

# Law Lore & Practice

PTMG



Pharmaceutical  
Trade Marks Group

May 2022



## Editorial: Adapting

Watering the garden again this afternoon after the fifth week in a row with no rain, I am struck by the resilience of all plants – from young vegetables to ancient trees – in the face of obvious climate change, even at the most local level. During the pandemic, there was a lot of talk about how we needed to harness our capacity to adapt,

how we needed to teach our children to be resilient to face the many threats that they will no doubt experience in their lives. Since February, we are humbled by the resilience of the Ukrainian population who are defending the principle of democracy against all odds.

Plants have always been attacked by insects and microbes, and now climate change. But unlike us, they cannot move to escape the danger. Our inter-dependence is well known to those who are active in the pharmaceutical field. As a major source of pharmaceutical raw materials, it is essential for human health to protect plants. Willow bark was used as a traditional medicine by

the ancient Sumerians and Egyptians more than 3500 years ago and needs no introduction as Bayer's world famous drug for pain relief.

It follows therefore that we as humans simply have no choice but to protect our vulnerable ecosystem, so that plants may provide future drugs or drug precursors to cure the many illnesses that continue to threaten human health. The challenge is to do that prior to the disappearance of ecosystems in which undiscovered plants with medicinal properties reside. Based on data from the online World Checklist of Selected Plant Families at the Royal Botanic Gardens, Kew, scientists have calculated that there are between 10 and 20 % more undiscovered flowering plant species than previously estimated.

This will only be good news for our species if we allow plants the right conditions to pursue their adaptation for millennia to come. In the more short-term future, the PTMG committee is looking forward to seeing many of you again in October, no doubt surrounded by beautiful flowering plants in Lisbon.

**Vanessa**

## US Update

**Jonathan S. Jennings**

**Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP**

The Trademark Modernization Act (TMA) makes significant changes in United States trade mark law. The implementing regulations went into effect in December 2021. This update focuses on two changes: (1) procedures for removing registrations of unused marks from the Register; and (2) codification of Letters of Protest to bring evidence of problems or conflicts to the attention of Examining Attorneys during their review of third-party applications. These options may help brand owners save both time and money by avoiding the need for costly cancellation and opposition proceedings.

### **Ex Parte Reexamination and Expungement Proceedings**

In response to a large influx of dubious

applications - and resulting registrations - the USPTO has provided efficient new ways to challenge trade mark registrations subject to either fraudulent or flawed specimens of use, or marks that have not been used in commerce. Brand owners now can petition the USPTO ex parte for the expungement or reexamination of these 'deadwood' registrations, instead of filing a potentially protracted cancellation proceeding. There is no standing requirement - anyone can file the proceedings. Unlike a cancellation proceeding, they can be filed anonymously.

In particular, the TMA authorizes brand owners to petition the USPTO to expunge registrations on the basis that the mark has never been used in

commerce for some or all of the pertinent goods or services. Expungement is currently available against any registration that is more than 3 years old. On 27 December 2023, however, there will be an upper limit added and the procedures will not be available against registrations that are more than 10 years old.

As an alternative to expungement, brand owners may also petition for reexamination of registrations of marks that they believe were not in use in commerce as of the 'relevant date.' For use-based filings, it is the application filing date. For intent-to-use registrations, it is the later of (i) the filing date of the amendment to allege use or (ii) the date of the expiration of the statement of use deadline (incorporating approved extensions). Reexamination is available for five years after the registration date.

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## Words from the Chair



Once more we had to hold a virtual event this March even though we were really looking forward to seeing you all in person. As the pandemic evolves and some countries lighten the restrictions, we are hopeful to see each other in Lisbon.

As IP professionals, we continue to build connections across the globe and to defend our IP rights and commercial interests within the legal frameworks and abiding to our long-standing values. I sincerely hope that the suffering in Ukraine finds an end in the very near future, and that governments go back to solving any type of issue via diplomacy. As a former student of the Diplomatic Academy of Vienna, I strongly believe that diplomacy is a way of thinking, not only a tool. We use it regularly in our day-to-day work; let's try to continue role modelling respect and open dialogue.

In parallel, technological developments continue to take place not allowing us to lean back and relax, but rather pushing us to be curious, to open our minds, bring in new talent, expand the horizon of the role of trade marks and how to best protect them in the future. Some of us are already defining their avatars to be used in the metaverse, whilst we are still digesting AI based inventions and others would prefer things to simply slow down. Tremendous opportunities lay ahead of us, that's the one thing I'm confident about.

Wishing freedom and peace for all.

**Myrtha Hurtado Rivas**

## Members News

### New Members

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

**Holga Gauss** from Grünecker, Munich, Germany [gauss@grunecker.de](mailto:gauss@grunecker.de)

**Valentina Niess** from Noerr PartG mbB, Munich, Germany [valentina.niess@noerr.com](mailto:valentina.niess@noerr.com)

**Makiko Coffland** [makiko.coffland@cojk.com](mailto:makiko.coffland@cojk.com) and **Melissa Nowak** [melissa.nowak@cojk.com](mailto:melissa.nowak@cojk.com) both from Christensen O'Connor Johnson Kindness, Seattle, USA

**Kelly Saliger** from CMS–CMNO, London, UK [Kelly.saliger@cms-cmno.com](mailto:Kelly.saliger@cms-cmno.com)

**Rebecca Atkins** from Abel + Imray LLP, London, UK [Rebecca.atkins@abelimray.com](mailto:Rebecca.atkins@abelimray.com)

**Ali Hijazi** from Abu-Ghazaleh Intellectual Property (AGIP), Amman, Jordan [ahijazi@agip.com](mailto:ahijazi@agip.com)

**Viktoriiia Smyrnova** [vsmyrnova@petosevic.com](mailto:vsmyrnova@petosevic.com) and **Igor Alfiorov** [igor.alfiorov@petosevic.com](mailto:igor.alfiorov@petosevic.com) both from Petošević, Kyiv, Ukraine

**Elena Szentivanyi** from Henry Hughes IP, Wellington, New Zealand [elena@henryhughes.com](mailto:elena@henryhughes.com)

**Zsófia Klauber** from Danubia Patent and Law Office, Budapest, Hungary [zsofia.klauber@danubialegal.hu](mailto:zsofia.klauber@danubialegal.hu)

### Moves and Mergers

**Heidi Gorenstein Nigri** has left Müller, Cid, Noronha, Cruz & Gorenstein to join Ouro Preto Advogados in Rio de Janeiro, Brazil. Heidi can be contacted at [Heidi.nigri@ouropreto.adv.br](mailto:Heidi.nigri@ouropreto.adv.br)

**Pieter van der Wees** has established a new firm called Markedly B.V. in Amsterdam, The Netherlands. Pieter can be contacted at [pieter@markedly.nl](mailto:pieter@markedly.nl)

**Dima Naber** has left Abu-Ghazaleh Intellectual Property (AGIP) to join The CWB Group in Dubai, UAE. Dima can be contacted at [dima.naber@cwblegal.com](mailto:dima.naber@cwblegal.com)

**Georgina Busku Wachtler** has left Abu-Ghazaleh Intellectual Property (AGIP) to join Thum & Partners in Budapest, Hungary. Georgina can be contacted at [busku@thum-ip.de](mailto:busku@thum-ip.de)

**Yee Swan Boo** has left Lee & Lee to join Amica Law LLC in Singapore. Yee Swan can be contacted at [yeeswan.boo@amicalaw.com](mailto:yeeswan.boo@amicalaw.com)

**Luka Jelčić** has left ZMP to join Makpharm in Zagreb, Croatia. Luka can be contacted at [luka.jelcic@makpharm.hr](mailto:luka.jelcic@makpharm.hr)

**Maria Fernandez Marques** has left Grünenthal to join Novartis Pharma AG in Basel, Switzerland. Maria can be contacted at [maria.fernandez\\_marques@novartis.com](mailto:maria.fernandez_marques@novartis.com)

**Thorbjorn Swanstrom** has left Chas. Hude to join Aera A/S in Copenhagen, Denmark. Thorbjorn can be contacted at [tsm@aera-ip.com](mailto:tsm@aera-ip.com)

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

Lesley Edwards  
**PTMG Secretary**



# Obituary: David Bowen Lloyd George

June 2nd 1936 – March 4th 2022

Alan Hunter



David, best known to us as Dai, was born in Dolgarrog, Wales on June 2nd, 1936. He was educated at grammar schools in Colwyn Bay and then Bangor before studying Veterinary Science at Bristol University, graduating in 1960 and qualifying as a vet in 1961. He worked in veterinary practice in Aberystwyth and Brecon before starting his own practice in Swansea in 1964 which he eventually sold in 1977, when he prepared for a change in career direction by studying at the College of Law at Chester from 1977 – 1979. After completing his articles in private practice in Swansea, he was admitted to the Law Society becoming a solicitor in 1983 and continued working in private practice in Swansea for Peter Williams and Co. until 1986, when he married Angela and they moved to London.

