

# Law Lore & Practice

PTMG



Pharmaceutical  
Trade Marks Group

Sept 2013



## Editorial: "To Autumn"

For those of us in northern Europe who enjoyed the hottest summer for a decade, returning to school was accompanied by a rapid drop in temperature. Jumpers, even raincoats were dug out of the chest of drawers in a panic, sandals packed away and a general air of "well, that's that then" has befallen parents and children alike.

With September come blackberry and apple pie, scrumping for apples and hazel nuts, jam and chutney making and the occasional sharp fresh mornings which serve to heighten our senses and make us look out for leaves on the turn. For children, this month also rhymes with bags laden with homework, an unwelcome return to routine and for secondary students English literature lessons where John Keats' romantic poetry features heavily. The mere mention of "season of mists and mellow

fruitfulness" catapults me back more years than I care to count!

European mobility week, now in its 12th consecutive year, also takes place this month and aims to remind us that there can and are alternative ways to get around. Several initiatives including car pooling and alternative cycle routes underscore this year's theme "clean air, it's your move" and challenge our dependence on the motor car. This is particularly timely as most of us return to the never ending race to deliver our children to their after school activities, with scant thought for the impact on their future planet.

Challenging our perceptions and broadening our horizons, two themes dear to PTMG as I'm sure those of you who are enrolled to attend the 87th conference in Vienna will soon find out.

I look forward to meeting you there.

**Vanessa**

## US Law Update

**James Thomas, Thomas Trademarks and Copyright Legal Services, USA**

The U.S. Trademark Trial and Appeal Board (TTAB) recently addressed the argument that marks of prescription pharmaceuticals are less likely to be confused because they are dispensed by pharmacists. Citing previous cases of US federal courts, the TTAB noted that courts have taken note of the fact that prescription products are increasingly marketed directly to potential patients. Therefore, although the TTAB acknowledged that such goods may be distributed in an "environment in which an above-normal degree of care will presumably be exercised," it would not negate likelihood of confusion. *Mylan, Inc. v Beaufort County Allergy*, 2013 TTAB LEXIS 315 (19 June 2013) (non-precedential).

Another recent decision of the TTAB demonstrates that the description of the goods can be critical. The applicant had filed applications to register DX BIOSCIENCES and DX BIOSOLVE respectively for "chemical preparations for medical and veterinary purposes for solubilizing tissue for cosmetic purposes." The Examining Attorney had rejected

both applications based in part on the assertion that "DX" was merely descriptive, which the Examining Attorney found merely referred to "diagnosis," a step in which was solubilizing tissue. Appealing this refusal, the applicant argued that although DX stood for "diagnosis" and although it was in the business of diagnosis-related products, the goods in these two applications were expressly limited to solubilizing tissue "for cosmetic purposes" and not for diagnosis purposes. The TTAB reluctantly agreed, finding that it could only reach a decision based on the language of the description of goods in the applications. In re *Dx Biosciences, Inc.*, 2013 TTAB LEXIS 289 (6 June 2013) (non-precedential).

Furthermore, a trio of TTAB decisions involving pharmaceutical goods demonstrates that an applicant cannot avoid its own marketing hype. In each decision, the TTAB overcame the applicant's assertions that its mark was not merely descriptive by referring to the applicant's own statements on its website and in its marketing materials. In re *Caldera Pharmaceuticals, Inc.*, 2013 TTAB

LEXIS 225 (3 May 2013) (finding applicant's own marketing materials demonstrated that the term "MOLECULAR X-RAY FLUORESCENCE" retained its descriptive qualities for the product) (non-precedential); In re *Taro Pharmaceuticals U.S.A., Inc.*, 2013 TTAB LEXIS 263 (13 May 2013) (finding that applicant's own packaging emphasized a "spill resistant" quality and thus "NONSPIL" was merely descriptive) (non-precedential); In re *Bio-Rad QL, Inc.*, 2013 TTAB LEXIS 265 (17 May 2013) (finding applicant's own website supported the conclusion that the terms "DROPLET DIGITAL" and "DROPLET DIGITAL PCR" were merely descriptive).

Finally, the US Patent and Trademark Office (USPTO) issued for comment a new draft Examination Guide on gTLDs. In light of ICANN's introduction of new gTLDs, which may include marks capable of source identification, the USPTO noted that some of the premises of its previous Guide may no longer apply. More information can be found at [http://www.uspto.gov/trademarks/notices/deaScale\\_gTLD.jsp](http://www.uspto.gov/trademarks/notices/deaScale_gTLD.jsp) politicians.

## Words from the Chair



As I write this brief article for LL&P, I am preparing to chair the 87th PTMG Conference in Vienna. It seems hardly any time since we bade farewell from our last meeting in Hamburg in the Spring. In the meantime, I hope you have all had a lovely summer and found time to relax with your friends and family.

For the forthcoming Conference in Vienna, we have tried to put the focus on attracting as many attendees from industry as possible, including by amending our policy on fees. We will certainly do the same for our Spring 2014 Conference in London.

I hope by now you have seen the great programme we have organised for you in Vienna and are looking forward to the usual interesting and informative presentations and some lively discussions, both during the meeting and also at the social functions.

I look forward to seeing many of you very soon in Vienna. In the meantime, I hope you all enjoy the last few days of summer.

**Sophie Bodet**

## Comparative Advertising in the United Arab Emirates

Sara Holder, Chad Dowle Rouse & Co. International, UAE

In a recent development that will be of interest to those PTMG members that have consumer divisions, the National Media Council (NMC) of the United Arab Emirates (UAE) issued Council Decision No. 35/2012 earlier this year relating to the Criteria and Content of Advertising (the Decision). The National Media Council is an independent federal level government body with responsibility for overseeing the development of the media in the UAE. The remit includes oversight of the advertising sector and the Decision covers all advertising content available in the UAE in any form of media, regardless of whether the content was created in the UAE or not.

It is commonplace in the UAE for companies in the consumer sector to utilise advertising techniques to allude to a competitor's product and the superiority of the advertiser's product. Such advertisements tend to stop short of actually using the competitor's trade mark and therefore, these cases have been traditionally difficult to action when one company has felt their product has been unfairly represented in the comparison. Actions under the Trade Mark Law are not possible in such circumstances and rarely practical under the Anti-Fraud and Deception Law, the Consumer Protection Law or the general provisions relating to unfair competition in the Commercial Transactions Law. On the face of it, the Decision should allow action to be taken against such advertising techniques.

