

Law Lore & Practice

PTMG



Pharmaceutical
Trade Marks Group

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Editorial: Europe

Next month 400 million European Union citizens will go to the polls to elect their representatives for the next five years. These elections will take place over four days with each country adapting the vote to its national practice and rules. This means that the minimum age for candidates from each member

state varies and nationals living abroad do not all have the possibility of voting in these elections, while compulsory voting exists only in four countries.

Much has been made about the fact that 2024 will see more people around the globe being able to vote than in any previous year, approximately 49% of the world's population in total. India's elections are currently underway until 1st June, allowing the 970 million people eligible to vote to reach the polling stations, while all eyes will inevitably be drawn to the duel across the pond in November. Meanwhile, the current situation on the eastern side

of the European continent should make these upcoming elections some of the most crucial in living memory.

Derived from the Greek words 'eurus' (wide) and 'ops' (eye), the continent is named after a mythical figure. A beautiful Phoenician princess from the city of Tyre who was abducted by Zeus disguised as a bull. Nowadays, this story is depicted on the Greek EUR €2 coin to pay tribute to the Godmother of Europe.

PTMG was recently in Athens, the birthplace of democracy, and delegates are impatient to discover in October the island in the centre of the Mediterranean that currently serves as the southernmost border of the continent. Here's hoping that all EU citizens who go to the polls between June 6th and 9th will have their eyes wide open as they cast their ballots.

I look forward to seeing many of you in Malta.

Vanessa

US Update

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

Trade mark counterfeiting poses significant public health risks, and economic and reputational challenges for pharma companies. In addition to civil counterfeiting actions, criminal prosecutions are an additional enforcement option if prosecutors can be convinced to take action. A recent case, *US v Davis*, exemplifies criminal prosecutions, even when defendants assert novel defenses. *US v Davis*, 2024 WL 343173 (E.D. Pa.).

<https://casetext.com/case/united-states-v-davis-3210>

In this case, the defendant sought to defend himself against charges of selling counterfeit pills on the ground that they were merely props for use in films and music videos. The pills lacked the active ingredients of the genuine products, but

nevertheless bore counterfeit trade marks, such as XANAX, and mimicked the appearance of anti-anxiety medications as well as oxycodone and hydrocodone. Selling through the website *rcroppill.com*, the defendant's scheme allegedly targeted drug dealers as customers. These dealers reportedly mixed the defendant's fake pills with genuine ones when selling to end-users.

The defendant moved to dismiss the charges, arguing that he had not trafficked actual pharmaceuticals (merely props) and thus should not be subject to drug-related anti-counterfeiting criminal statutes. However, the court rejected this defense, stating that the charges were rooted in broader anti-counterfeiting laws prohibiting the intentional trafficking of any goods (not just drugs) bearing

counterfeit marks.

The defendant argued he did not replicate the genuine pharmaceuticals, but the court noted it is 'axiomatic' that a counterfeit is never the 'real deal'. The court underscored the potential for post-sale confusion and injury, and how end-users could be misled despite defendant's disclaimers.

Public prosecutors, of course, contend with limited resources and various competing problems. Once they engage, they assume control over the prosecution and any settlement (plea) decisions, not the aggrieved pharma company. However, pharma companies may find themselves well served and strategically positioned to garner the interest of law enforcement authorities regarding counterfeiting problems, given the inherent danger posed by phony drugs.



I am honoured to have been elected as the new PTMG Chairman at our 103rd conference in Valencia. It is a privilege to have the opportunity to lead an organisation as reputable and respected as PTMG. I would like to thank my predecessor Myrtha Hurtado Rivas. She took over the role of Chairman from Frank Meixner in a difficult time during the pandemic and did a great job of guiding us through the online conferences and then our memorable return at the 100th conference in Lisbon.

Springtime in Valencia... the rain was a surprise! We had a wonderful PTMG Spring Conference with high quality speakers on a diverse range of topics such as Fonts, AI & copyright, the truth about Madrid and Social Media in the Pharma industry ..., to name just a few. As always, we had the chance to catch up with and meet new colleagues at dinner in a gorgeous location, together with a breathtaking Flamenco display to inspire us on the dancefloor at the next Autumn conference.

I am sure that like me, you will always remember your first PTMG conference fondly and the opportunity to join the PTMG community which is such a global, diverse and interesting group. I hope to maintain the excitement of PTMG meetings, to ensure we continue to deliver high quality presentations on topics which are relevant to the industry and all of our members.

As we look forward to the next conference in Malta in October, I am confident that we will continue to tackle relevant topics and provide thought-provoking discussions. I would like to take this opportunity to thank the Committee members who put so much work into ensuring the program is relevant. I look forward to seeing many of you in Malta. Until then, I hope you have a pleasant, calm and restful summer.

Kind regards

Jo

The top of the ICE-berg

Kelly Saliger, Partner, CMS (United Kingdom)

And your time. Starts. Now!

Statutory acquiescence is a defence against trade mark invalidity and infringement proceedings where the owner of an earlier trade mark with knowledge of use of the later trade mark has allowed **5 years** to pass without initiating proceedings. This 5-year period traditionally began when the earlier trade mark owner became aware of both **the use and registration** of the later trade mark. This was the precedent in the UK and EU after the CJEU case of Budvar, which subsequently became retained law in the UK following Brexit. However, the Court of Appeal of England & Wales has developed that precedent further.

In the case of Industrial Cleaning Equipment v Intelligent Cleaning Equipment, the Court of Appeal ruled that the 5-year period for calculating statutory acquiescence now runs from the date the earlier trade mark owner becomes aware of the use of the later trade mark, irrespective of when they become aware of the registration of the trade mark (assuming there's a registration at all). The result? A cynic might say it is encouraging litigation in the UK, the idealist that it is notifying new businesses early of any conflict rather than letting years pass unchallenged and lulling them into a security under which they build their brand.

