

# Law Lore & Practice

PTMG



Pharmaceutical  
Trade Marks Group

Dec 2012



## Editorial: Food, glorious food

Here we are again at that time of year in the Northern hemisphere when Brussels sprouts and parsnips figure heavily on the kitchen table, to the delight of some and to the horror of others. This difference in reaction in our household is driven by the generation gap and not by cultural differences; to my relief one can now buy

parsnips in French markets and I am no longer obliged to run a non-declared vegetable import business!

Children's taste buds evolve; we all know that and often have personal memories of the day when we actually enjoyed a particular food for the first time. You can of course also go off some food as my experience with snails, that ultimate French delicacy, shows. The moment was entirely psychological and not one of "lost in translation". Some years ago, whilst I was enjoying my escargots dripping in butter and garlic, the person sitting opposite me asked in pigeon English "do you like snails?" Whereupon one got stuck in my throat and I have never been able to eat them since!

For schoolchildren here in France, there are no such things as snails or frogs' legs on the lunchtime menu but nevertheless, to a Brit who enjoyed the joys of the tuck shop at school, there are daily, challenging gustative moments. A regular state school lunch menu here has four courses, where combinations of shredded beetroot or other raw vegetables, broccoli purée and international dishes such as moussaka are often proposed.

Given that on average 90% of all schoolchildren between the

ages of 3 and 15 eat in their canteens in France and lunch boxes are generally not permitted for health and safety reasons, you can begin to imagine how important this market is to food producers and caterers alike. Special dietician advisors are nominated in each school academy and great care is spent on developing balanced meals on a 6 week rota.

Whilst one can applaud these initiatives to teach children about food, the results are sometimes contradictory. Hoards of starving pupils rush out of school to devour mountains of patisseries, biscuits and other high-sugar content delights and the sale of cakes in front of the school one night a week raises large amounts of cash for school projects. The lone Mum who arrives with a box of chopped fruit is to be applauded but, in my experience, is fighting a losing battle.

Whatsmore, it would be just as appropriate, in my opinion, to tackle the vast amount of waste in school canteens and for both parents and the educational community to spend more time and resources educating children in the notions of world food economics and good food husbandry. The future health of the world's population certainly depends on a more balanced distribution of the food we produce and eat across the globe.

Meanwhile, it's back to the drawing board for the week's menus at home which of course, must vary from the ones offered in school! Whether your menu for Christmas Day includes sprouts or not, I wish you all an enjoyable festive season and a happy, healthy New Year.

Vanessa

## US Law Update

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

In two recent (non-precedential) decisions of the U.S. Trademark Trial and Appeal Board (TTAB), the TTAB concluded (1) that a domain name consisting of the INN prasterone plus .org was generic for providing a website featuring scientific and clinical research information about prasterone and therefore an application to register prasterone.org for such services was properly refused (In re Health Sci. Funding, LLC, 2012 TTAB LEXIS 367 (TTAB Sept. 19, 2012)) and (2) that dietary supplements and energy drinks are related goods (In re Dub Nutrition, LLC,

2012 TTAB LEXIS 397 (TTAB Oct. 3, 2012)).

Also, a new drug naming policy of the United States Pharmacopeia and National Formulary (USP-NF) will go into effect 1 May, 2013. The USP-NF is responsible for the naming policies for particular drug monographs of FDA-approved drugs. For example, the USP-NF policy calls for drug product names to consist of [DRUG] [ROUTE OF ADMINISTRATION] [DOSAGE FORM], aerosol products to consist of [DRUG] [ROUTE OF ADMINISTRATION] Aerosol, etc. In

general, this USP-NF compliant name will include the INN or established name of the active ingredient, but over time some inconsistencies developed between USP-NF names and the final established name of an approved product.

The USP-NF's new policy is intended to bring more consistency to this naming process and help avoid confusion among healthcare workers and patients. This will not affect the proprietary name approval process, which remains solely with the FDA. More information on the USP-NF naming policy is available at [www.usp.org](http://www.usp.org).

## Words from the Chair



With the end of 2012 fast approaching, I am delighted to say a few words in my capacity as the new Chair of PTMG.

Firstly, I want to say how pleased I am to be the Chair of such a wonderful organisation and I am looking forward to getting to know as many of you as possible in the future.

I must again pay tribute to Sue Evans and thank her for her superb leadership over the past years. Sue made the transition of responsibility very smooth and easy and has been so kind and helpful to me. My personal thanks also to all the PTMG Committee members without whom PTMG would not be this great organisation.

It was a great pleasure to host my first PTMG conference as Chair in Barcelona and I enjoyed meeting many of you then. I am delighted that we were able to introduce the first Founder's Lecture; congratulations again to Isabelle Dini for giving such an interesting presentation and special thanks to Derek Rossitter for attending the meeting and presenting Isabelle with the Founder's Lecture gifts and certificate. It was an honour for me to have Derek in the room for the first Conference I was chairing.

I am looking forward to seeing many of you at our next conference in Hamburg in March, and in the meantime, I wish you and yours a Merry Christmas and send you all my very best wishes for 2013.

**Sophie Bodet**

## Members News

### New Members

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

**Laura Pedemonte** of Barzano & Zanardo Milano S.p.A., Milan, Italy  
*l.pedemonte@barzano-zanardo.com*

**Rosalia Salvia Lopez** of Isdin S.A., Barcelona, Spain  
*rosalia.salvia@isdin.com*

**Pavel Gorokhov**, of Baker & McKenzie – CIS Limited, Moscow, Russia "  
*pavel.gorokhov@bakermckenzie.com*

**Heidi Gorenstein Nigri** of Luiz Leonardos & Cia – Intellectual Property, Rio de Janeiro, Brazil  
*stein@llip.com.br*

**Lucila Lodola de San Martin** of Obligado & Cia Ltda, Buenos Aires, Argentina  
*llodola@obligado.com.ar*

**Oluwayemisi Falaye** of Adeptun Caxton-Martins Agbor & Segun, Lagos, Nigeria  
*yfalaye@acas-law.com*

**Max Villaseca** of Estudio Villaseca, Santiago, Chile  
*max@villaseca.cl*

**Markus Müller** of Müller Fottner Steinecke, Munich, Germany  
*mueller@ipmunich.de*

**Mara Jankovic** of Mikijelj Jankovic & Bogdanovic, Belgrade, Serbia  
*mara.jankovic@mjb.rs*

**Ana Castedo Garcia** of Hogan Lovells LLP, Madrid, Spain  
*ana.castedo@hoganlovells.com*

**Clémence Maubisson**  
*Clemence.maubisson@pierre-fabre.com* and  
**Virginie Noel**  
*virginie.noel@pierre-fabre.com* both of  
Pierre Fabre SA, Castres, France

**Simon Bentley** of Abel & Imray, London, UK  
*simon.bentley@patentable.co.uk*

**Nichole Davies** of InterbrandHealth, London, UK  
*nichole.davies@interbrandhealth.com*

**Maria Kristin Gunnarsdottir** of Arnason Faktor ehf, Reykjavik, Iceland  
*mkg@arnasonfaktor.is*

**Bernadita Torres Arrau** of Porzio, Rios & Asociados, Santiago, Chile  
*btorres@porzio.cl*

**Sine Bramming Platz** of Chas. Hude A/S, Copenhagen, Denmark  
*sbp@chashude.com*

**Judit Lantos** of Sár and Partners Attorneys at Law – Danubia Patent and Law Office, Budapest, Hungary  
*judit.lantos@sarandpartners.hu*

**Grace Li** of Deheng Law Offices, Beijing, China  
*graceli@dehenglaw.com*

**Marloes Bakker** of Klos Morel Vos & Schaap, Amsterdam, The Netherlands  
*marloes.bakker@kmvs.nl*

**Ana Laura Ramirez** of Rossi, Martinez, Vargas, S.C. IBERBRAND, Mexico City, Mexico  
*ana@iberbrand.com*

**Brooks Bruneau** of Porzio Bomberg & Newman, Princeton, New Jersey, USA  
*brbruneau@pbnlaw.com*

**Rae Yan** of Hogan Lovells (Shanghai) Intellectual Property Service Co. Ltd., Beijing, China  
*Rae.yan@hoganlovells.com*