The Decision, amongst other things, states:

- the misuse of the intellectual property of another party is prohibited;
- that advertisements should not include false claims, exaggerate facts, claim exclusivity, belittle competitors nor do anything that pertains to fraud and deception; and
- that advertisements shall be true and not exaggerated, and shall not

cause any confusion or be misleading in any way, whether in relation to names, products or any other activities.

Sanctions that may be issued by the NMC under the Decision include:

- issuing a warning;
- requiring the advertisement to be stopped/withdrawn;
- payment of compensation for damage caused;
- cancellation or suspension of the license of a business that is in violation

The sanctions are without prejudice to the penalties that may be issued under other laws and regulations (such as the various health laws and regulations that regulate pharmaceutical advertising).

Notwithstanding this apparent jurisdiction to issue independent sanctions, to date in one complaint that has so far been filed with it under the Decision, the NMC has indicated it would only issue sanctions under the Decision, where another body (either administrative or judicial) indicates that there has been a breach of a law. Whilst a judicial authority could give a decision in relation to the Decision, other administrative authorities do not have jurisdiction to do so. Therefore, in practical terms in order to get an order under the Decision (without going to Court) a complainant would need to use another law or regulation to obtain a decision from another administrative authority and then ask the NMC to issue sanctions based on that determination under this Decision.

It is to be expected that there will be some issues relating to how regulations or laws will be implemented in practice when first issued. Notwithstanding this, we recommend that both advertisers and those who are targets of competitor advertising claims watch developments in this area closely.

# New EU Customs Enforcement Regulation - Some Improvements for Brand Owners

Robert Guthrie, SJ Berwin LLP, UK

The new Customs Enforcement Regulation (EC) No 608/2013 was published in the Official Journal of the European Union on 29 June 2013. Although it came into force on 19 July 2013, its main provisions will not have direct effect in Member States until 1 January 2014 from which date the existing Customs Enforcement Regulation will be repealed.

The new Regulation will strengthen the EU's border measures against counterfeit and pirated goods and make it easier for such goods to be destroyed following their seizure. Amongst other things, the new Regulation:

(a) adopts the previously optional simplified procedure as the standard compulsory procedure across all Member States;

This procedure gives customs authorities the power to destroy goods without a court determination that the goods infringe the relevant intellectual property rights, provided the right holder agrees and the holder or the declarant of the goods agrees or does not object. Importantly, customs may deem that the holder or the declarant of the goods has agreed to the destruction of the goods where there has been no opposition to the proposed destruction within 10 working days of notification.

(b) introduces a new procedure for the destruction of counterfeit goods in small consignments;

Right holders will now have an option of requesting that small postal or express courier consignments of counterfeit goods (three units or fewer, or where the gross weight of the goods is less than two kilos) be dealt with by the customs authorities without the right holder being contacted in connection with each consignment. Under this procedure, the customs authorities will contact the holder or the declarant of the goods to notify them that they intend to destroy the goods. If the holder or the declarant agrees, or is deemed to agree to the goods destruction by not opposing it, then the customs

authorities will destroy the goods without contacting the right holder. If there is no such agreement from the holder or the declarant, then the right holder will then be contacted and will have the option to initiate proceedings.

(c) covers a wider range of intellectual property rights than the current Regulation, including unregistered trade names; and

(d) provides for a new centralised electronic database (to be set up in early 2015) through which the various customs authorities of the EU member states will exchange information.

The Commission had initially proposed that the new Regulation should be extended to parallel imported goods but these proposals were removed during the legislative process and the new Regulation continues to expressly state that it does not apply to goods "that have been manufactured with the consent of the right-holder".

The new Regulation also fails to address the issues caused by the Court of Justice of the European Union's 2011 decision in *Philips and Nokia*, which decided that goods entering the EU under a suspensive customs procedure could not be classified as counterfeit goods or pirated goods within the meaning of the current Customs Enforcement Regulation. This decision followed on from previous Court of Justice decisions, including *Montex* (2006) and *Class International* (2005), which ruled that goods in transit do not infringe registered trade marks under EU law unless subjected to a commercial act directed to the EU, e.g. they were offered for sale. The result of the *Philips and Nokia* decision has been that counterfeit goods placed under suspensive customs procedures cannot be detained by the customs authorities unless there are indications that the intention is for the goods to be put on sale in the European Union. Furthermore, when such goods are detained, right holders have had to prove an intention to place the goods on sale in the European Union if they were to successfully bring infringement proceedings in relation to those goods.

The failure to deal with this loophole in the new Regulation will probably be the main area of concern for owners of pharmaceutical trade marks. However, it is worth noting that in March this year the Commission adopted proposals for changes to EU trade mark law (including significant amendments to the Community Trade Mark Regulation and a new Trade Marks Directive) that would close this loophole. Under the Commission's proposals, a new category of infringement provides that counterfeit goods (i.e. goods covered by a registration that bear an identical mark) will infringe registered trade marks in the EU merely by entering the customs territory of the EU (or, in the case of national marks, the Member State concerned) in the context of commercial activity.

The Commission is currently aiming for its proposals to be adopted in Spring 2014 with the European Parliament due to consider them in committee the following September, before they go before the Council at the end of that year. Brand owners in the pharmaceutical industry and elsewhere will hope that the Commission's proposed new category of infringement survives the legislative process unscathed. However, an amendment has been proposed before the Parliament that would require the trade mark owner to prove that its mark is also validly registered in the country of destination.



**Derek Rossitter, PTMG Hon. President, celebrated his 90th birthday in June 2013.**

# International Update

## Ukraine

### PETOSEVIC

On 4 July 2013, the State Administration of Ukraine on Medicinal Products held a public test of a new prescription drug monitoring system aimed at preventing counterfeit medicines from entering the supply chain.

The implementation of this system has been made possible by coating each drug package with a unique two-dimensional GSI DataMatrix barcode. This system has been tested in the European Union and recommended for use by the European Federation of Pharmaceutical Industries and Associations (EFPIA).

Ukraine and the EU are planning to gradually implement the new drug monitoring system in Ukraine by 2017.

In 2011, the EU published the Directive No. 2011/62/EU ("the Falsified Medicines Directive") according to which drug manufacturers throughout the EU need to mark all registered medical products with a unique identifier. The Directive came into force in January 2013.

## Croatia

### PETOSEVIC

Earlier in the summer, the Croatian Parliament passed the new Law on Medicines and the new Law on Medical Devices (Official Gazette No. 76/2013) under the urgent procedure, ahead of Croatia's EU accession. The two laws entered into force in Croatia on 29 June 2013.

The provisions of the former Law on Medicines, Medicinal Products and Devices and its amendments (Official Gazettes No. 71/07, 45/09 and 124/11) ceased to have effect in Croatia after the implementation of the two new laws.

