

# Law Lore & Practice

PTMG



Pharmaceutical  
Trade Marks Group

Sept 2019



## Editorial: IN MEMORIAM

Some Editorials are harder to write than others. Members will no doubt agree with me that this edition of LL&P brings its share of very sad news. I am indebted to both Richard Heath and Mark Foreman for agreeing to write the Obituaries that you will find herein.

As Editor for the past ten years, I had the honour of working closely with Sean Brosnan, sharing a common vision to

update our communication tools, both the newsletter and the website whilst retaining the quality both these tools have known from the start. In its current paperless format, available on-line too, LL&P lives on as witness to the PTMG Treasurer's worthy goals to both reduce cost and paper waste.

Next year, PTMG will celebrate its 50 years of existence and in this connection, much work has been done by committee members past and present to work through the archives.

A celebratory Book will be distributed at the 100th conference in London in March 2020. Whilst carrying out this work, I have been moved by the outpouring of emotions in past editions of our newsletter in memory of stalwart founding members of the Group and it once again brings home the unique essence of our organisation: a professional family.

At these difficult moments, one remembers other members of the profession gone beforehand and I often find myself wondering what it is that makes the world of trade marks so utterly unique. Perhaps the fact that our professional aptitudes have to include effective listening to others - the clients, be they in-house or not - whilst at the same time being able to express ourselves in clear, meaningful communication, can be the beginning of an answer.

Please join the Chairman and the Management Committee in addressing our deepest sympathies to all of Sean's family and most particularly to Lesley Edwards.

Vanessa

## US Update

by Jonathan S. Jennings Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP

Pharmaceutical companies routinely offer both products and complementary patient educational and support services. The US Trademark Trial and Appeal Board recently recognized this industry practice as an important factor in determining likelihood of confusion in an opposition proceeding, *Lupin Pharmaceuticals, Inc. v Ampel, LLC*, 2019 WL 3229399 (TTAB July 2, 2019)(non-precedential).

Lupin Pharmaceuticals, Inc. (Lupin) opposed Ampel, LLC's (Ampel) trade mark application to register LuPPiN, on the basis of Lupin's prior registered mark LUPIN as a 'house mark encompassing a full line of pharmaceuticals for medical purposes, but excluding dietary supplements and edible flour.' Ampel's application covered educational and patient services relating to lupus. At the outset, the Board found the marks to be highly similar, even though lupin refers to a type of flowering plant and Ampel's LuPPiN mark suggested a tie to lupus.

In conducting the standard analysis of the similarity or relatedness of the parties' goods and services, the Board found it irrelevant whether the opposer, Lupin,

actually offered patient support services (it apparently did not), stating the salient 'question is what relevant consumers are likely to think based on their exposure to industry practices in general.' Based on the evidence presented, the Board found 'the provision of educational and support services by pharmaceutical companies is sufficiently common that many consumers will make a connection between drugs and educational services about a particular disease or condition, and, thus, find these goods and services related.' It was the perception of such a relationship between the goods and services that mattered, as 'ordinary consumers are likely to believe that a single source exists for drugs and educational and patient support services relating to drugs,' when provided under the same or similar marks.

Based on this finding of relatedness between the parties' goods and services, and the prospect of at least some lupus patients using Lupin's products, the Board also found a significant overlap in the channels of trade. In doing so, the Board reiterated that the focus of this inquiry is the identification of goods in the registration and the services for the

application at issue, both of which did not restrict the channels of trade through which such goods and services are normally provided.

The Board agreed with Ampel that its target consumers, people afflicted with lupus, were likely to be careful in selecting their treatments, and that Lupin failed to present sufficient evidence as to the market strength of the LUPIN mark. However, the Board found that the other *du Pont* factors carried greater weight. Therefore, the Board found a likelihood of confusion and sustained the opposition.

This decision shows that the Board will consider the expectations of patients and healthcare professionals in determining the relatedness of goods and services, especially through the lens of any trade-channel restrictions (or lack thereof). As a practice tip, this suggests that to avoid refusal or an opposition, an applicant should give serious consideration to restricting its identification of services and/or limiting its application to certain channels of trade in situations where there is some similarity to a prior registrant's mark.



And the heat goes on.... For the second summer in a row, we have had record temperatures in Germany with two heat waves where we hit the 40 degrees (Celsius, not Fahrenheit!). Of course in other regions of the globe people may be used to it. But in Germany (and most probably also in the neighbouring countries) we are completely unprepared for this: air conditioning is common in cars by now, but very rare to be found in offices, private houses or flats and public transport. Every time a new heat wave is announced mobile air conditioning units are sold out within hours or days. In the long run something must happen here. My feeling is that fighting the symptoms of global warming by equipping buildings and public transport with air conditioning cannot be the one and only answer. Apparently, we have to change our way of life altogether: more environmentally friendly means of transport, less air travel, less cruise ship holidays, veggie food rather than meat etc. And it seems the youth has understood that it is their future that may be at stake. So they are very actively engaged in environmental politics. Representative in this context are Greta Thunberg and the Fridays for Future movement. Well, I can at least claim that during the summer I try to commute to the office on my e-bike rather than the car at least twice a week. So much about hot summers and the environment.....

I am very much looking forward to seeing many of you in Berlin in October. The PTMG Committee has again prepared a rather promising programme and I hope you will enjoy it. See you in Berlin!

**Frank Meixner**

### Moves and Mergers

**Ortrun Günzel** has left Taylor Wessing to join df-mp Dörries Frank-Molnia Pohlman in Munich, Germany. Ortrun can now be contacted at [ortrun.guenzel@df-mp.com](mailto:ortrun.guenzel@df-mp.com)

**Susan Proulx** has left Med-ERRS to join Leaderboard Branding in Philadelphia, USA. Sue can now be contacted at [sproulx@leaderboardbranding.com](mailto:sproulx@leaderboardbranding.com)

**Mireia Curell** can now be contacted at [mca@curellsunol.es](mailto:mca@curellsunol.es) following the formation of Curell Suñol SLP, Barcelona, Spain

**Felix Reimers** has left Advokatfirmaet Grette AS to join Advokatfirmaet GjessingReimers AS, Oslo, Norway. Felix can be contacted at [fr@gjessingreimers.no](mailto:fr@gjessingreimers.no)

**Patrick van de Vorst** has left Corsearch to join Hogan Lovells, Brussels, Belgium. Patrick can be contacted at [Patrick.vandevorst@hoganlovells.com](mailto:Patrick.vandevorst@hoganlovells.com)

**Maria Felix Troncoso** has left Troncoso y Caceres to join Felix & Co, Santo Domingo, Dominican Republic. Maria can be contacted at [mfelixt@felixco.com](mailto:mfelixt@felixco.com)

**Agnieszka Sztoldman** has joined Taylor Wessing, Warsaw, Poland and can be contacted at [a.sztoldman@taylorwessing.com](mailto:a.sztoldman@taylorwessing.com).