**Malcolm Bell** of Phillips Ormonde Fitzpatrick, Melbourne, Victoria, Australia  
*Malcolm.bell@pof.com.au*

**Veranika Shypitsa** of Lexpatent, Minsk, Belarus  
*Veranika.shypitsa@lexpatent.by*

**Vanessa Bockhorni** of Bockhorni & Kollegen, Munich, Germany  
*va@patguard.de*

**Todd Bates** of Hilborne Hawkin, Irvine, California, USA  
*tbates@hilbornehawkin.com*

**Bahia Abo Nasser** of Grant Thornton Yafi & Co, Beirut, Lebanon  
*bahia@gyafi.com*

**Inês Amaral Rodrigues** of Gastão Cunha Ferreira Lda, Lisbon, Portugal  
*ines.rodrigues@gasta.o.eu*

**Frank Mantey Daniel Gabarre Guillemos Hinarejos** of J. Isern Patents and Trademarks, Barcelona, Spain  
*info@jisem.com*

**Tom Sadler** of Novartis Pharma AG, Basel, Switzerland  
*Tom.sadler@novartis.com*

**Aleli Angela Quirino** of Angara Abello Concepcion Regala & Cruz Law Offices (ACCRALAW), Manila, Philippines  
*agquirino@accralaw.com*

**Olof Lindquist** of Skriptor AB, Stockholm, Sweden  
*dof.lindquist@skriptor.com*

**Goran Marjanovic** of Zivko Mijatovic and Partners (ZMP), Zagreb, Croatia  
*goranm@zm-p.com*

**Caroline Casseli** of Casseli Law Firm, Asuncion, Paraguay  
*seli@casselilawfirm.com*

**Marissa Lasso de la Vega F.**, of Alfaro Ferrer & Ramiez, Panama City, Panama  
*sodelavega@afra.com*

**Clemence le Cointe** of Dennemeyer & Associates S.A., Munich, Germany  
*clecointe@dennemeyer-law.com*

## New Members Continued

**Nola Bond** of DM Kisch Inc., Johannesburg, South Africa  
[nolab@dmkisch.com](mailto:nolab@dmkisch.com)

**Rachel Havard** of A.A. Thornton & Co., Northampton, UK  
[rsh@aathornton.com](mailto:rsh@aathornton.com)

**Iliana Muhibian** of J. Varbanov & Partners, Sofia, Bulgaria  
[ilmuhibian@jvpatents.com](mailto:ilmuhibian@jvpatents.com)

**Bruno Contamine** of CPA Global, Rueil-Malmaison, France  
[bcontamine@cpaglobal.com](mailto:bcontamine@cpaglobal.com)

**Karine Disdier-Mikus** of DLA Piper UK LLP, Paris, France  
[Karine.disdier-mikus@dlapiper.com](mailto:Karine.disdier-mikus@dlapiper.com)

**Justyna Rasiewicz** of LDS Lazewski Depo & Partners, Warsaw, Poland  
[justyna.rasiewicz@lds-ip.pl](mailto:justyna.rasiewicz@lds-ip.pl)

**Yuko Muramatsu**  
[y.muramatsu@sugi.pat.co.jp](mailto:y.muramatsu@sugi.pat.co.jp) and  
**Tetsuo Tsukanaka**

[t.tsukanaka@sugi.pat.co.jp](mailto:t.tsukanaka@sugi.pat.co.jp) both of Sugimura International Patent & Trademark Attorneys, Tokyo, Japan

**Helena Galan Diez** of Darts-IP, Brussels, Belgium  
[hgalan@darts-ip.com](mailto:hgalan@darts-ip.com)

**Jose Maria Del Valle** of Clarke Modet & Co. S.L., Barcelona, Spain  
[jmdelvalle@darkemodet.com](mailto:jmdelvalle@darkemodet.com)

**Jessica Schmidt** of Merck KGaA, Darmstadt, Germany  
[Jessica.schmidt@merckgroup.com](mailto:Jessica.schmidt@merckgroup.com)

**Christina Nielsson** of H. Lundbeck A/S, Valby, Denmark  
[cnie@lundbeck.com](mailto:cnie@lundbeck.com)

**Victor Adames** of Becerril, Coca & Becerril S.C., Mexico City, Mexico  
[vaadames@bcb.com.mx](mailto:vaadames@bcb.com.mx)

**Nicole Hickey** of Abbott Laboratories, Allschwil, Switzerland  
[Nicole.hickey@abbott.com](mailto:Nicole.hickey@abbott.com)

**Susan Vogt** of Gowling Lafleur Henderson LLP, Toronto, Canada  
[susan.vogt@gowlings.com](mailto:susan.vogt@gowlings.com)

**Tania Lovita** of Rouse, Jakarta, Indonesia  
[tlovita@iprights.com](mailto:tlovita@iprights.com)

**Aaron Montero** of E-Print, San Jose, Costa Rica  
[amontero@eprint.com](mailto:amontero@eprint.com)

**Alasdair MacQuarrie** of Gill Jennings & Every LLP, London, UK  
[Alasdair.macquarrie@gje.com](mailto:Alasdair.macquarrie@gje.com)

**Kati Rantala** of Juridia Ltd, Helsinki, Finland  
[kati.rantala@juridia.com](mailto:kati.rantala@juridia.com)

**Tatiana Draganova**  
[tdragaganova@computerpackages.com](mailto:tdragaganova@computerpackages.com) and  
**Manel Fernandez**  
[mfernandez@computerpackages.com](mailto:mfernandez@computerpackages.com) both of Computer Packages Europe BV, Breda, The Netherlands

**Josephine Liholm** of SMD Markeur, Ahrensburg, Germany  
[liholm@smd-markeur.de](mailto:liholm@smd-markeur.de)

**Alain Berthet** of Promark, Paris, France  
[info@promark.fr](mailto:info@promark.fr)

**Julie Sikker Hansen** of Kromann Reumert, Copenhagen, Denmark  
[jsh@kromannreumert.com](mailto:jsh@kromannreumert.com)

**Yingyu Han** of Beijing Sanyou Intellectual Property Agency Ltd., Beijing, China  
[sanyou@san-you.com](mailto:sanyou@san-you.com)

**Maite Ferrandiz** of Grau & Angulo, Barcelona, Spain  
[m.ferrandiz@gba-ip.com](mailto:m.ferrandiz@gba-ip.com)

**Elia Sugrañes** of Sugrañes, Barcelona, Spain  
[Esugranes@sugranes.com](mailto:Esugranes@sugranes.com)

**Ana Cristina Arroyave**  
[aarroyave@ideatpcr.com](mailto:aarroyave@ideatpcr.com) and  
**Maricruz Villanea** [Mvillanea@ideatpcr.com](mailto:Mvillanea@ideatpcr.com) both of Ideas Trademarks and Patents, San Jose, Costa Rica

**Vadim Shipilov** of Gorodissky & Partners Ltd., Moscow, Russia  
[ShipilovV@gorodissky.ru](mailto:ShipilovV@gorodissky.ru)

**Yves Kesch** of Tillotts Pharma AG, Rheinfelden, Switzerland  
[ykesch@tillotts.com](mailto:ykesch@tillotts.com)

**Emily Hill** of Spoor and Fisher Jersey, St. Helier, Jersey, Channel Islands  
[e.hill@spoor.co.uk](mailto:e.hill@spoor.co.uk)

**Joana Fialho Pinto** of A.G. da Cunha Ferreira Lda, Lisbon, Portugal  
[joanafpinto@agcunhaferreira.pt](mailto:joanafpinto@agcunhaferreira.pt)

**Puravee Shah** of Murgitroyd & Company, Croydon, Surrey, UK  
[Puravee.shah@murgitroyd.com](mailto:Puravee.shah@murgitroyd.com)

**Cherrie Stewart** of MacLachlan & Donaldson (UK) t/a Ansons, Belfast, Northern Ireland  
[stewartc@ansons.co.uk](mailto:stewartc@ansons.co.uk)

**Olga Yakimenko** of Salans, Moscow, Russia  
[Yakimenko@salans.com](mailto:Yakimenko@salans.com)

**Nicole Giesen** [Gesens@mhpatent.de](mailto:Gesens@mhpatent.de) and  
**Nicole Griebel** [Griebel@mhpatent.de](mailto:Griebel@mhpatent.de) both of Michalski Hüttermann & Partner, Düsseldorf, Germany