Background

The background relates to a dispute concerning the acronym 'ICE'. The defendant was the owner of two international trade marks, registered at both the WIPO and EUIPO, the latter being replaced with comparable UK marks as a result of Brexit, with a date of entry in May and June of 2016. The claimant admitted to having knowledge of the use of these marks from around July 2014 but insisted they were unaware of the registration of these trade marks until 2019. This is when the dispute began and the claimant commenced formal proceedings in May 2021.

In the first instance, the claimant was granted relief for trade mark infringement, with the Judge rejecting the defence of statutory acquiescence lodged by the defendants. This was because the claimants, as mentioned before, had not become aware of the registrations of the trade marks until 2019 and so the 5-year period had only commenced then. On appeal, the defendants invited the Court of Appeal to depart from this and to make it sufficient that the earlier trade mark owner was aware of the use of the later trade mark and to deem it irrelevant whether they were aware of the mark's registration. Arnold LJ, who led the Court of Appeal, was persuaded.

Departure

The Court of Appeal, in one of the first

post-Brexit departures from EU law, decided that it was right to develop Budvar using the power afforded to them in the European Union (Withdrawal) Act 2018 and build on the current approach. As a result, in Industrial Cleaning Equipment, it was decided that the five-year period begins to run when the owner of an earlier trade mark becomes aware of the use of the later trade mark, irrespective of whether they are aware of its registration.

Why?

The Court of Appeal cited various reasons for departing from the previous case law of Budvar. The most persuasive reason was the lack of consensus within the European Union courts themselves, with various cases seemingly departing from the required knowledge of registration to varying degrees. Furthermore, Arnold LJ argued that if the legislature required awareness of registration, then it would have been simpler just to say so. He also outlined the difference between registration and use, the former conferring a negative right (i.e., preventing another from using that mark) and the latter a positive one (namely, affecting the commercial market). The Court of Appeal believed it was time they exercised their powers to diverge from the EU and suggested that the Budvar decision will likely be overruled in the future within the EU as well.

Implications

In the pharmaceutical industry, unlike many others, trade marks are usually registered long before use begins as it can take a number of years to complete clinical trials, obtain marketing authorisation and then run clearance and register your mark (in whichever order the business prefers to operate).

Nonetheless, the departure in this case is important for all of those with charge of their client's or businesses' trade mark prosecution and litigation strategies – encouraging those with conflict to pursue their claims early and fully. This is a reoccurring theme in the UK world of trade mark litigation, asking those with a claim to be timely, upfront and practice with exemplary behaviour before the UK courts (Match Group v Muzmatch). The Muzmatch case was another example of where the UK courts left open a future divergence from EU law, suggesting that in very specific circumstances, goodwill acquired through trade could lead to a situation where the average consumer recognises that the signs have different origins – this being a factor in the overall assessment of confusion (honest concurrent use) and potentially a finding of no confusion, and so no infringement.

The cases are complex but clear – don't delay, sue today, or risk losing the ability to do so.

Members News

New Members

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

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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

A Guide to Trade Mark Opposition Procedures in the MENA Region

Zeina Salameh, Saba & Co. Intellectual Property s.a.l.

Navigating the complexities of trade mark protection in the Middle East and North Africa (MENA) requires a nuanced understanding of diverse legal landscapes. Each country in the MENA region has developed its trade mark laws based on different legal influences. For instance, while many Gulf countries are influenced by Islamic law, others may incorporate elements from French or British legal systems. This leads to substantial differences in how trade mark laws are interpreted and applied, including the opposition process.

This guide offers an analysis of the opposition system, providing clarity and insights for businesses and legal professionals looking to protect their intellectual property.

Main Features of Opposition Proceedings

1. Pre-registration opposition proceedings:

In most MENA countries, there exists a period during which third parties may oppose a trade mark application, typically ranging from 60 to 120 days after publication, depending on the country. However, there are notable exceptions such as Lebanon and

Algeria, where pre-registration opposition is not available, leaving cancellation after registration as the only option for challenging a trade mark's validity.

2. Administrative vs Court proceedings:

Opposition proceedings are mainly administrative and conducted before the respective trade mark offices (TMOs) across the region. These administrative processes are generally less costly and focus primarily on the written evidence, adhering to the first-to-file principle common in the region. Iran and Tunisia present a unique case where oppositions usually escalate to court proceedings.

3. Extension of time:

Extensions to the deadline for filing an opposition are not typically possible, except in Jordan. However, even in Jordan, such extensions are not granted automatically. A full explanation of the reasons for the request must be provided and deemed acceptable.

4. Financial aspects:

Opposition proceedings typically do not result in monetary compensation. Costs

incurred are usually limited to the fees associated with filing and defending a trade mark opposition. Consequently, withdrawing an opposition or an application can generally be done without financial risk to either party.

Grounds for an Opposition

1. Criteria for Fame and other grounds for opposition:

Oppositions must be based on prior rights within the country. However, even if prior rights are not established locally, an opposition can still be filed based on fame. The extent to which a trade mark is considered famous is usually determined according to the international standards for the protection of well-known trade marks (Article 6bis of the Paris Convention) as well as the local standards for well-known trade mark protection. Any probative evidence will be accepted, and a determination will be based on the totality of the evidence, including such factors as (i) the duration and geographic extent of sales; (ii) sales figures; (iii) advertising figures and samples of advertising;

Continued on next page

OPPOSITION PROCEEDINGS



Pre-registration opposition proceedings **available** except in Lebanon and Algeria



Opposition proceedings **administrative** and requests for **extending the opposition period** possible in Jordan only



Skeletal submissions possible in Egypt, Kuwait, Oman, KSA, and UAE



Oppositions must be filed based upon **prior rights** in the country of publication



No monetary compensation expected out of oppositions



Use of prior mark can not be contested

MENA Trade Mark Opposition Procedures cont

(iv) awards, reviews and press reports; (v) the reputation of the mark within the relevant trade and consumer groups in the country; and (vi) expert testimony and surveys designed to assess the recognition of brand names.

Other admissible grounds for opposition include: absolute grounds, bad faith issues, rights under Article 6septies of the Paris Convention (registration in the name of the agent or other representative of the proprietor of the mark), rights under Article 8 of the Paris Convention (trade names), rights under Article 6ter of the Paris Convention (Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations), and offenses against public policy or principles of morality. Copyrights are not typically a valid basis for opposition in most countries, except for Morocco.

