Law Lore & Practice

PTMG Pharmaceutical Trade Marks Group

Dec 2021

Editorial: What next?

As 2021 draws to a close, it is tempting to hope that the New Year will bring back normality as we remember it. However, as OMICRON wreaks havoc with everyone's plans for the festive season, we would be wise to try to retain a sense of realism for the future. A sense of realism that is nevertheless hard to retain as waves of news break across the airwaves every day. During a recent seminar for parents held within our schools, we learnt that the single most important action we can do to help reduce collective anxiety is to turn off the news.

Another powerful measure is to step outside. An October 2021 study published in the Journal 'People and Nature' reinforces what we already knew – that the mental health of children who connected to nature during lock-down fared better. Looking to the future, we must remind ourselves that the recommended 60 minutes of moderate physical activity and 120 minutes of being surrounded by nature per week really do make us feel happier.

It is our collective responsibility to ensure that all children have access to such a basic human right.

The Royal Horticultural Society leads the way in the UK to help fund local community projects to enhance green spaces and gardens. Not everyone can walk far but we can all enjoy the peace and tranquillity that being surrounded by nature provides. Last month's COP26 commitment from more than 130 countries to agree to halt and reverse deforestation by 2030 brings hope for future generations too.

Wherever you are, whichever natural environment surrounds you, take time to enjoy over the festive season.
The PTMG Committee and Chair join me in wishing you a happy, healthy 2022.

Vanessa

US Update

Jonathan S. Jennings

Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP

The Trademark Trial and Appeal Board (TTAB) recently found confusion to be likely between Opposer's mark SNORE[MD] and Applicant's mark SNORE DOCTOR, both for medical devices that treated snoring. James S. Fallon v Brown Innovation, LLC, 2021 WL 5196463 (TTAB 2021)(non-precedential). https://ttabvue.uspto.gov/ttabvue/v?pno=91252488&pty=OPP&eno=16
While superficially straightforward, the case identifies potential pitfalls to avoid when submitting evidence, and highlights the impact of inconsistent prior statements in other applications.

The TTAB initially found Opposer had established priority through common-law use, despite having no registration of the SNORE[MD] mark. The parties' goods were legally equivalent and there was no restriction in their channels of trade that would distinguish them in the marketplace.

Applicant attempted to show Opposer's SNORE[MD] mark was conceptually weak, with a narrow scope of protection, by submitting 12 third-party registrations of marks containing 'snore' for similar devices. However, the TTAB rejected this evidence because it was not submitted during the trial period. Submitting it afterwards in Applicant's trial brief was too late and, therefore, the TTAB did not consider this evidence. This error may have had an impact on the outcome, as the TTAB commented on the dearth of evidence, including a lack of evidence about the actual use of third-party marks.

In attacking the strength of the mark, Applicant also argued that 'MD' in Opposer's SNORE[MD] mark was an abbreviation of 'medical device,' and that Opposer's entire mark therefore meant snore medical device. Thus, it argued, the mark was completely descriptive and weak. The TTAB rejected these arguments, relying on how consumers would perceive SNORE[MD] by analyzing Opposer's mark, as actually used with its goods, and dictionary definitions. Ultimately, the TTAB found 'MD' suggestive of curing or treating snoring using Opposer's products.

The meaning of 'MD' came up again when the TTAB considered the similarity of the marks. Applicant claimed 'MD' could mean different things - differentiating the parties' marks - as it might not mean medical doctor. For example, it might signify to consumers that this is a medical device that has achieved FDA approval. In support of its position, Applicant turned to Opposer's own inconsistent statements in an Office Action response submitted in a prior and unsuccessful attempt to register SNORE[MD] which Opposer ultimately abandoned.

In that Office Action response, Opposer had attempted to overcome a likelihood of confusion objection based on the mark SNOREDOC for similar products.

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Words from the Chair

Here comes the end of 2021 and in some areas of the world a feeling of déjà-vu emerges. Increasing number of Covid-19 cases and respective restrictions are being implemented. Many of us feel tired and demotivated and even if we have been lucky not to experience losses in our closer circles of family, colleagues or friends, the pandemic continues to burden us. Earlier this year some of us started to attend face-to-face meetings, unfortunately the PTMG Autumn conference had to take place once more under the PTMG@home format. Happily, many of you joined us and showed your continued support to our organization by doing so.

As the holiday season is approaching which is normally a time of fun, family reunions and laughter we also experience tensions related to the pandemic regarding the uncertainty it creates and social expectations we hold towards each other.

My takeaway for this year is still a positive one when looking at our profession in our respective fields. Our industry continues to have the unique opportunity to transparently show all the efforts undertaken to protect patients and consumers and to deliver groundbreaking innovation. Trade marks and its related areas of responsibilities are an essential part of these endeavours across geographies.