In London, Dai began working as Manager of Legal Affairs at the Association of the British Pharmaceutical Industry (ABPI). During this time, he continued his studies, taking a course in Intellectual Property at Queen Mary and Westfield College, University of London and a master's degree at Greenwich University where he was awarded an LL.M with distinction.

He progressed to become Company Secretary for the ABPI and its Legal and Intellectual Property Director, before retiring in 1988 and returning to live in Wales, in Swansea, in 2000.

During his school and university days Dai was a keen sportsman excelling in athletics, in particular, hurdling, pole vault and high jump. He was a talented footballer captaining the school team and playing for the Bristol University first XI. He played semi-professional football and was offered a trial for Chelsea which he turned down.

It was during Dai's time at the ABPI that he joined the PTMG Management Committee in 1986 and attended his first conference in Mainz. Dai and Angela became regular attendees at conference and popular members of the PTMG family. Dai was an accomplished raconteur with many stories about his life in veterinary practice and his Welsh Television appearances as a vet. He truly enjoyed the opportunity to meet members of the PTMG family from all over the world. In 1999 when Derek Mitchell retired as Editor of Law, Lore and Practice, Dai took over this role using his inimitable literary style to great effect. His innovative approach brought many improvements to the publication with features such as the photo caption and Christmas Competition. Under his stewardship LL&P became a 'must read' for PTMG members and he even dropped the old 'yellow paper' historically used. Angela also took over the membership list and created a database for it.

Dai remained active in retirement, continuing his education by obtaining a Teaching Welsh to Adults Certificate from Swansea University and in 2010 started researching the Welsh Artist Vincent Evans at the Aberystwyth School of Art obtaining an M. Phil. for his work in 2015.

Dai was truly a multi-talented individual with particular interests in Welsh language and culture, classical music and gardening. He was an avid collector of many things including fountain pens, watches and clocks. His collection of Welsh Modern and Contemporary Art would grace any Art Gallery.

He seldom missed a Wales rugby match and was a season ticket holder at Swansea City Football Club.

A proud Welshman, a Welsh Nationalist and supporter of Plaid Cymru, if he had been a stick of rock Wales would have been imprinted throughout its length.

At conference he could detect the presence of a fellow Welsh person even in a crowded ballroom.

Dai gave his time unstintingly to many charitable organisations, holding honorary positions for the Union of Welsh Independent Chapels (Undeb Yr Annibynwyr Cymraeg), and served on Committees responsible for The National Eisteddfod, Friends of the Glynn Vivian Art Gallery in Swansea, The Guild for the Promotion of Welsh Music, the Contemporary Art Society for Wales and The Abertawe Festival for Young Musicians. He was recognised by several professional bodies, including being awarded Fellowship of the Royal Society of Arts and Honorary Membership of the British Veterinary Association.

Dai was a great enthusiast with many interests and friends and a keen attention to detail (especially grammatical). His books of Board Minutes at the ABPI, handwritten in his fine script, were a sight to behold – more like a work of art.

He regularly attended the Welsh Independent Chapel and whenever abroad would always visit the local church or cathedral and light a candle and recite The Lord's Prayer in Welsh (Gweddi'r Arglwydd) in memory of his mother.

In short, he was a lovely man, remembered fondly by colleagues as someone always willing to lend an ear to staff and to encourage their progress or help with legal or personal problems. A pleasure to work or be with, someone who always saw the bright side of any situation and never ceased to be polite and helpful. A true Welsh Gentleman.

He died of urothelioma carcinoma and lymphoma, at home in Swansea with his wife by his side on March 4th, 2022. He was 86 years old and is survived by his wife Angela, son Iestyn, daughter Sophie, sister Dianne and four grandchildren.

## **Gorffwys mewn Hedd**

*Angela would love to hear from any PTMG members with memories of Dai. Please contact the Editor.*

# US Update continued

A government filing fee of USD \$400 per class of goods or services must be paid for both proceedings. A petitioner must also submit a verified statement that it has conducted 'reasonable investigation' to determine that the mark was not in use at any time (expungement) or as of the relevant date (reexamination). The USPTO recently stated "it's not enough to say that you 'didn't find any hits'" and that constituted a reasonable investigation. See <https://www.uspto.gov/trademarks/laws/2020-modernization-act> ('best practices').

The petitioner must include a concise factual statement of the basis for the petition, containing enough evidence to establish a prima facie case for non-use in US commerce. If the USPTO determines the petition meets its requirements, it will institute the proceeding, and an Examining Attorney will issue an Office Action notifying the registrant. The Office Action will require a response from the registrant showing use of the mark in commerce sufficient to rebut the non-use allegations. For expungement actions against §44(e) registrations (based on corresponding non-US registrations) or §66(a) 'International' registrations (Madrid filings), the registrant may provide evidence of excusable non-use (an option not available to registrations obtained on other grounds). Once the proceeding is instituted, the petitioner has no further involvement. If the registrant cannot show use under either procedure, its registration will be cancelled, in whole or in part, as to the goods or services in question. The registrant will have three months to request reconsideration of this decision or appeal it to the Trademark Trial and Appeal Board (TTAB).

As of 25 April 2022, only about 71 expungement and reexamination proceedings had been instituted. (IPO webinar by J. Fraser, J. Greisman, and K. McKnight on 26 April 2022). Both proceedings will probably take around 6-9 months to complete. Id. Finally, the USPTO Director may also institute reexamination or expungement proceeding sua sponte. As of 25 April 2022, the USPTO Director had filed very few proceedings. Id.

## Letters of Protest

A Letter of Protest has long been an established ex parte procedure whereby a third party can submit evidence to the USPTO during the application examination process to attempt to block the registration of the applicant's mark. By codification of this procedure, the TMA sought to bolster and expedite the process. For example, the Director of the USPTO now has two months to act on a Letter of Protest. A Letter of Protest is not for just any perceived problem or objection. It must be based upon a 'specific, relevant legal ground' to refuse registration of the mark in the application, 'typically that registration is contrary to federal law,' or because the applicant has not met the applicable requirements regarding the registration of a mark. <https://www.uspto.gov/trademarks/trademark-updates-and-announcements/letter-protest-practice-tip>. The Letter must include evidence to support the basis asserted. The government filing fee is USD \$50. The Director's decision on a Letter of Protest is final and non-reviewable. If granted, the Examining Attorney does not receive the Letter itself, or the protestor's arguments, just the actual evidence submitted with the Letter, from which the Examining Attorney will draw his/her own conclusions. The party submitting the Letter must not contact the Examining Attorney, and the Examining Attorney is not informed of who submitted the Letter. The disposition of the Letter of Protest does not preclude the protesting party or anyone else from filing an opposition or cancellation proceeding.

