

International law update

David Stone
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Agenda

01 Interaction of Trade mark and Regulatory law

02 Small amount of use

03 Comparative advertising

04 Strong marks get strong protection

05 Descriptive marks

06 Likelihood of confusion between marks with descriptive elements

Interaction of Trade Mark and Regulatory law

NOVARTIS AG V BIOGEN INC 2024 FC 52 (OTTAWA FEDERAL COURT, JAN 24)

- Novartis successfully sued Biogen for infringement of BEOVU for using BYOOVIZ for a biologic drug used to treat same disorder with a different active ingredient.
- Patient was a relevant consumer - it could consent to being given a drug.
- Irrelevant that consumer's initial confusion was later remedied before making any purchase.
- TM confusion test wasn't affected by products being approved by Health Canada.
- Health Canada may reject names if it considers them misleading or there are safety concerns
- **BUT the Court doesn't take this into account when assessing confusion.**

THIS IS NOW ON APPEAL

Interaction of Trade Mark and Regulatory law

CASE 14 K 22, HERPIMUM (3 MAY 2024) (VERWALTUNGSGERICHT, ANSBACH)

- Legitimacy of HERPIMUM, registered as a trade mark
- Bavarian Authority for Food Safety and Veterinary Medicine objected - violated prohibition on disease-related advertising
- **Held: Prohibition lawful**
- Combination of "herp" + "immune" leads to obvious conclusion that product has a medicinal effect against herpes
- German Patent and Trademarks Office (DPMA) checks for legal obstacles (including medical) when registering TM
- BUT the successful registration of a TM does not circumvent food information regulations

Tiny use is still genuine use

CASE 3 U 60/22, WEIHRAUCHEXTRAKT (12 OCT 2023) (INCENSE EXTRACT) (OBERLANDESGERICHT, HAMBURG)

- Genuine use of the ayurvedic product H 15 GUFIC
- Product authorization not yet granted (severe side-effects)
- Sales of <250 packages annually allowed via an exception
- **Held: sales were sufficient to maintain the mark**
 - despite the lack of marketing authorisation
- Authority's approval as a medicinal product was not a prerequisite for genuine use to preserve trade mark rights

Implied messaging in comparative advertising

Gibraltar UK Ltd & Anor v Viovet Ltd [2024] EWHC 777 (Ch)

S9(3(f) EU TM Regulation:

TM Infringement where TM used in comparative advertising in a manner contrary to the Comparative Advertising Directive

Reg 4(d) Business Protection from Misleading Marketing Regulations 2008:

Comparative advertising permitted if it *“objectively compares 1 or more material, relevant, verifiable and representative features of products, which may include price”*

CLAIMANTS’ marks

SYNOQUIN, AKTIVAIT, FIBOR, COATEX and CYSTOID

Brand names of veterinary nutraceutical products

DEFENDANT’S website activities

- ◆ Sold Claimants’ products and own-branded veterinary nutraceuticals
- ◆ When customers selected one of claimants’ products, pop ups appeared: **“Swap and Save”, “Try Something New”. “Save £[x] per day”** – taking consumer to defendant’s products
- ◆ Price beneath each product and a reversible arrow symbol

Held (as prelim issue). Average consumer would:

- ◆ Be keen to ensure health of their pet and only reach advert after vet recommendation
- ◆ Regard adverts as statements that the defendant’s alternative products were comparable in nature, composition or specification to the products, including efficacy and quality
- ◆ Court now needs to decide at trial if comparisons were objective or misleading

Strong marks get broad protection

APPLICATION

Rezalto

EARLIER MARK

Xarelto

Class 5: "**Pharmaceuticals**, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical and veterinary use, food for babies, dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wash; disinfectants; preparations for destroying vermin; herbicides."

Class 5: "**pharmaceutical preparations** and substances, diagnostic preparations and reagents for medical use"

South Africa – High Court of Pretoria. Case 020175/2023 Bayer IP v Austell Pharmaceuticals

- **Held: There was a likelihood of confusion.**
 - The signs are visually similar.
 - The signs are aurally very similar. Saying one after the other is a "tongue twister".
 - As made-up words, there is no conceptual similarity.
-

Descriptive marks get limited or no protection

EUTM Application

CellCompDx

- ♦ *chemical, biological, medical or veterinary products, tissue cultures and preparations* (classes 1 and 5)
- ♦ *Medical and scientific research services and medical services relating to biological samples* (classes 42 and 44)

EUIPO and Board Appeal

- ♦ Rejected mark as descriptive
 - ♦ *CellComp* means cell composition
 - ♦ *DX* indicates that a diagnosis can be derived from the cell composition
- ♦ The aim of the analysis of the cell composition is to make a diagnosis