Due to our strong networks, of which I consider PTMG to be an important one, we continue to leverage relationships at in-house, outside counsel and stakeholder level to achieve our objectives and contribute to the overarching objective.

I'm hopeful that 2022 may bring a better management of the pandemic and the opportunities for face-to-face interactions. In the meantime, I wish you a very happy holiday season and all the best for 2022 – first and foremost good health!

Myrtha Hurtado Rivas

Members News

New Members

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

Anna Jarques from H&A, Barcelona, Spain ajarques@herrero.es

Daria Labut from Petošević, Moscow, Russia daria.labut@petosevic.com

Ashveena Lenz from Urovant Sciences GmbH, Basel, Switzerland ashveena.lenz@urovant.com

Nelson Biedma from Estudio Berbery, Buenos Aires, Argentina nbiedma@estudioberbery.com

Jennifer Sirop from Addison Whitney a Syneos Health Company, Charlotte, USA jennifer.sirop@syneoshealth.com

Annick Staudenmann from Ferring International Center S.A., St-Prex, Switzerland annick.staudenmann@ferring.com

Juli Hopf from Spoor and Fisher, Centurion, South Africa j.hopf@spoor.com

Alex Borthwick from Powell Gilbert LLP, London, UK alex.borthwick@powellgilbert.com

Joanne Gibbs from Wiggin LLP, London, UK joanne.gibbs@wiggin.co.uk

Moves and Mergers

Priya Rao has left K & S Partners to establish her own firm, Priya Rao & Associates in Haryana, India. Priya can be contacted at priya@priyaraoassociates.com

Toni Santamaria has left Accord Healthcare to join Adalvo and can now be contacted at toni.santamaria@adalvo.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 or directly to Lesley@ptmg.org or by writing to me at Tillingbourne House, 115 Gregories Road, Beaconsfield, Bucks, HP9 1HZ

Lesley Edwards
PTMG Secretary

US Update Continued

In other words, a third-party registration for SNOREDOC blocked Opposer's prior application to register. Opposer had asserted that the use of 'DOC' and 'MD' may not signify the same thing. Further, Opposer had stated that the differences in the parties' marks made confusion unlikely in the crowded field of snore marks. Opposer specifically stated that the use of 'MD' in its mark 'is a designation that the product is a FDA registered Medical Device, not medical doctor'.

The TTAB noted that while these prior statements would not constitute estoppel, barring Opposer from taking a different position here, they were admissions and admissible evidence that it would consider. Despite these admissions however, the TTAB emphasized that it had to make the final determination on the meaning of the marks at issue no matter what the parties asserted. Ultimately, the TTAB held that the reference to 'MD' in Opposer's mark would be perceived by consumers in the marketplace as referring to medical doctor and not medical device. Thus, both marks conveyed the 'idea' of a doctor helping to treat snoring. With this issue resolved, the TTAB sustained the opposition.

Pharma companies should be careful about what they argue in Office Action responses as these statements may be used as admissions in TTAB or court proceedings should the company refile an application to register the mark or attempt to enforce it later (as was the case here). In this dispute, Opposer was quite fortunate to win the case after taking a very different position in prosecuting an earlier-filed application. This success may have been due in part to Applicant's failure to timely submit evidence of third-party registrations in the trial period, and evidence of how consumers actually perceived the marks in the marketplace.

Overall, the short-term goal of overcoming an objection from an Examining Attorney in a pending application must be weighed against how those statements may impact efforts to enforce the mark in the future. In some cases, it may be better to forgo such arguments and abandon the application, if preserving future enforcement options based on common-law rights might be more important.

UK case law round-up

Suzanne Power, AA Thornton

With the UK IPO having seen record numbers of trade mark applications over the past year, a steady stream of objections, oppositions and cancellation proceedings has followed. Here is a round-up of some of the UK IPO's latest decisions on trade marks applied or registered for pharma goods and medical devices.

Watch out for misleading marks

Purcotton 全棉时代

met with objection on the basis that the mark could deceive consumers. The examiner held that the mark would be perceived to mean that the goods applied for (which included medical masks, and cushions and gloves for medical purposes, among other items) were made from pure cotton, and so consumers would be misled if it transpired that the goods were made from other materials.

In this case the applicant was able to overcome the objection by limiting the list of goods to indicate that they are all made from cotton, but this option may of course not be suitable in all cases - e.g. if the mark was not intended to refer to the goods, and does not accurately describe their nature. Caution therefore needs to be taken when selecting a mark to ensure that if it does refer to potential qualities of the goods, the reference is accurate (but that it also does not render the mark exclusively descriptive, which may give rise to an alternative objection).