**Thera Adam-van Straaten** has left Kneppelhout & Korthals N.V. to join Eversheds Sutherland Netherlands B.V., Rotterdam, Netherlands. Thera can now be contacted at [theraadam@eversheds-sutherland.nl](mailto:theraadam@eversheds-sutherland.nl)

**Željko Topić** has left the European Patent Office and joined Topić IP Ltd in Zagreb, Croatia. Željko can be contacted at [ztopic@topicip.com](mailto:ztopic@topicip.com)

**Ganna Prokhorova** has left Pakharenko & Partners to join AEQUO, Kiev, Ukraine. Ganna can be contacted at [prokhorova@aequo.ua](mailto:prokhorova@aequo.ua)

**Helene Whelbourn** has left Ablett & Stebbing to join Lewis Silkin LLP, London, UK. Helene can be contacted at [Helene.whelbourn@lewissilkin.com](mailto:Helene.whelbourn@lewissilkin.com)

**Andrew Murch** has joined iLaw Solicitors Limited, London, UK and can be contacted at [Andrew.murch@ilaw.co.uk](mailto:Andrew.murch@ilaw.co.uk)

**Celia Li** has left Kangxin Partners to join Beijing Weiheng Law Firm, Beijing, China. Celia can be contacted at [celiali@wh-law.com](mailto:celiali@wh-law.com)

**Robert O'Connell Jr.** has left Fish & Richardson PC to join Orrick, Herrington & Sutcliffe LLP, Boston, USA. Robert can be contacted at [Robert.oconnell@orrick.com](mailto:Robert.oconnell@orrick.com)

**Michael Peroff** has joined Peroff Saunders PC, Chicago, USA and can be contacted at [Michael.peroff@peroffsaunders.com](mailto:Michael.peroff@peroffsaunders.com)

**Nils Wolfgang Bings** has left DWF Germany RA-gesellschaft to join PwC Legal AG in Düsseldorf, Germany. Nils can be contacted at [nils.wolfgang.bings@pwc.com](mailto:nils.wolfgang.bings@pwc.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 Gregorys Road, Beaconsfield, Bucks, HP9 1HZ

**Lesley Edwards**



## In Memoriam

### Sean Brosnan – PTMG Treasurer

On 6th August Sean Brosnan, the former PTMG Treasurer & Director sadly passed away after a short illness.

The three strongest attributes that shone through Sean's life, and in which he inspired all those whose lives he touched, are Sport, Fairness and Meticulous Attention to Detail.

Sean's enthusiasm for Sport was infectious to all those whose lives he touched – his knowledge of most sports was boundless. It's hard to single out any one sport as his favourite but three perhaps stood out more than others for his unique and special attention:

- Rugby Union - he was a passionate supporter of Ireland and Leinster;
- Golf - which he played as often as possible;
- Soccer - he was a lifelong supporter of Manchester United.

His passion for all three was unlimited but to get him talking on any sport was a pleasure. He was often to be found in Board/Committee Meeting breaks, or at Conferences during the Social Events talking to supporters or fans of other national teams or sides about the latest results or clashes if a Championship was in progress.

Indeed, when the Olympics came to London in 2012, Sean was The 'Go-To' source on who had struck Gold, Silver or Bronze in anything from the Triathlon to the Javelin; the Pole Vault to the Long Jump; even Beach Volleyball – he always knew who was playing, who was winning...and who was getting the wooden spoon.

In football (soccer), as a life-long Manchester United Fan, he could name every match, every player and the entire history of Old Trafford if ever you needed any statistics.

Equally, as a true Irishman his enthusiasm for Rugby Union was unstinting. He was an avid supporter for the British & Irish Lions – especially the Irish international players (The British & Irish Lions is a rugby union team selected from players eligible for any of the Home Nations – the national teams of England, Scotland, Wales and Ireland) and also for his home team in the Rugby Six Nations Championship. In

the recent years of 2014, 2015 & 2018, when Ireland prevailed as World Champions – he travelled regularly to the Aviva Stadium in his home town of Dublin to see his National side thrash the English, the Scots, the Welsh, the French or the Italians on home turf, as well as occasionally on their own turf at Twickenham (England), the Principality Stadium in Cardiff (Wales), Murrayfield in Edinburgh (Scotland), Stade de France in Paris or even the Stadio Olimpico in Rome (Italy).

His lifelong love of Golf too was another sport in which he excelled, in recent years as a popular member of Lambourne Golf Club in Burnham, with an admirable handicap. Equally as an avid follower of The Open, he was never to be torn from the TV coverage when this was in play.

I often felt that if he could have had his time again, he might have followed a different career path from his chosen profession of accountancy instead to his unparalleled love of sport. His innate tendency towards fairness and accuracy would have made him a highly successful Referee/Umpire or other Game Official, ultimately rising up the ranks to become a leading authority for World Rugby (who just happen to be headquartered in Dublin); for FIFA (Soccer) or for The International Golf Federation. At any of these Sean would have excelled on the Global Stage, I am sure.

Sean was appointed Treasurer of PTMG in 2003, not long after the Group became incorporated. This followed a Corporate Restructuring that had taken place in the late Nineties, under the direction of the Board and Management Committee, and the then Chairman, Alan Cox, who was also sadly taken from us in 2004. An accountant by training, Sean immediately set to work to ensure our Annual Report & Accounts were pulled together accurately and promptly each year. With his strong eye for detail, the costs and income for each and every conference were always closely monitored, DMC's (Destination Management Companies) were challenged and suppliers constantly checked out, always ensuring that they delivered the best possible value that could be secured. The cost savings he made through this approach has allowed us to create the best value conferences in the business to our delegates, whilst always providing enough in reserve to enable us to survive financially if the worst



should ever happen and we need to cancel a conference at short notice for reasons beyond our control.

Sean was also a strong advocate of the push to go paperless both for Conferences and for our newsletter LL&P, as well as streamlining the website, but none at the expense of quality and reputation which he always maintained as paramount.

All of this and more we have achieved to a great extent during his tenure as Treasurer of PTMG for the past 16 years and he will be sorely missed by all those he worked with but especially The Board, The Committee, our Members and our Delegates. Indeed, in the words of PTMG Founder and Honorary President, Derek Rossitter, one has 'the greatest respect for a man to whom the PTMG owes so much.'

Sean was born in Dublin and was schooled at the Franciscan run Gormanston College, in County Meath. He took a degree in business and marketing at UCD 'night school' whilst working during the day. He came to England in 1994 and settled there whilst maintaining strong links to 'The Emerald Isle' back home.

Sean's links to the Pharmaceutical Industry go back a long way – indeed his career history and that of his wife, a Past Chairman of PTMG, now Honorary Vice President and Company Secretary, Lesley Edwards, are almost a mirrored history of the Pharmaceutical Industry itself, having been through so many mergers & acquisitions themselves. In an early part of his career, Sean was appointed Finance Director of Sterling-Winthrop Ireland. In 1988, Sterling was acquired by the then photographic giant Eastman Kodak and five years later in 1993 Kodak/Sterling

Winthrop set up a Joint Venture (JV) with the French pharmaceutical company Elf Sanofi (now Sanofi Aventis). Just a year later, in August 1994, Kodak sold what was left of Sterling Winthrop, excluding the Sanofi JV but including its OTC (over-the-counter) drug business, to the British company SmithKline Beecham, which subsequently merged with Glaxo-Wellcome to become the Pharmaceutical giant GSK, we know today. Sean joined SmithKline Beecham but shortly after took early retirement and then set up a consultancy working with a number of pharma companies but in later years mostly with the GSK consumer healthcare business.

