerning keyword ('AdWord') advertising (C-323/09). This decision follows the CJEU's earlier decisions in the AdWords cases, most notably in the three joined French cases (joined Cases C-266 to 238/08) which provided initial guidance on the legality of keyword advertising, the Austrian BergSpechte referral (C-278/08), the German referral, eis.de (C-91/09) and the Dutch referral in Portakabin (C-558/08). In Interflora, the court has now not only reiterated its basic approval of the AdWords business model, but has also decided against additional protection for trade marks with a 'reputation'. The decision is particularly noteworthy since it endorses and further defines the "investment function" as an additional function of a trade mark.

AdWords system

The search engine provider Google operates a system called 'AdWords', which allows advertisements to be displayed under the heading 'sponsored links' alongside 'natural results' in response to keywords being entered by an internet user in the search engine. In this article, the terms AdWord and keyword are used interchangeably.

Facts

The proceedings were brought by Interflora against Marks & Spencer (M & S) in relation to M & S's use of the mark INTERFLORA, spelled in different permutations ('Interflora Flowers', 'Interflora Delivery', 'Interflora.com', 'Interflora.co.uk' etc.) as an advertising keyword. When an internet user typed 'Interflora' into Google's search field, an advertisement for M & S's services was shown in the 'sponsored link' section, visually separated from the natural search results. A number of questions were referred from the High Court of England and Wales to the CJEU seeking additional clarification on (1) how keyword advertising may adversely affect the function of a trade mark used as a keyword and (2) whether keyword advertising may take unfair advantage of or cause detriment to the distinctive character or repute of that trade mark. Google itself was not part of the proceedings.

Decision

Referring to its precedents in Google France (Joined Cases C-236/08 to C-

238/08) and BergSpechte (C-278/08), the CJEU in Interflora reiterated that in cases of so-called "double-identity" trade mark infringement can only be assumed if there is an adverse effect on one of the functions of the trade mark. The court further confirmed that a trade mark owner could not 'oppose the use of a sign identical with the mark if that use is not liable to cause detriment to any of the functions of that mark. The relevant functions of a trade mark in this context not only included the 'function of indicating origin' but also other functions, such as guaranteeing the quality of the goods or services and the functions of communication, investment and advertising. With regard to keyword use in cases of "double-identity", the relevant functions to be examined were initially the functions of indicating origin and the advertising function and, somewhat more controversial, in cases of a mark with a reputation, the investment function.

Origin function

Again, referring to Google France, the court affirmed that whether the facts of a case indicated adverse effects on the origin function depended 'in particular on the manner' in which that advertisement was presented. Whether this was the case was for the national court to assess, on a case-by-case basis. Trade mark infringement would have to be assumed in two circumstances: (1) where a third party's advertisement suggests that there is an economic link between that third party and the trade mark proprietor; or (2) where an advertisement is so vague concerning the origin of the goods or services that a normally informed and reasonably attentive internet user is unable to determine, on the basis of the ad displayed, whether the advertiser is an unrelated third party or economically linked to that trade mark proprietor.

Applying this guidance to the specifics of the Interflora case, the CJEU addressed Interflora's argument that the mark INTERFLORA had acquired a secondary meaning such that it would be understood as denoting a commercial network of florists. The CJEU took the view that the origin function of the INTERFLORA trade mark could be adversely affected if internet users gained the incorrect impression from M & S's ad that M & S itself was part of the Interflora network. It was not enough if some users found it difficult to ascertain whether this was the case. The CJEU further held that the referring national court had to determine whether a reasonably well-informed and reasonably observant internet user who has entered search terms including the

word 'Interflora' into Google search engine "was able to tell that the flower-delivery service offered did not originate from Interflora". Since the Interflora network was "composed of a large number of retailers which vary greatly in terms of size and commercial profile" it "may be particularly difficult for (...) the internet user to determine, in the absence of any indication from the advertiser, whether or not the advertiser (...) is part of that network". As such, the CJEU appears to indicate that it was up to the advertiser to ensure that the language used in the ad was unambiguous concerning trade origin.