There is also a reminder here that the use of a non-standard spelling or a misspelling of a word will often not suffice to avoid an objection based on the perceived meaning of the word. The examiner did not appear to have any doubt in this case that consumers would recognise PUR as meaning PURE.

Slogans remain difficult (but not impossible) to register

These two unrelated decisions underline some of the difficulties in securing registrations for marks that are intended to be used as promotional slogans.

The mark 'Sex made simple.' was applied for in relation to goods such as personal sexual lubricants in class 5 and adult stimulation aids in class 10. The mark was refused, on the basis that it fulfils a 'purely marketing function, indicating that the goods will facilitate the simplification of sexual activity'. According to the examiner, this would preclude consumers from recognising the mark as an indicator of commercial origin.

A similar objection was raised against a subsequent application for SELFCARE IS THE NEW HEALTHCARE in class 10, with the Examiner finding that the mark would 'merely be seen as a non-distinctive statement, informing the consumer that taking actions to improve one's health has replaced the need for the organised provision of medical care'. However, it is interesting to note that the objection only affected the medical devices applied for – e.g. pulse oximeters and blood pressure monitors. It did not extend to the applicant's sex toys or condoms, which the Examiner presumably felt did not have a sufficiently direct link to the perceived message behind the mark for the objection to apply.

The question is therefore whether the mark is a purely promotional statement or whether it has some distinctive character that means it can function as a trade mark. In practice, however, that distinction is often quite hard to draw.

Not all medical products are created equally

The mark La Méduse

had been applied for in relation to a variety of goods, including 'ultraviolet ray lamps for medical purposes' in class 10. The application was opposed on the basis of a likelihood of confusion with earlier registrations for the mark

méduse

covering 'protective face masks for medical use', amongst other goods.

The UK IPO held that there was a 'general overlap in user and purpose' between the term 'ultraviolet ray lamps for medical purposes' in the application, and 'protective face masks for medical use' in the registration, in that they will 'both mostly be used by medical staff for medical purposes'.

However, this was not sufficient for the goods to be considered similar. The decision confirmed that other relevant factors for assessing similarity of goods include their physical nature, the trade channels through which they reach the market, their location within stores, and the extent to which they are in competition. As the goods did not coincide under any of these other factors, the UK IPO found them to be dissimilar.

The application was therefore granted for the goods 'ultraviolet ray lamps for medical purposes', with the UK IPO finding that there was no likelihood of confusion, in spite of the marks having a high level of visual and aural similarity.

Confusion need not be direct

The mark LANSERHOF was applied for in a number of classes, and opposed on the basis of a likelihood of confusion with an earlier registration for the mark LANSERRING.

The UK IPO held that a number of the goods and services applied for were identical or similar to the earlier goods and services. It was then necessary to determine whether the marks were similar such that there was a likelihood of confusion.

The UK IPO decided that there was no likelihood of direct confusion between the marks - i.e., consumers mistaking one for the other. The visual and aural differences caused by the different endings of each mark (HOF v RING) were too obvious to go unnoticed. However, the UK IPO went on to consider the possibility of indirect confusion - where the consumer recognises that the marks are different, but nonetheless concludes that they share a commercial source due to their having something in common.

In this regard, the UK IPO concluded that as the root of each mark, LANSER, is inherently highly distinctive, being an unusual combination of letters with no obvious meaning, the average consumer would assume that no-one else but the owner of the earlier mark would be using it in a mark. Therefore, the later mark LANSERHOF would not merely call to mind the earlier mark LANSERRING; consumers would perceive that the users of the marks are economically linked undertakings, meaning there is a likelihood of indirect confusion. This sufficed for LANSERHOF to be refused registration for the majority of the goods and services applied for.

This decision serves as a reminder that indirect confusion could still be an option even if direct confusion is ruled out. However, a mere association between the marks is not sufficient for indirect confusion; the relationship needs to be such that consumers can perceive an economic connection between the entities behind the marks.

International Update

EUROPEAN UNION

Verena von Bomhard, Bomhard IP

On 10 November 2021, the General Court of the European Union handed down three judgments in parallel oppositions concerning pharmaceutical marks (T-239/20, T-248/20, T-542/20). While nothing revolutionary, these decisions serve as good reminders regarding the approach taken by the EUIPO – mostly with the General Court's approval – to the comparison of pharma marks.

The opposed marks were RUXXIMLA, RUXYMLA, and RUXIMBLIS, respectively, and the earlier mark was RUXIMERA. The General Court, in essence, endorsed the EUIPO's conclusion that there was a likelihood of confusion given the overlap in RUXIM- or similar and the similar or identical nature of the products. The additional syllable in RUXIMERA, the doubling of the letter X in RUXXIMLA, the Y instead of the I in RUXYMLA, and the different ending in RUXIMBLIS, were all found insufficient to avoid a likelihood of confusion on the part of the relevant public. While the relevant public would be attentive if not highly attentive given the nature of the goods, that was just one factor to be taken into account when considering whether the similarity of the marks and of the goods would be likely to cause confusion.