After 29 June 2013, the Croatian Agency for Medicinal Products and Medical Devices initiated procedures to revoke the approval of marketing authorizations for medicines granted on the basis of the former law, and for those for which the period of data protection has not expired and which were authorized in the EU by the centralized procedure (CP).

Accordingly, for medicines or medical devices approved on the basis of the former law and for which the approval will cease to apply in the period from 1 January to 31 March 2014, the marketing authorization holders (MAHs) need to

submit an application for the renewal of the approval no later than six months before the expiration of the marketing authorization.

Prior to the entry into force of the new laws, Croatia was obliged to upgrade the marketing authorization dossiers of the generics according to the EU acquis communautaire. Croatia had no transitional period for applying the rules of data exclusivity. On the date of accession, the decisions on the centrally authorized products applied immediately. These products, when used as reference products, are protected for 8 years and not for 6 years. According to Article 89 of the Regulation (EC) 726/2004, the data exclusivity period of "8+2+1" refers only to those reference products for which the initial application for granting the marketing authorization via the CP was submitted before 20 November 2005. Therefore, marketing authorizations for generic products granted on the basis of reference products for which the data exclusivity period in the EU (8 or 10 years) has not elapsed will have to be withdrawn. Also if the market exclusivity period of 2+1 years for a reference product has not elapsed, generic products cannot be on the market until after that period.

Upon enactment of the new Law on Medicines on 29 June 2013, data exclusivity period is now explicitly governed by a provision of Article 235 of the new law stipulating that for the initial applications submitted under the CP from 20 November 2005 onwards, a validity period of 10 years applies.

With respect to the CP, the decisions on the centrally authorized products are extended automatically to Croatia as of 1 July 2013. However, the MAHs have to provide translations of the product information in Croatian, in line with the EU legislation. The MAHs should wait for the product information linguistic review (PALC) to be completed before putting the medicine on the Croatian market.

Croatia can be included in the Mutual Recognition Procedure (MRP) or the Decentralized Procedure (DCP) from the date of accession – 1 July 2013 was the first date that a MRP or DCP application could have been submitted to Croatia.

## Libya

### Zeina Salameh, Saba & Co IP

The Trade Mark Office re-opens nearly two years after its services were interrupted as a result of the latest civil unrest in the country. The Office is now ready to accept search requests and new trademark applications. All deadlines and

priority dates that fell due within the closure period will be properly dealt with to ensure that the files are in order.

The most important change which has taken place in the country following the recent events is related to the Libya-Switzerland relations. Specifically, Switzerland has recently established formal diplomatic relations with the Libyan government after a three-year breakdown in relations between the two countries. The implication of this development is that it will now be possible for Swiss applicants to file new applications.

Below is a timeline on the major trade mark-related events that took place in the country over the past three years that are worthwhile mentioning:

### 2009:

The list of goods and services was revised. The item "veterinary apparatus and instruments" was added to class 10 and the item "decorations for Christmas trees and related products" was removed from class 28. Also, during the same year, a Trade Mark Appeal Board was expected to be established with the main responsibility of hearing and deciding on appeals against any rejection decision issued by examiners in connection with trade mark applications. This plan was interrupted due to recent events.

### 2010:

A new Trade Mark Law was published in the Local Gazette and became effective in the country. This law replaces Law no. 40 of 1956. According to the new law, the definition of a trade mark has been broadened to include trade names, sound marks, and color marks. The new law recognizes famous trade marks that are well-known in Libya and ensures protection even if the marks are not registered. The law also gives the right to trade mark owners to initiate civil and criminal actions against any infringing party. Penalties include a maximum of two-year imprisonment and payment of fines of up to US \$ 7,500. The implementing regulations of the new law have not been issued yet.

### 2011:

(1) The certified copy of the corresponding home registration certificate that was usually required in support of a trade mark application was dropped.

(2) The country's official name changed from "Great Socialist People's Libyan Arab Jamahiriya" to the more commonly known name (now official) "Libya". The country's international code remains the same (LY).

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## Macedonia

### PETOSEVIC

The amendments to the Macedonian Law on Customs Measures for Protection of Intellectual Property Rights came into force on 14 May 2013.

The most significant novelty is that the seized counterfeit textile goods and footwear may be donated to socially disadvantaged people and residents of regions affected by natural disasters.

The law prescribes that the goods can be donated only upon the trade mark owner's consent and the removal of the trade mark from the goods. The competent authority will also have to confirm that the goods meet safety requirements.

The costs of transport, warehousing and trade mark removal will be covered by the state. The procedure will be conducted under the supervision of the trade mark representative and customs officials.

If it is not possible to remove the trade mark without permanently damaging the goods and if the trade mark owner does not approve the donation, the goods will be destroyed.

The amendments also foresee fines for repeat offenders ranging from EUR € 2,500-5,000 (USD \$ 3,300-6,500) for legal persons and EUR € 500-1,000 (USD\$ 650-1,300) for natural persons. The fines will be imposed in case of exporting or importing counterfeited goods bearing a trade mark that was subject to a previous seizure in which the same legal or natural entity was involved.

## Members News

### New Members

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

**Gokce Yilmaz** of Moroglu Arseven Law Firm, Istanbul, Turkey  
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**Penelope Catley** of Baldwins

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### Moves and Mergers

**Sonia Tondowski-Elkrief** has left Merck Serono and is now with Bugnion SA in Geneva, Switzerland. Sonia can be contacted at [soniaelkrief@bugnion.ch](mailto:soniaelkrief@bugnion.ch)

**Wolfgang May**, a former PTMG Committee member who was previously with Procter & Gamble, has recently joined DLA Piper in Cologne. Wolfgang can now be contacted at [wolfgang.may@dlapiper.com](mailto:wolfgang.may@dlapiper.com)

**Ralf Möller** has left Harmsen Utescher to join Esche Schümann Commichau in Hamburg, Germany. He can be contacted at [r.moeller@esche.de](mailto:r.moeller@esche.de)

**Malgorzata Darowska** has left Salans to join Bird & Bird Maciej Gawronski sp.k. in Warsaw, Poland. She can be contacted at [Malgorzata.darowska@twobirds.com](mailto:Malgorzata.darowska@twobirds.com)

**Giulio Martellini** has left Notarbartolo & Gervasi S.p.A., to join IP Skill in Turin, Italy. He can now be contacted at [g.martellini@ip-skill.it](mailto:g.martellini@ip-skill.it)