Advertising function

With regard to the advertising function, the CJEU stressed, again in reference to its precedent in Google France, that a trade mark owner was entitled to prevent a third party from using a sign identical with its trade mark in relation to identical goods or services, where that use adversely affects the proprietor's use of its mark as a factor in sales promotion or as an instrument of commercial strategy. It was 'clear' that use of a trade mark as a keyword by advertisers was liable to have 'certain repercussions' on the proprietor's 'advertising use' who, for example, had to pay a higher price per click if he wished to ensure that the advertisements appeared before those of other operators which had also chosen the mark as a keyword. In this context, the CJEU reiterated that the 'home and advertising page' was usually also displayed in the natural search results free of charge, which ensured a guaranteed visibility of trade mark owner and its products. In light of this, the court took the view that there was no adverse effect on the advertising function of the INTERFLORA trade mark.

Marks with a 'reputation'

Notably, the decision provided some new guidance concerning trade marks with a 'reputation' which are granted particular protection under European trade mark law, considering that there is a 'clear exploitation of a mark with a reputation' where such marks are used as advertising keywords. It had not been in dispute between the parties that the mark INTERFLORA had acquired considerable reputation. The CJEU therefore addressed the High Court's questions as to whether M & S's buying and bidding on the INTERFLORA trade mark as an advertising keyword amounted to trade mark infringement since it was either "detrimental to the distinctive character or repute" (so-called 'dilution') of the

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mark, or, alternatively took an "unfair advantage" of the mark (so-called 'free-riding').

Focus on the "investment function"

In *Interflora*, the CJEU for the first time discussed the protection of a trade mark's investment function in more detail. This concept had first been highlighted by the court in its *L'Oreal v Bellure* decision. The CJEU now expanded on this and held that use by a competitor of a sign identical to a trade mark in relation to identical goods or services has an adverse effect on that function where that use "substantially" interferes with the proprietor's use of its trade mark "to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty". Moreover, in a situation where a trade mark already enjoys a reputation, the investment function is adversely affected where such use "affected that reputation" and in so doing "jeopardised its maintenance". However, the investment function would not be affected if the only consequence of that third party use of the mark was that the trade mark owner had to adapt its own efforts to acquire or preserve its reputation and retaining consumer loyalty. The court also clarified that a trade mark owner cannot rely on the fact that such use could prompt some consumers to switch from the goods or services bearing the trade mark to those of a competitor.

The CJEU further held that use of a competitor's mark as an advertising

keyword would be "detrimental to the distinctive character" of that mark if there was a danger that the mark itself could become a generic term through this use ('dilution') and so was "no longer capable of creating an immediate association, in the minds of consumers, with a specific commercial origin". Nonetheless, the court appeared to take the view that selecting a competitor's trade mark as an advertising keyword did not necessarily contribute to this where it has "merely served to draw the internet user's attention to the existence of an alternative product or service to that of the proprietor of the trade mark". Things may however have to be judged differently by the national court where the ad that was triggered "did not enable the reasonably well-informed and reasonably observant internet user to tell that the service promoted by M & S is independent from that of *Interflora*".

However, the CJEU acknowledged that selecting a third party trade mark as an advertising keyword is an attempt to take advantage of a trade mark which has a reputation and thus amounts to "taking unfair advantage" of that mark ('free-riding'). This will particularly occur, if consumers then as a consequence decides to buy the advertiser's competing products rather than those of the trade mark owner. If such a keyword selection was made "without due cause", or affected the "origin function" of the trade mark, then this would have to be considered as

unfair. Especially where the advertiser's goods were imitations of the trade mark owner's goods. In contrast, where the third party ad offered an alternative to the trade mark owner's goods or services, use of the mark as a keyword would "as a rule" fall within the ambit of fair competition and thus lawful ("with due cause"), unless there was an element of confusion, tarnishment or dilution.

Comment

The CJEU has now addressed – but as some may say not necessarily answered – all questions relating to keyword advertising referred to it from the various national courts and, in the process, covered almost every possible perspective of trade mark protection. However, as some legal commentators were quick to observe, the guidance provided by the CJEU in the *Interflora* case on the issue of using trade marks with a reputation as advertising keywords is somewhat opaque. There is also some unease when it comes to the CJEU's focus on additional functions of a trade mark, in particular the investment function. The last chapter in the ongoing *AdWords* saga has not yet been written: it will now be for the referring national court, the High Court of England & Wales, to flesh out and further clarify this guidance by applying it to the actual dispute between M & S and *Interflora*.