The cases highlight how important the beginnings of the marks are generally considered to be. Even the full inclusion of the earlier mark will not necessarily make the marks similar overall, as illustrated by the MAR v OptiMar (fig.) case reported in the May 21 issue of Law, Lore & Practice.

Of course a confusing similarity can also be found where the overlap lies at the end; in this respect see the General Court judgment concerning AROSUVA and KORSUVA (T-584/20, 8 September 2021). In this latter case, the EUIPO Opposition Division had found no likelihood of confusion; however, the Fourth Board of Appeal considered the marks to be similar to an average degree resulting in likelihood of confusion – and its decision was upheld by the General Court based on the overall impression conveyed by the marks.

On the other hand, where the beginning is exceedingly weak or descriptive, that may save a later mark, as illustrated by the judgment SANODIN v SANOLIE (T175/20, 24 March 2021, also reported in May).

All in all the year 2021 did not bring any ground-breaking news on the pharma front from the General Court. However it did confirm that, if you have lost before the Boards of Appeal in a 'normal' case concerning likelihood of confusion between pharma marks, your chances of getting that overturned by the General Court are slim. There is a significant focus on the beginning of marks and arguments referring to the descriptive or commonplace nature of the element or elements in which the marks coincide will help only in exceptional cases.

NB : The author represented the opponent in the proceedings before the EUIPO and intervener before the General Court. It is noted that the judgments are not yet final as the appeal period has not expired.

INDIA

Vrinda Sehgal, CHADHA & CHADHA

Heightened standards to prevent infringement, given public health and safety concerns, drive the judiciary to take a strict stance in the pharmaceutical industry. The Bombay High Court, in the case of Franco-Indian Pharmaceuticals Pvt. Ltd v Alencure Biotech Pvt. Ltd., https://indiankanoon.org/doc/101917760/ has once again established that any bad faith adoption of trade marks or any attempts at passing off will be dealt with strictly. The Court granted ad-interim relief to the Plaintiff restraining the Defendants from using the mark GIAVIT for medicines, the mark being phonetically, structurally and visually similar to the Plaintiff's trade mark DIAVIT.

Background

The Plaintiff, a well reputed pharmaceutical company, claimed to have adopted the mark DIAVIT in the year 2000 in relation to multi-vitamin and multi-mineral products. It also claimed to have expanded its range of products under the mark DIAVIT PLUS in the year 2009.

The Plaintiff had come across the Defendant's products bearing the marks GIAVIT-L and GIAVIT PLUS online. Upon further investigation, the Plaintiff found a price list with images which included a wide range of marks such as GIAVIT-9G, GIAVIT-L, GIAVIT-PRO and GIAVIT- PLUS which were being used by the Defendants in relation to various medicinal products, including multivitamins.

In relation to this, the Plaintiff claimed that the GIAVIT marks of the Defendant were deceptively similar to the Plaintiff's registered mark DIAVIT and that the only difference was that the consonant D had been replaced with the consonant G. The Plaintiff also claimed that it was a matter of public interest and thus argued that an injunction must be granted in their favour.

Decision

Considering the merits of the case, the Court stated that the Plaintiff had made out a prima facie case and that the adoption of the mark by the Defendant was not bona fide. The Court held that, 'Not only is there a prima facie case, but the balance of convenience is with the Plaintiff, to which irretrievable prejudice will be caused if relief is denied.' The Court went further to state that, 'There will be an ad-interim injunction against the Defendants from directly or indirectly using in any manner the trade mark GIAVIT with or without any suffixes or variants for any purpose whatsoever.'

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International Update continued

UKRAINE

PETOSEVIC

The Ukrainian Supreme Court has recently upheld the decisions of the Ukrainian Antimonopoly Committee imposing a total of EUR €34,500 (USD $39,000) in fines on the Ukrainian wine producer NVP Niva TOV for violating the local competition protection legislation by using misleading bottle labels and deceptive packaging design in order to indicate the wine's alleged Italian origin.

In September 2018, the Antimonopoly Committee fined Niva EUR €7,170 (USD $8,100) for using the 'Prosecco' designation and a bottle design deemed confusingly similar to that of the Italian wine manufacturer Santero Fratelli & C I.V.A.S.S. SpA.

The Antimonopoly Committee also imposed another fine on Niva in the amount of EUR €1,660 (USD $1,880) for providing misleading information on the back labels and bottleneck labels of its 'Champagne of Ukraine Brut'. The labels featured the colours of the Italian flag and indicated that grapes of Italian origin were used for making the wines.