2. Contesting use of prior marks:

In all countries except the UAE, the applicant cannot contest the use of the prior mark that forms the basis of the opposition during the opposition proceedings. Separate non-use cancellation proceedings must be initiated, and the opposition proceedings will not be interrupted pending the issuance of a decision in the cancellation action and vice versa.

Briefs, Counterstatements, Oral Hearings, and Withdrawal of an Opposition

Most MENA countries still adhere to traditional paper-based submissions for oppositions but the process from filing an opposition to its resolution can differ from one country to the other. Some countries handle oppositions primarily through written submissions, while others, including Saudi Arabia, UAE, Egypt, and Oman, may require or allow for oral hearings, which can influence the preparation and presentation of the case. These hearings provide a platform for both parties involved in the opposition to elaborate on their arguments and answer any queries the authority might have. The availability and procedural importance of

oral hearings can depend greatly on the specific rules and practices of each country's TMO. Also, while there are no strict requirements for the format of documents in opposition proceedings, it is generally advisable to have supporting evidence translated into Arabic to facilitate understanding and processing.

Additionally, the role of the TMO in mediating or adjudicating these disputes varies, with some offices taking a more active role in seeking settlements or mediations. In Tunisia, for example, the TMO only plays a mediating role, facilitating meetings to encourage settlement between parties. If unresolved, the dispute may require judicial intervention to prevent the registration of a contested mark.

As the party bringing the case, the opposer is responsible for submitting a brief on the case. In jurisdictions such as Egypt, Kuwait, Oman, Saudi Arabia, and the UAE, it is possible to make bold submissions at the time of filing and then supplement arguments in response to a counterstatement. The applicant may file a counterstatement or choose not to. In most countries, with the exception of Bahrain, Saudi Arabia, Yemen, and Tunisia, the TMOs share the applicant's counterstatement with the opponent. However, in the UAE, the counterstatement is only accessible if a specific request is filed at the TMO.

Regarding the withdrawal of an opposition, in all countries, the proceedings automatically end upon withdrawal, regardless of whether the withdrawal terms are agreed upon by the applicant or opponent. However, in some jurisdictions, the process requires an official notification to formally conclude the proceedings. Until this notification is issued, both the opposition and the opposed application remain pending indefinitely. This can lead to complications where the opposed application blocks the registration of new applications on relative grounds, and no decisions can be made until the official notification is released, a situation commonly encountered in Egypt.

Conclusion

Trade mark opposition procedures in the MENA region are as diverse as the countries themselves, each with its specific requirements, timelines, and procedural nuances. Understanding these distinctions is essential for effectively navigating trade mark disputes. For businesses operating across this diverse region, crafting a tailored approach that respects these differences is essential for effectively managing and protecting intellectual property rights. This strategic awareness can facilitate smoother resolutions to trade mark disputes and help establish a stronger presence in the market.



International Update

GERMANY

Dr. Magnus Hirsch SKW Schwarz Rechtsanwälte

The Appellate Court of Hamburg recently decided that the use of a trade mark for the goods 'medicinal products' does not require that the branded product has a domestic marketing authorization as a medicinal product (judgment of 12.10.2023 - 3 U 60/22). In addition it held that for medicinal products which are not freely tradeable and which have to be ordered in small quantities by pharmacies pursuant to section 73 III German Pharmaceuticals Act (AMG) by way of individual procurement on the basis of orders placed by individual persons, lower quantitative requirements are to be placed on a use which preserves rights.

A pharmaceutical company which owns the German word mark H 15 in classes 3 and 5, including for 'pharmaceuticals', has been seeking injunctive relief against the defendant and its use H 15 or Hecht H 15® or H 15® Weihrauch. In turn, the defendant raised the non use defense.

The applicant has been using the mark H 15 Gufic for so-called Ayurvedic medicinal products with an active ingredient from frankincense extract. The Hamburg Regional Court considered the use as genuine and sufficient and granted the applicant's injunctive order. The defendant has appealed against this judgment.

The Regional Court had argued that the substantiation of sales of approximately 250 packs per year in Germany under the injunction mark was sufficient as use to preserve its trade mark rights. It had to be taken into account that the preparation did not have a German marketing authorization, which is why distribution in Germany had to be based on the exceptional provision of section 73 III AMG, i.e., in particular that the medicinal product had to be ordered in small quantities by pharmacies on the basis of orders placed by individuals. In view of the fact that it could not be freely traded, the sale of around 250 packs per year was sufficient to maintain the right of use. This view was sustained by the Appellate Court.

The Appellate Court also upheld the view that the authority's approval of the (branded) product as a medicinal product was not a prerequisite for the use of the goods 'medicinal products' in order to preserve trademark rights. There were no reasonable doubts about the classification of the preparation as a 'medicinal product' and the application of the regulations of the AMG. The refusal of approval due to

possible serious side effects does not make the preparation a dietary supplement or even a foodstuff. Rather, it remains a medicinal product that can only be marketed in Germany under the conditions of the AMG.

Both the regional and Appellate Court of Hamburg also confirmed that there was a likelihood of confusion between the mark H 15 and the defendant's signs H 15, H 15® Weihrauch and Hecht H 15® due to a high degree of similarity of signs and goods, namely medicinal products and food supplements with frankincense extract.

While the decision is a welcomed clarification regarding the use of trade marks for not specifically authorized medicinal products, it cannot be generalized to the effect that the sale of a quantity of 250 units always satisfies the quantitative requirements for genuine use, so that a case-by-case assessment will continue to be necessary in order to determine the genuine use of a trade mark.

GREECE

Eleni Lappa, IPWORK

By issuing its decision no. 2214/2023 the Council of State (the supreme administrative court in Greece) affirmed as lawful and consistent with the Constitution and the general principles of EU law, the order of the National Pharmaceutical Organization (NPO) which temporarily banned parallel exports of certain pharmaceuticals within the EEA and other countries.