US Update

James Thomas, Thomas Trademarks and Copyright Legal Services, North Carolina

In a non-precedential decision of the Trademark Trial and Appeal Board ("TTAB"), the TTAB found that the applicant's use of LAZACOR and LAZACOR + for "homeopathic supplements" is not likely to cause confusion with the mark NASACORT for a "steroid preparation for the treatment of allergic rhinitis". In reaching its decision, the TTAB reached a series of interesting conclusions. For example, the TTAB found that a prescription drug to treat rhinitis and a homeopathic supplement (not limited to any specific treatment and therefore including rhinitis) are sufficiently related such that if sold under the same or similar marks, they would be likely to cause confusion. The Opposer's marks were not famous despite evidence of annual sales well over USD \$200 million and substantial advertising expenditures because the Opposer did not produce unsolicited media references to the notoriety of Opposer's marks. Further, the Opposer's assertions that the product sold under its marks could be sold over-the-counter in

the future was not relevant to the current opposition. *Aventis Pharmaceuticals Inc. v. Heal the World Inc.*, Opposition No. 91192046 (October 24, 2011).

In another non-precedential decision of the TTAB, it upheld an opposition based on the marks ENSURE, PEDIASURE and NEOSURE (for nutritional products and supplements) against applications for the marks CATSURE and DOGSURE (for food supplements for cats and dogs). In reaching its conclusion, the TTAB found that the Opposer's goods (used by humans) were related to the Applicant's goods based on evidence that the Applicant had compared its product to Opposer's products (e.g., that its products do the same thing for cats and dogs that Opposer's product does for humans). *Abbott Laboratories v. Pet-Ag, Inc.*, Opposition No. 91170148 (November 22, 2011).

Finally, the USPTO issued the 8th edition of the Trademark Manual of Examining Procedure (the "TMPEP"), superseding all prior versions. Highlights of changes in

this edition include the following: (1) consent agreements making representations about both parties' beliefs concerning likelihood of confusion or which include undertakings by both parties to take certain actions to avoid confusion must be signed by both parties to be acceptable; (2) when using the language "full line of pharmaceuticals" in a description of goods, the applicant will be required to provide evidence that it uses the mark in connection with pharmaceuticals to treat diseases or health problems in all categories in the World Health Organization ("WHO") International Statistical Classification of Diseases and Related Health Problems; and (3) an applicant for an extension of protection under the Madrid Protocol may seek an amendment to the mark to add a standard character claim even though the international registration does not indicate that the mark is in standard characters, so long as the mark otherwise qualifies for such a claim (subject to consultation with the Supervisor of the Madrid Processing Unit).

83rd PTMG Conference, Prague, 12-14 October 2011

PHARMACEUTICAL TRADE MARKS IN A SHRINKING WORLD

Michele Katz and Julie Katz, Husch Blackwell LLP

Wednesday 12 October

Right from the get go, the PTMG delegates and their guests were greeted with Czech pivo (beer) at the Welcome Reception located in the Zlata Praha Restaurant and Terrace of the InterContinental Prague Hotel, which was situated in the historic Jewish Quarter of Prague. Gusts of wind carrying with it a bit of chill did not stop many of the attendees from taking in the scenic views from the Terrace. PTMG Veterans and first timers alike mingled, exchanged cards and stories, and took in the fresh Czech air.



Rosina Baxter and Richard Gilbey

Thursday 13 October

Delegates sipped coffee and tea (and took in a delicious treat) as they settled into Congress Hall of the Hotel waking up to the sweet and familiar voice of Sue Evans, Chairwoman. Richard Gilbey of Gilbey Delorey kicked off the morning discussing trade marks in history, particularly, the history of Aspirin. Quite a long and complicated history for such a little pill (see infra for mention of another little pill). The day progressed with a presentation by Rosina Baxter of Reckitt Benckiser who explained the practical and important implications