Finally, in October 2018, the Antimonopoly Committee fined Niva EUR €25,650 (USD $29,000) for including misleading information on the labels of its 'Salute Asti Sparkling Sweet White Wine'. These labels also claimed that the grapes used for producing the wine originated in Italy and featured the wording 'from Italian producers from Piedmont'.

Niva appealed the Antimonopoly Committee's decisions, but the Supreme Court ultimately upheld them.

UZBEKISTAN

PETOSEVIC

On 20 August 2021, Uzbekistan adopted amendments to the Law on Trade Marks, Service Marks and Appellations of Origin and the Law on Copyright and Related Rights. The amendments, which entered into force on 21 August 2021, introduced several important novelties.

One of the novelties is the introduction of the expedited examination of trade mark applications, which should be completed within one month from the formal examination decision date. Expedited examination is an alternative to the regular substantive examination, which takes between six and seven months. An applicant may file a request for expedited examination together with the trade mark application or within three months from the application filing date. For an application to undergo expedited examination, the applicant has to order a trade mark availability search, which takes 10 days and is subject to payment of a separate service fee, ranging from approximately USD $200 to USD $300 per trade mark for one class, depending on the type of mark. The Uzbek Intellectual Property Office is not limited to running the availability search only among existing trade mark applications and registrations, but can also include other available or well-known information that may serve as an obstacle for trade mark registration. It is uncertain whether the cited trade mark related information retrieved from the Internet can be treated as well-known or whether it should simply be treated as publicly available.

The amendments also introduced third party observations into the trade mark law. The IPO is required to publish information on new trade mark filings on its official website within one working day from the application filing date, and interested parties may then submit written observations against filed applications.

The amendments also stipulate exclusive trade mark rights starting from the registration date. Information about a trade mark registration will be recorded in the IPO's register and published on the IPO's website on the date of trade mark registration. Previously it was unclear whether trade mark rights started on the date of publication or on the date of registration. These two dates were different – publication usually took place at the end of each month, while registration took place three days after the payment of registration fees.

Under the copyright law amendments, duration of copyright changed from 50 to 70 years after the author's or the last co-author's death. The amended copyright law also stipulates a fine for breaching copyright law ranging from USD $540 to USD $27,000 depending on the severity of the infringement.

While the amendments are not substantive, they represent a step forward in following the principles and rules set forth in the TRIPS Agreement as part of Uzbekistan's aspirations to join the WTO.

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PTMG Spring 2022

March 21st-22nd, 2022

Cambridge

The Editor would be happy to receive your suggestions by email for the topic of Diversity in the IP industry to be discussed at this event.

PTMG@home October 2021: Face-to-Face in a Virtual World / AI for IP

Lisa M. Tittemore, Sunstein LLP

The theme of the October PTMG@home conference - Face-to-Face in a Virtual World/AI for IP – surely reflects the themes that we all confront as we address the lessons we are learning from the COVID-19 pandemic. Much of what we discussed addressed opportunities and challenges created by the technological advances of the 'computer age' that already existed prior to 2019, but which have been brought now to the forefront of our daily reality by remote working. The program was timely, thoughtful, and inspiring.

The first day of the conference was on October 7, and was presented in dual sessions to accommodate attendees from different time zones around the world. The first speakers, addressing 'How can AI and other Technology Help Manage IP Rights' were Ulrike Till, Director IP and Frontier Technologies Division, WIPO and Michal Ziemski, Senior Machine Learning Specialist, Advanced Tech Application Center at WIPO. Ulrike Till set the scene, describing our unprecedented era of digital interconnectivity. Digitalization of life and work is accelerating, especially due to COVID-19. 'Frontier technologies' as a whole now represent USD $350 billion market, and humanity has generated 90 percent of the world's 'data' in the last 2 years. Regulation aims at a balance between protection of rights and investment in data and encouraging free flow of data, but difficulty remains in determining where the balance should lie.

Ulrike Till

Ulrike explained that AI is a 60-year-old technology, but advances in computing power and huge increases in the availability of good data is currently driving the AI boom. Data highlights the importance of IP as an intangible asset, although data itself often does not involve originality or inventive contribution and thus application of IP to data is complex. Indeed, IP rights have been designed to foster human creation and innovation and AI is increasingly becoming more independent while the role of direct human input is decreasing. Ulrike explained that WIPO has a role in raising awareness of new technologies and their IP implications. Importantly, WIPO has created the 'WIPO Conversation' in 2019 to create a forum to raise awareness and knowledge building.