Sean's birthday was 19th March, which happens to be my birthday too, and many PTMG members will know that our Spring Conference dates often coincide with this – a fact that has not escaped the rest of the Committee and our Conference Organisers, over the years. This has resulted in some highly memorable events taking place on 19th March to commemorate our joint birthday in any given year. One such event took place at the Spring Conference held in Guernsey in 1996. Sean and I were sitting chatting at the same table for one of the lunches that year when a very large cake, which bore a close resemblance to a professional Chinese Firework, materialised in the hands of two waiting staff. It had so many candles on it (including some of the Roman Variety) we were unable to extinguish them between us. The Roman Candles then became showers of flames and sparks, so much so the fire alarms were triggered in the hotel, someone grabbed an extinguisher and we were all evacuated to the garden whilst the alarms were re-set and the cake extinguished. During the entire episode Sean remained calm, unfazed and unflappable whilst an air of panic descended briefly on the room. Those near him who were anxious were immediately calmed and that feeling then spread across the crowd which led to a text book evacuation. This is very much a reflection of Sean's relaxed and calming personality that put everyone at ease when he was present – something which I, and many PTMG members will carry in lasting memory of Sean.

Yet another illustration of Sean's engaging and infectious personality comes from one of PTMG's longest serving supporters and helpers, James Thomas, currently Trademarks & Copyright Counsel with Merck & Co Inc. who recalls the following incident, when he was working for Lesley at Glaxo at that time:  
'I had stopped by Sean and Lesley's home

to pick up Lesley on my way to work. Her car was in the garage (sic) or something and she had asked if she could catch a ride with me because I lived nearby. Well, I stopped in front of the house early that morning and Sean came bounding out of the house and hopped into my car. I'm sure I looked a bit surprised, but he introduced himself and explained that Lesley was running a bit late and he had come out to keep me company while we waited. He was both friendly and jovial and I enjoyed chatting with him. I still smile when I remember'.

These memories and tributes and many more like them, convey the respect that Sean commanded amongst his colleagues as well as his easy-going, affable nature which made such an impact on all those he met and worked with.

Lesley and Sean were married in 1998, when Lesley was Chairman, and so Sean became a regular on the Conference circuit from then on. In 2002 the Autumn Conference was held in Paris and Lesley & Sean had had their first child, Joshua in July that year. Lesley had just stood down as Chairman the year before and had been appointed Honorary Vice President earlier that year so needed to attend the Conference that Autumn. Many will remember Lesley and Sean as justifiably proud parents with Joshua as a very small baby, attending the Welcome Reception that year. Sean did a sterling job as babysitter throughout the Conference. At just 9 weeks old, Joshua remains the youngest ever registrant and attendee at a PTMG Conference. Two years later their second child Emma was born. Although she has not (yet) attended a PTMG Conference, I am sure she will at some stage in the future.

Sean, of course, was well practiced as a parent long before Joshua and Emma made their appearances in this world – he is also survived by his three other children – Michele and Ian both of whom live in Dublin, Ireland; Ross who lives in Melbourne, Australia - plus his five grandchildren, the youngest of whom was born, poignantly, in June this year just six weeks before Sean died.

Rest well & easy Sean, forever in our thoughts.

**Richard Heath**  
Director PTMG  
August 2019

*With thanks and acknowledgements to all those who contributed their memories of Sean to help compile this Obituary.*

What right have little I,  
Dear God, to ask  
of you the reasons for the  
self-imposed task  
you gave yourself when you  
created man and gave to each his  
allotted span to be determined  
solely by your mind divine whose  
workings far surpass a mind like  
mine.

I do but know dear God that your  
great plan involved the loss to us  
of this fine man but yours to give  
and yours to choose and ours to  
grieve and ours to lose a cherished  
friend we dearly loved grant him,  
dear God, your peace above.

**Derek Rossitter**

Founder and Honorary President PTMG

**A Reminiscence**

YES, thou art gone ! and never more  
Thy sunny smile shall gladden me;  
But I may pass the old church door,  
And pace the floor that covers thee.

May stand upon the cold, damp  
stone,  
And think that, frozen, lies below  
The lightest heart that I have  
known,  
The kindest I shall ever know.

Yet, though I cannot see thee more,  
'Tis still a comfort to have seen;  
And though thy transient life is o'er,  
'Tis sweet to think that thou hast  
been;

To think a soul so near divine,  
Within a form so angel fair,  
United to a heart like thine,  
Has gladdened once our humble  
sphere.

**by Anne Bronte**

# International Update

## AUSTRALIA

**Benjamin Kende, Emily Hong & Frances Drummond, Norton Rose Fulbright**

To mark World Intellectual Property Day, IP Australia released its seventh edition of the Australian Intellectual Property Report (Report). The Report provides a snapshot of the Australian IP landscape in 2018 by consolidating data, highlighting trends and critically analysing its future.

<https://www.ipaustralia.gov.au>

In its 2016 Inquiry Report into Australia's IP Arrangements, the Productivity Commission warned that trade mark 'cluttering' may be a potential problem. A trade mark register is 'cluttered' when it is crowded by unused or overly broad marks, which become costly and onerous obstacles for new applicants. In response to the Commission's inquiry, the government reduced the period before a trade mark is vulnerable to non-use cancellation from five to three years in February 2019.

However, the government may have been too quick to call in Marie Kondo. According to the Report, although there is an increasing number of 'cluttering' marks, they form only a small proportion of all active marks on the register. In reaching its conclusion, IP Australia analysed several factors explored below.

Although the number of marks removed for non-use have doubled in the last decade, they represent less than 0.1% of the total marks on the register, in line with the general trend noted above.

On the basis that single-word trade marks are generally considered more valuable to businesses (concise and memorable), IP Australia also investigated how many of the 1000 most popular words are registered as trade marks in Australia. They found that only 56% of the list were registered, compared to 86% in the US. This statistic seems to have been extrapolated to indicate that there are still a large number of one-word trade marks available for use and registration, and therefore a lack of cluttering, although this could be viewed as a questionable logical conclusion.

The Report acknowledges that the low rate of trade mark renewal after the first ten-year registration term, may indicate

the presence of trade marks in their ninth or tenth year, that are unused and therefore 'cluttering' the register. However, one could argue that this is adequately dealt with through the non-renewal of these registrations.

While IP Australia seems satisfied with the state of its trade mark register at present, it may consider the following strategies when it's time for tidying:

- reducing the non-use cancellation grace period further;
- reducing ten-year term of protection;
- requiring a 'statement of use' or 'intention to use' at time of application; and
- a Post Registration Proof of Use Audit Program, where randomly selected trade mark registrants are required to prove use of their mark (which its US counterpart launched in 2017).

## INDIA

**Simran Khetarpal, Chadha & Chadha**

Laboratories Ltd. v Ajanta Pharma Ltd. has taken a step ahead and demystified the test for deceptive similarity of marks in case of nutraceutical medicines.