## Practice Tips

We will of course learn more about how the USPTO will handle these new reexamination and expungement proceedings, while Letters of Protest already have been approved and rejected under the new procedures. Based on the regulations, brand owners should consider the reexamination and expungement proceedings in several contexts, such as against a blocking registration discovered during the clearance process. In addition, when a registration is cited against a

brand owner's pending application to register, a suspension of the deadline to respond to an Office Action may be sought on the basis of pending expungement or reexamination proceedings. (IPO webinar by J. Fraser, J. Greisman, and K. McKnight on 26 April 2022). This would allow time to file a proceeding, eliminate the blocking registration, and render the Office Action moot. Of course, a brand owner also may just file a petition at any time against a registration of a similar mark that diminishes the scope of its rights.

A reexamination or expungement procedure may not always be the best option, such as when settlement is being negotiated, as the proceeding cannot be withdrawn once filed. In addition, a cancellation proceeding in which a default is expected may be faster than either expungement or reexamination. Id. This is particularly so, as there is now a new cancellation ground under the TMA that allows for an expungement action against a registration for a mark that has never been used. It is permitted three years after the registration date.

Conversely, brand owners must also take steps to ensure that their own registered marks are not jeopardized by the new expungement and reexamination proceedings. They should ensure the accuracy of the email contact information for each registration, including that for the Attorney of Record, who first receives USPTO notices. In addition, brand owners should periodically confirm that their registered marks are actually in use in US commerce, and amend registrations as needed to delete goods or services for which use of the mark cannot be proved. It is less expensive and bothersome to resolve such issues before registrations are challenged through reexamination or expungement proceedings.

Finally, there is no guarantee that Letters of Protest will be granted by the Director or that the Examining Attorney will refuse registration based on the evidence provided, but it is a fairly low-cost means of finding that out. There are benefits to submitting Letters of Protest early in the examination process, potentially saving brand owners time and money in contested adversary proceedings later.

# The importance of the therapeutic indication under Art. 47 (2) EUTMR

Dr. Ralf Möller, Esche Schümann Commichau

Owners of pharmaceutical trade marks usually apply for and register their class 5 trade marks for the class heading 'pharmaceuticals' to enjoy the broadest scope of protection within this category of goods.

If a pharmaceutical trade mark is challenged at a later stage by a revocation action based on non-use (Art. 58 (1) (a) EUTMR), it is common practice of the EUIPO that the proof of use of a medicine with a specific therapeutic indication also preserves the rights for the broad term 'pharmaceuticals'. In other words, the evidenced use for e.g., a certain pain-relief medicine saves the registered class heading 'pharmaceuticals' with no need for a further limitation of the list of goods to e.g., 'pharmaceuticals, namely painkillers'.

However, this practice does not apply in opposition proceedings if the opponent has to furnish proof of use of its earlier right upon request. Art. 47 (2) EUTMR states that an opposed trade mark, which has only been used in relation to part of the goods or services for which it is registered, shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

This principle likewise applies to invalidation proceedings (Art. 64 (2) EUTMR).

In its judgment of 14 July 2005 (T-126/03 – ALADIN), the General Court of the European Union (EGC) held that if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong (cf. para. 45).

To define sub-categories of the broader term 'pharmaceuticals', the therapeutic indication becomes crucial.

In this respect, the EGC held in its further judgement of 13 February 2007 (T-256/04 – RESPICUR v RESPICORT) that since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product in question is vital in directing their choices. Consequently, the criterion of the purpose or intended use is of fundamental importance in the definition of a sub-category of goods or services (cf. para. 29). The purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication (cf. para. 30).

The EGC further stated that the dosage form, the active ingredient and the obligation to obtain a doctor's prescription, are, as a rule, inappropriate for defining a sub-category of goods, as the application of those criteria does not fulfil the abovementioned criteria of purpose and intended use of the goods (cf. para. 31). In fact, a given medical condition can often be treated using a number of types of medication with different dosage forms and containing different active ingredients, some of which are available over-the counter whilst others are available only on prescription (cf. para. 31). Therefore, the EGC concluded that the sub-categories of the good 'pharmaceuticals' must be determined based on the criterion of therapeutic indication (cf. para. 33).

This finding, namely that the therapeutic indication is the most important criterion when determining the sub-categories of 'pharmaceuticals', has been confirmed by the ECJ in its judgment of 11 December 2014 (C-31/14 P – PRAMINO v PREMENO).

Thus, if the opponent only proves use of the opposition mark for e.g., a 'pharmaceutical preparation for the relief of pain related to teeth growth', the EUIPO has – in applying Art. 47 (2) EUTMR – to categorize this good not only under the broader term 'pharmaceuticals' (as it does in revocation actions based on non-use) but under the specific sub-category covering the therapeutic indication of this pain-relief medicine and subsequently compare only this sub-

category in which the evidenced product of the opposition mark falls with the goods applied for (cf. EUIPO, 16.03.2009, opposition no. B I 084 930 – NANI v NANIT).

## Conclusion + Comment

Once correctly sub-categorized, the specific good used under the opposition mark is compared with the goods applied for. A different therapeutic indication of the goods to be compared with (e.g., 'pharmaceutical preparation for the relief of pain related to teeth growth' v 'medical and medical technology preparations for bone treatment') will in the end lead to only a low similarity of the goods in question, although both goods are pharmaceuticals, have the purpose to cure illnesses and are distributed through the same channels, in particular pharmacies.

Moreover, such a low level of similarity can partly be outweighed by the fact that the relevant consumers of the goods covered by the marks will be handled by different categories of physicians (in our example paediatrist v orthopeadist) and that the goods covered by the marks have very different therapeutic indications, are not in competition to each other, nor are they complementary.

In the above described example, the EUIPO in its decision of 16 March 2009 denied in its global assessment a likelihood of confusion between the trade marks in question NANI v NANIT despite the high similarity of the signs because of the different therapeutic indications of the specific goods ('pharmaceutical preparation for the relief of pain related to teeth growth' v 'medical and medical technology preparations for bone treatment') resulting in a low similarity of the goods.

Before filing an opposition, it is therefore advisable for pharmaceutical companies to carefully sub-categorize the class 5 goods of a (potential) opposition trade mark, which is under the use obligation. The identified sub-categories then need to be compared with the applied goods to evaluate the chances of success and to avoid a rejection of the opposition despite a high similarity of the signs in question.

# PTMG@home Spring, 21 - 22 March 2022

## Event Digital, Nutrical, Intellectual, Cynical – Pharmaceutical Trade Marks in the Social (Media) Era

### Ben Mooneapillay, J A Kemp

With an announcement that we will hopefully meet in person again at the Autumn conference in Lisbon, Portugal this was likely the last virtual PTMG meeting. At one level, I suspect we will miss the flexibility that the virtual world provides, but on another and probably more important level we will all, I am sure,



Myrtha Hurtado Rivas

enjoy seeing each other in person, talking over coffee and cake, sharing a glass or two of something stronger in the evening and perhaps even dancing the night(s) away.

Until then, we remain in a virtual conference world. On this occasion, the virtual world was provided by the Airmeet platform, which was well laid out and user-friendly. The 'tea and talk' sessions worked particularly well on this platform.

The opening remarks were poignant with thoughts shared about the terrible situation in Ukraine and with the announcement that Dai George, a founding Member of PTMG and former editor of Law, Lore and Practice had passed away.