The NPO took this action for the sake of public health and public interest and wanted to discourage incomprehensible incidents of shortage of certain medicinal products, stocks of which were believed to exist in Greek distributors' warehouses. Pharmacist associations viewed such shortages as an effort by some distributors to increase their business profit by stocking up on certain pharmaceuticals and then selling them off to other EU countries where their retail price is much higher as per relevant media reports.

Inspections to distributors' storage houses were put in place by the NPO for the purpose of ensuring compliance. If deviation from the NPO's order were discovered, fines were imposed.

The Council of State's decision gave the 'green light' to the NPO that all such measures were lawful, in order to protect the consuming public and, even more importantly, patients, who had experienced serious shortages of medicines necessary

for their health and wellbeing. The Council of state held that, whenever issues of public policy are at stake, such as public health, public safety and well-being, the NPO is allowed to take measures which are proportionate and responsive to the circumstances. Such measures can be legitimately taken by the NPO both on a reactive basis (as a response to an existing or anticipated shortage) and also on a proactive basis (in order to avert risks on public health and public safety). In this case, the principle of freedom of movement of goods within the EEA has been superseded by the principle of safeguarding public health and safety for the time needed to secure the required quantities of missing medicinal products to patients. The NPO's renewed order is to have effect until 19 April 2024, unless a further extension is deemed necessary.

The Council of State's ruling is important on a European level, as it confirms that in the interest of public health and public safety the principles of a free economic activity within the EEA may come second, if there are instances where prioritizing is necessary, for a limited time, as may be needed in the circumstances.

In part due to the post-Covid era and the new realities it brought to the area of health and safety, reports of extensive lists of medicinal products missing have been highlighted by mainstream media in various countries, including the US, showing incidents of serious conditions for which patients could not locate their prescribed medicine.

To be fair, in many if not most cases, generic medicines were actually available for patients to take, however as the issue of medicine and human health is dependent on many sensitive parameters, it is important to have available the medicine of choice in each occasion, for the patients to choose, with the guidance of their healthcare provider.

SUDAN

JAH Intellectual Property

As of 11 February 2024, the Sudanese Trademarks Office has resumed its normal operations after an almost 10-month closure period as a result of the unrest in the country. As of now, the TM Office has started accepting filing of new trade mark applications, renewals, recordals...etc. without attending to subsequent procedures such as examination of applications and supporting documents, which will be dealt with as soon as their trade mark database has been updated. All pending instructions received during the TM Office closure period will be dealt with immediately once the trade marks office resumes its normal operations.

Could UK Appeal Court decision help those seeking non-traditional trade mark protection?

Emily Swithenbank & Gill Dennis, Pinsent Masons (United Kingdom)

In March 2024, the Court of Appeal of England and Wales handed down its judgment in *Lidl v Tesco*. These were high profile proceedings between two major supermarkets.

Discount supermarket Lidl has used the 'Mark with Text' since 1987 and owns UK trade mark registrations for both the Mark with Text and the 'Wordless Mark' (both shown below – together 'the Trade Marks'). The Wordless Mark has never been used in its registered form.



The Wordless Mark



The Mark with Text

In 2020, Tesco began using 'the CCP Signs' (an example of which is shown below) to promote its Clubcard Prices, being discounted prices available to its loyalty card holders.



Lidl issued proceedings for trade mark infringement under s10(3) of the Trade Marks Act 1994 alleging that the CCP Signs took unfair advantage of, and/or diluted, the distinctive character and reputation of the Trade Marks by suggesting price equivalence. Lidl's argument was that consumers seeing the CCP Signs would make a link to the Trade Marks and Lidl's reputation for low prices and believe (incorrectly) that Tesco's goods were 'price matched' (available at the same or a lower price than Lidl's goods). This would slow down the rate at which Tesco shoppers looking to make savings would 'switch' to Lidl. Lidl also claimed passing off and copyright infringement.

Tesco counterclaimed for revocation of the Wordless Mark for non-use and/or bad faith alleging that at the time of applying to register the Wordless Mark

Lidl had no intention of using it.

Lidl was successful in the High Court on trade mark infringement and passing off. In particular, the judge held that Lidl's 'Vox Populi' evidence, consisting of spontaneous and unprompted consumer comments on social media, demonstrated that consumers did indeed link the CCP Signs and the Mark with Text, erroneously assuming (or being deceived as to) price matching by Tesco to Lidl. She held that these consumers were 'not outliers' but were likely to be 'the tip of the iceberg'. The judge also upheld the claim for copyright infringement.

On Tesco's counterclaim, the High Court was satisfied that the Wordless Mark had been genuinely used but revoked the registration for bad faith. The judge held that the initial registration had been obtained purely for use as a legal weapon in enforcement proceedings and that most of Lidl's subsequent registrations were 'evergreened' versions of it.

Both Tesco and Lidl appealed.

Tesco's principal ground of appeal was that the High Court judge had erred in her assessment of Lidl's evidence and was wrong to find as a fact that consumers would link the CCP Signs and the Mark with Text and believe that Tesco's goods were price matched to Lidl's. Giving the leading judgment, Lord Justice Arnold stated that this finding was 'somewhat surprising' as the CCP Signs made no reference either to Lidl or to price matching. However, although the judge had made a 'small flaw' in the weight she had placed on some of Lidl's evidence, this did not undermine her assessment of the rest of the evidence. Acknowledging that an appellate court was only able to interfere where the decision at first instance was 'rationally insupportable', Arnold LJ upheld the finding of trade mark infringement and passing off. The judge had been entitled to make the assessment she did on the evidence before her and there was no basis for overturning it.

Lord Justice Lewison expressed similar surprise at the judge's finding of fact based on the evidence. He too doubted whether he would have come to the same conclusion but agreed that it was not open to the court simply to substitute its

own evaluation where (as here) the judge's finding was rationally supportable.

The Court of Appeal also upheld the revocation of the Wordless Mark, finding that there was no serious flaw in the judge's reasoning here either. However, the Court did overturn the finding of copyright infringement holding that, although the version of the Mark with Text pleaded by Lidl was sufficiently original to attract copyright protection, the scope of protection was narrow. As at least two of the key elements had not been replicated (the shade of blue and the distance between the circle and the square), there was no substantial copying by Tesco.