The quintessential question decided by the Court was whether the test for infringement and passing off for nutraceutical products is the same as the test applicable for pharmaceutical products. The Court, while answering the question in the affirmative decided in favor of the Plaintiff and restrained the Defendant from using the mark GLOTAB, it being deceptively similar to Plaintiff's trade mark GLOEYE, both used in respect of nutraceutical medicines used to cure age related dimness of vision and diabetic retinopathy.

The Defendant laid major emphasis on having separate parameters or tests for deciding deceptive similarity between competing marks involving nutraceutical products as against those followed in respect of pharmaceutical products. The Defendant argued that nutraceuticals are not akin to pharmaceuticals and hence the stricter approach adopted by Indian courts time and again in determining deceptive similarity between competing marks for pharmaceutical products should


not apply in the present matter.

However, the Delhi High Court reaffirmed the need for adopting a stricter approach and dismissed the Defendant's plea observing that 'the mere fact that these products are nutritional food supplements or nutraceuticals and are not pharmaceuticals in the strict sense is not convincing enough for adoption of a less stringent test. Pharmaceuticals and nutraceuticals are used in respect of diseases and disorders. They are both meant to address specific ailments. Both these products are meant to improve the health of patients. The mere fact that nutraceuticals are termed so, as they contain ingredients derived from plants, does not mean that a lenient test needs to be adopted in respect of these products. The effects of the products and the consumers of the products all being similar in nature, the test applicable to pharmaceutical products would be applicable even to nutraceuticals.' The Court paraphrased the specific parameters as detailed in the decision passed by the Hon'ble Supreme Court in Cadila Health Care Ltd. v Cadila Pharmaceuticals Ltd. (2001) 5 SCC 73 and expanded the scope of operation of the relevant parameters to be applicable to nutraceutical products as well.

The Hon'ble Court with its said decision has yet again unequivocally demonstrated its intention that no amount of risk would be taken or encouraged, which has major impact or implication on public interest, especially their health and well-being. Further, the decision strengthens the belief of the brand owners in Indian Courts and protection accorded to the brand from any third party attempting to take unfair advantage of reputation gained among the relevant public in the medicinal field.

## POLAND

**Marek Lazewski & Krystyna Zurawska, Ladewski, Depo & Partners**

The Polish Supreme Administrative Court has issued a decision saying that there is no similarity between the Polish word-figurative trade mark  (vita-miner PRENATAL) and the word mark PRENATAL despite the fact that the

## International Update continued

goods are identical (among others pharmaceutical products). Notably, the Court also rejected the evidence for reputation of PRENATAL as it showed PRENATAL combined with other elements and used for various products of the same family.

### Background

Holbex LLC (the complainant) opposed the word-figurative trade mark vita-miner PRENATAL applied for goods in classes 3, 5 and 44 by Aflofarm Farmacja Polska LLC (the applicant). The opposition was based on the Polish word mark PRENATAL protected in classes 5 and 39. The opposition and further complaint were dismissed by the Polish Patent Office and the Regional Administrative Court respectively. In its Cassation complaint, Holbex LLC appealed the earlier judgments arguing that the trade marks in comparison are similar and that the trade mark PRENATAL should be considered as well-known. To prove its reputation, the complainant submitted, among others, advertising and promotional materials, data of sales volume and market share of several PRENATAL products available under the names: Prenatal Classic, Prenatal Complex, Prenatal DHA, Prenatal ProBaby, Prenatal UroCare, Prenatal DHA.

### Decision

The Polish Supreme Administrative Court rejected the view that a party may present evidence relating to the designations from the same family of trade marks when claiming reputation of the umbrella trade mark. The court expressly stated that the evidence presented in the case relates to trade marks other than Prenatal such as: Prenatal Classic, Prenatal Complex, Prenatal DHA. In consequence, the owner of the umbrella trade mark was not able to successfully prove the reputation of PRENATAL by showing evidence relating to PRENATAL combined with other elements, even if such additional elements could be claimed as descriptive.

The Court also found that the mark PRENATAL is similar to the designations providing general information of descriptive character since in at least three European languages the term relates to the pre-birth period. In consequence, the complainant should take into account that other entrepreneurs in the pharmaceutical industry have a right to mark their products with signs containing similar allusive elements if such elements indicate, for example, a type of disease, a

part of the human body, or a name of the chemical component of a pharmaceutical preparation. In such situations, the trade mark protection afforded is weakened and is limited to cases of obvious violation only.

### Comment

The current practice of the Polish administrative courts and the Polish Patent Office seems to be unfavorable to opponents since even a full incorporation of a prior trade mark is often considered insufficient for acknowledging the similarity of trade marks. In case of proof of reputation, the threshold seems to get even higher. However, the most surprising is that a family of trade marks may work against the trade mark owner who might not be able to prove the reputation of the umbrella mark if it is not used alone on the products.

### SERBIA

#### PETOSEVIC

On 6 March 2019, the Serbian Supreme Court of Cassation issued a decision stating that the trade mark holder is authorized to prohibit the transit of goods infringing their intellectual property rights through Serbia, and not only the import or export of such goods. This is the first ruling of its kind in Serbian practice, and is therefore significant because it is likely to influence future decisions related to goods in transit.

While the previous Serbian trade mark law explicitly prohibited the transit of goods infringing IP rights, the transit of goods through Serbia is not mentioned in the current trade mark law (in force as of 2013), which only prescribes that a trade mark holder can prohibit, among other things, the import or export of infringing goods bearing their trade mark. The Serbian Customs Law, on the other hand, prescribes that the import, export and transit of infringing goods are not permitted, and entitles customs officials to detain goods suspected of infringing IP rights in any of these cases.

On 25 November 2015, the Commercial Court in Belgrade ruled in favour of the plaintiff, a well-known sportswear company, in court proceedings against a Bosnian company that transported counterfeit goods through Serbia into neighbouring countries. However, on 23 August 2017, the Commercial Appellate Court decided that the rights holder cannot prohibit the transit of counterfeit

goods through Serbia because the trade mark law does not explicitly prohibit it. Even though the case went to the Supreme Court of Cassation, Serbian Customs had to release more than 5,500 infringing goods, because proceedings before the highest court do not postpone the execution of the lower courts' decision. However, the Supreme Court of Cassation eventually overturned the decision of the Commercial Appellate Court, ruling that the rights holder can prohibit the transit of goods infringing IP rights.

Until this decision, no Serbian court had argued that rights holders can prohibit the transit of counterfeit goods through the country. Customs authorities were therefore required to release goods in transit even if they were proven to infringe IP rights. This is the first time that a case regarding goods in transit reached the Supreme Court, allowing rights holders to invoke the ruling in their struggle against this type of trade mark infringement. While lower courts in Serbia are not obligated to follow the practice of higher courts, they rarely rule contrary to higher courts' decisions.

### SINGAPORE

#### Denise Mirandah & Yan Chongshuo, mirandah

Legislative amendments bringing broad-ranging reform to the intellectual property (IP) regime in Singapore were tabled before lawmakers in early July 2019, following public consultations in July 2017 and August 2018.