Michal Ziemski provided insights into the specific work that WIPO has been doing. He explained that in his role he is focused on building applications based on machine learning techniques. He described a number of WIPO projects and initiatives, including WIPO's work on the PATENTSCOPE tool, a search engine permitting searching of over 98 million patent documents. WIPO has also developed its own WIPO Translate Architecture. WIPO Translate used on PATENTSCOPE translates ~ 3.5 million words each day (65% of which is translation of Chinese, Japanese and Korean). The huge volume prevents human translation even though human translation might be more accurate. WIPO Translate is used instead of Google Translate because it allows training that is more keyed to the highly technical language of patents.

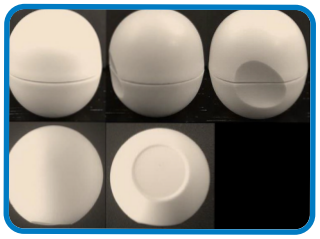
Michal Ziemski

PTMG participants noted that it is good to see the focus that WIPO is placing on leveraging technology to promote the efficiency and accuracy of its work.

Next up was Jussi Mikkola, EU TM attorney, of Papula-Nevinpat, Helsinki, Finland, with a more traditional subject – the International Case Round Up! Jussi provided commentary on a number of cases. An interesting case specifically in the pharmaceutical field addressed topics which we have heard about in past PTMG meetings, including the related nature of cosmetics and pharmaceuticals. Specifically, Jussi explained that in General Court of EU – T-501/20 (30.6.2021) the trade marks PANTA RHEI and PANTA THEI were considered confusingly similar, noting that the Court found that pharmaceuticals were similar to cosmetics to a low degree, and also cited the partial overlap of points of sale, e.g., pharmacies.

Jussi Mikkola

Along with a number of other decisions, Jussi discussed several EU decisions that demonstrated the difficulty of overcoming refusals based on lack of distinctiveness in the EU, as well as the importance of providing sufficient evidence when relying on reputation grounds. For example, General Court of EU T-489/20 (8.9.2021) addressed an EU application for 'three dimensional market shape of a spherical container' (shown below). I don't know about you, but I immediately recognized the shape of this distinctive lip balm container! Jussi let us know that the court did not agree that the container had become distinctive through use because the container had been used in color while the application showed the container as white.



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Jussi also discussed Fifth Board of Appeals of EUIPO – R-249/2021-5 (3.9.2021), addressing the marks shown below. Jussi explained that Amazon failed to file sufficient evidence of support of reputation to overcome the differences in the marks themselves, even though the contested mark contained a similar yellow arrow. During appeal, Amazon filed a substantial amount of evidence, but because Amazon was unable to show that it could not have provided the evidence earlier, the appeal was rejected.

Earlier mark

Contested mark

Reporting on a US South Carolina District Court decision, Jussi explained that a US federal district judge had sentenced a Latvian citizen to four years in prison and fined him USD $4.5 million in restitution for mail fraud. The case related to a scheme tricking trade mark owners into sending payments to a fraudulent 'Patent and Trademark Office LLC' and 'Patent and Trademark Bureau LLC.'

Jussi discussed in some detail Court of Justice of EU C-197/21, focusing on the 29 March 2021 Preliminary Ruling in a dispute between MySoda and SodaStream, a case which Jussi reported is ongoing at the EU Court of Justice. The case concerns relabeling and trade mark exhaustion. MySoda distributes carbonating machines and CO2 cylinders in Finland that are compatible with both MySoda and competing SodaStream machines. When consumers returned cylinders for recycling, MySoda removed SodaStream label, refilled the cylinders, and added a MySoda label, leaving the engraved SodaStream trade mark on the neck visible. The commercial court of Finland found that SodaStream's trade mark rights were exhausted. However the Supreme Court allowed appeal to EU Court of Justice to address a number of questions, including applicability of the precedent of the Bristol-Myers Squibb case. Jussi's recap was well received, and participants appreciated the extra time that Jussi was able to spend on the facts of the MySoda/SodaStream dispute to bring the case to life.

Nancy Globus of Syneoshealth/Addison Whitney provided an excellent report regarding Branding and Patient Safety in a Post-Pandemic World. Nancy reported that brand name confusion is decreasing.

An Institute for Safe Medication Practices report in 2018 reviewed a study looking at name confusion (brand versus generic, generic versus generic, etc.) and found that brand versus brand confusion has decreased, while generic versus generic confusion has increased. This may be due to the increase in the number of generic products and complexity of generic names containing similar stems.

Nancy Globus

Nancy observed that brand names are getting longer to help with changing 'shape' of names and to lower orthographic confusion. Nancy also reported that they are seeing less common starting letters and letter pairings, with names becoming more difficult to pronounce. Nancy noted that the EMA recently rejected a name for difficulty in pronunciation, and she believes this trend will continue.