In this case, Lidl asserted, and the courts accepted, that the Trade Marks did not only denote Lidl the supermarket. Through Lidl's use, consumers also perceived the Trade Marks as having a broader (arguably descriptive) meaning of denoting discount pricing. This was central to Lidl's success in its trade mark infringement claim as it was accepted that consumers would not be confused as to trade origin of the Tesco products. On its face, this would appear to be helpful to those seeking non-traditional trade mark protection in the pharmaceutical sector. Brand owners regularly seek to widen the scope of protection for their products through the registration of colour or shape trade marks but run into difficulties when that colour or shape over time is perceived as the informal convention for a given type of product. The General Court's recent decision on purple inhalers in *Glaxo* acknowledges that user perception can change over time according to new trends and product evolution.

However, while the Lidl decision recognises that Trade Marks can be infringed where the use only encroaches upon that wider equivalence-type meaning, it does not impact the initial question of validity; there remains the necessity for the trade mark to also designate the origin of the products in the eyes of consumers. If the Trade Mark only denotes products with a certain characteristic and not also origin, then the infringement argument becomes moot with the trade mark likely being declared invalid.

I03rd PTMG Conference, Paella and IPTizers, Time to taste what the IP world is cooking!

Rebecca Atkins, Abel + Imray

Having lived in Valencia 20 years ago, the city is like a second home to me, so I was thrilled to have a reason to come back. Situated on the beach overlooking the Mediterranean, the Hotel Las Arenas provided a great setting for the conference. I did not hear of anyone going for a swim in the sea, although this was probably in view of the weather and unfortunately, the outdoor pool was closed.

PTMG's I03rd conference, 'Paella and iptizers, time to taste what the IP world is cooking!' (although the lack of paella was noted by some delegates!), began on Monday after lunch and the AGM, in which Joanne Green was formally appointed as the new Chairperson, taking over from Myrtha. Joanne welcomed us all to Valencia and thanked Myrtha for her time as Chair during the Pandemic, leading us through a mix of online and in-person conferences.



Joanne Green

We started, rather appropriately, in Spain, with Marta Gimeno's look at the implementation of the new EU Trade Mark Directive. Marta provided a clear summary of what has changed in Spanish Trade Mark Law and Practice since the EU Directive was brought into effect. Whilst most of the Directive was implemented in 2019, provisions relating to the administrative proceedings for cancellation and invalidity actions did not come into force until 2023.

The most significant changes included the removal of the requirement for graphical representation, making the registration of non-traditional trade marks easier, at least in principle. Marta provided some examples of sound marks registered in Spain, and gave some statistics regarding other non-traditional trade marks: there are 40 motion marks on the register, and only 13 pending applications for hologram marks.

Another key change was the removal of the category of well-known trade marks known as 'notorious trade marks'. Previously, Spanish Trade Mark law recognised two distinct categories of famous marks: notorious trade marks - which are known by the relevant public in that particular sector (Marta gave Gibson

guitars as an example) - and well-known trade marks, which are more widely known to the general public (marks such as Zara). Well-known trade marks under the EU Directive fall somewhere in between. There is some concern, however, that marks which would have previously passed the test to be considered 'notorious' will no longer benefit from a broader scope of protection.

In practice, it seems that it will be more difficult for the Courts to analyse the evidence and decide on the scope of protection. There was more discussion on this topic at the end of the talk and it was noted that the CJEU appears to now be distinguishing between marks with a reputation and marks with an exceptional reputation, much like the old Spanish practice. It will be interesting to see how the Spanish Office and Courts implement this change and whether both types of well-known mark will continue to be afforded a broader scope of protection.

Up until 2023, all Spanish cancellation actions were handled through the mercantile courts. Marta took us through the new rules relating to these proceedings at the SPTO, alongside the grounds for and the effects of revocation and invalidity, which many of us are already familiar with as they largely mirror the practice of the EUIPO and UKIPO. There are advantages and disadvantages of the new procedures; Marta mentioned that she is not keen on the lack of oral hearings, and Applicants cannot see TM Proprietors' responses in cancellation proceedings, but overall the process is likely to be simpler and cheaper (it remains to be seen whether it is quicker as there have been relatively few cancellation actions so far). The new rules also allow for torpedoing in infringement actions.

Other changes, which delegates from other member states and the UK will be familiar with, included the requirement to file proof of use in opposition proceedings, rights of licensees to bring infringement proceedings, and a registration no longer automatically grants the owner the right to use the mark if



Marta Gimeno

there are earlier third party rights.

The title of the next talk ('All you ever wanted to know about copyright') downplayed the topical nature of Constantin Rehaag's presentation and its relevance to current copyright discussions. It was in fact a very comprehensive look at copyright issues arising from the increasing use of AI; a hot topic, with all industries considering how it can be used without impacting the value of human input. Constantin's objective was to demystify AI-related copyright issues, and he certainly did that well, whilst leaving us with a lot to think about.

He began the talk with a great example of an AI-generated brand, campaign, slogan and packaging for a new analgesic, using ChatGPT and neuroflash.com

The result was 'ReliefXcel' and an amusing campaign description including 'Break Free from Pain, Live Life Unleashed' which Constantin described as 'gripping' and 'a movement for living'. The packaging, whilst clever in the lid design, had some limitations including the lack of any branding. This was an interesting example of how LLMs and

AI can be used in the healthcare industry and some of the challenges that may crop up, including issues with trade mark clearance and infringement (in a similar way to the problems which can arise when using a branding agency).



Constantin Rehaag

Moving on, Constantin gave a recap of the basics of copyright and the definition under the German Copyright Act, noting the prerequisites for copyright to subsist in a work. The most relevant of these when considering AI is the need for human involvement; the work must be created by a human and, accordingly, AI-generated material is not necessarily protectable. Constantin considered where the data for AI models comes from, whether it is original, how human and machine actors contribute to the creation of AI-generated works and how this leads to questions over authorship and ownership. Is a prompt by a human enough for 'authorship'?