**Michael Leonard** has left Panitch Schwarze Belisario Nadel to join Fox Rothschild LLP in Philadelphia, USA. He can now be contacted at [mleonard@foxrothschild.com](mailto:mleonard@foxrothschild.com)

**Yves Asaert** has left Corsearch and is now with Nameshield in Brussels, Belgium. He can be contacted at [yves.asaert@nameshield.net](mailto:yves.asaert@nameshield.net)

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  
PTMG Secretary

# How similar are pharmaceutical preparations with different therapeutic indications?

## The Community trade mark law perspective

Verena von Bomhard and David E.F. Slopek, Hogan Lovells (Alicante) S.L. & Cia., Spain

### Introduction

The similarity of pharmaceutical preparations has always played a crucial role in the assessment of likelihood of confusion between trade marks for such products. However, in recent times, there seems to be a trend at the Office for Harmonization in the Internal Market (OHIM) whereby different therapeutic indications lead to likelihood of confusion being denied. Given the fundamental importance of this aspect, the absence of clear guidance and inconsistent EU case law as to the impact of therapeutic indications of opposing marks on the assessment of similarity of goods give rise to concern.

### General criteria

In the Canon judgment, the European Court of Justice (ECJ) established as relevant criteria for assessing the similarity of goods, "inter alia, their nature, their end users [should read 'intended purpose'] and their method of use and whether they are in competition with each other or are complementary" (judgment of 29 September 1998, C-39/97, para. 23). Later case law referred also to the distribution channels, the relevant public and the usual origin of the products under comparison. The decisive test question is, generally, whether the relevant consumer, assuming identical marks, would reasonably believe that the products come from the same commercial source. This also follows from the Canon judgment, where the ECJ emphasized the origin function of trade marks and held that "the risk that the public might believe that the goods or services in question come from the same undertaking (...) constitutes a likelihood of confusion" (ibid., para 29).

### The case of pharmaceutical trade marks

In applying these criteria to pharmaceutical trade marks, the General Court (GC) has adopted two fundamentally opposed approaches. On the one hand, pharmaceutical preparations for different therapeutic indications have been found to be similar

to a normal degree. The judgment of 16 June 2010 (T-487/08 [KRENOSIN/KREMEZIN]) is a good example. The goods under comparison were pharmaceutical preparations "for use in the treatment of renal disease, liver disease, diabetes mellitus and Crohn's disease (...) and none (...) being for use in the treatment of heart conditions "on the one hand and" for the treatment of the heart" on the other hand. The GC found that these goods were of the same kind (pharmaceutical products), directed at the same consumers (health professionals and patients) and traded via the same channels of distribution (health centres and chemist's shops). These similarities outweighed the only difference, which was the respective therapeutic indication. The significant differences between the therapeutic indications in that case only meant that the goods were not regarded as highly similar; however, a normal degree of similarity was found to exist (ibid, para. 75 et seq.).

On the other hand, in other judgments, stricter criteria have been applied. The leading case is the Tolposan judgment (15 December 2010, T-331/09 [TONOPAN/TOLPOSAN]). In this case the GC held that there was only a low degree of similarity between analgesics for soothing pain and muscle relaxants. Whilst the Court admitted that most of the criteria which render goods similar were fulfilled, it went on to explain that these similarities were due to the fact that both goods were medicines, a broad category that included goods that may be different. It was, therefore, "necessary to have regard to other factors, in order to properly assess the similarity between the medicines. These factors are, in particular, whether these medicines are in competition with each other or complementary, as well as their purpose and their specific intended use (treatment of specific health problems). In taking these factors into account, a medicine's therapeutic indication is of decisive importance" (ibid, para. 36). Where the therapeutic indications are different, the products under comparison will hardly be in competition. Obviously, a medicine for one disease is not interchangeable with a medicine for

another disease. Therefore, pharmaceutical preparations for the cure of different diseases can only be similar to a more than low degree if they are complementary. Unfortunately, however, the case-law on the complementarity of pharmaceutical preparations is also inconsistent.

### Comment

The Tolposan decision plays an important role in practice. OHIM's Boards of Appeal refer to it on a regular basis in order to establish that goods are similar to a low degree only (e.g. BoA, decision of 14 January 2013 in Care R 1149/2012-1 [BESIRO/BETIGO], para. 26), to then deny likelihood of confusion. However, the judgment is problematic for a couple of reasons. From a policy perspective, it reduces the scope of protection of pharmaceutical trade marks. From a legal perspective, there are further aspects which have to be taken into account when relying on the Tolposan judgment. The decision is inconsistent with the GC's approach otherwise as summarized above. This leads to legal uncertainty for owners of pharmaceutical trade marks. It is also inconsistent with other case law where the GC compared pharmaceutical preparations and other goods. If there is an average degree of similarity between pharmaceutical preparations and dietetic preparations for medicinal purposes (GC, judgment of 15 December 2009, T-412/08 [TriBion Harmonis (fig.)/Trubion], para. 32), this assessment must apply, a fortiori, to different medicines. Finally, the Tolposan judgment overestimates the importance of the therapeutic indication and could, therefore, be regarded as being in conflict with case law of the ECJ. As set out in OHIM's Manual Concerning Opposition (Identity and Likelihood of Confusion, Part 2.2, page 43) "several, if not all criteria for similarity are usually met: [specific pharmaceutical preparations] share the same nature because they are specific chemical products; their purpose is, broadly speaking, healing and/or curing; they are sold in the same places, namely, pharmacies; and they come from the same source, which is the pharmaceutical industry."

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In its Tolposan judgment the GC plays down the relevance of these criteria by arguing that medicines are a very broad category and that the decisive factor for finding an adequate sub-category must be the therapeutic indication. It is noteworthy that this focus on the intended purpose/therapeutic indication does not follow from the Canon judgment of the ECJ, but from the GC's Respicur judgment (Tolposan, para. 36 with reference to GC, judgment of 13 February 2007, T-256/04 [RESPICORT/RESPICUR], para. 29 et seq.). However, the relevant passage in said decision did not deal with the likelihood of confusion, but with the question, for which sub-category of goods the mark at issue had been genuinely used. As the concept of genuine use is different from the concept of likelihood of confusion, the reference to the principles laid down in the Respicur judgment is flawed.

All in all, the Tolposan decision is vitiated by error. Its basic assumption, that the level of similarity between medicines is generally low as medicines are a broad category that includes goods that may be different, is a circular reasoning. Moreover, the GC did not give any weight to the fact that muscle relaxants may also have the effect of alleviating pain (ibid., para. 39), which should, however, enhance the similarity to analgesics.

