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Bristows
Agenda

1. Europe –
   MSD v Abacus, Impexeco v Novartis, Creaticon v EUIPO

2. UK –
   Vagisil, Skykick

3. USA –
   Meenaxi, Hetronic, Jack Spaniels

4. China –
   Novartis; Jagermeister

5. India –
   Mankind Pharma v Tata Medical & Diagnostics, Biocon v Basarass Biocon, Sun Pharma v Hetero Healthcare

6. Australia –
   Yey v Active Skin
MSD v Abacus

• Falsified Medicines Directive (FMD) requires “anti-tamper device”.
• Parallel importers obliged to open package and replace the PIL in language of country of import.
• Question: If the replacement leaves visible traces on the original packaging, is the parallel importer entitled to replace the entire packaging?

CJEU decision:
1. FMD permits use of a replacement anti-tamper device on original packaging as long as it is replaced with an equivalent
2. If a relevant market has a strong resistance to the relabelling of medicinal products, or to the purchasing of products whose packaging bears visible traces of having been opened, due to the replacement of the existing “anti-tampering device”, then repackaging of these products would be viewed as necessary and could not be opposed.
3. However, the importer can not rely on a presumption of consumer resistance.

MSD v Abacus (C-224/20), Bayer v Kohlpharma, (C-204/20) and Novartis v Abacus (C-147/20)
Quiz Question 1

What is the Fifth Condition from BMS?
Impexeco v Novartis

Background:
- Parallel import of Sandoz generic letrozole from NL to BE
- Re-labelled as FEMARA (Novartis’ originator product) in BE
- Is the re-naming necessary in order to gain effective market access?

CJEU decision:
- Where the parallel importer is able to market that product under its trade mark of origin by adapting, where appropriate, the packaging in order to satisfy the market requirements of the importing Member State, the condition of necessity is not satisfied.
- Rebranding was exclusively motivated by desire to take advantage of the FEMARA trade mark’s reputation and to place the product into a more profitable category, therefore the relabelling was purely for economic reasons and not necessary for market access.

Impexeco & PI Pharma v Novartis (C-253/20 and C-254/20)
Europe

Louboutin v Amazon

Background:
• Third parties selling infringing products on Amazon
• Was Amazon “using” the trade mark?
CJEU decision:

- Amazon is a “hybrid marketplace”
- Advertisements displayed on an online sales website incorporating an online marketplace must be presented in a way which enables a well-informed and reasonably observant user to distinguish easily between offers originating, on the one hand, from the operator of that website and, on the other, from third-party sellers active on the online marketplace which is incorporated therein
- Amazon’s listing does not enable user to understand whether product originates from Amazon or third party therefore Amazon is itself using the trade marks

Relevant factors:

- Uniform listings
- Logo in adverts
- Additional services
Quiz Question 2

What act of ‘use’ does not belong in this non exhaustive statutory list of ‘use’ – it is from the UK but this replicates EU legislation:

*a person uses a sign if, in particular, he—*

- affixes it to goods or the packaging thereof;
- offers or exposes goods for sale,
- sells
- puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
- imports or exports goods under the sign;
Background:
- Opponent's SKINTEGRITY in Classes 5, 10 & 25
- Applicant's figurative mark in Class 3 (creams, cosmetics, serums etc.)

General Court:
Upheld likelihood of confusion
Class 5 ‘pharmaceutical products for skin protection and cleansing purposes of personal hygiene’ similar to Class 3 goods because:
- Same nature and purpose
- Likely to have same ingredients & consistency
- May be same distribution channels
- Complementary
UK

Combe v Wolff

• High Court: VAGISAN infringed VAGISIL
• Statutory acquiescence if continuous period of five years
• Interesting decision because the Court of Appeal applies leading pre-Brexit CJEU cases and is persuaded by a post Brexit CJEU decision

Court of Appeal:
• UKIPO cancellation action after 3 years did not stop the clock.
• Bringing infringement proceedings is only way to stop the clock.
• However, Claimant believed the infringing product had been withdrawn. So were not continuously aware of defendant’s use for 5 year period.

Result: The acquiescence defence failed. Infringement upheld.

Combe International LLC v Dr August Wolff GmbH [2022] EWCA Civ 1562
Quiz Question 3

I mentioned the concept of taking into account the ‘legitimate interests of the trade mark proprietor’ on a number of occasions already when referring to the CJEU and UK case law. From where does this term originally come from? It is not a case.
Sky v Skykick..... Still to come this year

Bad faith trade mark filings?

Chronology:
- 2018: High Court judgment finds infringement
- 2020: CJEU referral (bad faith, broad specs)
- 2021: Court of Appeal rejects bad faith allegation and restores Sky's trade mark registrations

Issue- Is the lack of intention to use a TM in relation to certain types of goods and services falling within a broader category of goods/services considered an application in bad faith?

Supreme Court: to be heard in June 2023

Sky Ltd and others v Skykick, UK Ltd and another [2021] EWCA Civ 1121
Meenaxi v Coca-Cola

- Coca-Cola owns THUMS UP and LIMCA brands in India
- Meenaxi has distributed the drinks in the US since 2008.
- Coca-Cola brought cancellation proceedings against Meenaxi’s US marks for THUMS UP and LIMCA.