**Barbara Goossens** of Multisearch by Knijff Trademark Attorneys, Weesp, The Netherlands  
[b.goossens@knijff.com](mailto:b.goossens@knijff.com)

**Leva Zvejsalniece** of Petersona Patents, Riga, Latvia  
[ieva.zvejsalniece@petpat.lv](mailto:ieva.zvejsalniece@petpat.lv)

**Juan Lapenne** of Fox & Lapenne, Montevideo, Uruguay  
[jlapenne@hotmail.com](mailto:jlapenne@hotmail.com)

**Ai Ming Lee** of Rodyk & Davidson, Singapore, Singapore  
[lee.aiming@rodyk.com](mailto:lee.aiming@rodyk.com)

**Shaohui (Simon) Yuan**  
[yuansimon@cpahktd.com](mailto:yuansimon@cpahktd.com) and  
**Lei (Rachel) Zhang**  
[zhangrachel@cpahktd.com](mailto:zhangrachel@cpahktd.com) both of China Patent Agent (HK) Ltd., Beijing, China

**Timothy Pinto** of Taylor Wessing LLP, London, UK  
[t.pinto@taylorwessing.com](mailto:t.pinto@taylorwessing.com)

**Ellen Breddam** of Plougmann & Vingtoft A/S, Copenhagen, Denmark  
[elb@pv.eu](mailto:elb@pv.eu)

**Montserrat Puente** of Zacarias & Fernandez, Asuncion, Paraguay  
[M.puente@zafer.com.py](mailto:M.puente@zafer.com.py)

**Maria Kyriakou** of Markides, Markides & Co. LLC, Nicosia, Cyprus  
[info@markides.com.cy](mailto:info@markides.com.cy)

**Ida Daae** of Protector IP Consultants AS, Oslo, Norway  
[imd@protector.eu](mailto:imd@protector.eu)

**Nicola Tarantini** of Bugnion SpA, Milan, Italy  
[tarantini@bugnion.it](mailto:tarantini@bugnion.it)

**Fani Bojinova** of Bojinov & Bojinov, Sofia, Bulgaria  
[office@ptmbojinov.com](mailto:office@ptmbojinov.com)

**Taro Seo** of Bufete Soni, Mexico City, Mexico  
[Lseo@soni.mx](mailto:Lseo@soni.mx)

**Søren Ekelund-Jørgensen** of Novo Nordisk A/S, Bagsvaerd, Denmark  
[sejg@novonordisk.com](mailto:sejg@novonordisk.com)

**Amal Abdallah** of Saba & Co. IP, Hazmieh, Lebanon  
[aabdallah@sabaip.com](mailto:aabdallah@sabaip.com)

## Moves and Mergers

**Wolfgang May** retired from Procter & Gamble earlier this year and may now be found at May & Pursch-May Rechtsanwälte. His e-mail address is [maypurschmay@aol.com](mailto:maypurschmay@aol.com).

Following the acquisition of Nycomed by Takeda, **Wolfgang Feiler** has moved offices and can now be found at Takeda Pharmaceuticals International GmbH in Zurich, Switzerland. His e-mail address is [wolfgang.feiler@takeda.com](mailto:wolfgang.feiler@takeda.com).

**Elka Stegeman** has left Novagraaf Nederland B.V. to join Arnold Siedsma in Enschede, The Netherlands. Elka can be contacted at [estegeman@amold-siedsma.nl](mailto:estegeman@amold-siedsma.nl)

**Kathrine Kjendlie** has left Nycomed Norway to join Onsagers AS in Oslo, Norway. She can be contacted at [Kathrine.kjendlie@onsagers.com](mailto:Kathrine.kjendlie@onsagers.com).

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](http://www.ptmg.org) or directly to [Lesley@ptmg.org](mailto:Lesley@ptmg.org) or by writing to me at Tillingbourne House, 115 Gregories Road, Beaconsfield, Bucks, HP9 1HZ

**Lesley Edwards**

# International Update

## Australia

Earlier this year the Therapeutic Goods Administration (TGA) issued a consultation paper on medicine and labelling packaging reform in Australia. The 110 submissions received in response to this review have now been analysed and the TGA has announced the next steps in its review.

The TGA has announced strong support for changes regarding: active ingredient prominence; standardised medicine information presentation; dispensing label space; and the creation of a committee to provide advice to the TGA on labelling and packaging issues. However, less consensus exists in the remaining areas, including: look-alike, sound-alike names; look-alike packaging; look-alike branding; pack inserts; small containers; and blister strips. Significant opposition to some areas of proposed reform was apparent. The TGA will now undertake further discussions with stakeholders, including consideration of alternative approaches to achieve greater consensus to the reforms being considered.

Two polarising issues were the prominence of active ingredient names and use of umbrella branding. Significantly, after consideration of the submissions, the TGA has formed the view that a single set of requirements for medicines labelling is not appropriate for all classes of medicines. Therefore, it is now proposed that labelling requirements will be specific to the class of medicine, divided into: 1.) prescription; 2.) over the counter (non-prescription registered); and 3.) listed (complementary). Labelling requirements will be developed in consideration of the healthcare professional interaction associated with each class of medicine. That is, requirements will vary for prescription only medicine when compared with a product self-selected in a pharmacy or supermarket.

The TGA will first focus on labelling requirements for registered prescription and non-prescription medicines. Products at the therapeutic and consumer products interface, such as sunscreens, have been highlighted as being a particular focus. The goal being to achieve greater consensus across the proposed changes, after which independent consumer testing is planned for early 2013, ahead of changes to the regulations.

**Georgina Hey, Norton Rose Australia**

## Russia

The new official patent and trademark fees were introduced by the Russian government's order No. 781 of 15 September, 2011 and came into force last August after Russia formally joined the World Trade Organization (WTO).

As prescribed by the WTO, the Russian government's order introduced equal fees for both domestic and foreign applicants.

The official fees for trade mark matters were the same for both domestic and foreign applicants during the last 7 or 8 years. Now the official fees for trade mark prosecution have increased by approximately 30%.

The order stipulates a 15% discount for electronic filing, i.e. a EUR 3-10 (USD 4-13) discount, depending on the type of the official fee and a 50% discount for the official fees for small business applicants.

RU MARKS, a company that specializes in trade mark registration in Russia, announced on its website that Russia's PTO recently registered the first scent trade mark in Russia.

In Spring 2012 this year Russian perfume maker Natalia Kolyago succeeded in obtaining trade mark rights for a leather tag with a strong leather smell.

Kolyago's perfume, which will smell like the registered trade mark, is expected to appear on the Russian market by the end of this calendar year.

## PETOSEVIC

### Saudi Arabia

At a recent seminar hosted by the Riyadh Chamber of Commerce relating to the issue of fake pharmaceuticals, the CEO of the Saudi Arabian Food and Drug Authority announced new draft legislation that strengthens the penalties that can be awarded against those engaged in counterfeit drug trade. Of note is that, in addition to the existing penalty of imprisonment, the possible fine is proposed to be increased to SAR5million (approx. USD \$1.36M). He further called for closer co-operation between the Authority and private sector to fight counterfeit pharmaceuticals and noted that the proximity of Saudi Arabia to the free trade zones in the United Arab Emirates causes the country to be a target market for counterfeiters.

[Source: Al Riyadh Newspaper – 29 November 2012]

It remains to be seen how or when the proposed legislation will be implemented and if the Courts will start to issue higher penalties as a result.

## Sara Holder, Rouse & Co. International Ukraine

Yuridicheskaya Praktika, a Ukrainian legal newspaper, reports that the World Trade Organization (WTO) will consider the formal complaint Ukraine filed earlier this year against the Australian law that sets new requirements for the design of cigarette packs.

The law, expected to enter into force on 1 December, 2012 will make Australia the first country in the world to introduce plain cigarette packaging devoid of manufacturers' logos.

According to the law, cigarettes will be sold in standardized packets with brand names written in a uniform font. Health warnings and graphic images of diseases caused by smoking will cover at least 75 percent of the front of the pack and at least 90 percent of the back.

Ukraine is one of several countries that filed complaints against Australia arguing that the logo-free cigarette packaging undermines trade mark owners' rights.