The IP (Dispute Resolution) Bill (the IP Bill) has the following overarching aims:

- (1) The consolidation of civil IP proceedings in the Singapore High Court, instead of multiple fora;
- (2) The introduction of new formal procedures in the grant of patents, namely,
  - (i) third party observations for patent applications; and
  - (ii) a post-grant patent re-examination process; and
- (3) Providing clarification that IP disputes may be arbitrated.

To note that, whilst these amendments cover all aspects of IP, this update refers exclusively to trade marks:

#### Consolidation of IP proceedings in the High Court

At present, civil IP disputes are heard in multiple fora including the Intellectual

# International Update continued

Property Office of Singapore, the State Courts, or the High Court depending on a multitude of factors that can hinder access to IP dispute resolution processes. The IP Bill aims to simplify this by granting the High Court exclusive jurisdiction of the following matters:

- (i) infringement of registered (i.e. patents, trade marks, registered designs) and non-registered (i.e. copyright) IP rights;
- (ii) passing off; and
- (iii) declarations of non-infringement of patents.

A summary of the proposed position with regard to jurisdiction under the IP Bill is set out below:

| Area of Law | Current Position   | Proposed Amendment under the IP Bill |
|-------------|--|--------------------------------------|
| Trade Marks | The High Court is the exclusive forum for hearing trade mark infringement actions. | No change                            |

## Arbitrability of IP Disputes

The IP Bill sets forth amendments to the Arbitration Act (Cap. 10) and the International Arbitration Act (Cap. 143A) to clarify that IP disputes can be arbitrated in Singapore.

The amendments further provide that the resulting arbitral award (and any judgment entered in terms of the arbitral award) binds only the parties to the arbitration and not third parties. In particular, an arbitral award does not affect the rights or liabilities of third party licensees and third party holders of security interests of the IP right in dispute.

## Comments

The IP Bill seeks to achieve laudable policy goals in both streamlining and expounding on the procedures available to enforce one's IP rights.

The consolidation of civil IP disputes in the High Court may result in the increase of legal costs in the short run compared to IPOS proceedings which are generally more cost-effective. Furthermore, the 'fast-track' litigation track last mooted in the October 2018 Public Consultation on IP Dispute Resolution Reforms, which aimed to reduce costs in IP proceedings in court, is conspicuously absent from the IP Bill.

That said, the consolidation of civil IP disputes in the High Court (along with future bills to introduce measures such as

'fast-track' litigation) may herald the beginnings of a dedicated IP court analogous to the UK Intellectual Property Enterprise Court.

## TAJIKISTAN

### PETOSEVIC

A law introducing amendments to the Tajik law on trade marks entered into force on 2 January 2019, bringing several important changes.

The Tajik IPO now publishes in its Official Gazette information on pending trade mark applications that passed the formal examination, which is carried out within a month from the date of filing. Any interested party may then submit a written opposition against the pending application between the moment of publication in the Official Gazette and the substantive examination, which is usually carried out 11 or 12 months after the formal examination. Before the new law, the Tajik IPO only published information on registered trade marks, while written oppositions were not officially provided for in the law.

Trade marks will not be registered if they are identical or confusingly similar to, or contain elements that are identical or confusingly similar to:

- Religious symbols;
- Flag, emblem or other state symbols;
- Abbreviated or full names of international, intergovernmental organizations, their emblems, flags and other symbols;
- Official control and guarantee marks, hallmarks, seals, and other marks or insignia (these elements may be included with a trade mark disclaimer, if the applicant has the consent of the authorized bodies);
- Industrial designs registered in Tajikistan before the priority date of the trade mark in question.

The previous version of the law only stipulated that 'generally accepted symbols and marks' could not be registered.

Finally, if a trade mark registration expires and a renewal request has not been filed, the trade mark will not be re-registered for a period of one year from the date of expiration in the name of a person other than the previous rights holder or legal successor (this period used to be three years).

## UZBEKISTAN

### PETOSEVIC

A resolution introducing the criteria for determining whether a trade mark is well-known entered into force in Uzbekistan on 2 July 2019.

While the Uzbek trade mark law implies that, in order to be recognized as well-known, a trade mark must be widely known among consumers in Uzbekistan as a result of its extensive use, until now there were no specific guidelines for establishing the well-known status.

According to the resolution, a well-known trade mark must be recognized in relation to the goods/services for which it is registered by the relevant public sectors including:

- Actual and/or potential consumers in Uzbekistan; or
- Persons involved in the distribution of the goods/services bearing the trade mark; or
- Business circles dealing with the type of goods/services to which the trade mark applies.

Furthermore, in order to be recognized as well-known:

1. The relevant sectors of the public must be able to recognize a certain quality of goods or services in connection with the trade mark;
2. The trade mark must have high inherent distinctiveness, or acquired distinctiveness resulting from its extensive use in Uzbekistan, including the use in domain names in the Uzbek country code top-level domain (ccTLD); and
3. The trade mark must have commercial value resulting from its continuous and extensive use.

Under the resolution, the Board of Appeal (BoA) of the Uzbek Intellectual Property Office (IPO) has been brought under the jurisdiction of the Ministry of Justice. The Minister of Justice is now the Chairman of the BoA. This measure was likely introduced to minimize the IPO's influence on BoA's rulings, and to ensure a more impartial review of appeals and observations.

# The new Argentine Trade mark Law in perspective

Iris V. Quadrio and Juan López Mañán, partners of Marval, O'Farrell & Mairal, Buenos Aires, Argentina.

In early January 2018, the Argentine trade mark environment was shaken up by a government issued emergency decree which introduced significant changes to the IP legislation, including trade marks, patents and designs. In May 2018, Congress passed Law 27444 which replaced the decree with all the same provisions.

These changes motivated the issuance of regulations by the Argentine Trade Mark Office (TMO) to manage the transition, including the implementation of the new administrative trade mark opposition procedure, followed by the government decree 242/19 regulating the trade mark law, which entered into force on 3 June 2019.

The new legislation changed the dynamic of proceedings and marked the first time that the trade mark law was modified since 1981. Major amendments were introduced, including:

- Administrative opposition system: under the previous legislation, the Argentine unique opposition system included a long negotiation phase and a pre-trial mediation phase. In the absence of a settlement, the applicant had no choice but to file a full court action before a Federal Court to avoid the abandonment of the mark. This system was replaced by a more simplified administrative proceeding before the TMO, with the possibility to appeal the Trade Mark Office decision directly to the Federal Court of Appeals;
- Mid-term declaration of use is required between year five and six of the registration, in addition to the declaration of use for renewal purposes;
- Cancellation actions: the TMO will now decide on non-use cancellation actions and on cancellation actions based on absolute and relative grounds.;
- Partial non-use cancellation is now allowed;
- In line with existing case-law, shapes and colour marks that acquired secondary meaning will be excluded from the list of non-registrable marks by the TMO.

## New trade mark opposition process

Under the former system, the burden of prosecuting an application lay on the applicant, who was granted a one-year term (which in practice was almost two years) to try to reach an amicable settlement with the opponent. In the absence of an agreement, and to avoid the application from becoming abandoned, the

applicant had to complete mandatory pre-trial mediation proceedings and, if unsuccessful, take the case to court.

The balance of power under the old opposition system was tilted in favor of the opponent.