Continued on next page

Conference Report: continued

He turned to the German Federal Supreme Court for some of the answers and discussed the importance of clever prompting; if we provide precise, detailed prompts and essentially downgrade the AI application to a typewriter, it will be easier to claim copyright ownership in the output. It is clear that lots of practical issues arise from the use of AI and there are a number of risks relating to copyright. First, in relation to the input and training of AI applications (text and data mining and copyright infringement). Second, ensuring that we make the work our own: what can the creator do to make sure the output is protectable by copyright? This led to discussion among delegates around disclosing the extent to which AI has been used, for example, in news articles or by marketing agencies, and the need for agreements with marketing agencies to be updated to refer to AI-created outputs.

In the final session of the afternoon, Alexander Roussanov presented some of the challenges arising out of the increasing use of social media for the pharmaceutical industry, and the risks relating to social media posts and advertising. He began with an introduction to advertising and promotion of medicines, providing the definition from Article 86(1) of the EU Directive: 'any form of...inducement designed to promote the prescription, supply, sale or consumption of medicinal products' and set out the main principles for advertising pharmaceuticals. These include the prohibition of off-label promotions, and promotion of prescription-only medicines to the general public, and the need for adverts to be accurate.

There are certain activities which may not be 'promotional' at first glance but could still be considered to promote products. In the Damgaard case, the court held that offending promotions may not necessarily be in the course of commercial activity or disseminated by the manufacturer or seller of the products; advertising can be anything that motivates the consumer to change its behaviour, and third-party articles could also be considered to be promotions.

Care should therefore be taken as responding to requests on social media, posting press releases on social media, quotes from the CEO, clinical trial



Alexander Roussanov

recruitment on social media could all fall foul of the regulations.

Alexander gave some interesting examples of problematic activity on LinkedIn, Twitter/X (which he thinks is a minefield!) and Instagram against which The Prescription Medicines Code of Practice Authority (PMCPA) in the UK took action. The PMCPA provides detailed guidance on what should be considered before posting material to social media. He also discussed two complaints heard by the PMCPA (against ALK-Abello and AstraZeneca) and in both cases the Panel found there was no breach of code.

The overall message was that companies should review compliance with the advertising regulations, have strict policies which provide employees with clear guidelines regarding what can and cannot be posted on social media, and focus on educating employees. As well as reducing the risks of inappropriate material being posted, this will also assist if they are found to be in breach of the legislation. He reminded us that there are no exceptions for social media. The same rules apply and social media is in fact riskier; it is difficult to distinguish between personal and business accounts, it is fast-paced and more informal, and the use of links and hashtags (never mention the product name) present problems. Moreover, you cannot control what happens to the post once it is released and you cannot control user generated content. Finally, he noted the difference between the EU/many other countries and the US, where direct-to-consumer advertising is permitted.

Joanne then rounded up the afternoon by thanking the speakers and inviting delegates to dinner at Campo Anibal, a beautiful century-old house on a family citrus farm and surrounded by ancient gardens.

Delegates enjoyed the evening's cocktail reception and Gala dinner at the house. Unfortunately we could not make the most of the outdoor space and ancient gardens due to the rain, but the flamenco dancers provided excellent entertainment. As has become tradition, after some tricky trivia questions, Joanne announced that the next Spring Conference will be held in Edinburgh. She also wished Alan Hunter a very happy Birthday!

The next day kicked off with the international case round up, presented by Carlos Moran.

Carlos gave us a whistlestop tour through Nigeria, India, the EU, Spain, US and the Andean Community, with cases relating to company names, parallel imports, and jurisdiction of the EU Courts. Cases covered included:

a) Beverage City & Lifestyle GmbH et al v Advance Magazine Publishers Inc (DIAMANT VOGUE), in which the CJEU held that, under Article 8 of Regulation No. 1215/2012 Brussels I, an exclusive distribution agreement might allow for infringement proceedings to be brought in the Courts where the distributor is domiciled, where there are several

defendants and the claims are closely connected. In this case, the Vogue publisher sought a pan-EU injunction through the German Court whereas the drink was manufactured in Poland.



Carlos Moran

b) Schweppes, S.A. v Red Paralela, S.L. et al. – a parallel imports and exhaustion of rights case. Red Paralela imported tonic water manufactured in the UK into Spain. Schweppes SA brought infringement proceedings and claimed their rights had not been exhausted as the goods had not been put on the market in the UK by them or with their consent (Coca-Cola owned the trade marks in the UK and had put the products on the market there, and there was no economic connection between Schweppes and Coca-Cola). There was some back and forth, but the CJEU and the Spanish Supreme Court held that Schweppes' rights were exhausted; the two companies conveyed the image of a single global trade mark, there was clearly still a connection between Coca-Cola and Schweppes and their protection of the mark, and the bottles sold in Spain referenced the UK origin of Schweppes tonic water.

Turning to a couple of cases involving pharmaceuticals, Carlos mentioned Sage Therapeutics, Inc. v Sagely Enterprises Inc from the US, in which the TTAB confirmed that cosmetics containing CBD in Class 3 are not similar to pharmaceuticals in Class 5, as consumers will not associate CBD products with pharma products or believe that they come from the same manufacturer. He also drew our attention to Indian Immunologicals Ltd. v IPCA Laboratories Pvt. Ltd, a case in India involving the marks INIMOX v IMOX. It was held that marks which are derived from the active pharmaceutical ingredients have weaker protection. In this case, MOX was commonly used and not distinctive and the elements INI and I were sufficient to distinguish the marks.

Continued on next page

Conference Report: continued

Next, Lisa Ritchie, who expressed how delighted she was to be back as part of the LL&P team, drew on her previous in-house experience in an FMCG (non-pharma) company to provide a comprehensive insight into how to build an IP strategy and the key elements to this.

She made it clear that she was not trying to be prescriptive when it comes to IP strategy; what she covered was not intended to be new or revolutionary but she wanted to bring together a range of ideas and suggestions for companies to then create their own approach.