Case T-512/23 Cellphenomics v EUIPO (15 May 2024)

- No need to interpret “DX” as either “to diagnose” or “diagnosis” (leaving the other non-descriptive)
- Applicant combined both aspects into a singular product
- Goods and services (e.g. *biological tissue cultures for medical purposes* and *scientific research for medical purposes*) may be closely connected by virtue of the same purpose
- Complex marks with elements which have different meanings can be descriptive if the descriptive character is established for the whole
- The mark was not merely an “allusion” expressed by the abbreviations of the words – the mark was sufficiently clear in its description for diagnostics of cell composition

Descriptive components don't necessarily lead to a descriptive combination



TVIS v Howserv services [2024] EWCA Civ 1103; [2023] EWHC 2589 (Ch) 1562

CLAIMANT'S marks

VETSURE

Class 36 “*pet insurance*”

DEFENDANT's use and mark

PETSURE

Class 3 “*pet insurance*”

◆ HIGH COURT : No likelihood of confusion

- ◆ Marks are visually and aurally similar but conceptually different because each refers to a different descriptive concept
- ◆ Where marks include descriptive words, the Court is rightly wary of granting a monopoly
- ◆ Where TMs are largely descriptive, small differences may suffice to avoid confusion
- ◆ Evidence only showed “mistakes” or “admin errors”

◆ COURT OF APPEAL: Likelihood of confusion

- ◆ Marks not conceptually different – both refer to insurance for vet bills
- ◆ No need for conceptual similarity if you have aural/ visual similarity
- ◆ Conceptual connotation is exceptional - only where one of the signs has a clear and specific meaning that can be grasped immediately
- ◆ Component descriptive parts don't necessarily lead to a descriptive combination
- ◆ Evidence demonstrated a clear potential for confusion based on imperfect recollection

Likelihood of confusion between marks with descriptive element



Combe International v Dr August Wolff [2021] EWHC 3347 (Ch); *Combe International LLC v Dr August Wolff* [2022] EWCA Civ 1562

CLAIMANT'S marks

VAGISIL

- ◆ Class 3: “non-medicated preparations for the care of the skin and body”
- ◆ Class 5: “medicated, deodorising and sanitary preparations and substances all for vaginal use”

DEFENDANT'S products



- ◆ Moist cream, intimate wash lotion, ointment

HIGH COURT DECISION: Likelihood of confusion for VAGISAN and DR WOLFF' VAGISAN

◆ VAGISAN

- ◆ VAGISIL and VAGISAN are “very, very similar”
 - High degree of visual/aural similarity and no meaning
- ◆ Identical products within the same healthcare sector
- ◆ Average consumer's level of attention was at the lower end of spectrum
- ◆ Considerable evidence of actual confusion

◆ DR WOLFF'S VAGISAN

- ◆ Common for pharma/cosmetic brands to use “DR [NAME]” as house mark for range of sub-products:
 - Establishes credibility – approved by medically qualified person
 - Doesn't signify trade origin but product's authenticity/ effectiveness
- ◆ **DR WOLFF** not well-known so doesn't eliminate confusion
- ◆ **VAGISAN** plays independent distinctive role in composite sign under *Medion v Thomson*




COURT OF APPEAL REFUSED TO INTERFERE WITH MULTI-FACTORIAL ASSESSMENT

Multiple actions around the world



SINGAPORE:

CASE	REASONING	RESULT
<p><i>Dr Augus Wolff v Combe International</i> [2021] SGHC 49</p> <p>Invalidity action against VAGISAN</p>	<ul style="list-style-type: none"> ◆ VAGI has weak distinctive character – not distinctive and dominant element ◆ Suffixes are distinctive components BUT difference in last three letters doesn't overshadow coincidence of first five letters ◆ Visually and aurally similar to average degree 	<p>Likelihood of confusion:</p> <ul style="list-style-type: none"> – Consumers would assume an economic link – Not negated by other traders using VAGI – may not denote trade origin – Mark invalidated
<p><i>Combe International v August Wolf</i> [2022] SGHC 78</p> <p>Opposition to:</p> 	<ul style="list-style-type: none"> ◆ DR WOLFF'S and VAGISAN equally dominant and distinctive <ul style="list-style-type: none"> – (“DR WOLFF” has no meaning) ◆ Visually dissimilar – added distinctive component “DR. WOLFF’S” ◆ Aurally dissimilar – majority of syllables are different ◆ Conceptually dissimilar – idea of a medical professional who endorsed the product 	<p>No likelihood of confusion:</p> <ul style="list-style-type: none"> – Nature of the products means consumers would be more careful in making their purchases (despite price) – Registration allowed