On 18 July 2018, the TMO issued Resolution P-183 setting out the new administrative procedure for resolving trade mark opposition disputes, under the following rules:

- After service of notice of the opposition, the applicant will have a 3-month term to negotiate a settlement with the opponent. If the parties fail to reach an agreement upon expiration of this term, and once the official file of the opposed mark comes up for examination, the TMO will serve notice to the opponent, who will have a 15-working day term to ratify the opposition, submit additional arguments and evidence, and pay an official fee (USD \$200 at the current exchange rate) to keep the opposition in force. In case of multiple oppositions, separate ratification briefs must be submitted. Failure to pay the official fee will result in the termination of the opposition proceedings and the TMO will treat the opposition as an informal objection and will resolve the case without further intervention from the opponent;
- If the opponent ratifies the opposition, the TMO will notify the applicant of any briefs and evidence submitted by the opponent. The applicant will have a 15-working day term to file counter arguments and submit evidence to support the response;
- Evidence: Resolution P-183 clearly indicates that the supporting evidence must be filed by the opponent when ratifying the opposition or by the applicant when filing a response to the opposition. The TMO will not admit new evidence that was not timely filed by the parties and will review and assess any non-documentary evidence and reject any unwarranted or redundant evidence. The TMO decision admitting or rejecting evidence may not be appealed before the TMO, but the parties may attempt to introduce the evidence in the appellate stage before the court;
- Closing arguments: once the production of evidence has been completed, the parties will have ten-working days to submit final arguments. At this stage the parties may resort to mediation, conciliation or other alternative dispute resolution proceedings to settle the opposition;

- After the parties have submitted the closing arguments, the TMO will decide on the merits of the opposition. The TMO's decision may be appealed, within 30 working days, before the TMO will then submit the case to the Federal Court of Appeals.

The introduction of the above described new opposition proceedings marks a radical change in the prosecution of oppositions, which for over a century were decided by the courts rather than by the TMO. In particular, the burden of prosecuting an opposition has shifted from applicants to opponents, who tend to be more proactive and take the lead to negotiate and, more importantly, must now pay an additional official fee if they wish to keep the opposition in force. This has had a negative impact on the number of oppositions filed, which dropped by around 38% in 2019, according to a projection elaborated by the TMO.

Almost one year has passed since the new oppositions system became operative. The TMO is accelerating the rate of notifications to opponents and applicants and is trying to expedite the opposition dispute process as much as possible.

According to an official report, over 30% of the oppositions (approximately 3000) have been ratified by the opponents so far. Taking into account that the new team of examiners exclusively assigned to handle the opposition process consists of 6 new examiners, local practitioners have started to alert the TMO that, unless new examiners are hired and trained and more technical resources are assigned to the TMO, the current team will not be able to issue decisions in a timely fashion.

## Mid-term declarations of use

Under the new law trade mark owners must file a sworn declaration of use between the 5th and 6th year of the registration, subject to the payment of an official fee and a penalty fee for late filing. Failure to submit this declaration will lead to the presumption of non-use but will not result in the automatic cancellation of a trade mark registration. Last but not least, the TMO will not prosecute trade mark renewals until the mid-term declaration of use has been filed.

## Non-use cancellation and invalidity actions

The new law has transferred the authority of resolving non-use cancellation and invalidity actions from the Federal Courts to the TMO and introduced partial non-use cancellation actions.

Under the previous law, use of a mark on one product or service, even in a different class, or as part of a trade name was



enough to repel a non-use cancellation action, which allowed the proliferation of defensive marks. The new law has set a more stringent use standard; to avoid lapsing, a trade mark must be used in connection with the goods and services covered by the trade mark or in connection with related goods or services, even if they belong to a different class. Although the TMO has not yet issued the procedural rules for non-use cancellation and invalidity actions, according to the regulatory decree of the Trade Mark Law, the general rules of the Administrative Procedure law will be applicable until the TMO issues a special proceeding.

### Trade mark renewal

No changes have been introduced to trade mark renewals. Applicants must still continue to submit a sworn statement of use indicating that the mark has been used within the five years preceding the renewal expiration date and specifying the goods or services on which it was used. Use of a mark for goods or services in a different class is valid to renew such mark in another class. However, according to the new rules, if the mark has not been used in relation to the goods or services covered by the registration or on related goods or services, it will be at risk of partial cancellation for lack of use. The TMO has also allowed the renewal of trade marks within 6 months prior to the expiration of a registration or up to 6 months after the expiry date.

### Final thoughts

More than a year has passed since the new law was issued and in general, the changes have been well received by the trade mark community as most amendments appear to be positive and are in line with international standards.

At an operational level, the TMO is working to shorten the prosecution of straight forward applications, and we should begin to see some progress in the coming months.

On the opposition side, we are at the initial stages of the process as the TMO has not issued any decisions so far, although they anticipated that they will follow the principles derived from existing court decisions.

Nevertheless, despite the fact that implementation of the new law took longer than expected, we remain optimistic once processes are streamlined and more resources are assigned to the TMO. Overall, the benefits of the new system will translate into a reduction of prosecution costs and a simplification of opposition, cancellation and invalidity proceedings, thus upgrading and modernizing the Argentine trade mark system.

## Can sedative tablets acquire a reputation?

Tomasz Szambelan, Kochanski & Partners, Poland

On 19 March 2019 the Administrative Supreme Court (SAC) issued an award in the case between BIOGARDEN TABLETKI USPOKAJAŃCE and TABLETKI USPOKAJAŃCE LABOFARM which requires a reconsideration of all evidence by the Polish Patent Office (PPO) and a comprehensive assessment of all relevant circumstances affecting the risk of confusion, including whether the earlier trade mark is a trade mark with reputation.

The case is relevant because it concerns trade marks which contain the word elements 'sedative tablets'. In addition, the word element LABOFARM is an element of the opponent's company name and the BIOGARDEN element is very similar to the word BIGGARDEN, which is also an element of the opposing company name.

### Background

On 12 March 2014 the PPO granted protection to BIGGARDEN Sp. z o.o. for the word mark BIOGARDEN TABLETKI USPOKAJAŃCE for goods in Class 5. On 29 September 2014, the opponent (LABOFARM) filed an opposition, indicating that he had a right of protection for the word mark TABLETKI USPOKAJAŃCE LABOFARM also for goods in Class 5. The opponent had been operating on the market since 1988 and had been marketing a renowned medicinal product with the same name for 20 years. According to the opponent, the compared trade marks were used to designate similar goods and the compared trade marks were similar. What's more, in the 1980s, the term 'sedative tablets' could be regarded as generic to indicate use of a medicinal product but after a period of uninterrupted use for the last 22 years, that term had acquired secondary meaning. LABOFARM pointed out that until 2013 there was no product on the market other than its product marked in this way.

The opponent also argued that the contested trade mark takes advantage of the reputation of the opposing trade mark; that the contested trade mark had been applied for bad in faith and finally that BIOGARDEN TABLETKI USPOKAJAŃCE may be misleading to the relevant public. The PPO dismissed the opposition. In the opinion of the PPO, the compared trade marks have different elements, and the identical term TABLETKI USPOKAJAŃCE contained only a general informational element, which for the relevant public will be information about the product, its type and intended use. The term BIOGARDEN in the contested trade mark does not evoke the term LABOFARM in the opposing trade mark. Those elements constitute imaginative and distinctive elements in the compared trade marks and determine their distinctive character. Furthermore, the PPO pointed out that the opponent had not proved that the term sedative tablets had acquired a

secondary meaning. In the opinion of the PPO the opponent does not have a registered trade mark in these words as TABLETKI USPOKAJAŃCE does not have any distinctive character. In addition, the PPO held that there were no grounds for considering that the application had been made in bad faith.