## PETOSEVIC

### Hot off the press

**Chris McLeod**

*As we went to press, the Court of Justice of the European Union's judgment in Case C-457/10 P AstraZeneca AB and AstraZeneca plc v European Commission was issued, on 6 December 2012. This judgment is some 40 pages long so a full report will appear in the next issue of Law Lore & Practice. In the meantime, as readers may be aware, the judgment relates to LOSEC products and allegations of abuse of a dominant position with reference to third-party generic equivalents to LOSEC. This decision is effectively an unsuccessful appeal against a fine of €60 million imposed by the Commission in 2005.*

# European Union Case Notes

## Likelihood of confusion between ZEBINIX and ZEBEXIR

Gill Dennis and Chris McLeod, Squire Sanders (UK) LLP, London

In April 2008, Isdin, SA applied to register ZEBEXIR as a Community Trade Mark for goods in class 3, covering 'bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; (abrasive preparations) soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices' and in class 5 covering 'pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides'. Bial-Portela & Ca, SA opposed the application on the basis of Article 8(1)(b) of Regulation 40/94 (now 207/2009), relying on its Community Trade Mark registration of ZEBINIX dating from March 2005 and covering identical goods in classes 3 and 5.

### Apped

The Opposition Division rejected the opposition, finding no likelihood of confusion between the marks. The Office for the Harmonization of the Internal Market (OHIM)'s First Board of Appeal also dismissed the opposition, finding that, notwithstanding some common elements (in particular, the first syllable 'ze' and the first three letters), the visual and phonetic differences between the marks were sufficient to eliminate a likelihood of confusion, even for identical goods. Bial-Portela appealed to the General Court.

### General Court decision

The General Court upheld Bial-Portela's appeal and annulled the Board of Appeal's decision. It held that the Board of Appeal had been correct in finding that the respective goods were identical and that the relevant public, for the purposes of assessing likelihood of confusion, was composed of the average EU consumer, who was reasonably well informed and reasonably observant and circumspect. However, the Board of Appeal had erred in its findings on the similarity of the marks and the likelihood of confusion.

### Visual similarity

Assessing the visual similarity of the marks, the Court considered that consumers normally attach more importance to the first part of a word. It found that the visual differences between the marks created by the central and end parts 'inix' and 'exir' were not sufficient to cancel out the impression of similarity created by the common first part 'zeb'. Although those end groups of letters were different as regards the order of the vowels and consonants and the final letter, both groups of letters contained an 'i' and 'x'. Also, the common letter 'x', which was visually striking, reinforced the similarity created by the common first part of the two marks, even though it was not in the same position in each of the signs. Accordingly, when taken as a whole, the marks were visually similar to an average degree.

### Phonetic and conceptual similarity

Assessing the phonetic similarity of the marks, the Court found that both comprised three syllables, the first syllable being identical and the second syllables 'be' and 'bi' being close in sound. The Court found that the third syllables 'xir' and 'nix' had the common letters 'i' and 'x', the second of which had a clearly recognisable sound. Furthermore, the sounds 'eks' in ZEBEXIR and 'iks' in ZEBINIX were capable of attracting consumers' attention, and created a similar phonetic impression. Accordingly, the two marks had some degree of phonetic similarity.

On the question of conceptual similarity, the Court upheld the Board of Appeal's finding that neither mark had any meaning in the relevant languages and that conceptual comparison did not, therefore, influence the comparison of the marks.

### Likelihood of confusion

The Court went on to assess whether the Board of Appeal's errors in the findings on similarity had detrimentally influenced its decision on likelihood of confusion. The Court concluded that it had. It found that the marks had an average degree of similarity,

particularly visually. Further, the goods in class 3 and a large proportion of the goods in Class 5 (namely food for babies, materials for dressings, disinfectants, preparations for destroying vermin, fungicides and herbicides) designated by both marks were normally marketed on display in supermarkets and therefore chosen by consumers after a visual examination of their packaging. This meant that the visual similarity of the marks was especially important. The Court found, therefore, that there was a likelihood of confusion.

From an external perspective, the decision appears to be correct not only because the marks bear significant similarity but also because the respective goods are identical. The case is particularly interesting because of the importance the Court attached to the visual display of the marks on packaging of goods when assessing likelihood of confusion.

## SPIRIVA and ABIRIBA not confusingly similar for pharmaceuticals

Gill Dennis and Chris McLeod, Squire Sanders (UK) LLP, London

Boehringer Ingelheim Pharma GMBH & Co KG (B) was the proprietor of a Community Trade Mark registration of SPIRIVA, registered in June 1999 in Class 5 for pharmaceutical preparations. In March 2011, Johnson & Johnson (J) applied to register ABIRIBA in Class 5 for human pharmaceuticals. The application was published on 17 June 2011. B opposed on the basis of section 5(2)(b) of the Trade Marks Act 1994 which prevents a mark being registered where, because it is similar to a mark the subject of an earlier trade mark registration and is to be registered for identical or similar goods, there exists a likelihood of confusion on the part of the public.

### Proof of use

As B's mark had been registered for more than five years prior to the date of J's application, The Trade Marks (Proof of Use, etc) Regulations 2004 were applicable. These required B to prove that

it had put its mark to genuine use in the UK, in relation to the goods for which it had been registered, during the five years ending on the date of publication of J's application (18 June 2006 to 17 June 2011).

B filed evidence in the form of annual reports showing use of SPIRIVA in various EU countries since 2002 and evidencing total sales of more than £5.6 billion euros. The Hearing Officer was satisfied that this demonstrated genuine use of SPIRIVA in the UK during the relevant five year period. The evidence also showed that SPIRIVA was used for the treatment of Chronic Obstructive Pulmonary Disorder, an umbrella term for various respiratory diseases. The Hearing Officer found that the average consumer would describe SPIRIVA as designating 'pharmaceutical preparations all for use in the treatment of respiratory diseases' and that this was, therefore, the fair specification on the basis of which to consider the matter.

### Section 5(2)(b)

In assessing the likelihood of confusion, the Hearing Officer adopted the global

approach advocated by case law and applied the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods (and vice versa).

The average consumers were found to be medical professionals (with a high degree of attention when prescribing) and the public (with a reasonable degree of attention when purchasing) but the fact that marks are rarely recalled perfectly was taken into account. The Hearing Officer found that the marks shared a very low degree of visual similarity (because the most important aspect of each was the beginning and this was completely different), a low degree of aural similarity (pronounced SPY-REE-VA and ABBEY-REE-BER respectively) and were conceptually neutral. It was felt that B's mark, as an invented word, had a high level of inherent distinctive character, which had been further enhanced by the extensive use made of it. The Hearing Officer also found B and J's goods to be identical (as 'pharmaceutical preparations all for use in the treatment of respiratory diseases' were included within the broader 'human pharmaceuticals' category).

### Decision

The Hearing Officer found that the average consumer tended to regard the beginning of a word as most important. In this case, the first two letters of SPIRIVA and ABIRIBA were different, as were the endings. The words were only seven letters long in total. In the Hearing Officer's view the similarities between the marks were 'more than offset' by the differences. Taking all of the above into account, and considering the marks as a whole, the Hearing Officer had 'no difficulty in concluding' that there was no likelihood of confusion between the marks. B's opposition failed despite its mark being deemed to have acquired enhanced distinctiveness.

From an external perspective, this decision appears to be correct because the marks do not appear to bear great similarity. However, it may be that there was a commercial reason behind the opposition. Interestingly, in 2010 Johnson & Johnson registered the same mark as a CTM for the same goods with no opposition by Boehringer Ingelheim. As an item of trivia, Abiriba is also a town in south eastern Nigeria.

## Enforcement of trade marks with Reputation (BOTOX)

Margret Knitter LL.M., SKW Schwarz, Germany

The Court of Justice of the European Union had to deal with the reputation of the trade mark BOTOX in two connected cases in May this year (Judgement of 10 May 2012, Ref. C-100/11). The companies Helena Rubinstein and L'Oréal had applied for the designations BOTOLIST and BOTOCYL, respectively, to be registered as EU trade marks in 2002. The Office for Harmonization in the Internal Market (OHIM) had registered the marks for goods of Class 3, in particular 'cosmetics'. The U.S. company Allergan is the proprietor of a number of BOTOX trade marks, which are registered, among other goods, for 'pharmaceutical preparations for the treatment of wrinkles'. In 2005, Allergan applied for a declaration that the registration of the disputed marks BOTOLIST and BOTOCYL was invalid.