Multiple actions around the world (cont'd)



EU:

CASE

Dr Wolff v Combe International Ltd. R2459/2019-4
Cancellation of **VAGISAN** mark

REASONING

- ◆ **VAGI** at least allusive to purpose of use
- ◆ Weak(er) distinctive character does not necessarily mean it can't be dominant element particularly when at the beginning of sign
- ◆ Differing last letters 'IL' and 'AN' are not sufficient to counteract the similarities resulting from the majority of the common letters
- ◆ Consumer's level of attention is above average to high

RESULT

- Likelihood of confusion**
- **Mark cancelled**



UNITED STATES:

CASE

Combe Inc v Dr. Aug Wolff GMBH & Co. 382 F. Supp. 3d 429 (E.D. Va. 2019).
4th U.S. Circuit Court of Appeals

REASONING

- ◆ VAGISIL is a made-up word - does not directly describe the products.
- ◆ VAGISIL has substantial public recognition
- ◆ Marks are similar in sight, sound and meaning and will confuse consumers for similar goods
- ◆ Evidence of actual confusion

RESULT

- Likelihood of confusion**
- **Application refused**

Multiple actions around the world (cont'd)



NEW ZEALAND:

CASE

Dr Wolff v Combe International
[2020] NZHC 1679
High Court of Auckland
Opposition to **VAGISAN**

REASONING

- ◆ VAGI descriptive
- ◆ Suffixes -SAN and -SIL look and sound more different than similar
- ◆ Eye/ ear may be drawn to the beginning of word
- ◆ Prefix unlikely to be disregarded merely because last two letters differ – with imperfect recollection, there is visual/aural similarity
- ◆ A reasonable degree of care expected, given the nature of the goods – especially for therapeutic products

RESULT

Likelihood of deception/confusion

- **Application refused**



AUSTRALIA:

CASE

Combe International v Dr August Wolff [2021] FCAFC 8
(Full Federal Court)
Opposition to **VAGISAN**

REASONING

- ◆ Consumers likely to consider VAG or VAGI as reference to the vagina
- ◆ But can't discount it entirely
- ◆ First two syllables likely to be remembered
- ◆ Visual and aural similarity

RESULT

Deceptively similar

- **Application refused**

Are these decisions correct?



VAGI is a descriptive or sign-posting term



Common in the healthcare industry, e.g., “pedi”/“opti”/“pepto”/“derm”

- ◆ Signposting names for medical products often refer to ingredient/part of the body
- ◆ Reference to the purpose of the product not origin
- ◆ E.g., T-266/17 UROAKUT and UROCYSS for products treating urinary tract infections



U.K. court thought marks had acquired distinctiveness – so average consumer would not see VAGI(S) as signposting female intimate health sector but a part of the longer VAGISIL brand



But has this granted a wide punumbra of protection for an element that is not distinctive?

Are these marks with descriptive elements confusingly similar?

EU APPLICATION



Class 5: **Medical and veterinary preparations and articles; dental preparations and articles; sanitary preparations and articles; dietary supplements and dietetic preparations**

Class 35: Services of wholesale trade and retail trade as well via internet, in relation the following goods: medical and veterinary preparations and articles, dental preparations and articles, sanitary preparations and/or articles, dietetic preparations and nutritional supplements, medical devices, medical apparatus and instruments.

EARLIER EU MARK



Class 5: **Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use; material for stopping teeth, dental wax**

Class 35: Retailing and wholesaling in shops and retailing via computer networks of natural dietetic food-supplements, natural foodstuffs, herbal products, cosmetics, beauty preparations and perfumery; import-export; sales promotion for others.

ANSWER: NO LIKELIHOOD OF CONFUSION

EU BOARD OF APPEAL (July 2024): Case R-1713/2023-1 *Neuva Diettica v best medical GmbH*

- Common elements 'best' and 'medical' are laudatory, descriptive and non-distinctive (separately and as a single expression).
- Figurative elements, stylisation and colours are decorative and of secondary importance.
- 'diet' in earlier mark is descriptive and cannot differentiating factor.
- Low visual and conceptual similarity and below average phonetic similarity.
- Weak distinctive character of earlier mark and high degree of consumer attention means no confusion, despite identical/ highly similar goods/ services.

Are these marks with descriptive elements confusingly similar?