Lisa set out four pillars as the foundation of an effective, holistic, IP Strategy and then applied each of these to the pharma industry: defensive risk management, IP portfolio building and maintenance, proactive enforcement, and commercial and advisory support. Of course, a number of factors will determine the approach to take when it comes to clearance, filing and enforcement strategies, such as budget, appetite for risk, geographical extent of use of trade marks. She noted that for the pharmaceutical industry there will be additional considerations relating to marketing authorisation which will impact on timing. In respect of designs, there are also disclosure considerations to ensure that novelty is not destroyed. Each case will be different.

When it comes to litigation, Lisa discussed the difficulties of deciding which cases to litigate, and this involves looking at the importance of the IP asset, the business' objectives and litigation options. There is a 'sweet spot' where infringement of core brands or a key product overlaps with a significant impact.

The fourth pillar – commercial and advisory support – involves embedding the IP team in the business, communicating with the leadership team, educating and ensuring that there are guidelines and tools in place to support the business.

After a coffee break, we continued the morning sessions with the truth about Madrid (the International Trade Mark system, not the Spanish city!). Eva Maria Strobel presented the pros and cons and



Lisa Ritchie

debunked some of the myths of Madrid applications. Most of us are heavy users of the Madrid system and so I don't think the facts and figures came as a surprise, but it was nonetheless interesting to hear the views of other users.



Eva Maria Strobel

Eva started with some numbers:

- Of the top 30 Madrid applicants, 10 are Pharma companies with GSK and Novartis in the top 3 filers.
- There are 114 members, covering 130 countries, which accounts for around 80% of world trade.
- 69,000 applications were filed in 2022.
- 50.3% of registrations recorded since the Madrid system was set up remain on the register now (revealed at the end of the presentation when nobody guessed correctly!)

It was noted that the International System might not be suitable in all cases – it will depend on the mark, budget and the countries of interest. For example, for non-traditional marks or very particular goods/services, it might be better to file nationally.

Eva took us through some of the 'myths' of the Madrid system, making the following points:

- The Madrid system is not necessarily cheaper (particularly if provisional refusals are issued and these are common), quicker or simpler.
- There are many limitations of the Madrid system: it does not automatically cover everything; the protection granted by an International Registration may vary by country, as some national offices are better than others at processing and acknowledging the rights afforded by International Registrations; validity is not guaranteed and may require additional actions to be taken in particular countries; there is a lack of flexibility, particularly when it comes to specifications of goods and services; and national laws vary (for example, certification marks, graphical representation).
- Central attack is in practice quite rare. There are currently discussions and proposed changes regarding the dependency period – it might be reduced

to 3 years or eliminated entirely.

In the last session before lunch, Nora Ho Tu Nam gave us some very helpful practical tips on how to deal with falsified medicines in Africa, and some examples of methods she has used in different countries.



Nora Ho Tu Nam

Around 1 in 5 pharmaceutical products in Africa are falsified or substandard medicines, and the African pharmaceutical industry has double digit growth, so this is an increasing problem. It may seem like it is impossible to take action against falsified medicines, but the situation is not as hopeless as it seems.

Each country has different challenges, and there is not one solution that can be used across Africa. Some of the difficulties include corruption at customs, no ability to notify customs of rights, no formal recordal at customs, and the lack of an independent judiciary. However, Nora said that the Courts of many African countries are aware of and understand IP and counterfeiting issues.

Nora also discussed how falsified medicines arrive into a country and are traded – considering ports of entry for landlocked countries, free trade zones (FTZ) which facilitate the transit of goods and increase counterfeiting, medicines arriving from China and India FTZ. Then there are more informal trade routes which makes it easier for falsified medicines to enter the market; informal traders offering cheaper and more easily available/accessible medicines become trusted by locals.

Nora advised that you cannot expect people locally to act in the way you want; you have to be flexible and think outside the box. Some of the steps she has taken to deal with counterfeit goods in Africa include approaching the local embassy, anti-counterfeiting agencies, the NAFAC in Nigeria, EU customs and Fraud Agency if the goods are going to the EU. She also recommended some ways to use technology to verify that goods are genuine, such as SMS and scratch cards in the box.

After lunch, Mel Jones gave a fascinating talk on fonts. He gave some history of the printed word, going back to the Phoenicians 10,000 years ago and the creation of the letter A, which originates

Continued on next page

Conference Report: continued



Mel Jones

from a symbol representing a cow or ox ('aleph' in the Phoenician alphabet). Over time, it has been turned upside down and modified to the current letter A.

Mel walked us through customised typefaces (those used in logos such as Barbie and Coca-Cola), which are not 'fonts' and are protected by trade mark law, he tested our knowledge of chocolate bar brands and explained the role of font foundries. He also discussed how fonts are protected by IP rights (i.e., copyright) and how font foundries are enforcing their copyright. There have been a number of sizeable claims in the US, and claims of copyright infringement relating to unauthorised use of fonts are increasing and becoming more complex. Mel gave the example of Monotype's 4 phase approach to enforcement, which they claim to be based on 'honesty, accuracy and empathy', although Mel is not convinced! It is clear that the objective is not to stop use of the font, but to arrange a licence and build an ongoing relationship. Negotiators within the font foundries have sales backgrounds and are not lawyers.

Font foundries now tend to outsource enforcement (much like the copyright infringement letters we see from the stock photo companies such as Shutterstock and Getty) and they see claims as a key part of their revenue stream, by seeking 'retrospective licences' from infringers. The claims very rarely get to court as most settle beforehand. When dealing with and responding to infringement claims and preparing for settlement, the advice is to stop the infringing act as soon as possible and to thoroughly investigate the details of the claim before accepting any settlement offers; damages and estimates of page impressions are often overstated.

Mel provided some useful tips for avoiding infringement claims: ensure employees are aware of the restrictions on use of fonts, take appropriate licences, use bespoke typefaces or artwork rather than fonts, and understand and communicate the terms of any licences. At the end of Mel's talk there was discussion around keeping a record of licences as it can be difficult to find evidence of licences which are already in place. The overall message was that fonts are important!