Edward Hardcastle

today of the shrinking market in which we live. After a quick coffee break, Edward Hardcastle delivered a resolute message that it takes patience and determination to accomplish your IP goals in the Middle East. A critical point, depending on the stake-holder: Do not bother with efforts to obtain a trademark covering alcoholic beverages in this region regardless of your perseverance or tenacity. From the Middle East, we



transversed to the other side of the world where Alejandro Luna of Olivares & Cia discussed the current trade mark issues facing his country of Mexico. After a cosmopolitan presentation of delicious food and stunning day time views from the 9th floor of the Hotel, Jeremy Newman of Rouse explored the war against counterfeiters in the EU where methods appear to differ from other regions of the world, including the US, as viewed through the Nokia and Philips ECJ cases. D'Arcy Quinn of CropLife made a chilling link between counterfeit products and in-house counterfeiters, so the essential take-away of the day was to initiate a "Know Your Customer or KYC program. You cannot be in Prague for an International Intellectual Property Conference and not discuss famous Czech trade marks. Thanks to Lukáš Lorenc of Cermák a spol who told the captivating history of BUDVAR and BUDWEISER. That night, delegates enjoyed an evening of regional cuisine and entertainment starting with pivo tasting on the trolley ride to



Jeremy Newman

the restaurant, U Fleku, where we consumed as much goulash as one could possibly eat! Who knew that trolley rides could be so much fun in and of themselves?



Lukáš Lorenc

Friday 14 October

Delegates spent the morning visiting BRIC (Brazil, Russia, India and China). After a succinct setting of the scene by Carly Mansell from GSK who chaired the morning session, Mario Soerensen Garcia of Soerensen Garcia Advogados got us underway discussing the pharmaceutical industry in the



Mario Soerensen Garcia



Eugene Arievich

emerging market of Brazil where he concluded, “I love you drug dealers!” (thanking his pharma clients for enforcing their IP rights in his country). Likewise, after comparing and contrasting various aspects of Brazil and Russia, Eugene Arievich, Baker & McKenzie, followed suit, not to be outdone. Chander Lall of Lall Sethi covered the India portion of BRIC and the delegates roared over the Viagra lifestyle drug video from YouTube (how many of our readers just searched it?).



Chander Lall and Carly Mansell



Finally, Catherine Zheng of Deacons concluded the morning’s sessions with her eloquent coverage of the emerging pharmaceutical market in China.



David Lossignol

The afternoon was just as riveting. First, David Lossignol of Novartis took us through the role of a trade mark during the various stages of growth from a compound to a pharmaceutical product. Second, Jonathan Jennings of Pattishall McAuliffe discussed the US perspective on gray market goods. And finally, Keith Barritt of Fish & Richardson closed this year’s sessions with an interesting discussion of what’s new with gTLDs, including the very provocative .xxx domain names. The Gala Dinner and Dance took place at the Zofin Palace, located on a beautiful island in the heart of Prague. With bated breath, the attendees waited for Sue Evans to reveal next year’s location. After toying with us, Sue finally announced: Barcelona! We look forward to seeing you next year for another set of sessions on the most cutting edge, relevant IP news, and growing strong bonds with other PTMG members.

**Here’s to a healthy,
happy and prosperous
New Year**



Jonathan Jennings



Keith Barritt



**The Editor enjoying the
entertainment at Zofin
Palace**

Court of Justice clarifies scope of design rights

By David Stone, Simmons & Simmons LLP, London

A strong pharmaceutical brand is important in fostering loyalty among healthcare professionals and patients alike, and is an important part of a strategy to mitigate the loss of revenue when a patent (or supplementary protection certificate) expires. In addition to more traditional intellectual property rights, design rights can be used to protect the shape, colour and packaging of pharmaceutical products and medical devices, particularly for consumer orientated products. Community design rights can also be useful tools in tackling counterfeit or falsified medicines and parallel imports, and can also be used to obtain some registered protection in an otherwise non-distinctive element of packaging while it acquires distinctiveness through continued use.