The First Board of Appeal of OHIM as well as the General Court of the European Union found that – at least for the UK – BOTOX had a reputation. Both instances observed that the common syllable 'BOT-', respectively 'BOTO-' does not refer to the botulinum toxin, the active ingredient of the pharmaceutical product sold by Allergan and thus is not descriptive. Further, it was held that there is no likelihood of confusion between the disputed marks and the earlier mark

BOTOX, but the public would establish a connection between those marks. Also, the younger trade marks take advantage of the distinctive character and repute acquired by BOTOX. The trade marks were annulled.

Now the Court of Justice has confirmed this opinion, giving the following clarification:

The evidence for the reputation of a trade mark in only one Member State (here the UK) is a sufficient ground for refusal of registration.

Basically, only such pieces of evidence can be taken into account which are presented in the language of the proceedings, or which are accompanied by a translation into this language, which Allergan failed to do in the present case. Still, the Court of Justice admitted the documents since it had been possible for Helena Rubinstein and L'Oréal to contest the legal relevance of the foreign-language documents, and they had therefore obviously understood their meaning.

There does not need to be an actual danger of confusion with the younger trade mark. Instead it is sufficient that the public establishes a link between the marks and makes an association between

the two signs at issue (Art. 8(5) Community Trade Mark Regulation).

The proprietor of the earlier trade mark is not obliged to provide any evidence for the existence of an actual and present detriment to its trade mark. In fact, it is sufficient to specify aspects from which it can be concluded that there is a danger that the trade mark may be taken advantage of or suffer detriment in the future, and that this danger is not only a hypothetical one.

### Comments

The costs of proving the reputation of a trade mark can be considerable, taking into account the public surveys which usually need to be conducted. However, the evidence can at least be restricted to one country.

Even if the Court of Justice has in this case considered evidence which was not filed in the language of the proceedings to be admissible, this exception should not be relied upon. Evidence – at least the relevant passages – should be translated into the language of proceedings, otherwise the risk is that it will not be considered.

# Copyright (Amendment) Act 2012 in Malaysia

Cheah Chiew Lan, Tay & Partners

The Malaysian Copyright Act 1987 (Act) was recently amended by the Copyright (Amendment) Act 2012 to, inter alia, facilitate Malaysia in fulfilling the requirements for accession to the WIPO Copyright Treaty (WCT) and WIPO Phonograms and Performances Treaty (WPPT). The amendments came into force on 1 March 2012.

This update will provide a summary of some of the amendments provided by the Copyright (Amendment) Act 2012.

A Voluntary Notification of Copyright System has been introduced. The Voluntary Notification mechanism is governed by the Copyright (Voluntary Notification) Regulations 2012 which was gazetted on 28 May 2012 and came into force on 1 June 2012.

An applicant who is the author of the work eligible for copyright in Malaysia, the copyright proprietor, assignee of the copyright or a licensee of an interest in the copyright who is a Malaysian citizen or a permanent resident of Malaysia, may file the Voluntary Notification by himself. If he is not a Malaysian citizen or a permanent resident of Malaysia, he may appoint a representative who is a Malaysian citizen or a permanent resident of Malaysia to file the Voluntary Notification on his behalf.

If the Copyright Office is satisfied that the notification filed is in order, the particulars stated therein shall be entered into the Register of Copyright and a letter confirming the same will be sent to the applicant.

A certified true extract from the Register of Copyright is recognised as prima facie evidence of the particulars entered therein and shall be admissible in all courts.

## **Provision of compulsory registration of licensing bodies for copyright owners.**

A society or an organisation which intends to operate as a licensing body for copyright owners or for a specified class of copyright owners is required to register itself with the Copyright Office as a 'Licensing Body'. The Copyright (Licensing Body) Regulations 2012 were gazetted on 28 May 2012 and came into force on 1 June 2012 to govern the provision of compulsory registration of licensing

bodies.

Any society or organization operating as a Licensing Body prior to 1 March 2012 shall continue to operate as a Licensing Body provided that such society or organisation is registered with the Copyright Office within 3 months from the effective date of the amendment. Otherwise, it will be liable upon conviction for a fine not exceeding RM500,000.00.

A licensing body registered with the Copyright Office shall submit a copy of its profit and loss account, balance sheet and auditor's report tabled at the annual general meeting to the Copyright Office within 1 month from the date of the annual general meeting. Failing which, it will be liable upon conviction for a fine not exceeding RM500,000.00.

The definition of performer has been amended to include an actor, singer, musician, dancer or any person who acts, sings, delivers, declaims, plays in, interprets, or otherwise performs a performance.

Additional provisions are added to provide an avenue for a performer to apply to the Copyright Tribunal to determine equitable remuneration to a performer in the absence of a contract or to vary any such contract.

In view of technological developments, a more elaborate provision for circumvention of technological protection measure and right management information has been inserted to the Act.

## **Additional relief is introduced.**

In addition to the relief of, an order for injunction; damages; an account for profits and any other order as the court deems fit, available to the copyright owner, the Court may grant statutory damages of not more than RM25,000.00 for each work but not more than RM500,000.00 in total.

## **New Offences**

It is now an offence under the Act to operate an audiovisual recording device in a screening room to record any film in whole or in part. Upon conviction, it is liable to a fine of not less than RM10,000.00 and not more than RM100,000.00 or to imprisonment for a term not

exceeding 5 years or to both. It is also an offence to attempt to do the foregoing and upon conviction, it is liable to a fine of not less than RM5,000.00 and not more than RM50,000.00 or to imprisonment for a term not exceeding 1 year or to both.

## **Limitation and exemption on the liability of service providers.**

Generally, a service provider shall not be held liable for copyright infringement for merely providing connection, transmission or routing through its primary network.

A service provider shall also not be liable for copyright infringement due to system caching, storing electronic copy of the work at the direction of the user or referring/linking a user through information location tools such as a hyperlink or directory.

## **Additional power granted to the enforcement officers.**

The enforcement officers are granted additional power to access computerised or digitalised data and to intercept communications under the Act.

## **Admissibility of evidence of agent provocateur.**

It is provided that notwithstanding any written law or rule of law to the contrary, no agent provocateur is presumed to be unworthy of credit just because he attempted to abet or abetted the commission of an offence by any person if such act was for the sole purpose of securing evidence against such person.

It is also provided that any oral or written statement made to the agent provocateur by any person subsequently charged with an offence under the Act shall be admissible as evidence.

## **Conclusion**

The Copyright (Amendment) Act 2012 has brought about several important aspects in protecting copyright in Malaysia. As the amendments have just come into force, the effect and enforcements of the provisions will need to be seen in time to come.

# PTMG 85th Conference Report

Barcelona, 3rd to 6th October 2012

*Realities for pharmaceutical trade marks in the physical and virtual world*

**Bill Ladas, Corrs, Chambers, Westgarth**

The 85th PTMG Conference in Barcelona continued the trend of each meeting being better than the last.

The inspired choice of host city, Barcelona, must take some credit for the exciting and fun-filled atmosphere. But the organizers and attendees also played their vital roles, making this a PTMG that will be long remembered. Furthermore, the presentations were consistently excellent and raised issues many may have not considered previously.

The conference was also memorable for the number of “firsts” that it had in store.

## Thursday 4 October 2012

Sue Evans gave an inspiring introduction, letting us all know that she was stepping



down as chairman of PTMG, and that she could not “begin to tell you how good it feels”. The handover to Sophie Bodet of GSK gave us the first of the “firsts”, being Sophie’s first speech. This was much like handing over the Olympic torch. Sophie gave Sue a glowing thank you and set about letting the crowd know how excited she was about the challenges ahead. Sophie mentioned that the conference was over-subscribed, but noted that the intention was never to make the conference bigger than it already is. Quite rightly, Sophie also mentioned the importance of having attendees from the industry at PTMG.



Guilherme Cintra (IFPMA) then got the conference “proper” underway with his talk on “Biopharmaceutical Innovation Today Treading New Ground.” Guilherme discussed the bleak outlook being touted against the actual reality and queried

whether the glass is really half empty or half full, and whether we should all start looking for new jobs! He has charted the evolution of pharmaceutical companies into project managers and on the positive side advised that investors are still seeing value in the pharmaceutical industry.