There are of course cases where two pharmaceutical preparations with different therapeutic indications are similar to a low degree only. The OHIM Manual gives a good example by referring to contraceptives and eye-washes. In this case, the different nature of the goods and their different manner of use reduces their similarity to a low degree.

## Conclusion

OHIM's practice shows an increasing tendency to deny likelihood of confusion between pharmaceutical trade marks, if they cover pharmaceutical preparations with different therapeutic indications. Whilst this development is in line with the Tolposan judgment, the judgment itself gives rise to criticism. It is inconsistent with other decisions and overestimates the importance of the therapeutic indication. As set out above, the over-riding question in assessing the likelihood of confusion is whether the relevant public might believe that the products in question come from the same undertaking. However, the public is well aware that pharmaceutical companies often manufacture a broad range of drugs with various therapeutic indications.

# SORTIS and Sortistatin, likelihood of confusion

Karin Costescu, Bardehle Pagenberg, Munich, Germany

## Facts of the case

The Opponent is the owner of the German trade mark SORTIS, which is registered among others for the goods medicines, pharmaceutical and veterinary products in class 5. Based on this trade mark, the opponent filed an opposition against the German trade mark Sortistatin in as far as it is registered for goods in class 5, ie. sanitary preparations for medical purposes; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

After the opponent had evidenced genuine use of the trade mark SORTIS for the goods medicines only available on prescription, namely lipid lowering agents, the German Patent and Trade mark Office (PTO) denied there was a likelihood of confusion between the conflicting trade marks in two decisions, claiming that the conflicting signs would be sufficiently different.

## Decision

The German Federal Patent Court (FPC) granted the appeal after the opposition had been partially withdrawn and only directed against the goods pharmaceutical and veterinary products; medicines; dietetic substances for medical purposes, food for babies.

Taking into account the general principles of genuine use of pharmaceutical trade marks as well as the higher attention of the relevant public in the field of health, FPC assessed that the conflicting goods are partially identical and partially similar. This is due to the fact that lipid lowering agents are used to regulate increased cholesterol levels, whereupon the corresponding diet also has an influence upon it so that a change of diet is one part of the therapy.

As regards a similarity of the conflicting signs, the FPC stated that the conflicting signs were not sufficiently similar as the last part -statin of the contested trade mark Sortistatin could not be ignored. However, the overall impression of the contested trade mark Sortistatin is characterized by the more observed initial part Sorti- on its own. This is due to the fact that the last part "-statin" is a common suffix for active ingredients that are used as cholesterol-lowering agents for influencing the lipid metabolism. This indication would be recognized not only by the addressed professionals but also by

the general public, since -statin is a common element of numerous pharmaceutical trade marks.

The fact that the contested trade mark Sortistatin is a unitary term would not preclude the fact that it is characterized by the initial part Sorti-. The determination of a likelihood of confusion, from the point of the characterization of the overall impression of a trade mark by one of its elements, does not necessarily require the corresponding trade mark to consist of more than one word. Rather, even in case of trade marks that only comprise one word, the relevant public would be able to perceive one element thereof as being the sole characterizing part. Consequently, the FPC assumed a likelihood of confusion between SORTIS and SORTI- in an aural respect.

## Remarks

The decision of the FPC strengthens the protection of pharmaceutical trade marks, as the Court emphasized that even if the trade mark in question consists of one word alone, it is still possible to determine a characterizing element in that mark. It is not necessary for the corresponding mark to consist of more than one word. Since a similarity in aural respect can be sufficient to assume a likelihood of confusion, it would be illogical if the outcome was different between signs consisting of two separate words and signs consisting of one word only.

Due to the present decision of the German Federal Patent Court, it is now more complicated to lean on a pharmaceutical trade mark by combining a similar sign with a further component. However, this should also apply if the additional component is not of weak distinctiveness, but rather has an independent distinctive character for other reasons.

With respect to the ending -statin, it is doubtful whether the general public would indeed perceive it as factual information. However, it is not necessary for both addressed circles, the general public and the professionals, to confuse the conflicting trade marks SORTIS and Sortistatin, in order to affirm a risk of confusion. Rather, it would have been more convincing to consider it sufficient for the professionals alone to confuse the conflicting trade marks SORTIS and Sortistatin. Then pharmaceutical marks would be comprehensively protected.

# The Trade mark Clearinghouse for New gTLDs: Beware the Hype

Keith Barritt, Fish & Richardson P.C., USA

The avalanche of approximately 1400 new generic top-level domain name extensions will soon be upon us, possibly including many in the pharma space such as brand-centric .abbott, .merck, and .pfizer and disease-centric .hiv. There are even some disease-centric top level domains that are proposed to be closed to outsiders such as .cancerresearch and .stroke, though the fate of all such "closed generic" top level domains is in limbo.

The first new gTLDs to be delegated will be the 100 or so "internationalized" gTLDs (those in non-Latin scripts such as Chinese, Arabic or Cyrillic). Once the process gets rolling, ICANN believes it can delegate as many as 20 new gTLDs per week.

To help brand owners protect their marks, a new Trade mark Clearinghouse has been established, jointly run by Deloitte and IBM. A trade mark owner may record in the Clearinghouse marks that are (1) registered at the national or multi-national level (such as for Community Trade marks, but excluding US state registrations), (2) court-validated common law marks, and (3) protected by statute or treaty, which are likely rare in the pharma industry.

## What Are the Benefits?

The new gTLD system incorporates several rights protection mechanisms that directly rely on information in the Clearinghouse.

### • "Sunrise" Domain Name Registrations

For at least 30 days before domain names in a new gTLD become generally available, the registry must first offer a Sunrise registration period for "identical matches" of trade marks that are recorded in the Clearinghouse that meet the eligibility requirements for the new gTLD. The "identical match" rules are quite strict.

When relying on a trade mark registration to support a Sunrise application, the Clearinghouse must first verify the mark is in use. In addition, though changes are still possible, under the current version of ICANN's Applicant Guidebook the trade mark application must have been filed before 13 June 2012 (the date ICANN revealed the new gTLD applications), and the trade mark registration issued on or before the date of the registry agreement for the particular new gTLD of interest. If multiple mark owners file for the same domain name during the Sunrise period, the rules adopted by the registry of the new gTLD apply (often involving an auction, with the proceeds -- surprise! -- going to the registry).

### • Notice of Claims Service

After the Sunrise period, domain names will become generally available (subject to the registry's eligibility requirements). For a minimum of the first 90 days after general launch, domain name applicants will receive a notice if their requested domain name is an identical match to a trade mark recorded in the Clearinghouse. If the applicant proceeds to register the domain name, the trade mark owner will receive notice that the domain name has been registered. It is then up to the mark owner to take whatever action it deems appropriate, if any.