A Registered Community Design (“RCD”) gives the right holder a monopoly right throughout the European Union for the outward appearance of an object (or part thereof) resulting from the lines, colours, shape, texture and/or ornamentation. The right is initially for five years, extendable up to 25 years, and contrary to trade marks, is available absolutely with no need to register the design for particular goods or services. The Design Regulation (6/2002) allows designs to be registered if they are new and have individual character. Individual character requires the design to produce a “different overall impression” on the “informed user”. Practical limitations affecting registration include where a design element is dictated solely by its technical function and the freedom of the designer in developing the design.

On 20 October 2011, the Court of Justice of the European Union had its first opportunity to substantively consider the new design law in the case of *PepsiCo Inc v Grupo Promer Mon Graphic SA* (C-281/10P). The significance of this case cannot be understated – it is binding on all courts, OHIM and national registries in Europe, it provides guidance on the interpretation of the Design Regulation and of course affects the work that practitioners across Europe are doing on a daily basis. In particular, clarity is provided on the definition of “informed user”, the concept of design freedom and the “overall impression” a design creates. All pharmaceutical brand owners should be aware of this decision and consider its implications for their designs portfolio.

Background

PepsiCo applied to register a RCD for “rappers” in September 2003 (figure 1), claiming priority from an earlier Spanish design (a rapper is a small collectible promotional toy, often included in food products aimed at children). The design

was published and registered in November 2003 as “promotional item[s] for games”. In February 2004, Grupo Promer applied to OHIM for a declaration of invalidity, based on an earlier RCD for “metal plate[s] for games” (figure 2), arguing that PepsiCo’s design lacked novelty and individual character (Article 25(1)(b)) and that PepsiCo’s design was “in conflict” with Grupo Promer’s prior design (Article 25(1)(d)). Furthermore, Grupo Promer argued that PepsiCo had acted in bad faith, as Grupo Promer had previously shared its rapper design with Frito Lay (a division of PepsiCo) under terms of confidentiality.

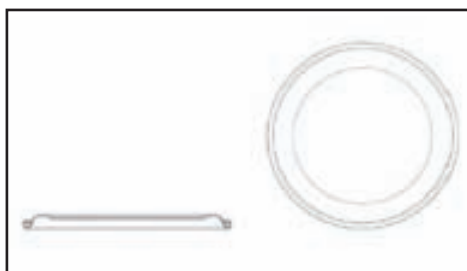


Figure 1: PepsiCo’s RCD.

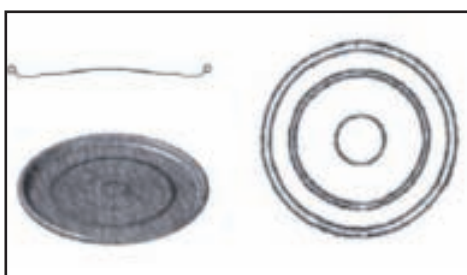


Figure 2: Grupo Promer’s earlier RCD.

OHIM’s Invalidation Division invalidated PepsiCo’s RCD on the basis that it was “in conflict” with the prior design, but Grupo Promer’s other arguments failed. At the time PepsiCo applied for its RCD, Grupo Promer’s design had not been published and it could not be taken into account as a prior design for the purposes of Article 25(1)(b), and bad faith is not a ground for invalidating a design under the Design Regulation.

PepsiCo successfully appealed to the Third Board of Appeal. Grupo Promer took the case to the General Court, which reversed the decision again, invalidating PepsiCo’s design. PepsiCo then appealed to the European Court of Justice; the Advocate General gave his opinion on 12 May 2011, noting that “this case offers the first opportunity to clarify a number of points ... in relation to Community designs”.

The Court of Justice’s Decision

At the heart of the case was whether PepsiCo’s RCD was “in conflict” with Grupo Promer’s earlier RCD. To answer

this question, the Court of Justice assessed whether PepsiCo’s RCD created a different overall impression on the informed user, taking into account the degree of design freedom of the designer. Although this case related to invalidity proceedings, this test also applies to the infringement of RCDs.

Who is the informed user?

To date, Courts have been happier to say who the informed user is not, rather than who it is. Given that the identity of the informed user has a significant impact on the validity of a design (and also whether or not it is infringed), it is useful that the Court of Justice has now laid down a comprehensive test.

The Advocate General had helpfully suggested that the informed user is not the “average consumer” of trade mark law, nor a “person skilled in the art” from patent law. Rather, the informed user “can be said to lie somewhere between the two”.