An action to the Administrative Court was brought by LABOFARM. This first instance Court held that the PPO had not made an incorrect assessment of the similarity of the trade marks. However, it found that the PPO had failed to carry out a complete analysis of the evidence and, as a result, failed to fully establish the risk of confusion as a fundamental ground for invalidation of the contested trade mark. The PPO failed to analyse the evidence relating to the reputation of the opposing trade mark with the earlier priority. Consequently, the Court reversed the contested decision.

### The award of the SAC

The owner of the trade mark BIOGARDEN TABLETKI USPOKAJAŃCE brought an action to the SAC. The court stated that the action could not be upheld because it lacked justified grounds. The SAC agreed that the PPO had failed to analyse the evidence concerning the reputation of the opposing trade mark. A correct interpretation of the provisions referred to requires, at the outset, that it be determined whether the earlier trade mark has the status of a trade mark with a reputation and, if so, that the similarity be assessed using other, much more mild criteria.

Moreover, in the opinion of the SAC, the facts of the case were not established in a correct and exhaustive manner by the PPO. Following the Court's award, the case must be re-examined by the PPO.

### Conclusion/Comment

Now the PPO must examine whether TABLETKI USPOKAJAŃCE LABOFARM is a trade mark with reputation. Undoubtedly, proceedings before the PPO are entering the most interesting phase because establishing the reputation of the opponent's trade mark will require the opponent to collect and present necessary evidence.

At the same time, it should be stressed that the aforementioned judgements do not directly refer to the fundamental issue of whether a word mark such as TABLETKI USPOKAJAŃCE LABOFARM should be registered as a trade mark at all. It is also questionable whether a trade mark containing the term 'sedative tablets' could acquire a reputation. If the PPO decides that the trade mark TABLETKI USPOKAJAŃCE LABOFARM cannot be deemed as a trade mark with reputation, it would undoubtedly be disadvantageous for the opponent.

# A little evidence can do a lot.

Allister McManus & Chris McLeod, Elkington & Fife LLP, UK

The UK Intellectual Property Office (UK IPO) has upheld an application for a declaration of invalidity confirming a likelihood of direct confusion between the marks Cephalus and CEPHALON in class 5.

<https://www.ipo.gov.uk/t-challenge-decision-results/o43819.pdf>

This decision is notable for the Hearing Officer's (HO) assessment of the case law and principles relating to genuine use, particularly EU trade mark (EUTM) registrations, and the standards of evidence that the UK IPO will accept to demonstrate genuine use and a reputation under section 5(3) of the Trade Marks Act 1994 (TMA 1994).

## Background

Cephalon, Inc. (the invalidity applicant) filed an application for a declaration of invalidity (invalidity application) under Section 47 of the TMA 1994 against a UK trade mark registration for the mark Cephalus owned by Mohammed Aslam (the UK trade mark owner), based on the invalidity applicant's earlier EUTM registration for the mark CEPHALON.

The UK trade mark owner's later registration for Cephalus covered class 5 'Pharmaceutical preparations and substances; Pharmaceutical preparations for human use'. The invalidity applicant's earlier EUTM registration for CEPHALON covered a broad range of goods in classes 5 and 42, namely, 'pharmaceutical and veterinary preparations'. However, the invalidity applicant stated that it had only used the mark on 'pharmaceutical preparations' and 'pharmaceuticals, bio pharmaceutical, and speciality pharmaceuticals for use in human medicine'.

The invalidity applicant argued that there was a likelihood of confusion under Section 5(2)(b) of the TMA 1994, because the marks CEPHALON and Cephalus were similar and covered identical or similar goods and services. The invalidity applicant also argued that its earlier EUTM registration for CEPHALON had a reputation under Section 5(3) of the TMA 1994 in relation to 'pharmaceutical preparations' and 'pharmaceuticals, bio pharmaceutical, and speciality pharmaceuticals for use in human medicine'. The later UK registration for

Cephalus would therefore take unfair advantage of, or be detrimental to the distinctive character and/or repute of its earlier EUTM registration.

The UK trade mark owner filed a counter-statement denying the invalidity applicant's claims and requested that the invalidity applicant provide proof of use of its earlier EUTM registration which had been registered for more than five years before the date of the invalidity application.

The invalidity applicant filed evidence and evidence in reply in the form of witness statements and exhibits, which included evidence of use purporting to show that the mark CEPHALON had been in use in the UK since 1987, namely, pictures of the mark on various pharmaceutical products and UK sales and accounts figures. The UK trade mark owner filed submissions arguing that the invalidity applicant's evidence was insufficient to demonstrate proof of use of the earlier CEPHALON mark. The UK trade mark owner also argued that there was a discrepancy in the invalidity applicant's evidence regarding the ownership of the invalidity applicant's UK company, which meant the invalidity applicant could not rely on the evidence of use. The UK trade mark owner also argued that the product images did not demonstrate genuine use because the packaging showed use of another mark in addition to CEPHALON, and that CEPHALON merely identified the medical license holder.

Neither party requested a hearing, and opted instead to file written submissions in lieu of a hearing. The HO therefore based the decision solely on the papers filed by the parties.

## Decision

The HO provided a detailed analysis of the law governing sections 47, 5(2) and 5(3) of the TMA 1994, and a detailed analysis of the invalidity applicant's evidence and evidence in reply, the parties' submissions and the case law and principles relating to genuine use.

The HO referred to Arnold J's summary of the case law and principles relating to use in *Walton International Ltd & Anot v Verweij Fashion BV* [2018] EWCH 1608 (Ch) (28 June 2018). As the invalidity

applicant was relying on an EUTM registration, the HO also referred to the territorial scope for use of an EUTM noted in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11. The HO then noted Arnold J's subsequent review of the case law following *Leno* in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, and the differing approaches taken to the question of what geographical extent is necessary to show genuine use of an EUTM registration. The HO stated that it 'will depend on whether there has been real commercial exploitation of the EUTM...sufficient to create or maintain a market for the goods...in the Union...'. In paragraph 45, the HO confirmed that 'use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient'.

The HO dismissed the UK trade mark owner's argument that the evidence of use could not be relied upon, noting that the evidence and evidence in reply had shown a clear relationship between the invalidity applicant and the UK company. There was clear 'consent' under section 47 (2B) of the TMA 1994, which did not need to be formalised or documented.

The HO noted the case of *Collosum Holdings AG v Levi Strauss & Co.*, Case C-12/12, as 'sound law' regarding whether use of a mark in a different form constitutes genuine use. The invalidity applicant's use of the CEPHALON mark as a word or in combination with a device was therefore acceptable and it could rely on this use.