The second talk of the day was from Salvador Ferrandis entitled “Pharmaceutical Trade Marks in Spain – What’s New?” Starting with the fact that nothing revolutionary had occurred in Spanish law that year, Salvador then discussed the issues with the Spanish government trying to push down pharmaceutical prices, urging the attendees not to let their children become pharmacists under any circumstances!

The next speech was another first. The talk by Justice Farrukh Khan, of the Lahore High Court was entitled “Interface between Politics and the Law – How far can the Judiciary go?” and was delivered entirely by video. Notwithstanding that Farrukh Khan wasn’t with us that day, the presentation was thought provoking in the extreme and the audience was transfixed by the man on the screen!

We were left with the sage advice: “politics and law are like train tracks – they must co-exist in parallel”.

Up next we had yet another first, namely the first “Founder’s Lecture”, presented by Isabelle Dini of Norgine. The Founder’s lecture will be delivered annually at the Autumn Conference by a person selected by the Management Committee. Isabelle’s talk provided a whirlwind tour through the use of the ® and TM symbols throughout the world, highlighting traps for new (and probably not so new) players. Isabelle’s excellent talk (and visual aids) ended with a personal note of thanks from the charming and witty nonagenarian the Honorary President of PTMG, Mr Derek Rossitter. Mr Rossitter gave Isabelle the effusive praise that her talk deserved, and Derek noted that the next generation of professionals such as Isabelle would comprise the future leadership, and ensure



the continuing viability of PTMG. The standing ovation that followed was an inspiring and emotional tribute to Derek, and this attendee will certainly never forget Derek hoisting his cane high into the air while the crowd cheered him on.

The final session for a jam-packed Thursday was a group session on the topic “Product trade dress and non-traditional trade marks”. Jo Grist of GSK provided a polished performance, giving the industry perspective, with particular reference to the purple colour combination mark used in relation to GSK’s ADVAIR products. Jo discussed that case, and the fact that the value of non-traditional marks is (still) underestimated. Jo also discussed the important practical



issue, namely obtaining evidence of acquired distinctiveness from end users and how difficult that can be, particularly where those users cannot be accessed. This required some creative thinking in terms of evidencing secondary meaning, though ultimately the registration was expunged.

The next talk was from Grant Lynds of Gowlings. Grant’s engineering background provided us with his memorable metaphor about digging into the earth when it is “too dark to see and too far to feel”. Grant noted this was a little like the courts when they consider trade dress cases. Canadian law had provided a high threshold for non-traditional marks, and it seemed as though the actual source needed to be known by the relevant consumers, rather than the fact that the mark itself indicated (an albeit anonymous) single source.

Laetitia Benard of Allen & Overy then provided an update from France on non-

traditional marks and particularly the use of trade dress by generics. Laetitia discussed various aspects of the Directive, including in relation to comparative advertising cases, and also looked at specific provisions of French law, particularly Article 42 of the French law on Sanitary Safety. The concerns caused by that far-reaching provision of French law, expressed by the International Trade Mark Association (INTA) in a letter to the EU Commission in June 2012, were also discussed.

The final speaker for Thursday, Mr James Weinberger of Fross Zelnick had the unenviable task of talking to a crowd that sensed that the cava was already flowing pool-side. James dealt with that issue with aplomb, and soon had the crowd entranced by his talk on the development of the US law on trade dress. James focused on “look-alike brand v generic pill” cases, and particularly at the decision of the US Court of Appeals in *Shire v Barr*. While that case failed (*Shire* did not show that its product configuration was “non-functional”), the decision was a creature of its own unique facts, and James finished up by pointing to some light at the end of the tunnel, referring to the recent decision of the 2nd Circuit in *Christian Louboutin v YSL* (relating to the Red Sole trade mark of Louboutin), that re-affirmed the protectability of colour trade marks.

## Friday 5 October 2012

Friday’s first three talks related to the “now” topic of social media. Mark Bard’s (Digital Health Coalition) presented some incredible and terrifying statistics as to the



number of users on Facebook and Twitter. Examples of successful and not-so-successful social media forays by pharma were given, including how to deal with user-generated content (UGC).

Timothy Pinto (Taylor Wessing) was then



passed the social media baton to discuss the legal risks presented, and looked at UGC further, including themes of “control” and “knowing involvement”. Of

particular practical assistance were the examples given as to dealing with letters of demand.



Paul Woods (Paul Woods Compliance Limited) was the third and final runner in the social media stakes, and looked at the codes and regulations relating to advertising of pharma goods. His key message was that companies must comply with the law on the one hand, but on the other hand must also act ethically to build trust with their consumers.

Mark, Tim and Pauls’ talks left us wondering what will happen next in this evolving field.

Christian Rassman (Lorenz Seidler Gossel)



then took us on a stroll through the law on ambush marketing, with the assistance of various thoroughly entertaining video advertisements featuring the world’s best footballers. This provided the same kick (if you’ll excuse the pun) as a strong coffee that many of the attendees may have needed after the events of the previous evening at the Cordorniu winery. Christian’s analogy of keeping others out of your wine cellar was particularly memorable.



Stephen Reid of Imperial Tobacco was up next. He had the limited benefit of having received the Australian High Court’s decision on plain packaging at 5am that morning. Lucky then that it was only 139 pages long Stephen discussed the issues posed for tobacco and the other legal avenues that were being pursued and provided an excellent summary. The

regulatory trends and how this would play out for other industries, including alcohol, pharma and fatty foods were also discussed.

The transition from tobacco to healthy foods may have raised some eyebrows in



the hall but the talk from Antoine de Brosses of Keller & Hickman entitled “Consumer wellness – functional foods and health claims” was another first for PTMG. Indeed, as a regulatory lawyer, Antoine said he felt like an “alien” compared to other attendees but he certainly achieved the aim of raising awareness amongst members on this vital topic for the future of the industry and its borderline competitors. He berated attendees with the watch words that the competition is already ahead of the game in the area of functional foods.

To conclude the conference, Nick Wood from Valideus provided another key update



on gTLDs. For those attendees still resisting the temptation of the pool, Nick advised that the next stage of this saga will take place early in 2013 with the auction of contested strings, to be organised by ICANN. Subsequently, an independent objector is to police the results by June 2013. News of the dollars raised by the whole process as venture capitalists seize another opportunity brought many shaking heads, especially among the sceptics, but there is no doubt that the statistics provided by Nick mean that the future for pharma companies will include these new virtual addresses.

With that, the conference ended and Sophie could rest assured that her first conference as Chair had achieved the same high standards as previous ones. Richard Gilbey’s now traditional toast to the Chair brought the official part of the conference to a close. At the gala dinner that night, at the extraordinarily beautiful Castell de Sant Marçal before things really took off on the dance floor, the attendees fell silent waiting for the venue of the 2013 PTMG meeting: Vienna! See you all there.

# Comparative Advertising for generics in Germany and France after *L'Oréal v Bellure*

Laëtitia Bénard-Allen & Overy, Oscar Benito-GSK, Rainer Kaase and Ralf Möller-Harmsen & Utescher

## Introduction

In *L'Oréal v Bellure*, the Court of Justice of the European Union (CJEU) held that riding on the coat-tails of a trademark with a reputation, in order to benefit from its power of attraction, its reputation and its prestige, and to exploit the marketing effort expended by the proprietor of that mark, is unfair within the meaning of Art. 5(2) of First Council Directive 89/104/ECC (the TM Directive).

The CJEU clarified that there can be an unfair advantage without the need to show any detriment to the distinctive character or repute of the registered mark, although these two elements may be taken into account in the global assessment that a court must carry out when determining unfair advantage.

In order to determine whether the use of a sign takes unfair advantage of the distinctive character or repute of the mark, the CJEU indicated that it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation, the degree of the mark's distinctive character, the degree of similarity between the marks at issue, and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of the mark's distinctive character, the Court has already held that it would be easier to accept that a mark having a strong distinctive character and reputation has suffered a detriment that would be the case with a mark having a less strong distinctive character and reputation. It is also clear from the case-law that, the more immediately and forcefully that the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or repute of the mark or is, or will be, detrimental to them.

All the trade mark owner needs to show is that the defendant has obtained a commercial advantage from the reputation of his mark by establishing a link with that well-known mark through use of an identical or similar sign.