Nancy addressed the naming used for vaccines relating to the Coronavirus, noting that treatments for COVID-19 have resulted in increased awareness of generic names. In addition, we have seen increased public discussion of drug development, clinical trials, and references to scientific journals. Nancy noted that although there was a strong public reaction to the 'pause' of clinical trials due to an adverse drug event during the trials, this is a typical occurrence during clinical trials and a result of good pharmacovigilance.

Nancy noted that COVID-19 vaccines to date are largely being referred to by manufacturer name. For example, COMIRNATY, the name for Pfizer's vaccine, was not used until after August, when the vaccine received full approval by FDA.

Nancy noted that for non-COVID therapies, there was some slow down with respect to clinical trials during the pandemic, but no decrease in the number of drug approvals at end of 2020. A major shift in the conduct of clinical trials was the increase in remote clinical trials, which increased from 18% in 2019 to 76% in 2020. New products and technologies have been (and are being) developed to allow for 'remote' monitoring of patients, even within a hospital (e.g., equipment to allow a shield between patient and doctor).

Kicking off the second day of the conference on October 8th was a fascinating discussion between Jonas Kölle (GC TM) and Elisabeth Prchla (Head of Innovation HR) of Merck KGaA, entitled What has the pandemic taught us? It's time to shape our future! My thoughts have returned to their comments many times since that day! We are all attempting to take away some positive

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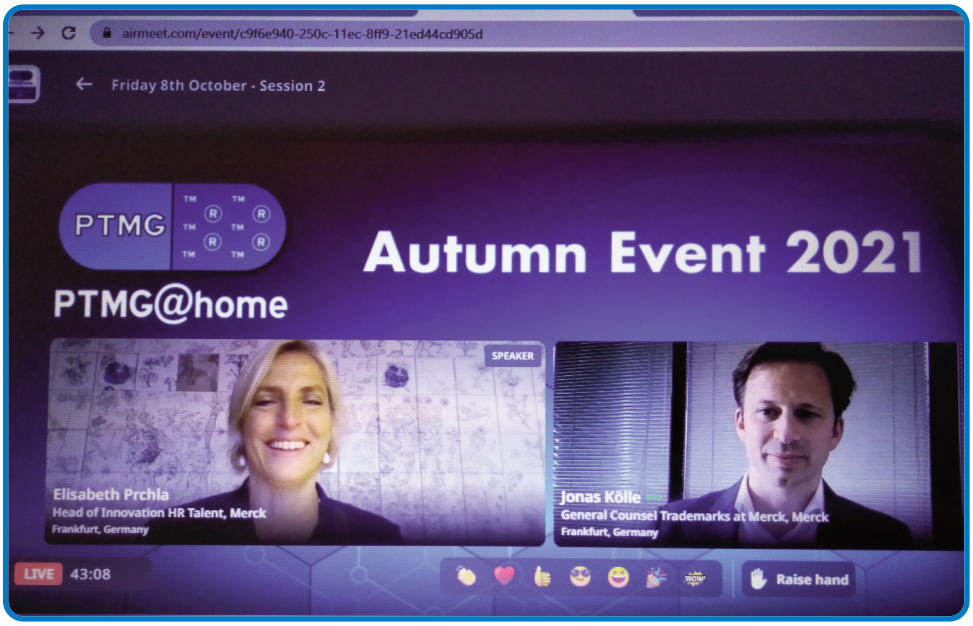
PTMG@home October 2021: Face-to-Face in a Virtual World/AI for IP continued



lessons from our remote work during the pandemic, and their discussion was excellent in this regard.

Jonas and Elisabeth noted that Merck has a history of 350 years and the company has a long history of reacting to difficult circumstances. Merck has developed a set of 'Future Ways of Working' Principles: 1) evolve working habits & leverage flexibility; 2) sustain trust & collaborate beyond boundaries; 3) double down on data and technology; and 4) clarify direction, empower action, recognize impact. Merck will focus on 'how we work; how we learn; how we lead.'

Jonas and Elisabeth discussed that employees everywhere are demanding more flexibility re when, where, and how work is conducted. It is important to find the right balance to sustain culture and DNA. At Merck, they are looking at hybrid working and reflecting on which meetings benefit from face-to-face interaction in particular. Key is to find the right balance between on line collaboration and in person work.

As leaders, it is important to identify opportunity to encourage employees and empower them. The leadership program at Merck is called EMPOWER. Leaders need to ask the right questions, rather than have all the answers. Leaders need to admit their own personal vulnerabilities. We saw each other's homes, families, pets, and technical difficulties during the pandemic, transparency that led to increased support and understanding during strange and difficult times. Leaders need to create 'psychological safety' for their teams to permit advancements in performance, inclusion, innovation, and build a strong culture of trust.