Federal Court reversed cancellation of marks:
- Territoriality; Langham Act does not require Coca-Cola to possess or use a TM in commerce in order to seek cancellation. Relied on alleged reputational injury arising in the Indian-American community.
- However, Coca-Cola unsuccessful because:
  - unable to identify any lost sales or reputational injury in the US
  - Court not persuaded that members of the Indian-American population in the US were aware of Coca-Cola’s foreign products let alone misled

Meenaxi Enter., Inc. v. Coca-Cola Co., 38 F.4th 1067 (Fed. Cir. 2022)
Abitron distributed products (identical to Hetronic’s and same branding) in the EU.
Hetronic awarded damages covering foreign sales that never reached the US or confused US consumers. Abitron appealed.

US Court of Appeals (10th Circuit):
Langham Act had extra-territorial effect despite general presumption against extraterritoriality.
Abitron’s sales had “substantial effect” on US commerce and applying Langham Act would not create a conflict with non-US trade mark rights:
- Some direct sales to the US;
- Some sales made abroad ended up in the US; and
- Some diverted foreign sales that Hetronic would otherwise have made

Supreme Court to decide: When does the Lanham Act apply to non-US sales of foreign defendant?
USA

Jack Daniel’s v VIP Products….. Still to come this year

Background:
• Bad Spaniels dog toy
• First instance decision: dilution by tarnishment.
• Ninth Circuit reversed: “humorous parody”, entitled to First Amendment protection.

Supreme Court to decide:
• Is humorous use on a commercial product subject to usual likelihood of confusion analysis?
• Whether humorous use on one’s own commercial product is ‘non commercial’

Jack Daniel’s Properties, Inc. v. VIP Products LLC, No. 21-16969, 2022 WL 1654040 (9th Cir. 2022)
Background:
Novartis in Chinese (Class 5) vs. Novartis LU and Novartis TUO PIAO in Chinese (Class 3)

Beijing High Court:
• 诺华 (Novartis in Chinese) is a well-known trade mark so entitled to cross-class protection to “shampoos; cosmetics and etc.” in Class 3
• 诺华露 (Novartis LU) and 诺华妥飘 (Novartis TUO PIAO) therefore invalid
• Although 诺华 (Novartis in Chinese) not used to identify a particular pharmaceutical product it is still used in relation to those products because even if not the name of the medicine, it can denote the source of origin.
China

**JAGERMEISTER**

**Background:**

- Defendant used deer head graphic and the name “YEGO HUNTER”.

**Beijing Intellectual Property Court:**

- “Jägermeister” well-known trade mark with a “high reputation”.
- Obvious intention to free-ride.
- Found trade mark infringement and unfair competition.
- Jagermeister awarded over US$ 1.4 million in punitive damages. Defendant continued acts, did not engage with cease and desist letter.
A “Jaegerbomb” is a shot of Jagermeister inside a glass of Red Bull. What do you call a shot of Red Bull in a glass of Jagermeister?
India

Mankind Pharma v Tata Medical & Diagnostics

Background:

• OMIPURE in class 5 for antacids, anti-reflux agents and anti-ulcerants
• Tata Medical & Diagnostics used ‘OMISURE’ for PCR test kits

Delhi High Court:

• 9 year gap where there were no sales of ‘OMIPURE’
• Different products (capsule v swab) and sales method (OTC vs labs)
• “Blurring” not well founded given absence of sales-need extensive use for dilution
• No risk of confusion: Interim injunction not granted.
India

Sun Pharmaceutical v Hetero Healthcare

Background:
INN - ‘Letrozole’
Sun product: “LETOZ”, alleged TM infringement against Hetero in relation to “LETERO”.

The Delhi High Court:
• Little possibility of confusion because of colour scheme, packaging and price differences.
• Adopted first 6 letters of the INN name.
• No distinctiveness or exclusiveness could be claimed in LETROZ when that name is so closely derived from the INN.
Self Care IP v Allergan - High Court

Background:
Appellant used sign PROTOX, a skincare product advertised as an injection-free solution to 'prolong the look of Botox®', and
Also used 'Inhibox', a skincare product advertised to be an 'instant Botox® alternative'.

Decision:
No infringement - clarified previous Federal Court decisions and determined you do not take reputation into account when assessing deceptive similarity. No risk of confusion.
The phrase ‘instant Botox alternative’ was not used to indicate origin so no infringement.

Yey Pty Ltd v Active Skin Pty Ltd [2022] FedCFamC2G 865 (Federal Circuit Court of Australia)
Australia
Yey v Active Skin

Background:
- ACTIVE SKIN (word and device) for online retail and wholesale of cosmetics and related services
- Opposed ACTIVE SKIN (word and device) for cosmetics

Decision:
- Opponent possessed significant reputation in cosmetic retail services in its mark.
- Applicant’s evidence of use at the priority date was insufficient, even if it predated Opponent’s use.
- Registration refused: likelihood of confusion because consumers likely to assume Yey has expanded beyond online relating into distribution services.

Yey Pty Ltd v Active Skin Pty Ltd [2022] FedCFamC2G 865 (Federal Circuit Court of Australia)
Quiz Question 5

What is the name of the Australian men's rugby team?
Thank you

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