Day 1 kicked off with a firm favourite of the conference – the International Case Round Up, which on this occasion was ably delivered by Rachel Wilkinson-Duffy



Rachel Wilkinson-Duffy

of Baker McKenzie. Rachel took us around the world in... about 40 minutes - stopping off along the way in Australia, China, the EU, Colombia before finally landing in the USA. In Australia the owners of the BOTOX trade mark successfully opposed the use of PROTOX on the basis of 'indirect confusion'; i.e., that the goods would be seen as coming from the same source even if the differences in the marks were clear. The defendant was also unable to reply on a comparative advertising

defence in relation to its use of the phrase 'Instant BOTOX® alternative'. In China, the case of Hu Min Zhong 596 – Klüber (2021) demonstrates that China's IP law is evolving rapidly in recognising that the concept of international exhaustion has its limits. In this case, the court held that where the quality of the goods is impaired this can constitute a legitimate reason for opposing the further commercialisation of the goods. In the EU the court in Novartis AG v Impexco NV and PI held that repackaging in order to obtain a commercial advantage is not acceptable. In Colombia there is a huge trade in dummy or ineffective drugs, where criminal gangs use well-known trade marks to sell 'useless' pills. Helpfully, the criminal code in Colombia prohibits the 'corruption of pharmaceutical products' and using this provision the authorities are able to stop the production of these products at the manufacturing stage (where traditional intellectual property rights have no effect, because they are not being used). The US Trade Mark Modernization Act was next up. Amongst other things, it introduces a 3 month response period for Office Actions (replacing the more leisurely 6 month period), but which can be extended by 3 months with payment of a USD \$125 official fee. Rachel ended with a discussion around the case of Ohio State University v Redbubble where the court found that in actively assisting customers with design, branding and marketing products Redbubble (a trading platform) could not rely on a defence that it was merely an intermediary.

Next up was Meriem Bourahla-Loudiyi (Servier) who took us through the impact of the Digital Services Act on digital healthcare and how it is failing to address the problem of online intermediaries

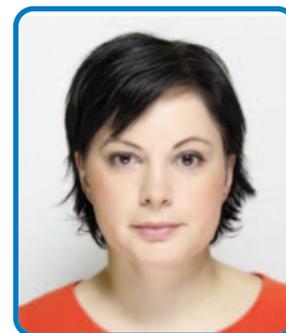


Meriem Bourahla-Loudiyi

facilitating the sale of falsified medicines. A whopping 96% of online pharmacies are illicit, with 50% of them concealing their actual physical address. The sale of pharmaceutical products that are ineffective or dangerous is obviously a significant risk for patients.

Meriem explained the various ways in which the DSA is seeking to address some of these problems including regulations around transparency, notification of suspicious behaviour and sanctions. In Meriem's view the current proposals fall short in a number of ways, in particular the fact that there is an exemption for small and medium sized enterprises (SME's). This exemption for SME's is based on the principle of 'proportionality' and the belief that SME's will not be able to effectively implement the regulations or that they are too burdensome for such companies. Meriem opined that if SME's are exempted then the bad actors will simply use the smaller platforms provided by the SME's. Myrtha reminded delegates that we have seen this before in the shipping arena where counterfeiters have switched from large consignments to smaller consignments, which fly (or should that be sail?) under the radar.

Zorita Pop from Nestlé gave us an enthusiastic and fascinating overview of the field of 'Nutraceuticals' (a term coined by Dr Stephen DeFelice as long ago as 1989). With thousands of trade marks now being filed for nutraceuticals and with social media platforms awash with celebrity endorsements, this is clearly a growing field. Interest in this area has apparently increased significantly since the



Zorita Pop

start of the pandemic and is not limited to younger or older people. Zorita gave various pointers on searching and clearance for Nutraceuticals (don't forget the food and drink classes)

as well as enforcement strategy, including consideration of possible labelling law and consumer protection law angles. Because the market is not highly regulated, those operating in the nutraceutical field can bring innovative products to market very quickly compared with manufacturers of pharmaceutical products. It will be interesting to see how confidence in these products progresses and whether, in time, celebrity endorsements will be replaced with regulatory approval.

Continued on next page

Nick Beckett of CMS led us into Day 2 with an interesting look at bad faith filings in China.

Echoing comments from Rachel Wilkinson-

Duffy, Nick opined that China's IP laws have seen a marked improvement over the last 10 years (a view which I am sure is shared by anyone who has been operating in China over that period). In March 2021, the CNIPA announced an action plan for combatting bad faith applications and by the end of that year it had rejected some 482,000 filings on those grounds (which gives you a sense of the scale of the problem). Under Article 4.1 of the Trademark Law, the CNIPA has the power to reject applications which are not intended for use and this appears to be the CNIPA's preferred weapon in tackling applications made in bad faith. The CNIPA will also take into account such things as the number of applications applied for, the industry and operation of the applicant, previous rulings against the applicant and similarity of the mark being applied for with famous names. Nick was asked if bad faith filings of the past could be revisited under the new legal provisions. Laws in China do not have retroactive effect and so Nick's view was that the new law could not be applied to older registered trade marks.

The theme of bad faith continued with an informative presentation by Nick Aries of Bird & Bird,

who took us through a number of cases that will be familiar to UK and EU practitioners. In Lindt the court stated that it was necessary to examine the applicant's intentions at

the date of filing and where the intention was not to use a mark, but to prevent others from entering the market then this could constitute bad faith. A 'lack of commercial logic' is also a determining factor. Skykick tells us that a lack of 'clarity and precision' in the specification of goods and/or services is not a basis for invalidation and that obtaining a trade mark right for purposes other than those envisaged by their essential functions or, as



Nick Beckett

held in Lindt, for undermining the interests of third parties may also constitute bad faith. The facts in the Monopoly case were rather specific, but it is clear that re-filing purely so as to avoid the requirement to prove genuine use is unjustified. This case does not prohibit re-filing per se – the re-filing must be coupled with a dishonest intent. Nick's wise advice to trade mark owners is to keep records of plausible commercial reasons for re-filing trade marks. Objective and commercial logic along with credible business rationale need to be demonstrated.

Day 2 concluded with a detailed and interesting talk from Christian Schalk (Bayer) on the subject of Repetitive Filings in the Pharmaceutical Industry. Christian

took us through a range of scenarios and posed the question whether and to what extent re-filing in each instance would be considered commercially reasonable. His slides are worth a second read. Christian rounded off with some well-received words from the heart about respecting each other with human dignity and striving for our dreams peacefully. Amen to that.



Christian Schalk

## 'I have a dream'



I have a dream, that we can see each other again soon, in person, in good health, and in real peace.

Real peace is more than the absence of war and must not be confused with the silence of a cemetery.

For me, real peace means living together in mutual respect for each other's human dignity, being able to express our opinions freely, to develop our abilities freely, to strive for let our dreams become true and to live in all our diversity.

We must never give up these, our values!

Derek Rositter, one of the founders of PTMG, whom you can see on the bottom right of this collection of photos, experienced as a young man in Northern Africa and in Italy what we did not think could happen near us again. Our organization, the PTMG is somehow also a peace project.

How many trade mark conflicts have been settled peacefully during a conference? During a coffee break or in the seating areas of the hotel lobby or even late at night at the hotel bar!

Maybe we sometimes think that our world of trade mark lawyers is a small world. It isn't. We are a large, well connected global community.

I have experienced more than once that when my marketing colleagues were looking for a contact at a competitor, who did they ask?

I am convinced that if we stand together, our values will prevail in the end! PTMG will continue to bring together colleagues from all over the world.

And in this way, it will also contribute to reconciliation. The latter is also a kind of leitmotif in one of Derek's books.

In any event, it is always a great pleasure for me to attend a PTMG conference and I am honoured to have been selected as a speaker for this PTMG spring meeting.

**Christian Schalk**

# International Update

## Albania

### PETOSEVIC

Amendments to the Albanian Industrial Property Law, introducing new provisions regarding trade secrets, trade marks and the Internal Market Inspectorate, entered into force on 22 August 2021.

#### Trade Secrets

The most significant change is the transposition of Directive (EU) 2016/943 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure.

Trade secrets were previously regulated by the Law on Entrepreneurs and Companies and the Labor Code and their subject matter was defined in broader terms. Now, under the amended IP law, a trade secret is defined as undisclosed expert knowledge, experience or business information that is not generally known or easily accessible, that has a certain market value, and for which sufficient measures have been taken to keep it a secret.