### • Beware the Hype

There have been exaggerated claims of other purported benefits of recording a trade mark in the Clearinghouse. In reality:

- Recording a mark in the Clearinghouse does not avoid the chance of infringement – it merely provides notice to the domain name applicant of an identical match to a mark recorded in the Clearinghouse and then provides notice to the mark owner if the domain name is registered anyway. It is up to the mark owner to take any appropriate action.
- Recording a mark in the Clearinghouse is not a requirement to use the tried-and-true Uniform Dispute Resolution Procedure.

- Recording a mark in the Clearinghouse is not a requirement to use the new Uniform Rapid Suspension service, though the complainant's mark must be of the type that is eligible for inclusion in the Clearinghouse.

- If identical trade marks are recorded in the Clearinghouse by different parties, it is not the case that an auction or lottery will automatically result – rather, it is up to the individual registry of each new gTLD to decide how to resolve conflicts during Sunrise.

### What Is A Trade Mark Owner To Do?

Trade mark owners should review the list of applied-for new gTLDs and decide if they want a second-level domain name that is an identical match to an existing trade mark registration. By drilling down into the new gTLD application, particularly the answers to Questions 18 and 29, you can determine the eligibility requirements and procedures for resolving disputes in case there are multiple qualified applications for the same domain name during Sunrise. After four months or so of being

operational, only about 7,000 trade marks were recorded in the Trade mark Clearinghouse, and reportedly less than 1% of these related to the pharmaceutical/medical industry. This cautious wait-and-see approach may be prudent, but waiting too long risks delays and being excluded from Sunrise registration periods for new gTLDs. While each new gTLD registry must give a 30 day notice prior to the launch of Sunrise registrations, there is no guarantee that recordation can be accomplished in this time frame – especially with so many trade mark owners evidently sitting on the sidelines who may now all rush at once to record their marks.

Thus, one option is to record your marks early, even if you do not know for certain a new gTLD of interest will in fact be delegated. If you wish to be more involved in the process and only record marks after having greater confidence that a new gTLD of interest will actually be delegated, you can monitor the signing of individual registry agreements at ICANN's website at <http://www.icann.org/en/about/agreements/registries>. Though signing a registry agreement is not an assurance that the new gTLD will be delegated, it is a very good indicator.

If a mark owner does not want a Sunrise registration but does want to monitor for potential conflicting domain names of others, a private domain name watch service should be considered rather than relying on the Clearinghouse. Private watch services will not be limited by the narrow identical match rules and will last longer than 90 days. It is also notable that the decision not to submit a mark in the Clearinghouse cannot be used against a trademark owner in any enforcement action. As stated in the Applicant Guidebook:

- Inclusion in the Clearinghouse is not proof of any right, nor does it create any legal rights. Failure to submit trade marks into the Clearinghouse should not be perceived to be lack of vigilance by trade mark holders or a waiver of any rights, nor can any negative inference be drawn from such failure.

While recordation in the Clearinghouse is a requirement for a Sunrise domain name registration, mark owners should carefully consider if the other benefit of recordation -- providing notice only for identical matches and for only as few as 90 days after general launch -- is worth the cost when compared to other monitoring options that go far beyond identical matches and last far beyond 90 days.

# IP TRANSLATOR: the new very bad trip

By Elisabeth BURST and Camille DRABER, INLEX IP EXPERTISE, France

The IP TRANSLATOR decision (hereafter the IPT decision) highlighted the duality, problems and limitations associated with i) the coexistence of national trade marks and practices and ii) Community trade marks and practices. Nearly one year later, what have been the impacts and changes in today's practice?

## The Issue

The IPT decision concerned the definition and contents of general class headings: should we apply a literal interpretation (whereby the class heading would include all products and services that fall naturally into a general category) or a broad interpretation (where the general class heading would include the entire alphabetical list of a given class)?

The issue concerns whether or not to include isolated products under a general class heading - i.e., one or more products that do not match the natural definition of a general class heading - or one or more products that relate (or not) to the general spirit of a given class.

## The Rules of the Game

On 16 June, 2003 OHIM Communication 04/03 stated that "the use of class headings constitutes a claim for protection of all products and services pertaining to the respective class".

This had gone unnoticed by the examiners at the Office who continued in practice to apply a literal interpretation to the general class headings.

OHIM was compelled and forced by the IPT decision to redress the situation. In Communication 02/12 the Office confirmed that, before the IPT, in using a given class heading "the applicant's intent was to cover all products and services included in the alphabetical list of the said class". It also stated that it is essential that the actual protection of the mark reflects the applicant's intent.

A "magic" tick-box is thus provided for applicants on the electronic application form to claim protection for the entire class in just one click.

The French Office took a stance on this issue and reminded applicants that "the wording, and nothing but the wording" was the limit within the trade mark application system, and that there is no room for isolated products if these do not clearly reflect the applicant's intent.

So, here in France, we were supposed to deal with a two-tier system: the OHIM system on the one hand and the INPI system on the other.

## Impact

### 1. Oppositions

The major consequences of the IPT decision are best reflected in opposition procedure as here applicants found themselves facing a three tier system. The outcome of an opposition proceeding actually differs depending on whether the decision was rendered before the IPT, after the IPT on a CTM filed before the IPT decision, or after the IPT decision, based on a CTM filed after the IPT decision!

The major risk induced by the IPT decision would be to file a great number of oppositions against a multiple-page description.

As the taxonomy was banned by OHIM and is a simple informative tool deprived of any legal effect, the only solution would be that OHIM publish a list of the isolated products per class to avoid opposition proceedings with endless argumentations.

### 2. Availability Search

The impact of IPT decision on availability searches is more limited since it occurs in the unusual case where an applicant wishes to file a CTM for "isolated products" or similar products, and where it is necessary to evaluate the risk of facing opposition, invalidity or cancellation actions before OHIM.

A CTM filing claiming protection for a general description and filed before the IPT decision will be considered as a priority for one trade mark project. However, the same trade mark will not necessarily have priority if filed after the IPT decision.

### 3. Revocation for non-use

If the owner of a trade mark wishes to obtain maximum protection and claims protection for an entire class, this decision may turn against him at the end of the fateful 5-year period.

The stakes are high, as the said owner could eventually lose all protection for products he would need to manufacture one day...

### 4. Filing

Here, over-stretching oneself could have fateful consequences.