The Court of Justice developed this notion, confirming that the informed user:

“must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question ...

[A]s regards the informed user’s level of attention, it should be noted that, although the informed user is not the well-informed and reasonably observant and circumspect average consumer who normally perceives a design as a whole and does not proceed to analyse its various details (see, by analogy, Case C342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I3819, paragraphs 25 and 26), he is also not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs in conflict. Thus, the qualifier ‘informed’ suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.”

continued on the next page

The Court of Justice appears to have found the right balance, giving Community designs a robust scope of protection.

Degree of freedom of the designer

When assessing whether two designs create the same overall impression on the informed user, the degree of freedom of the designer must be taken into consideration. Some features of a product are “compulsory” – and so the designer is not free to change them. Where there are significant constraints and limited design freedom, small differences between two designs may be enough to create a different overall impression on the informed user. This is particularly relevant to pharmaceutical design, where for many products (e.g. tablets) a designer would have limited freedom.

Cases to date have highlighted such design constraints as safety legislation and product standards and other features which the design must possess if it is to fulfill its function. But the Advocate General also posed the question of whether the designer’s freedom can be restricted by features which the market expects the product to have. Intervening to support PepsiCo’s appeal, OHIM also urged the Court to take market expectations into account.

The Court of Justice did not need to decide the question, and has not, declining to interfere with the General Court’s finding that design freedom included:

“the constraints of the features imposed by the technical function of the product or an element thereof or by statutory requirements applicable to the product.”

Technical aspects of a design are already excluded from protection, so it seems more sensible to include in the restrictions of design freedom things other than technical issues only. If a syringe is

expected to have a needle, a barrel and a plunger, these are restrictions on the designer’s freedom, and something that would be apparent to the informed user. The fact that two syringes each have these features does not contribute to their creating the same overall impression on the informed user. The Court of Justice has left this discussion for another day.

How to assess overall impression

In making the assessment of overall impression, the informed user looks at the two designs side by side – the notion of “imperfect recollection” from trade mark law will only be relevant if a side by side comparison is impractical or uncommon in the sector concerned. This sits well with the notion of an “informed user” – this is not a rapid decision of a consumer in a supermarket, but rather a considered analysis by an educated user of the product concerned.

All parties agreed that the primary comparison should be between the RCD as shown in the registration, and the prior design (in this case comparing two line drawings), but PepsiCo argued that the General Court had based its assessment on an examination on PepsiCo’s physical rappers, rather than the design drawings in the RCD.

The Advocate General had suggested that the comparison should be between the RCD as filed and the prior design, but that the physical rapper could be used “only to confirm the findings already made”. One of the dangers, of course, is that it is extremely difficult to determine whether a physical object is made to the design – in many cases, the physical object will have additional material that makes it different to the line drawing or photograph in the RCD.

The Court of Justice has adopted the Advocate General’s approach, noting:

“since in design matters the person making the comparison is an informed user who ... is different from the ordinary average consumer, it is not mistaken, in the assessment of the overall impression of the designs at issue, to take account of the goods actually marketed which correspond to those designs.

... [T]he General Court did indeed base its assessments on the designs in conflict as described and reproduced in the respective applications for registration, with the result that the comparison of the actual goods was used only for illustrative purposes in order to confirm the conclusions already drawn and cannot be regarded as forming the basis of the statement of reasons given in the judgment under appeal.”

The Court of Justice dismissed PepsiCo’s appeal with costs. The end effect is that PepsiCo’s RCD, filed in 2003, has now been held to be invalid. There is no appeal from the Court of Justice.

Comment

Pharmaceutical companies must take advantage of all rights available to them to ensure their intellectual property benefits from comprehensive and strong protection. This decision provides clarity to some of the key concepts in the Design Regulation, and most importantly it confirms the strength of the Registered Community Design. The impact of this decision on both ongoing design disputes and any infringement actions not taken in the past should be assessed. Practitioners should always be alive to the possibility of filing design registrations for new and innovative designs, and where possible, should apply for a design registration at the same time as a trade mark registration.