Apart from defining trade secrets, the amended law sets the rules for their lawful and unlawful acquisition, use and disclosure, and the rules for maintaining their confidentiality during and after court proceedings. The law also provides trade secret holders with a number of measures to be used in the event of trade secret misappropriation, including compensatory damages.

#### Internal Market Inspectorate

The amendments to the IP law also define the role and duties of the Internal Market Inspectorate (IMI), the main responsibility of which is to ensure the safety of non-food consumer products by instigating internal market inspections. The IMI's role in enforcing IP rights was previously not defined at all.

Under the amended law, right holders can file formal requests before the IMI for the seizure of goods infringing their registered IP rights once they become aware of such goods on the market. The request should contain information on the infringer or information on the points of sale of infringing goods. The IMI also has the right to act ex officio.

The law also sets deadlines for acting before the IMI or before competent courts if the goods are seized by the IMI

and the parties fail to reach an agreement. In this case, if the right holder fails to take the matter to court, the seized goods will be released.

The amendments also clarify that the costs associated with the destruction of goods seized by the IMI are borne by the rights holder.

The amended law now also includes the definitions for 'counterfeit goods', 'pirated goods' and 'goods suspected of infringing industrial property rights'.

#### Trade Marks

Under the amendments, a trade mark registration may be divided into two or more registrations; previously, it was only possible to divide a trade mark application.

Finally, the Albanian Intellectual Property Office will now reject a trade mark application during substantive examination if the mark's dominant element is considered non distinctive, even if the applicant requests a disclaimer of such an element. This was previously not expressly defined in the law.

## India

### Vrinda Sehgal, CHADHA & CHADHA Intellectual Property Law Firm

In the case of Mankind Pharma Limited v TATA Medical and Diagnostics Limited, the Delhi High Court refused to pass an ad interim injunction against the Defendant, restraining them from using the mark OMISURE with regard to a testing kit used for detecting the Covid-19 variant, Omicron.

The Plaintiff in this case claimed that the Defendant's mark OMISURE was infringing upon their trade mark OMIPURE which was being used by them for formulations of Omeprazole which are used as antacids, anti-reflux agents, and anti-ulcerants. The Plaintiff also alleged that the Defendant's use of the mark OMISURE would cause confusion on the part of the public and that there was also a likelihood of 'blurring by association' between the two products.

The Defendant on the other hand argued that there can be no monopoly over the prefix OMI as the same was being used as reference to the Omicron variant of Covid-19. The Defendant further argued that the sale of their products

ought not to be restrained due to the public interest element involved in this matter. Lastly, it was also noted that while the Plaintiff's products fall under class 5 of the Nice Classification, the Defendant's products were more likely to fall under class 10.

The Court observed that, 'in the present case, perusal of the two marks in question, i.e., OMIPURE and OMISURE shows that the marks are not identical. Moreover, pharmaceutical and medical preparations for which the Plaintiff's mark is registered is not the product for which the Defendant is using the mark i.e., diagnostic kits. Thus, this would not be a case of identical mark or identical goods.'

The Court also took into account precedents for establishing confusion and deceptive similarity and found that there were certain broad differences between the two products and marks. Finally, the Court stated that, 'The Defendant's product being a RT-PCR test kit to test Omicron variant of the Covid19 is claimed to be a breakthrough innovation... Any interdicting by the Court, at this stage, would be contrary to the interest of the patients and the public who are suffering from Covid-19.' Also, the fact that the full form of the Defendant's mark was TATA MD CHECK RT-PCR OMISURE was taken into account. Therefore, the Court concluded that there was no likelihood of confusion or association.

The Court also held that, 'Covid-19 is omnipresent and Courts are no exception. Disputes relating to trade marks and patents in respect of Covid-19 products have reached the doors of courts. In such cases, the Court has to strike a balance between the rights of the individual and the public interest and apply the law to the facts and circumstances of each case. While the phonetic similarities between these two marks are clearly perceptible, the present case would not be one for an ad-interim injunction.' Thus, rejecting the Plaintiff's claim, the Court found in favour of the Defendant.

## Saudi Arabia

### JAH

We are pleased to inform you that Saudi Arabia has approved the accession to The Hague Convention Abolishing the

Continued on next page

# International Update continued

Requirement of Legalization for Foreign Public Documents (Apostille Convention). As per the current practice, official documents such as POA, recordal documents etc. are only accepted if they meet all the formalities of legalization abroad. The Kingdom is expected to complete the legal formalities for the accession in due course of the year.

## Singapore

### Key Developments expected in Intellectual Property Law in Singapore

#### Shahera Safrin, mirandah

The key developments that are currently being anticipated in the near future in Singapore are as follows: (1) the enactment of the (1) Intellectual Property (Amendment) Bill 2021, and (2) the implementation of Singapore's obligations under Phase 3 of the EU-Singapore Free Trade Agreement.

#### (1) Intellectual Property (Amendment) Bill 2021

The Intellectual Property (Amendment) Bill (the Bill) was approved by the Parliament after its Second Reading on 12 January 2022, and is set to come into effect on or around May 2022. The Bill seeks to amend several provisions which are found in the Geographical Indications Act 2014, the Patents Act 1994, the Plant Varieties Protection Act 2004, the Registered Designs Act 2000 and the Trade Marks Act 1998 (cumulatively the Amended Statutes). These amendments were directed in order to achieve the following objectives: (1) enhanced business-friendliness; (2) operational efficiency; and (3) enhanced legislative and procedural clarity.

In summary, the Bill does the following:

- a. Simplify the process for registration of various Intellectual Property Rights; and
- b. Consolidate and standardize similar provisions that are found across the Amended Statutes.

The changes which relate to trade marks in particular, are elaborated as follows:

#### Partial registration for trade marks

The current trade mark registration procedure requires applicants seeking protection across multiple classes of

goods and services to overcome all objections in relation to all classes of the mark before being allowed to publication and/or registration. The amended regime, however, has made provisions for partial acceptance for goods and services for which no objections were raised. Mr Edwin Tong, Second Minister for Law, has stated that the allowance of partial registration is expected to benefit 13%, or approximately 2,100 applications, annually.

#### Deadline for Revival of withdrawn trade mark applications

Trade marks are generally deemed to be withdrawn if applicants do not meet the deadlines set by the IPOS in relation to Office Actions. Under the current trade mark regime, applicants could seek relief for such withdrawal by requesting for the reinstatement of their trade mark within six months of such withdrawal. The amended provisions, however, have shortened such timelines from 6 months to 2 months. Applicants are now encouraged to be more vigilant in meeting their deadlines.

#### Other Changes

The Bill also makes further changes in relation to other Intellectual Property Rights, including, amongst others, the following:

- (a) Removing the requirement for an additional fee for the publication of English-translated patent applications in International Patent Applications;
- (b) Introduction of third party opposition for any correction of errors made to applications or registrations for Geographical Indications, Trade Marks or Registered Designs; and
- (c) Improving efficiency in the patent examination procedure by shortening timelines for minor amendments.

The changes provided in the Bill offer a welcome change in improving the efficiency of Singapore's Intellectual Property regime and maintaining its competitive edge.

#### (2) Phase 3 of the EUSFTA

Singapore is due to enhance its border enforcement measures for intellectual property rights in relation to the Registered Designs Act and Geographical Indications Act within three years of its entry into the EU-Singapore Free Trade Agreement (EUSFTA), i.e., by 21 November

2022. These changes, which are termed as Phase 3 of Singapore's obligations under the EUSFTA, are slated for implementation during the course of this year.

Changes will include enhanced border enforcement measures for articles or works protected by the Registered Designs Act, new powers of seizure and provision of information at the border in respect of seized goods covered by the Registered Designs Act and Geographical Indications Act, and consolidating and standardizing similar provisions that are found across the Registered Designs Act and Geographical Indications Act.