Furthermore, the CJEU held that the concept of unfair advantage of Art. 5(2) of the TM Directive and Art. 3(a)(1) of the Directive 84/450/EEC (the Comparative Advertising Directive) must in principle have the same interpretation.

Consequently, the owner of a trademark can prevent the use of its mark in comparative advertising if the advertisement does not satisfy all of the conditions laid down in Art. 3(a)(1) of the

## Comparative Advertising Directive

In relation to Art.3(a)(1)(h): comparative advertising must not present goods or services as imitations or replicas of goods or services, the CJEU clarified that (i) this provision does not require the goods to be counterfeited, (ii) the advert does not have to be misleading for it to be prohibited, (iii) the imitation could be implicit or explicit, and (iv) that the imitation could be for the product as a whole or in part. The CJEU further added that any advantage gained by the advertiser by presenting goods or services as imitations or replicas would be regarded as taking unfair advantage of the reputation of that mark in breach of Art.3(a)(1)(g): comparative advertising must not take unfair advantage of the reputation of a trade mark.

This article focuses on the different approaches recently adopted by the French and German courts in relation to pharmaceuticals.

## Germany

In a recent decision dealing with the comparative advertising of pharmaceuticals, the Hamburg Higher Regional Court applied the CJEU principles outlined above in case No. 3 U 17/11. The case concerned an advertisement of a generic manufacturer aimed solely at healthcare professionals. In the contested advertisement the trade mark PROGRAF®, owned by the originator of a formerly patented pharmaceutical product with the active ingredient Tacrolimus, had been integrated into the logo of a generic manufacturer offering a generic containing the same active ingredient Tacrolimus through use of the following "Bioequivalent to PROGRAF®" tagline:



This logo was used as a prominent heading displayed on each page of the multi-page advertisement.

The court held that the use of the trade mark PROGRAF® took unfair advantage of the reputation of this trade mark in the particular context of the comparative advertising rules, corresponding to Art. 3 a (1) g of the Directive 84/450/EEC. The question whether the advertisement could also be seen as presenting imitations or replicas of the original product was not raised in this case.

The reputation of the trade mark

PROGRAF® was derived from the fact that PROGRAF® was originally a patented product and had been the only Tacrolimus preparation on the market for many years. This reputation was, according to the court, exploited by the challenged advertisement by way of an unjustified image transfer. Given the fact that the generic manufacturer referred to the bioequivalence to PROGRAF®, and thus pointed out the possibility of substitution, it was held that the addressed professionals would transfer the reputation attributed to the trade mark PROGRAF® to the generic product.

Taking into account the aims and purposes of Directive 97/55/EC and Directive 84/450 EEC as well as the findings of the CJEU in *L'Oréal v Bellure*, the court held that the question of whether the use of a third party trade mark in a comparative advertisement constitutes an unfair exploitation of the reputation of that mark depends on the specific circumstances of the case but that, in particular, the interest of the trade mark owner in a modest use of its trade mark has to be weighed against both the interest of the competitor in carrying out effective advertising and the aim of the Directive 84/450/EEC, namely to enhance market transparency for the benefit of the consumers. By comparison to the Higher Regional Court of Duesseldorf, which held in case No. I-20 U 126/10 that the reference to a third party trade mark is only allowed in cases in which this reference is absolutely necessary for an effective comparative advertisement, the approach of the Hamburg court is much more flexible.

According to the Hamburg court, the tagline "Bioequivalent to PROGRAF®" as a recurring reference in connection with the generic manufacturer's logo impeded the trade mark rights of the originator to an extent that was not justified by the above-mentioned legitimate interests of competitors and consumers. The court held that more cautious kinds of use of the trade mark seemed to be available and which would have sufficed to reasonably serve the interests of both the generic manufacturer and consumers in ensuring effective comparative advertising. The court emphasized that the generic manufacturer is well-known to the addressed professionals, meaning that those professionals would deduce from the name of the generic company and the reference to the agent Tacrolimus that the advertised pharmaceutical is a generic product of the Tacrolimus preparation of the originator.

*Continued on next page*

What can be learnt from this decision? The owner of a trade mark is not obliged to accept the use of its trade mark simply because it is used in a comparative advertisement. In fact, the competitor using a third party trade mark in a comparative advertisement must do so in a modest way, carefully observing the conditions laid out in Directive 84/450/EEC and taking into account the interpretation of the CJEU in *L'Oréal v Bellure*.

## France

In France, the questions raised by comparative advertising for pharmaceutical products have been examined in the Deroxat "saga".

In 2003, GlaxoSmithKline and Beecham group filed a trade mark infringement action against the generic company GGAM (later acquired by Sandoz) for having used the trade mark of the reference anti-depressant product Deroxat in an advertisement for its generic product Paroxetine GGAM aimed solely at healthcare professionals.



In 2006, the Paris Court of Appeal held that the mere mention of Deroxat in the advertisement for the generic product Paroxetine GGAM did not qualify as comparative advertising under Article 3 of Directive 84/450, because no objective comparison between the original product and the generic product was made. Furthermore, it considered that the reproduction of the original product's trademark was not "necessary to indicate the intended purpose" of the generic product under Article 6(c) of the TM Directive, because the mention of the international non-proprietary name (INN) on the packaging was sufficient to inform professionals that the generic product could be substituted for the original product. Consequently, it concluded that Sandoz was liable for trade mark infringement.

In 2008, the French Supreme Court quashed the Paris Court of Appeal judgment and returned the case to the Versailles Court of Appeal. According to the Supreme Court, by presenting Paroxetine GGAM as the generic of Deroxat, the advertisement "objectively compares material, relevant, verifiable and representative features of those goods". As a result, it fell within the definition of

comparative advertising.

The Versailles Court of Appeal had to then rule on whether, in the circumstances of that case, such comparative advertising fell under Articles 3(a)(1)(g) and (h) of the Comparative Advertising Directive, in other words, whether the advertising took unfair advantage of the reputation of the trade mark Deroxat or presented the generic product Paroxetine GGAM as an imitation or replica of Deroxat.

The court held that the conditions set by Articles 3(a)(1)(g) and (h) of the Directive were met. However, it considered that the contentious advertisement could not benefit from the comparative advertising defense because the conditions of Article 6(c) of the TM Directive were not met. In this respect, it further held that the reproduction of the trade mark Deroxat was not necessary to indicate the intended purpose of Paroxetine GGAM, because this was not the only means by which professionals could be informed that it was the generic of Deroxat (CJEU, *Gillette*, C-228/03). The court concluded that the conditions of Article 6(c) of the TM Directive must therefore be satisfied on a cumulative basis for the advertisement to be exempted from trade mark infringement.

This last finding was quashed by the French Supreme Court on 24 May 2011. Making reference to the O2 judgment of the CJEU (12 June 2008, C-533/06), where it was held that the "proprietor of a registered trade mark is not entitled to prevent the use by a third party of [...] his mark in a comparative advertisement which satisfies all of the conditions laid down in Article 3a(1) of Directive 84/450", the French Supreme Court concluded that there was no trade mark infringement where the conditions provided by the Comparative Advertising Directive, as implemented under French law, were satisfied.

In relation to the rest of the decision, the French Supreme Court confirmed the findings of the Versailles Court of Appeal that the conditions provided by Articles 3(a)(1)(g) and (h) of the Directive were met. In particular, it held that generic products are, by nature, presented as bioequivalent to original products, but not as imitations and that providing information to professionals about the possibility of substituting the generic product for the original product was not taking unfair advantage of the original product trade mark but, rather, enabled the existence of effective competition in the market.

This decision, which seems to have been influenced by matters of public policy, has been subject to criticism for not taking into account all of the holdings set out in *L'Oréal v Bellure*.

Indeed, the fact that a generic product is bioequivalent to the original product does

not exclude the fact that it could be an imitation or replica within the meaning of Art.3a(1)(h). In this respect, the CJEU ruled in *L'Oréal v Bellure* that "it is irrelevant in that regard whether the advertisement indicates that it relates to an imitation of the product bearing a protected mark as a whole or merely the imitation of an essential characteristic of that product". Thus, the decision of the French Supreme Court does not seem to concord with the findings of the CJEU.