IP TRANSLATOR: guidance given by AG on trade mark specifications

Dr. Alexander von Mühlendahl, J.D., LL.M., Rechtsanwalt,

On 29 October 2011, Advocate General Bot delivered his Opinion in Case C-307/10, Chartered Institute of Patent Attorneys v. Registrar of Trade Marks. The case arose from an application of the mark IP TRANSLATOR for the services “Education; providing of training; entertainment; sporting and cultural activities”, which is the class heading for Class 41 of the Nice Classification. The United Kingdom Intellectual Property Office objected because the mark was descriptive for translation services which fall into Class 41. The Institute argued that translation services were outside the

specification, but the Office refused, taking the view that since the Institute had specified the Class 41 headings it had also claimed protection for translation services. On appeal to the Appointed Person, the following questions were referred to the Court of Justice of the European Union for a preliminary ruling:

“In the context of the Directive:

(1) Is it necessary for the various goods or services covered by a trade mark application to be identified with any, and if so what particular, degree of clarity and precision?

- (2) Is it permissible to use the general words of the class headings of the [Nice Classification] for the purpose of identifying the various goods or services covered by a trade mark application?
- (3) Is it necessary or permissible for such use of the general words of the Class Headings of [the Nice Classification] to be interpreted in accordance with Communication No 4/03 ...?”

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The reference thus raised the central questions in the ongoing debate about the use of class headings or other generic terms in trade mark applications and registrations and the consequences of allowing such generic claims. The Advocate General proposed the following as answers:

(1) (a) Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks and Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark are to be interpreted as meaning that the identification of the goods or services for which the applicant seeks protection must satisfy requirements of clarity and precision which are sufficient to enable the competent authorities and the economic operators to determine accurately the scope of the protection conferred by the trade mark.

(b) Those requirements may be satisfied by a specific list of each of the goods and services for which the applicant seeks protection. They may also be fulfilled by identification of the basic goods or services enabling the competent authorities and economic operators to determine the essential characteristics and objective properties of the goods and services concerned.

(2) Directive 2008/95 and Regulation No 207/2009 are to be interpreted as not precluding the applicant from identifying the goods or services for which they seek protection by using the general indications of the class headings of the common classification of goods and services for which a mark is registered, provided that that identification satisfies the necessary requirements of clarity and precision.

(3) Communication No 4/03 of the President of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations, by which the President indicates that OHIM does not object to the use of any of the general indications and class headings as being too vague or indefinite and that the use of those indications constitutes a claim to all the goods or services falling within the class concerned, does not guarantee the clarity and precision required for the purposes of the registration of a trade mark, whether

a national or a Community trade mark.

Aside from interesting general comments made by the Advocate General, such as the welcome statement that the answers must necessarily be the same for the CTM system and for all national systems, the forthcoming judgment of the ECJ, if it follows, which seems likely, the Opinion of the AG, should demand the attention of all trade mark proprietors and practitioners. The following five points are of particular interest.

Firstly, the use of generic indications in the class headings (example: clothing – Class 25) in specifications will be allowed, provided these indications, or any other generic indications, satisfy “the necessary requirements of clarity and precision”. This requirement is the corollary to the requirement for the representation of a mark to be clear, precise, self-contained, easily accessible, intelligible, durable, unequivocal and objective (the so-called “Sieckmann requirements”). If the practice of OHIM and national Frank Mark Offices in Europe are taken into account, this requirement is fulfilled with almost all of the class headings.

Second, using the class headings or any other generic indication does not constitute a claim to goods or services which may not properly be understood as falling under the generic term. Thus, OHIM’s and the practice of many national offices “includes all” cannot be maintained. Generic terms, including class headings, must be interpreted to “mean what they say” (e.g. “musical instruments” in Class 15 do not cover “carrying cases for musical instruments”, also classified in Class 15). Applicants wishing to have protection for all goods or services in a class such as Class 15 must find ways of describing these goods in terms other than by use of the class headings.

Third, as regards registrability examination, offices will have to take into account only goods or services falling under the generic term. In the IP TRANSLATOR case, a refusal would be appropriate only if translation services would fall under any of the class headings, which does not appear to be the case.