#### Conclusion

The changes proposed through both the Bill and the EUSFTA show Singapore's continued commitment to an updated and efficient Intellectual Property protection system. Business should continue to seize the opportunity to protect their intangible intellectual property assets in line with the updated regime.

## Singapore

#### Denise Mirandah, miranda

The Intellectual Property Office of Singapore has announced certain changes to IP practices, as well as a general increase in official fees. The pertinent changes, which will take effect from 29 April 2022, are highlighted below:

#### Official Fees

A general increase in official fees will be applied across the various stages, including application, renewal and opposition. Application fees will be increased from the current S\$341 to S\$380, while renewal fees have generally increased by about 15%, from S\$380 to S\$440, on a per mark per class basis.

Official fees for contentious matters have also increased, from S\$374 and S\$357 per class for oppositions and revocations, respectively, to S\$420 per class for both types of actions.

#### Trade mark Practice

Several changes will also be implemented on trade mark processes, such as:

- a. Acceptance of partial specifications not objected to during examination will be allowed;

Continued on next page

# International Update continued

- b. The time period to request for reinstatement of an application is reduced from 6 months to 2 months;
- c. Applications with status 'Treated as Withdrawn' will continue to be cited by the Registrar against identical or similar marks with later filing dates or priority dates (in contrast to the existing practice);
- d. Corrections to an application may be advertised and any person can file a notice of opposition against the proposed correction within 2 months.

## Launch of IPOS Digital Hub

IPOS will also be launching a new IP filing system, which will replace its existing e-services platform on 4 May 2022. Consequently, IPOS has declared 29 April 2022 and 4 to 6 May 2022 as excluded days so that all deadlines falling due on these dates will be automatically extended to the next working day of 9 May 2022 (including the weekend in between).

These changes are intended to enhance operational efficiency and business-friendliness as innovators and businesses use IP to grow locally and globally.

## Turkey

### Dicle Doğan and Ayşenur Çitak Bozdağ, Gün + Partners

The Turkish Court of Cassation (the CoC) issued a decision in which the registrability of a 3D medical device trade mark is discussed. This paper aims to provide the details of the matter and to remark upon its importance.



**Trade mark No: 2016/58202**

## Background

A 3D device trade mark application covering goods in classes 5 and 10 was filed before the Turkish Patent and Trademark Office (the Office) and was rejected as the Office found the application as non-distinctive and descriptive.

## Court Phases

The trade mark holder filed an action to cancel the Office's decision rejecting the application with the following arguments:

- The 3D trade mark is not an ordinary device; it is a unique composite shape in which different parts are brought together,
- It is clearly different from the inhaler shapes available in the inhaler market as the trade mark is used by the plaintiff for the first time, with the edge lines being holistic and the inflated balloon shape pressed from the bottom to the top,
- It is an original shape that can be perceived by any potential consumer without any difficulty, with elements such as a double round curved line that prevents the finger from slipping in the use of the device,
- The trade mark has acquired distinctiveness due to use made of it on the market.

The first instance Civil IP Court (the IP Court) determined that the subject trade mark is descriptive for 'Medicines for human and animal health, chemical products for medical and veterinary purposes, radioactive chemicals for medical and veterinary purposes' in class 5 and 'Surgical, medical, dental and veterinary apparatus, instruments and furniture' in class 10. Therefore, the IP Court decided that this 3D shape should not be monopolized by one party. Also, the IP Court revealed the trade mark has no abstract distinctiveness for the rest of the goods which is an obstacle for registering a trade mark. The IP Court finally stated that acquired distinctiveness was not proved by the plaintiff. As a result of this assessment, the IP Court rejected the case.

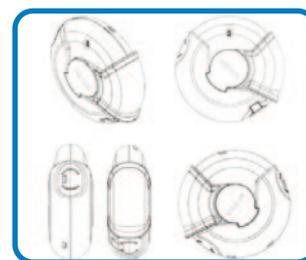
Upon appeal of the plaintiff, the matter was reviewed by the Regional Court of Appeal (the RCA). The RCA rejected the plaintiff's appeal with the same reasoning. Finally, the matter was reviewed by the Court of Cassation (the CoC) which upheld the RCA's decision on 1 June 2020.

## Comment

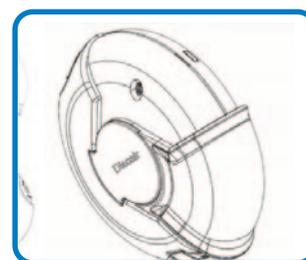
It can be seen that the CoC's perspective is the same as the Office, the IP Court and the RCA. Even if the subject trade mark is rejected in the end, there are several 3D device trade marks within the Office's records, which are registered on behalf of the plaintiff without facing any ex-officio rejection:



**Trade mark No: 2016/8204**



**Trade mark No: 2016/75700**



**Trade mark No: 2016/58225**

There is a significant difference between these trade marks and the rejected application: the addition of Disclair word element. Disclair is also a registered wordmark before the Office covering goods in classes 5 and 10. These examples show that details of the 3D trade marks such as distinctive word elements are significantly taken into consideration for registrability examination.

**Continued on next page**

# International Update continued

## Ukraine

### PETOSEVIC

Until recently it was not quite clear exactly how IP deadlines are affected by the martial law in Ukraine. The martial law, which was first introduced in Ukraine on 24 February 2022, and currently remains effective until 25 May 2022.

The Ukrainian IPO published several notices back in March, informing the IP community that the IPO continues to operate on a full-time basis to ensure uninterrupted functioning of the intellectual property system and explaining that the earlier published letter of the Ukraine Chamber of Commerce and Industry, certifying the events of force majeure, could be interpreted as applicable only to applicants and right holders residing or domiciled in Ukraine. The IPO did not have the discretion to prescribe the deadline-related procedural issues, which required adoption of a special law.

This uncertainty was finally resolved on 1 April 2022 with the adoption of the Law On the Protection of Rights of Intellectual Property Subjects during Martial Law in Connection with Military Aggression of the Russian Federation Against Ukraine' No. 2174-IX (the Law).

This Law, which entered into force on 13 April 2022, provides for:

1. Suspension of deadlines relating to protection and acquisition of IP rights to trade marks, inventions, utility models, industrial designs, semiconductor topography rights, geographical indications, copyright, and plant varieties for the duration of the martial law period, starting on 24 February 2022. Other than the general prosecution and IPR maintenance deadlines provided by relevant IP laws, the suspension also affects the deadlines for:
  - filing oppositions against national trade mark applications and international registrations under the Madrid Agreement and Protocol,
  - challenging decisions of the Ukrainian IPO before courts,
  - filing appeals before the IPO Board of Appeals,
  - filing patent invalidation actions,

- filing requests for reinstatement of the missed deadlines, etc.

According to the Law, these deadlines will continue as of the day following the date on which the martial law regime stops or is lifted, taking into account the time that passed before 24 February 2022.

2. Continuation of validity of IP rights for which the relevant deadlines were suspended. The respective patents and certificates remain valid and fully enforceable.
3. Possibility to subsequently pay the renewal and annuity fees, falling due within the martial law period, within 90 days after the martial law regime is lifted.
4. Possibility for applicants/IPR holders to take necessary actions, i.e., file relevant applications, requests, objections, responses, not later than 90 days following the day on which the martial law regime is lifted, without paying any extension or reinstatement fees.

In spite of all mentioned provisions of the Law in place, IPR holders and applicants are not explicitly exempt from the duty to perform all required actions aimed at securing and protection of IPRs.

It has to be made clear that the primary purpose of this Law was to establish additional protective mechanisms that can be used as a 'safety blanket' by IPR holders and applicants in case they cannot comply with respective deadlines due to unforeseen circumstances caused by the war, or when performing certain actions becomes impossible or complicated.