Ken Taylor of Com Laude gave the final presentation of the conference on dotbrands, a type of TLD. A new round of applications will open in 2026, so brand owners will get another chance to register their own .brand TLD. Ken reminded us of the history of TLDs and gTLDs and the first round of applications back in 2012. He then set out some of the benefits of owning a gTLD or .brand.



Ken Taylor

The key advantage of dotbrands is the ability of the brand owner to control who uses the domain – the owner of the dotbrand deals with applications in the same way as other Registries. They are also highly secure and provide flexibility to tailor websites for use in particular countries or for particular campaigns / initiatives.

However, not many companies applied for .brand TLDs and they are not really being used – it was expensive (around GBP £200,000 initial costs) and unknown and the companies that did register them did so defensively and did not really have a plan of how to use them. There are some great examples of .brand domains though particularly in the pharmaceutical and banking sectors (examples included .pharmacy which can only be used by accredited healthcare merchants, a number of pharma companies for support and disease awareness campaigns and online banking portals). People are not accustomed to seeing .brand domains and

so adopting a dotbrand should be part of a long term plan.

Brand owners are advised to start planning ahead of the application period opening in 2026 by investigating use cases and discussing with the technical team. The application process will largely be the same as the 2012 round, but the registry technical testing will now take place at the start of the process, hopefully saving some time. The same rights protection mechanisms will be in place as in 2012: sunrise period, trade mark clearing house, uniform rapid suspension and dispute resolution procedures. It was noted, however, that the Trade Mark Clearing house didn't do what it was meant to, it didn't block anything and Registries' own IP blocking services might be more worthwhile. Ken mentioned that it is interesting to sit in on ICANN meetings to understand the process, although Trade Marks are not popular in those meetings!

Joanne brought the conference to a close with a thank you to Lesley and all the speakers, and for the support from BCD team, and she looks forward to seeing everyone in Malta in October!

104th PTMG Conference

Malta
October 16-19
2024

Booking opens in June

PTMG gives back to the community



Thanks to support from Sofia Hamouda of Bomhard IP, a small group of delegates and guests joined the Editor at RedMadre, a local association in Valencia for our first 'giving back to the community' event. We hope to grow this gesture at the Spring 2025 conference in Edinburgh.

PROFILE: Jorge Isern

Jorge Isern is a graduate in economics with a postgraduate degree in patent chemistry. He is also a Spanish patent and trademark agent, as well as a community trademark agent. His professional journey commenced in the patents department, where he later assumed leadership roles and spearheaded the firm's international expansion. His expertise lies in the valuation, licensing, and transfer of industrial property assets. Throughout his career, he has been committed to innovation in his sector, pioneering internet portals such as vendoptente.com and domimark.com.

This year marks the centenary celebration of the firm Isern, a milestone that fills us with pride. We extend our heartfelt gratitude to all the clients and colleagues who have supported us throughout this journey. We assure them that the best is yet to come.



Where were you brought up and educated?

I live, was born and educated in Barcelona, for me the best city in the world. A city with good quality of life, excellent medical services and good universities.

How did you become involved in trade marks?

Being a family business, we are the third generation. All our lives my father explained to us the importance of having a well distinctive and protected brand to sell any product or service, so for me it was natural to get involved in the issue of brands. It is our family, it is genetic and we carry trade marks in our DNA.

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

Hard to say: As an economist by training, I would have explored the world of finance and capital management, market analysis, but everything focused on innovation, I am by nature curious and entrepreneurial.

Which three words would you use to describe yourself?

Familiar, conciliatory and curious.

Complete the sentence: 'I wish ...'

to leave a better world for future generations, even if it sounds very generic.

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

Mathematics, physics and chemistry.

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

Working in a family firm, and then going on to direct it, always sets a bar or expectations that others expect, you have to improve on the 'predecessor' to prove your worth and this sometimes becomes an obsession and this is a mistake. Each person has their seal or imprint, and you have to leave yours.

What do you do at weekends?

I try to spend the weekends with my family, my children and my grandchildren, being able to enjoy the simple things of everyday life.

What's the best thing about your job?

I love my profession. The best thing is to be able to create a professional and friendly relationship over the years, it allows you to meet people from all over the world and is enriching on both a professional and personal level.

I believe that our profession is a perfect example of a multi-ethnic, religious community who share professional interests and cultivate personal relationships.

What is the best age to be?

All ages are good, the important thing is mentality and being healthy. Although professionally I think that the 40-55 stage is the best because you have energy and maturity.

What is your philosophy in a nutshell?

I think that life is a miracle, and that we should enjoy it, ambition in its fair measure is good but on the other hand, you should help others in whatever way you can and never expect anything in return.

Who was your mentor or role model?

My father - both professionally and in his way of being and understanding life.

What music is in the CD player in your car / what is your iPod set to at the moment?

I am a music lover and I use SPOTIFY® a lot, I have several music lists that I share under the name Joisja and they reflect who I am. I would be delighted if the PTMG members listened to them or we

created one together. Currently I'm with a musician called Teddy Swims.

How do you relax?

When possible, I love going sailing and stopping in the middle of the sea and enjoying the silence, or being able to listen to music, although if I am stressed what helps me the most is to change activities, to start doing DIY or go play with my grandson.

Which sport do you play and/or enjoy?

I practice skiing, sailing and paddle tennis.

Which one person would you invite to dinner (other than a family member or relative)?

Pope Francis, he is a person who has an enormous burden on him and his opinion is very important; I would like to know more about how he thinks.

Which word or sentence do you most often say?

If you are ok then I am ok.

What is your favourite holiday destination?

In summer Cadaqués on the Costa Brava, in winter Soldeu in Andorra.

Where do you see yourself in 10 years' time?

Well, at 67 years old, I hope to be more dedicated to the family and supervising the business less intensely in the office, it would be a very interesting time of transition.

Which piece of advice would you give a visitor to the area in which you live?

Barcelona offers a lot, gastronomy, music, architecture, museums and beaches. My advice is not to get obsessed with seeing everything, leave something pending to visit it again.

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