Only well-balanced specifications that are not too broad or precise will ensure optimum protection. Also a specification

giving broad protection at the time of filing may eventually reduce the owner's rights to an absolute minimum after 5 years.

Filing an application for the general category of the products of interest, and possibly the isolated products, may be an option to consider but this requires a case by case analysis.

### 5. Renewal

Particular interest must be paid in the case of renewal of CTMs that claim protection for a general specification.

OHIM did not take this opportunity to require the owner to provide any information at the time of renewal to specify the scope of his trade mark specification by asking whether the renewal applies to all products/services or only to the general description according to its literal interpretation.

### 6. Conversion of a CTM into a national trade mark

No Office has yet rendered a decision on this. However, the French Office will apply its literal interpretation to CTMs. This is where the divergence of interpretation between Offices takes on its full meaning!

A CTM filed before the IPT decision and claiming protection under a general description should be given a broad interpretation. Yet the French Office will go for a literal interpretation and should thus reject the insertion of "isolated products" in the specification.

Given that the French Office totally rejects the statement whereby the applicant intends to protect the entire class of interest, what will be the position of the French Office when it comes to converting such CTMs?

## Conclusion

At first glance, one may well ask "What is all the fuss about?"... All this for "isolated products"? The aim of IPT decision was to fulfil an urgent and substantiated legal requirement, but it did not establish the general framework that was necessary in view of the implications, uncertainties and risks, or even the dangers that have resulted from this decision and will no doubt continue to generate for practitioners.

# Navigating the Challenges of Pharmaceutical Trade mark Protection in the Arab World

Ghaida Alaeddein, Saba & Co IP, Jordan

The Arab pharmaceutical market is reportedly valued at over \$12 billion and growing at more than 10% per year, with around 450 manufacturers. With the exception of Egypt, all Arab countries are high importers of branded drugs, while local manufacturing capabilities are limited to generic and licensed drugs with very little research and development. Thus, it has become more important for trade mark owners to address the challenges of pharmaceutical trade mark protection and to become more familiar with the requirements that are specific to this region.

## Clearance

In addition to a typical trade mark search, a full pharmaceutical trade mark availability search should also attempt to cover a selection of sources, including the records of local regulatory authorities. However, there are two limitations that trademark owners should be aware of:

- (1) there is no pan Arab marketing authorization, and
- (2) not all of the records are easily accessible.

## Examination

Some trade mark Offices do take into consideration the issue of “sophistication of consumers” when assessing the likelihood of confusion between pharmaceutical trade marks. When it comes to International Non-Proprietary Names (INNs), there seems to be no specific regulations to prevent the acquisition of trade mark rights in INNs. Practice across the region differs considerably. In Lebanon and Morocco, where there is no substantive examination, the Registrar will not check whether the mark is an INN. In countries where there is substantive examination, the examiners are not expected to verify if the mark is an INN; however it may be possible to successfully oppose a trade mark for being identical to an INN.

## Requirements

With the exception of Syria, Arab countries do not impose filing requirements that are only specific to class 5. The Syrian trade mark Office asks for detailed information on the origin of the product.

## Packaging

The Arabic transliteration of the mark must appear on the package and/or the leaflet in most Arab countries, including Morocco, Tunisia, Egypt, UAE, Syria, Saudi Arabia and Qatar. Hence, protection of the Arabic transliterated version of the trade mark becomes necessary.

In short, protection of pharmaceutical trade marks poses some challenges that require special consideration and handling. Trade mark owners must be able and ready to adopt a model that incorporates both legal as well as regulatory approaches in order to arrive at a well-established protection strategy. Needless to say, owners should seek sound advice before they decide on the best route to pursue.

## The Difference a Letter Can Make...

Frances Drummond and Emma Bekens, Norton Rose, Australia

### International Non-Proprietary Names

In an effort to avoid confusion, the World Health Organisation designates a generic name, or International Non-proprietary Name (INN), for each ingredient in medicines. Pharmaceutical companies then use proprietary names, or trade marks, to distinguish their goods from those of other traders. An example of this is the INN paracetamol which is also known by proprietary names such as Panadol in Australia, or Tylenol in the US.

In Australia, the formulation of a product must be supplied to the Therapeutic Goods Administration (TGA) during the process of registration or listed as a therapeutic good. The TGA maintains a database of approved ingredient names to be used for this purpose.

Only from 2002 onwards has the TGA adopted the World Health Organisation’s INN terminology for new medicines’ ingredients. This has resulted in some ingredients added to the TGA’s database prior to 2002 retaining names inconsistent with INN terminology. The TGA has indicated that 472 ingredients have names inconsistent with INN terminology.

### Proposed changes

To address this issue, the TGA announced on 15 May 2013 that it will undertake a process of harmonisation of ingredient names. The changes do not impact herbal ingredients, ingredients in medical devices, biologicals and, importantly, trade names.

While some of the changes are relatively minor and for many ingredients involves a change to only one letter (for example a change from PH to F, or Y to I), the process of harmonisation will still have a major impact on pharmaceutical businesses. For example, the common antibiotic ingredient amoxycillin will be changed to amoxicillin to reflect the INN. Some changes are more significant and will have a real impact on labelling and space; for example the ingredient glucose will be changed to glucose monohydrate. Many of the changes, such as the change from adrenaline to epinephrine will be recognisable to the industry as the known American names.

The TGA is seeking comments and feedback on the proposed changes to ingredient names and the associated transitional provisions for their implementation on packaging, labelling, Product Information documents and Consumer Medicines Information leaflets. In relation to packaging, the TGA has proposed that sponsors update their labels and packaging within two years of the TGA’s ingredients database being updated, or at the next print run, or packaging artwork amendment, if this occurs within 2 years. It is proposed that the updates will occur in 2014.

### What does this mean for you?

This could mean that some businesses (especially those who sell over the counter or homeopathic health products) will need to be prepared to make changes shortly after the updates as the requirements may be triggered by a promotional campaign that uses advertising on the packaging to support the point of sale materials.

*continued on next page*

Arguably, international companies may benefit from increased standardisation of ingredient names across their packaging, despite an increase in costs initially. With the TGA's medicine labeling and packaging review still under way (for more information, see our article from the December 2012 issue of LLP) pharmaceutical businesses will still need to co-ordinate a number of changes to their packaging and branding. If the TGA adopts its proposed labeling and packaging changes, Australian products will, regardless, need to comply with different requirements. We note that to date the TGA has not publicly released any further information on the progress of the review since the initial analysis of submissions was released in January this year.

Submissions to the TGA on the harmonisation of ingredient names closed on 10 July 2013. At the time of writing, no further information regarding the number of submissions or key themes has been released.