Obviously, some actions may require extensive research and investigation, collection and securing of evidence, negotiating and/or formalising agreements, etc., which is often significantly jeopardised by unpredictability of war. Also, there is a number of troublesome circumstances that IPR holders and applicants, particularly those residing or domiciled in Ukraine, or those whose legal representatives are in zones of military conflict, can face under the martial law. For this particular reason, and understanding the importance of IPRs for future economic recovery and growth, the legislator quickly responded to legislative initiative aimed at preserving IP deadlines and adopting relevant protective

mechanisms preventing possible loss of IPRs and damages from such loss of rights in this difficult time.

Still, given that the Ukrainian IPO operates on a full-time basis, and that the e-filing system is fully functional, IPR holders and applicants, particularly non-residents, are advised to follow the 'normal' course of action in Ukraine, relying on the Law only in exceptional cases.

There are several reasons for this:

- As noted, the present Law is a 'safety blanket' mechanism for the prevention of possible loss of rights and a formalised ground justifying reinstatement of missed deadlines. In its previous notices, the IPO had sent a clear message that the system is fully operational, hence there are no reasons for not meeting due deadlines, unless there are serious obstacles that prevent the applicant from performing the required actions;
- Given the mentioned provisions of the law, there will be only a relatively 'narrow window' during which IPR holders will have to perform all actions that fell due within the period of the martial law. It is not difficult to imagine that this may result in a significant backlog in the IPO once the martial law is lifted and possibly create problematic situations;
- The potential backlog problem is coupled with procedural issues, particularly the need to correctly calculate relevant IP deadlines on a case-by-case basis, depending on whether the respective countdown date fell before the introduction of the martial law or during the martial law period, still complying with the provisions of relevant guidelines regulating the procedures of reinstatement. The IPO has not issued its recommendations yet.

Good planning and portfolio management under these difficult circumstances is key to avoiding possible future complications and delays with resumption of IPR prosecution and maintenance files and founding a solid base for the protection and enforcement of intellectual property rights in the post-war economy that will strive for innovation and growth.

Continued on next page

# International Update continued

## Ukraine / WIPO

### PETOSEVIC

On 27 April 2022, the Ukrainian .UA domain operator Hostmaster announced on its website that in view of the martial law currently in force in Ukraine, the WIPO Arbitration and Mediation Center temporarily suspended its domain name dispute resolution services under the .UA Domain-Name Dispute-Resolution Policy (UA-DRP) and will not accept any new .UA domain name registration requests until further notice.

This decision was taken following WIPO's consultations with Hostmaster and based on the fact that Ukrainian registrars and parties to a dispute may have difficulties participating in arbitration proceedings during the ongoing military actions.

The UA-DRP administrative proceedings will resume once the martial law regime is lifted in Ukraine. The martial law, which was first introduced on 24 February 2022, currently remains effective until 25 May 2022.

The UA-DRP is a domain name resolution mechanism similar to the UDRP (Uniform Domain-Name Dispute-Resolution Policy). The proceedings are administered by the WIPO Arbitration and Mediation Center. For a complaint to be successful, the following must be proven:

- The complainant's trade mark is identical or confusingly similar to the domain name;
- The domain name registrant has no rights or legitimate interests in respect of the domain name in question; and
- The domain name is registered and/or used in bad faith.
- The remedies available to the complainant are the domain name cancellation or its transfer to the complainant.

The UA-DRP procedure cost is equal to the UDRP procedure cost and ranges from EUR €1,315 (USD \$1,500) to EUR €4,385 (USD \$5,000). The UDRP procedure usually lasts 60-75 days.

## UAE

### JAH

We are pleased to inform you that the UAE Trade mark Office has done away with the local publication procedures

(publication in two local newspapers) for trade marks matters such as registrations, renewals, recordals and amendments. As you may be aware, the UAE trade mark law has now been changed with many new reforms and waiving of the publication in the local newspapers is seen as an added incentive to trade mark owners. In light of this new announcement, the publication for all trade mark procedures will be now limited only to the official gazette which is published twice a month. The new practice has been applicable from 27 February 2022.

## UNITED KINGDOM

### Suzanne Power, AA Thornton (UK)

This recent opposition decision from the UK Intellectual Property Office (UK IPO) took us all back to the classroom, for a quick revision session on how to assess marks applied for or registered in foreign languages.

The opposition was based on a claim to reputation in the earlier mark, and a claim

in class!). However, he could not guarantee that RECHERCHE would be understood to mean 'research', given the visual differences between the words.

With the word BIOLOGIQUE not being particularly distinctive in respect of the Opponent's goods (which included goods that could contain botanical or biological extracts), the Opponent's claims proceeded on the basis that the average consumer would likely find the unfamiliar word RECHERCHE to be the more distinctive part of the Opponent's mark, and make the greatest contribution to the overall impression it conveyed.

It is therefore perhaps not surprising that the HO concluded that there was no likelihood of confusion between the marks, in spite of an overlap between the goods. The only common element was the word BIOLOGIQUE and consumers were in his view very unlikely to rely on that word as an indicator of trade origin. Rather, it would tell them that the goods sold under the marks are biological in nature. This was in spite of the Opponent

Earlier mark	Marks applied for
 in classes 3, 10 and 33	 in classes 3, 5 and 30

to likelihood of confusion between the earlier mark and the marks applied for.

The UK IPO's Hearing Officer (HO) acknowledged that all of the marks in question were composed of French words. Therefore, in order to assess the opponent's claims, the HO needed to consider the extent to which the average (primarily English speaking) UK consumer would understand the marks in question.

The HO held that French is 'routinely taught' in UK schools, and so 'many average [UK] consumers are likely to have a basic understanding of the language'. In his view, the average UK consumer, armed with this basic understanding of French, would recognise the word BIOLOGIQUE in both marks to mean 'biological' (or at least be able to guess at that meaning – perhaps those who had paid less attention

having established that its earlier mark had a slightly enhanced distinctive character resulting from its use. The reputation-based claim failed for similar reasons (among others).

It will be interesting to see the UK IPO potentially having to issue more decisions concerning marks in other languages, with rights holders now (following Brexit) filing more marks directly with the UK IPO that they might previously have only filed with the EUIPO. French remains perhaps the most popular foreign language to be taught in UK schools; the decision may well have been different had the word shared between the marks been from a less familiar language, and also had it not otherwise so closely resembled the English equivalent.

# Is it time for PTMG to talk about diversity and inclusivity? If so, why and what do we mean?

**Julie Barrett, Purposive Step**

## Why talk about D&I?

It is now well established<sup>1</sup> that diversity and individual uniqueness in its people bring creativity and vitality to an organisation, enriching its business practices and making it more successful.

Therefore, by capturing and drawing on diverse points of view, we can improve the advice and services that we offer to our pharma trade mark clients – and prospective clients – whether in-house or in private practice, and wherever we work in the world. Pharma is focused on creating new brands, and on attracting and maintaining market share and reputation, usually multi-nationally. This requires novel perspectives that are more likely to arise from divergent thinking, or differing experiences and points-of-view.

Lost opportunities or undesired outcomes can arise without diversity. For example, we in pharma are aware of the deficiencies in clinical trials outcomes, due to the novel drugs or vaccines not having been tested on a diverse cohort<sup>2</sup>. And what about those no-touch antiseptic gel dispensers that we all used during the covid-19 pandemic? These often don't work for people of colour, as a dark-skinned hand may not be light enough to register on the sensor used. Also, it's not uncommon to 'clear' a potential new ('invented') word mark for use, then have it turn out to be a rather inappropriate word in another far-off language or context, which could have been spotted sooner by a more diverse 'clearance' team.

But it's not just about our clients and their customers. Diversity in our own organisations could enable us to relate more effectively to the variety of other stakeholders in our world of work, including Trade Mark Office personnel, associates at home and abroad, other service providers, and the wider community in which we operate.