In addition, it cannot seemingly be disputed that, in the present case, the reference to the DEROXAT trade mark can have no purpose other than to introduce the generic product in the wake of the original product, in order to immediately benefit from the reputation of the trademark under which the original product is marketed. The French Supreme Court decision thus seems to be totally at odds with the findings of the CJEU in *L'Oréal v Bellure*, with that Court clearly holding that "the taking of unfair advantage of the distinctive character or the reputation of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the reputation of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image".

## Conclusion

One may wonder whether the impact of the Deroxat precedent should be limited to the specific circumstances of that case. In particular, the courts took into account the fact that the reference to DEROXAT was in brackets and in smaller characters than the rest of the advertisement, that it was not reproduced on the packaging of the generic product which illustrated the advertisement, and that the advertisement was aimed at professionals. However, these are circumstances that are not dissimilar from those that were present in the *PROGRAF®* case, where the reproduction of the original product's trade mark in the advertisement for the generic product was held to take unfair advantage of its reputation. In such a case, comparative advertising is not permitted under Articles 3a(1)(g) of the Comparative Advertising Directive.

These points might merit further clarification from the CJEU.

# Australia Case Notes: Principles for Office objections to trade marks containing INN stems

Carly Mansell, Davies Collison Cave

*Boehringer Ingelheim International GmbH [2012] ATMO 117 (30 November 2012)*

## Decision

A recent decision of the Australian Trade Marks Office will be welcomed by pharmaceutical companies seeking to register trade marks containing an INN stem.

The decision indicates the Office may be willing to take a more flexible and practical approach, considering all the relevant circumstances, when considering whether a trade mark containing an INN stem is likely to deceive or cause confusion or carry a connotation.

## What is the basis for objection to trade marks containing INN stems?

A trade mark application will receive an objection if, because of some connotation of or within the trade mark, the use of the trade mark in relation to the applied for goods or services would be likely to deceive or cause confusion (section 43 of the Trade Marks Act 1995 (Cth)).

The recent practice of the Office has been to automatically raise an objection under section 43 where a trade mark to be used in relation to pharmaceuticals, veterinary substances or pesticides contains an INN stem "in a meaningful way", and the goods covered by the specification are not restricted to substances indicated by the INN stem.

Consideration of whether the stem is incorporated "in a meaningful way" has led to inconsistency, since many marks fall in the grey area between non-meaningful (eg. the stem –AST in FAST) and meaningful (eg. the stem –GLIFLOZEN in AGLIFLOZEN). Many examiners have been reluctant to withdraw objections even when faced with evidence that confusion or deception is not likely to arise, for instance due to market or state of the Register evidence.

## *Boehringer's application for ZELCIVOL:*

Boehringer Ingelheim International GmbH (Boehringer) requested protection in Australia of an International Registration Designating Australia (IRDA) for the

trade mark ZELCIVOL for pharmaceutical preparations in class 5.

The application received a section 43 objection on the basis that the mark contained the suffix –OL which is an INN stem said by the Examiner to indicate ALCOHOL or PHENOL derivatives. If the mark was not to be used for goods or services containing or relating to these substances, the Examiner considered the mark would be likely to deceive or confuse consumers. The objection would, however, be overcome by agreeing to the following endorsement on the registration:

"It is a condition of registration that any use in respect of pharmaceuticals will be limited to such goods containing substances belonging to the pharmacological group designated by the International Non-Proprietary Name stem OL".

Trade mark registrations in Australia can be cancelled on the ground that such a condition entered in the Register in relation to the trade mark has been contravened. Arguably, such a condition could also expose the registration to the risk of partial removal for non-use in time.

The applicant requested a hearing.

## Relevant principles when considering INN stems:

The Hearing Officer found that the use of the INN stem was unlikely to deceive or cause confusion and accepted the IRDA for protection in Australia.

Taking a sensible and pragmatic approach, he outlined the following general principles such that where most of the following factors are present a section 43 objection should not be raised on the basis of an INN stem contained within a mark:

The suffix is in common use other than as an INN stem, as evidenced by both the state of the Register and the marketplace.

The INN stem is 2 or 3 letters long.

There are other or alternative obvious suffixes present in the trade mark.

The INN stem is non-specific – in the context of the trade mark, the stem would not generally be apprehended as

indicating only a particular kind of pharmaceutical.

The Hearing Officer also took note of the fact that a number of other comparable countries had extended protection to the IRDA without raising objection or requiring the restriction. He also noted that other government bodies are better placed to assess deception in the marketplace and, consequently, an objection under section 43 will only exist where there is a real tangible danger of deception or confusion arising.

## Impact for pharmaceutical companies

The Trade Marks Office is currently conducting a review of its practice with regard to trade marks containing INN stems, with an outcome expected in early 2013. This decision may provide an early indication of a shift in the practice, suggesting a more sensible and flexible approach may be taken with respect to future applications.

This decision should be welcomed by pharmaceutical companies, seeking to clear global product names in Australia. Pharmaceutical companies should review their pending applications facing class 5 objections to determine whether further submissions might now overcome the objection in light of this recent decision.

**86th  
PTMG  
Conference**

**Hamburg**

**18th - 19th March  
2013**

**Registration will open on  
PTMG website in mid  
January 2013**

# PROFILE: Alan Hunter

Alan is the editor of several books on the legal classification of medicines for Royal Pharmaceutical Society of Great Britain (RPSGB) law department and acted as undercover agent for RPSGB Inspectorate. He has worked as Regulatory Controller for the Wellcome Foundation, advising on legal and Code of Practice issues. Alan was Board Secretary and Director of Law, IP and Regulatory at the Association of the British Pharmaceutical Industry (ABPI), serving on government and international committees representing the pharmaceutical industry. He is past chairman of The Organisation for Professionals in Regulatory Affairs (TOPRA) and holds fellowships of TOPRA, RPSGB and the Royal Society of Medicine. Current activities include serving on the PTMG Management Committee, TOPRA Fellowship Panel, Editorial Board of the Journal of Pharmaceutical Medicine and the Pharmacy Advisory Group, Kingston University.



## **Where were you brought up and educated?**

Raised and educated in Twickenham – Trafalgar School and Hampton Grammar. On to The School of Pharmacy, University of London for my B Pharm and UL again as an external student for my LLB. (I also have an NVQ in Spectator safety for my volunteer stewarding role!)

## **How did you become involved in trade marks?**

Whilst working at the Wellcome Foundation where I was Regulatory Controller. I joined a team working with Geoff Foot engaged in litigation with the UK government concerning the supply of a parallel imported product and whether it complied with the Medicines Act in respect of the nature and quality documented (known as the Septrin/ Eusaprim case). We won in the court of first instance but lost in the Court of Appeal and in the House of Lords. We all enjoyed our trip to the House of Lords which started with a typical Geoff Foot breakfast of a bacon buttie in a Greasy Spoon café!

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

I would have loved to have been a TV sports commentator.

## **Which three words would you use to describe yourself?**

Not too serious!

## **Complete the following sentence. If I have time to myself ...**

I like to read poetry (particularly Roger McGough) and sometimes try to write it.

## **Complete the sentence: I'm no good at ...**

DIY

## **What is your biggest regret?**

Failing my mid session exams at University and missing the chance to represent GB in rowing at the Mexico Olympics.

## **What is your favourite work of art?**

The Persistence of Memory by Salvador Dali.

## **What is the soundtrack to your life?**

Street Fighting Man – The Rolling Stones

## **What is your philosophy in a nutshell?**

"In every job that's to be done there is an element of fun" just like Mary Poppins

## **What is your weakness?**

Chocolate!

## **Which book or books are you currently reading?**

By my bedside a thriller "Blood Line" Felix Francis, an autobiography

"Beware of the Dog" Brian Moore, a poetry book "The Anthology of Birds"

## **What music is in the CD player in your car / what is your iPod set to at the moment?**

The Rolling Stones (always!)

## **What is your favourite food dish?**

My wife's Lobster & champagne risotto.

## **What is comfort eating for you?**

Fish & Chips and Blackcurrant crumble

## **Which is your favourite restaurant?**

The Glasshouse Kew

## **What is your favourite drink?**

Champagne, preferably Louis Roederer Cristal (or real ale in a pub).

## **What is your favourite holiday destination?**

The Galapagos Islands – like walking into another world where time has stood still and the animals have no fear of man.

## **Do you have any unfulfilled ambitions?**

To visit India and see tigers in the wild, to see all of Shakespeare's plays (still 7 to go!)