EU APPLICATION

SKINLY

Class 5: Nutritional supplements; Food supplements in liquid form; **Pharmaceutical preparations**; Dietary supplemental drinks; **Dietary supplements and dietetic preparations**; Dietetic preparations adapted for medical use; Medicinal tea; Chewing gum for medical purposes; Gum for medical purposes; Candy, medicated.

EARLIER EU MARK

SKINLICK

Class 5: **Dietary supplements with a cosmetic effect**; Medicated after-shave lotions; Medicated hair lotions; Medicated shampoos; **Pharmaceutical preparations for treating dandruff**; Acne treatment preparations; Serums; Thermal water.

ANSWER: NO LIKELIHOOD OF CONFUSION

EU BOARD OF APPEAL (April 2024): Case R-1308/2023-1 *Wagner v Creaticon*

-
- Only similar element is 'SKIN', which is descriptive
-

Are these marks with descriptive elements confusingly similar?

EU APPLICATION

Healthily

Class 5: Pharmaceutical products...

EARLIER EU MARK

Healthies 

Class 5: Pharmaceuticals

ANSWER: LIKELIHOOD OF CONFUSION

General Court (April 2024): Case T-288/23 Unilab v EUIPO

- *'Health'* is not descriptive in some countries because you can't assume knowledge of English.
- No conceptual similarity but visual and aural similarity.

Are these marks with descriptive elements confusingly similar?

EU APPLICATION



Class 5: **Dietary supplements and dietetic preparations; dietary and nutritional supplements;.... dietary supplements for infants; food supplements for nonmedical purposes;** food supplements; food for medically restricted diets; **food for babies; dietetic foods adapted for medical purposes; intravenous fluids used for rehydration, nutrition and the delivery of pharmaceutical preparations...**

EARLIER EU MARK



Class 5: Pharmaceutical and veterinary preparations; **dietic products for medical use, food for babies; mineral food-supplements; food supplements not for medical purposes...**

ANSWER: LIKELIHOOD OF CONFUSION

EU BOARD OF APPEAL (April 2024): Case R-1376/2023-1 Real Pharm v real

- 'PHARM' element is descriptive and can't distinguish.
- The blue bars in the earlier mark are of secondary importance – consumers focus on word elements.
- The elliptical shape in the application is commonly used/ decorative so is non-distinctive.
- Signs are similar

Are these marks confusingly similar?

EU APPLICATION

The logo for the EU application consists of a solid black inverted triangle on the left, followed by the word "BIONIC" in a bold, black, sans-serif font.

Class 10: Physical therapy equipment; **prosthetics and artificial implants**; mobility aids; medical apparatus and instruments; braces and supports, for medical purposes.

EARLIER EU MARK

Bebionic

Class 10: **Prosthetic limbs and limb parts**; powered prosthetic limbs and limb parts; Prosthetic apparatus; prosthetic hand devices; powered prosthetic devices; powered prosthetic hand devices; prosthetic upper limbs and upper limb parts; powered prosthetic upper limbs and upper limb parts; myoelectric prosthetic hand devices; prosthetic wrist units; powered prosthetic wrist units; powered robotic or artificial limbs and limb parts; powered robotic or artificial hands; powered robotic or artificial upper limbs and upper limb parts; powered robotic or artificial wrist units; electrically powered robotic or artificial limbs and limb parts.

ANSWER: LIKELIHOOD OF CONFUSION

EU BOARD OF APPEAL (August 2024): Case R-1931/2023-5 *Vbionic v Ottobock*

- The signs share 'BIONIC' but the impact of that (visually and conceptually) is limited. It has a very weak distinctiveness (for prosthetic and artificial limbs) and is allusive (for other physical therapy equipment).
 - Phonetically, the marks are almost identical (and goods are often ordered orally).
 - Even with a slight similarity, there is a likelihood of confusion due to identity of the goods.
-

Are these marks confusingly similar?

EU APPLICATION

EARLIER GERMAN and FRENCH MARK

MICROLAX

PigroLAX

Class 5: **Pharmaceuticals**; Sanitary preparations for medical purposes; Medicines for alleviating constipation.

Class 5: Pharmaceutical products.

Class 10: Medical device; Disposable medical devices for treating constipation.

ANSWER: NO LIKELIHOOD OF CONFUSION

EU BOARD OF APPEAL (July 2024): Case R-1733/2023-1 Kenvue v Pediatrica

-
- Clear differences in the beginnings of the signs but 'MICRO' has a clear meaning for consumers so earlier mark has low distinctiveness.
 - Low visual similarity, below average aural similarity and low conceptual similarity
 - The similarity in the weakly distinctive element 'LAX' cannot be sufficient to establish a likelihood of confusion.

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