## How do we know that D&I really matter in business – especially in our profession?

Besides being self-evident that diversification is good for driving performance<sup>3</sup>, research has shown that the overall performance of organisations or teams is linked to diversity<sup>4</sup>. By 'performance' is meant one or more of the typical business indicators, such as profitability, market share, etc. Heterogeneous teams or organisations, even if these initially experience internal conflicts or misunderstandings, can produce constructive results and better advice for our clients. Cognitive diversity has been shown<sup>5</sup> to be especially useful

for problem-solving and innovation; and diverse juries who, like Trade Mark Attorneys, need quickly to absorb and retain a variety of facts and case details, have been shown<sup>6</sup> to recall more of these details with greater accuracy and with consideration of a wider range of perspectives, than did homogeneous juries. A collection of diverse traits therefore appears to be ideal for bettering our responses to examination reports, preparing for hearings, and communicating with our innovative clients.

Furthermore, diversity may be key to the survival of our team or business<sup>7</sup>: in private practice, our clients or prospective clients are increasingly demanding that we demonstrate diversity – or they will take their work elsewhere. In industry, company policies often require us to recruit and maintain a diverse team or department, and external consultants and IP agents. Many intellectual property offices now operate D&I policies; and many of the professional organisations and regulatory bodies who govern them (and PTMG members) also have rules and guidelines that impact D&I in our workplaces.

## What do people mean when they talk about diversity & inclusivity (D&I)?

Diversity in the workplace involves co-operation between people with differing characteristics, skills and personality traits – particularly those differences that are not directly relevant to being able to do our pharma trade mark work well. We may be used to thinking or hearing about differences based on gender, ethnicity, and related aspects, but D&I also considers age, social/economic background, accent, religion, neurology, marital and parental status, and so on.

D&I is not just about getting a variety of people into our organisations: it's also about retaining people that contribute to this diversity. This is where inclusivity comes in: people who feel that they belong, or who are included in the most interesting work, decision-making processes or other positive aspects of our work lives, are likely to stay longer in our organisations.

Moreover, increased inclusivity can lead to greater diversity<sup>8</sup>. Job candidates who have minority characteristics tend to be more attracted to already-diverse workplaces. A virtuous circle can therefore develop, with diversity and inclusion each supporting and even promoting the other.

## When and where can we discuss D&I matters further?

Your PTMG Committee is planning a session on diversity and inclusion at an upcoming conference. I would therefore appreciate your feedback, including comments on this article and the issues raised, together with any thoughts or experiences you may share on the topic in general, so that we can tailor the session to suit. So, Yes – it's time to talk about diversity and inclusivity!

[Julie.Barrett@PurposiveStep.com](mailto:Julie.Barrett@PurposiveStep.com)

<sup>1</sup>There is a plethora of research supporting this statement, for example McKinsey & Co.'s 19 May 2020 report, Diversity Wins: How Inclusion Matters, available at <https://www.mckinsey.com/featured-insights/diversity-and-inclusion/diversity-wins-how-inclusion-matters#> (accessed 13Nov2021)

<sup>2</sup>Jonathan M. Loree, MD1; Seerat Anand, MBBS2; Arvind Dasari, MD2; et al; Disparity of Race Reporting and Representation in Clinical Trials Leading to Cancer Drug Approvals From 2008 to 2018, *JAMA Oncol.* 2019 5(10):e191870. doi:10.1001/jamaoncol.2019.1870

<sup>3</sup>Examples adapted from Paolo Gaudiano and Ellen Hunt, How To Convince Executives To Embrace Diversity, 07Nov2016, available at <https://www.forbes.com/sites/gaudianohunt/2016/11/07/how-to-convince-executives-to-embrace-diversity/?sh=770ee3de7650> (accessed 25Jan2022)

<sup>4</sup>See footnote 1

<sup>5</sup>Scott E. Page, The Difference: How the Power of Diversity Creates Better Groups, Firms, Schools, and Societies, 2007, available at [https://www.researchgate.net/publication/24117966\\_The\\_Difference\\_How\\_the\\_Power\\_of\\_Diversity\\_Creates\\_Better\\_Groups\\_Firms\\_Schools\\_and\\_Societies](https://www.researchgate.net/publication/24117966_The_Difference_How_the_Power_of_Diversity_Creates_Better_Groups_Firms_Schools_and_Societies) (accessed 25Jan2022)

<sup>6</sup>Samuel R Sommers, in conversation with Anne Sasso, Group Diversity: Mock Juries Reveal Surprising Effects of Diversity on Groups, 05May2006, available at

<https://www.science.org/content/article/group-diversity-mock-juries-reveal-surprising-effects-diversity-groups> (accessed 25Jan2022)

<sup>7</sup>There are many examples, such as those referenced in

[https://www.americanbar.org/groups/intellectual\\_property\\_law/publications/landslide/2017-18/march-april/diversifying-intellectual-property-law/](https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2017-18/march-april/diversifying-intellectual-property-law/)

<sup>8</sup>Glassdoor (amongst others) publishes regular statistics. For example, 2/3 candidates reported that diversity is important in evaluating job offers; and over 50% employees believe their company should do more to improve diversity, cited by Christine del Castillo in Diversity in the workplace: the case for building a diverse team, available at <https://resources.workable.com/stories-and-insights/diverse-team#> (accessed 25Jan2022)

# PROFILE: Julia Tellechea

I am a lawyer and for the past 27 years I have been a partner at FRTB Ferrer-Reyes, Tellechea & Bouché, an IP boutique firm. I focus on both patent and trade mark prosecution and defence proceedings, mainly for multi-national companies within the pharmaceutical, chemical, agrochemical and communications fields, providing pre-filing practical advice, leading extensive due-diligence projects, pre and post-merger data validation, assisting clients in defining IP protection strategies, including trade mark searching and clearance.

I am a long-time member of PTMG, ECTA, AIPPI and INTA.



## Where were you brought up and educated?

I was born and raised in Buenos Aires, attended a bilingual school where I learnt English at an early age and at the same time studied French at the Alliance Française in Buenos Aires. I graduated in law at the University of Buenos Aires.

## How did you become involved in trade marks?

I was practising in corporate law and transfer of technology contracts and following the suggestion of a friend from university, I applied for a job in a large IP firm to serve international clients, and loved it.

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

When I graduated from law school I passed the exams to join the Foreign Service, but unfortunately due to family issues, I had to let it go.

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

Open-minded, imaginative, curious.

## Complete the sentence: I wish . . .

. . . people would first stand in the other person's shoes before judging him/her.

## What do you do at weekends?

Getting together with friends from the choirs to share a nice meal and sing. I also like being out in the countryside, enjoying nature.

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

. . . I read, listen to music and if I have a lot of time, I do some sewing or decorating in the house".

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

. . . pretending".

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

Meeting people from all over the world, from different cultures. An enriching experience.

## What is your biggest regret?

I don't have regrets. Very often what appears negative, turns out to be positive in the long run. I learnt to be patient and wait for things to fall in to place.

## What is your favourite work of art?

Les Grandes Décorations by Monet. I could spend hours immersed in them.

## What is the soundtrack to your life?

Music was my first love", John Miles. Especially, where it says: "Music was my first love and it will be my last. . . . In this world of troubles my music pulls me through.

## What is the best age to be

All ages have their magic.

## What would be your ideal night out?

A nice quiet dinner al fresco by a waterfront with a glass of good wine.

## What is your philosophy in a nutshell?

Take life as it is, make the most of it and enjoy it.

## Who was your mentor or role model?

The person that generously gave me the best advice and I am forever grateful to is Peter Siemsen.

## Which famous historical person would you like to have been and why?

Da Vinci. A world of knowledge and talent.

## What is your favourite drink?

Red wine, Malbec.

## What is your most treasured possession?

My books.

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

My feet. I love walking. If the distance is not walkable, the car because it gives you freedom. You can choose the road, you can stop whenever you wish and visit places you can't reach in other modes of transport.