There was lively discussion during the Tea and Talk sessions. Participants commented that the key take away for them from the Merck presentation was 'balance.' Discussion of mental health is important. Another participant commented that during 'pre-digital' times, lawyers would work at work, not at home, and we would have dinner with family (provided we could get home in time for dinner). Now, there is pressure to look at phones and computers during dinner. There was intense conversation about the benefits and risks of technology, including the need to train ourselves to be aware of the need for personal time, and respect different time zones, different cultures, and find ways to formalize this approach.

The final presentation of the conference addressed the developments in TM Searching from Paper to AI by Mireille Valvason, Senior IP Counsel, Novartis. We have come a long way from paper searching, which Mireille described doing in the early days of her career. Trade mark searching remains one of the fundamentals in the TM world. Mireille explained that the most useful search analysis includes competitive intelligence about the marks cited and what is happening in the market, which typically requires further research beyond the search results. She noted that a search analysis that states a 50% chance of successful registration is not enough: what does 50% chance of success mean? Good decision-making requires more information. In addition, wearing a business 'hat' is important for trade mark counsel as well. It is necessary to point out to colleagues what will make a great trade mark, which includes many factors, such as avoiding prior third party marks. Mireille noted that Novartis typically wants searches conducted during all phases of product development – including searching INNs etc. Bringing regulatory insight to bear on search results is crucial for assessing trade marks for pharmaceuticals. In-house TM counsel should consult with name creation / regulatory colleagues. POCA scores are an important tool, but only a tool and not the end of the story. Indeed, Mireille was confident that we will not replace human analysis with AI, although AI is also an important tool, including to help save time.

Mireille Valvason

In closing, we recognized both the incredible benefit of having technology enabling us to meet again virtually from around the world, and the limitations of technology precluding us from connecting on the same level as we do in-person. I believe that the conference participants left with a renewed connection to PTMG along with the hope that we can meet again in person soon.

PROFILE: Jonas Kölle

Jonas Kölle is General Counsel Trade Marks at Merck. He and his team take care of Merck's global portfolio of non-technical Intellectual Property rights. Jonas is a fully qualified German lawyer being educated at the Universities of Heidelberg and Mannheim.

Since joining Merck in 2002 Jonas has gained manifold experience in the field of IP, including IP litigation, portfolio management and strategy, protection and enforcement of trade marks, designs and copyrights. He is member of the PTMG committee and has served various INTA committees and working groups at the German Markenverband.

Where were you brought up and educated?

I was born and raised in Heidelberg, Germany. We then moved to Athens, Greece, where I spent my teenager years. After high school I decided to become a lawyer and studied law in Heidelberg and Mannheim.

How did you become involved in trade marks?

My interest in intellectual property was triggered by a phenomenal lawyer, Tilman Schilling, during an internship at an early stage of my studies. I then started focusing on the rare courses for patent, design and trade mark law to further develop my knowledge in IP.

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

I guess I would still have become a lawyer but in a much less fascinating area of law.

Which three words would you use to describe yourself?

Candid, curious, considerate.

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

A mistake I made early in my career was to provide a client with a complex legal analysis without additional guidance. I hope I learned to translate legal statements into useful advice.

What do you do at weekends?

Being with my beloved ones, cooking, doing sports.

Complete the sentence: If I have time to myself …

I spend it mostly outdoors.

What's the best thing about your job?

My excellent team at Merck!

What do you wish more people would take notice of?

What a blessing vaccines are for us human beings.

Which book or books are you currently reading?

One Hundred Years of Solitude by Gabriel Garcia Marquez.

What is your favourite children's book?

With great passion I read most of Astrid Lindgren and Erich Kästner children's books, many of them multiple times, it is very difficult to pick one out.

Which book changed you?

Thinking Fast & Slow by Daniel Kahneman.

Which music recording would you take with you to a desert island?

Purple Rain from Prince.

Which sport do you play and/or enjoy?

I enjoy playing soccer, tennis and golf if time allows.

Which is your favourite restaurant?

My best dinner I had at Masala Library in Delhi, but my favorite restaurant nearby is the Landgasthof zum Rössl in Waldhilsbach.

What is your favourite holiday destination?

My favourite will not be revealed to keep it as intact as it is. It has sea views!

If you could save only three things from your burning home, what would they be?

All the photographs and of course our little dog.

What is your favourite building / piece of architecture and why?

Pont du Gard because of its beauty combined with its functionality - an unbelievable technical masterpiece.

What's your favourite mode of transport and why?

Cycling on summer evenings as I like the wind on my skin.

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

My old, dented, loud and smoking Vespa 50 with manual gear ship, my children hate that vehicle!

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