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## ITMA'S AUTUMN SEMINAR

BIRMINGHAM

10 October, 2013

# Recent Australian decisions relating to marks containing INN stems

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

In the May 2013 edition of LL&P, we featured a case note relating to the registrability of marks containing INN stems in Australia. In particular, the mark ZELCIVOL faced objection based on it containing the INN stem "OL". It was said that the mark would be likely to confuse the relevant public unless the specification was limited to goods that accord with the stem. In the result, ZELCIVOL was accepted without restriction or endorsement, based on consideration of a number of factors that have now been captured in the AUTMO's Practice Manual (Part 29.4).

Since then, a number of decisions relating to marks containing INN stems have been handed down. The two most recent cases related to the marks SYNCROSTIM and OESTROEASE.

### SYNCROSTIM

Ceva Sante Animale applied for SYNCROSTIM in respect of veterinary products in class 5.

The examiner raised an objection on the basis that the suffix -STIM is listed as an INN stem indicating that the goods upon which it is used consist of colon stimulating factors.

Ceva argued that STILL was obviously derived from "stimulate", and that "-STIM" would not be seen as a distinct element. Further, the relevant consumers were highly trained and so were unlikely to be confused. In support, Ceva filed evidence of existing registrations in class 5 that contained the suffix "-STIM", and a list from PUBCRIS of product names containing STIM.

This was not sufficient to persuade the Delegate of the Registrar. It was considered that the mark would be broken down into two elements, SYNCRO and STIM, and that the four letters that comprise "STIM" are "an unusual combination in the English language". The Delegate also considered that highly trained practitioners were in fact more likely to recognize and rely on INN stems, which was a factor tending to increase the risk of confusion. Overall, it was considered that the "-STIM" stem was meaningful in the SYNCROSTIM mark, and the examiner's objection was upheld.

### OESTROEASE

Health World Limited applied for OESTROEASE in relation to "hormone deficiency preparations, including oestrogen deficiency preparations;

pharmaceutical preparations for use in the treatment of menopause and allied disorders in women including post menopause symptoms and conditions; pharmaceutical preparations for use in female hormonal replacement therapy; pharmaceutical preparations for boosting low levels of oestrogen" in class 5.

The examiner raised an objection on the basis that the mark contained OESTR, which is very similar to the INN stem "ESTR".

It was recognized that limiting the specification to goods containing estrogens would not be appropriate, as the Applicant's goods "rather than containing estrogen, contain compounds to ease the effects of the fall in estrogen in the human body".

In allowing the application to proceed to acceptance for all of the goods, the Delegate took into account that the use of "ESTR" in the OESTROEASE mark did not necessarily connote that the products contained estrogen. In fact, the mark appeared to convey the intended purpose of the goods, namely that they ease the effects of the fall in estrogen which occurs during menopause.

The Delegate also took into account that there were at least four products in the Australian market that do not contain estrogens and that are named in a manner similar to the Applicant's goods (namely Estro Balance, Estro-sense, Estro-EZ and Estro-Ease).

In line with the comments of the (different) Delegate in the SYNCROSTIM decision, this Delegate referred to health professionals as being those at greatest risk of being confused. On the other hand, the Delegate took into account that many menopause relief products are available without prescription.

The Delegate was not satisfied that the OESTROEASE mark would cause confusion when used upon pharmaceutical or medicinal goods not containing estrogens, and the application was accepted without restriction or endorsement.

### Comment

These two decisions serve to confirm that marks containing INN stems may still face problems under Australian practice. The issue as to whether the relevant public is likely to be confused is highly fact specific, and will take into account the meaningfulness of the stem within the context of the overall mark.

# PROFILE: Martin André

Martin is employed at Merck KGaA, Darmstadt, Germany. He is head of Trade Marks Department as well as General Counsel for Chemical Performance Material Division. He is based in Darmstadt with a team of 20 people in Trade Marks and 15 people in 6 global locations for Chemicals.

Prior to joining Merck KGaA in 2003 and entering into the Pharmaceutical Industry he was corporate counsel at Schott AG (Carl Zeiss Foundation) and in private practice in a German law firm. Studied law at Goettingen University in Germany and at University of Illinois at Urbana-Champaign, USA; he is admitted to the Bar in Germany and New York and holds a doctorate degree from Goettingen University and an MBA from University of Wales in Cardiff, UK. He is a regular member of INTA and national trademark committees at German Trademark Association "Markenverband" and Association of Pharmaceutical Companies "VfA" and has served on the Management Committee of PTMG since 2005.



## Where were you brought up and educated?

I was born in Wiesbaden and raised in a small town in Northern Germany. I studied law at Goettingen University and as a postgraduate at University of Illinois at Urbana-Champaign USA.

## How did you become involved in trade marks?

At my first occupation as an associate lawyer in a mid-size law firm in Germany I was in charge of general commercial law including IP and particularly trademark affairs. My spirit was captured.

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

I sure would be a lawyer anyway, most probably in the area of commercial or banking law.

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

Reliable, multifunctional, optimistic

## Complete the following sentence. "I wish ..."

... that Murphy's law would always work in my favour.

## What was your worst experience in the world of work?

When promises made to me from one of my first employers were not kept.

## What was your biggest work or career mistake and what did you learn from it?

Luckily, I do not perceive to have suffered from that experience.

## Who was your mentor or role model?

I owe much of what I am today to the invaluable guidance and teachings of mentors Ernesto O'Farrell, Ernesto Aracama Zorraquin and Michael Cassels, who transmitted to me their passion for IP and for high quality work.

## What do you do at weekends?

Playing with my kid, exercising magic tricks, enjoying life.

## Complete the sentence: If I have time to myself ...

...I would share it with the people I love the most and good friends.

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

... answering questions about what I am not good at.

## What's the best thing about your job?

To work with the excellent people in my teams and the variety of challenges

## What did you want to be as a child?

A centaur in order to run faster.

## What does all your money get spent on?

If I only had an idea about that myself.....????

## What is your biggest regret?

Not to have spent more time with some beloved people that now have passed away.

## What is your favourite work of art?

The logo of my Company

## What is the soundtrack to your life?

General songs from Tina Turner and Michael Jackson

## What do you dream of?

That I could go back in time to again enjoy the most wonderful adventures and experiences of my life.

## What is your all-time favourite film?

Billy Wilder: Some like it hot

## Which one person would you invite to dinner?

Harrison Ford

## What is your favourite food dish?

New York Strip Steak with pepper sauce and white wine

## What is your favourite item of clothing?

Fitted Jeans with boots.

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