Fourth, as regards conflict cases, the earlier (or later) mark should be taken as claiming only those goods or services which fall within the generic terms properly employed. Other goods or services falling into the same class would be disregarded.

Finally, as regards use, both for purposes of the defence of non-use and of revocation for non-use, any use outside of the scope of a generic indication would not constitute use for the goods or

services for which the mark is registered.

All these consequences would go against current OHIM practice. To the extent that trade mark proprietors would be put at a disadvantage as compared to earlier practice, appropriate amendments of specifications should be allowed by OHIM and offices in a similar situation, already now on a case-by-case application and perhaps legitimised by an amendment of applicable legislation, permitting proprietors to add goods or services included under current OHIM practice (e.g. “carrying cases for musical instruments” in addition to “musical instruments”), without expecting a rejection on the grounds of impermissible extension of the list of goods or services.

The judgment of the ECJ is expected in the first half of 2012.

PTMG

2012 Autumn Conference

3rd to 5th October 2012
Barcelona

For more details visit the
website
www.ptmg.org

Editor's note:



A special mention for Julie Katz who adopted a 2 year old girl from Moldova on Friday, October 21. Julie left PTMG Conference in Prague early to join her husband in Moldova after a nearly two year process. Yet another remarkable PTMG story. We are delighted to feature this family shot here and offer our congratulations to all.

PROFILE: Frances Drummond

Frances is a partner of Norton Rose Australia, specialising in contentious and non-contentious trade marks. Frances started her career with The Wellcome Foundation in London and then worked for nine years in Hong Kong, latterly as a partner of the law firm Deacons. She has been working in Australia since 2000 and was formerly a partner at Freehills in Sydney. As well as being a lawyer, Frances is a qualified mediator and notary.



Where were you brought up and educated?

I was born and brought up in Belfast until I was 11 and then I moved to the Midlands in the UK where I was educated until I went to University and Bar School in London.

How did you become involved in trade marks?

In 1988, I had completed my law degree and been called to the Bar but decided that I didn't have sufficient funds to commence pupillage. I therefore thought I would seek either a commercial pupillage or a job to last for about 12 months until I saved enough money to go back and do the pupillage. During that time whilst looking for commercial pupilages I saw an advertisement in the newspaper for a job with The Wellcome Foundation, which I had never heard of. I went for an interview with Geoffrey Foot and have been doing trade marks ever since.

What would you have done if you hadn't become involved in intellectual property?

I think I would have been a criminal barrister. I worked with the Crown Prosecution Service as a student and could see myself strutting around in the Old Bailey.

Which three words would you use to describe yourself?

Honest, extrovert and friendly.

Complete the following sentence. 'I wish ...'

If I have time to myself... to go shopping.

What's the best thing about your job?

Wherever I go in the world I usually know someone and I have lived in London, Hong Kong and Sydney – not too bad.

What is a common misperception of you?

That I am somehow scary. In the past, I have been nicknamed "Rottweiler" amongst others but am actually far from scary.

What is the best age to be?

I find that changes from year to year!

What would be your ideal night out?

Dinner and drinks with a bunch of friends and then dancing. The PTMG conference usually provides an ideal opportunity.

What's the toughest thing about your job?

Timesheets.

What is your weakness?

Shopping.

Which book or books are you currently reading?

The Widow Clicquot and My Life in France. The first is about my favorite drink combined with a study of a remarkable woman pioneer. The second is Julia Child's biography. She could be said to be one of the first "celebrity" chefs.

Which one person would you invite to dinner (other than a family member or relative)?

Colin Firth – preferably dressed as Mr Darcy in the lake scene.

What is your favourite food dish?

Thai, I was addicted to this when I was pregnant with my son, so much that my husband insisted we give it up for quite a while afterwards.

What is your favourite drink?

Champagne

What is your favourite holiday destination?

Port Douglas in Australia: fab beaches, the Barrier Reef and always warm.

Which piece of advice would you give a visitor to the area in which you live?

Move here. Bronte in Sydney is a fantastic place to live.

What's your favourite mode of transport and why?

Anything that stays on the ground. I am frightened of heights so I hate flying.

What do you like, even though it's not fashionable?

Sewing - I take classes with a range of women including a surgeon who is a very neat seamstress!

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