The HO then dismissed the UK trade mark owner's argument that use of two marks on product packaging did not amount to use of CEPHALON. The HO confirmed that 'a business is not limited to using only one trade mark on their goods', and 'it is not uncommon for businesses to use their house mark on all goods...and to use secondary marks to identify sub-brands...'.

As to whether the invalidity applicant had shown genuine use of the earlier CEPHALON mark, the HO confirmed that the evidence showed a list of products and total sales which amounted to several million pounds. However, the

## OBITUARY: David Tatham

HO noted that the evidence was 'far from complete', as there were no invoices or images of products bearing the mark that could be identified within the relevant use period. Nevertheless, the HO was satisfied that the invalidity applicant had done enough to demonstrate use in the UK, which the HO noted was sufficient for an EUTM. The HO then went on to decide a fair specification and noted that the invalidity applicant's product descriptions - tablets or creams for the treatment of particular conditions in humans - fell within the meaning of 'pharmaceutical preparations'. Based on the evidence, the HO was satisfied that a fair specification was class 5 'pharmaceutical preparations; pharmaceuticals for use in human medicine'.

On this basis, the HO analysed the section 5(2)(b) case, and unsurprisingly, considered the marks CEPHALON and Cephalus to be visually and phonetically similar to a high degree and conceptually neutral. The HO noted that the marks coincided in the first six letters CEPHAL, and referred to the important principle established in *El Corte Ingles, SA v OHIM, Cases T-183/02 and T-184/02* that 'the beginnings of marks tend to make more impact than the ends'. The HO found the respective class 5 goods to be identical, citing *Gérard Meric v OHIM, Case T-133/05*, and determined that the average consumer, i.e. medical professionals and members of the general public, would pay a medium degree of attention to the class 5 goods. The HO also determined that the invalidity applicant's earlier mark had a high degree of distinctive character. There was therefore a likelihood of direct confusion, as the marks would be 'mistakenly recalled as each other'.

As the invalidity applicant had succeeded on the first ground, section 5(2)(b), the HO was not required to consider the 5(3) reputation ground. Nevertheless, the HO confirmed that whilst the invalidity applicant's evidence was sufficient to demonstrate genuine use, it fell short of demonstrating a reputation under section 5(3), particularly as it contained no articles or advertising campaigns referring to the CEPHALON mark, or any information on market share.

As some of you may have read, David Tatham OBE, one of the founders of the PTMG, sadly passed away on the 4th of July.

I had the pleasure and honour of working with David between 1985 and 1991 and witnessed first-hand his considerable contribution to the international world of trade marks.

David began his career in private practice, before moving to The Wellcome Foundation and then to Imperial Chemical Industries (ICI), where he became Head of the Trade Marks Department and continued in that role until he retired in 1994.

ICI, often described as the bell weather of British Industry, boasted a significant pharmaceutical division. Such was the success of the pharma business that it was spun out in 1993 to form Zeneca, which in turn quickly merged with Astra AB to become Astra Zeneca Plc. The pharmaceutical industry looked very different then, with many more players, but David seemed to know everyone and he had an uncanny knack of being able to resolve most conflicts. He always said that PTMG meetings were a key forum for settling disputes.

Another of David's great skills (and he had many) was to see the bigger picture. This was never more evident than in relation to the work he did to harmonize the national trade mark laws of the EU member states, the creation of the then Community Trade Mark Regulation and the Madrid Protocol. His ability to negotiate and articulate the greater vision no doubt contributed significantly to the WIPO, EU and domestic legislation that followed and so many of us still rely on.

David's skills as a leader, visionary and someone who could make a difference were recognised elsewhere and during his illustrious career, he also served as:

- President of European Communities Trade Mark Association (ECTA)
- President of the Trade Marks Patents and Designs Federation (TMPDF)
- Director of INTA
- Chairman of the trade marks working group of the Union of Industrial and Employer Confederations of Europe (UNICE)



- Chairman of the trade marks working group of the Confederation of British Industry (CBI)
- Member of the Council of the then Institute of Trade Mark Attorneys (ITMA),

In 1994 he was awarded the Order of the British Empire (OBE) by the Queen for services to industry.

Following his retirement from ICI, David continued to be active in the IP world, as an arbitrator for domain name disputes at WIPO and Nominet as well as acting as a consultant for WIPO, promoting the use of IP in developing countries.

Whilst David gave his all for ICI and the trade mark world, his first love was always his family. David's numerous roles (combined with the fact that the internet was yet to be invented) meant that he was often required to be overseas. Wherever possible David would travel with his beloved wife Jen. They were inseparable and celebrated their 58th wedding anniversary earlier this year.

David was a consummate professional, a loving husband and father and a true gentleman.

**Mark Foreman**

Osborne Clark LLP

*Photo reproduced courtesy of CITMA*

# PROFILE: Eva Borgen

PTMG committee member Eva Borgen is Associate General Counsel and heads up Corporate Trade Marks at Novo Nordisk A/S and is overall responsible for the management of the global trade mark portfolio, including strategy, protection and enforcement. As such, Eva is the legal business partner in the creation and development process of new product brands. Previously, Eva was in-house trade mark counsel with dairy producer Arla Foods. Before that she was in private practice with IP consultants Plougmann & Vingtoft joining from a position as trade mark examiner at the Danish Trade Mark Office. Since 2012 Eva has been a member of the Danish Board of Appeals for Patents and Trade Marks.



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

Copenhagen & Copenhagen University, spending 6 years as a young girl in England, my father being an ex-pat with Ford Motor Company.

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

By chance! A girlfriend had just got a job at the DK Trademark Office and convinced me that it was so much fun!

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

I nearly became an IBM business consultant.

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

Witty, empathetic and analytical.

## **Complete the following sentence:**

### **"I wish that ..."**

I had started playing golf earlier"

## **What was (were) your best subject(s) at school?**

Maths and Physics.

## **What do you do at weekends?**

Golf, see friends and family, biking in Copenhagen – in all-day rains Netflix.

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

I attend yoga classes touching my toes with ease.

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

After my colleagues, the satisfaction of helping the company market our lifesaving products under great brands.

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

No idea – too busy playing.

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

Frits Zyberg's painting 'Spring' the tree blossom is breath-taking.

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

Must be the first LP I bought: Billy Joel 'The Stranger'.

## **What is the best age to be?**

Must be my thirties – fun and on track.

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

Don't spend time and energy on things you cannot change.

## **What car(s) do you drive?**

VW Up! GTi – It's fun!

## **Whom do you most admire and why?**

My husband – our 30th anniversary is coming up soon and he still makes me laugh!

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

'Shackleton: By Endurance We Conquer' by Michael Smith.

## **Which sport do you play and/or enjoy?**

Golf and yoga.

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

The one around the corner Mondän.

## **What's the best invention ever?**

The discovery of vaccines since they have (and hopefully will) eradicate dangerous illnesses and antibiotics (and I hope our industries try harder to invent new ones!)

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

Pink gin – at the moment.

## **What's your favourite mode of transport and why?**

Being a Dane must say bike.

© 2019 The Pharmaceutical Trade Marks Group

Circulated for information only to PTMG Members. The Group takes no responsibility for the contents

Editor: Vanessa Parker

Tel.: +33 679 316 860 email: vparkercordier@wanadoo.fr