

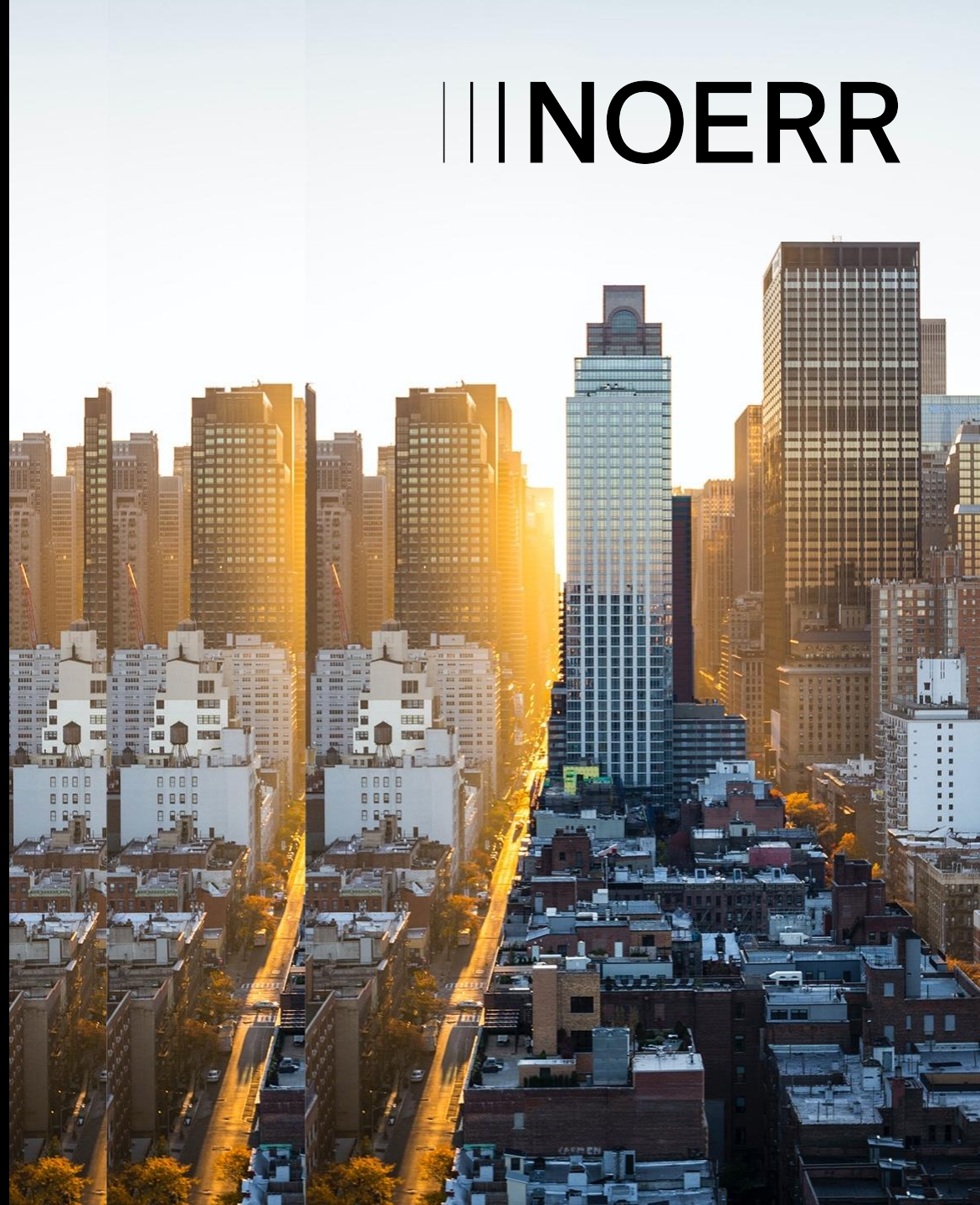
# Shifting sands: similarity of goods & services in an evolving pharma industry

PTMG Spring Conference 2025

Michael Hawkins

Edinburgh, 25 March 2025

||| NOERR



# Contents

1	Evolving pharma industry – what’s on the horizon?
2	Recap of “traditional” related classes
3	What is required for finding of similarity of goods/services
4	Applying principles to pharma-adjacent goods/services
5	Impact on searching and filing strategies

Which classes (other than 5) do you include in a search for a new pharma name?

0 responses

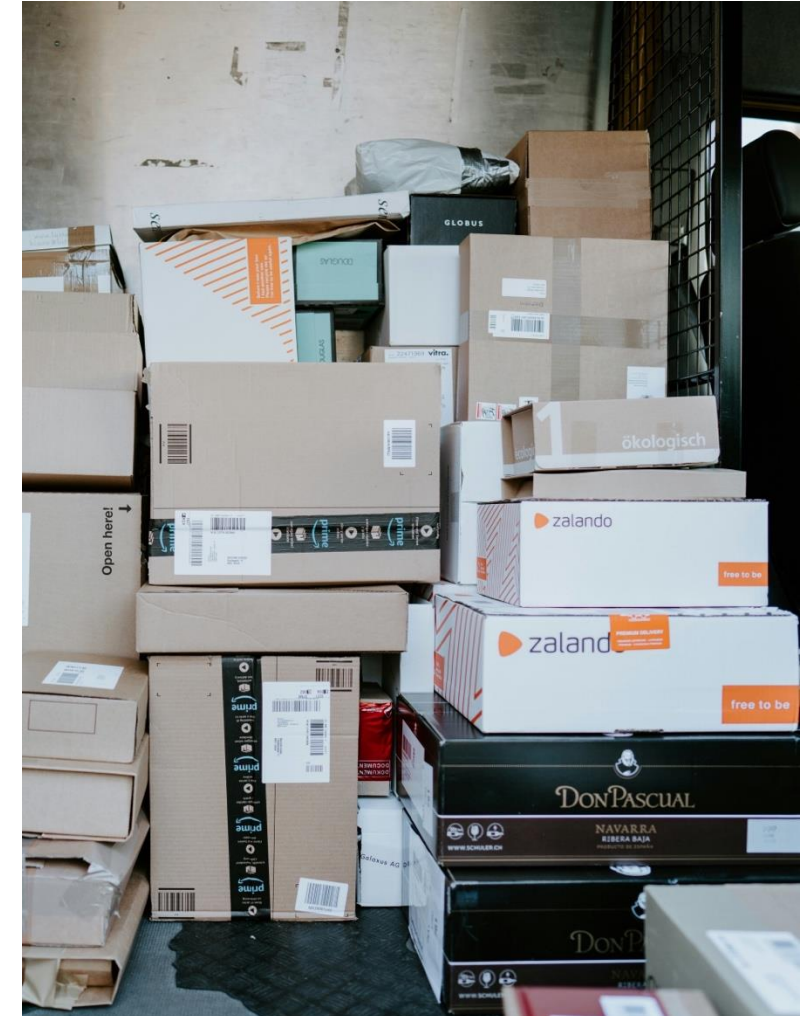


# Evolving pharma industry



# E-commerce / new distribution methods

- Online pharmacies like Amazon Pharmacy (U.S.), DocMorris or Redcare Pharmacy (EU)
- Integration of delivery services like Uber Eats or Wolt for the delivery of medications
- Facilitated by innovations such as digital prescriptions
- Controversial - medication safety concerns and not permitted everywhere
- Expected global market ~ USD 80 billion 2023 to ~ USD 440 billion 2033



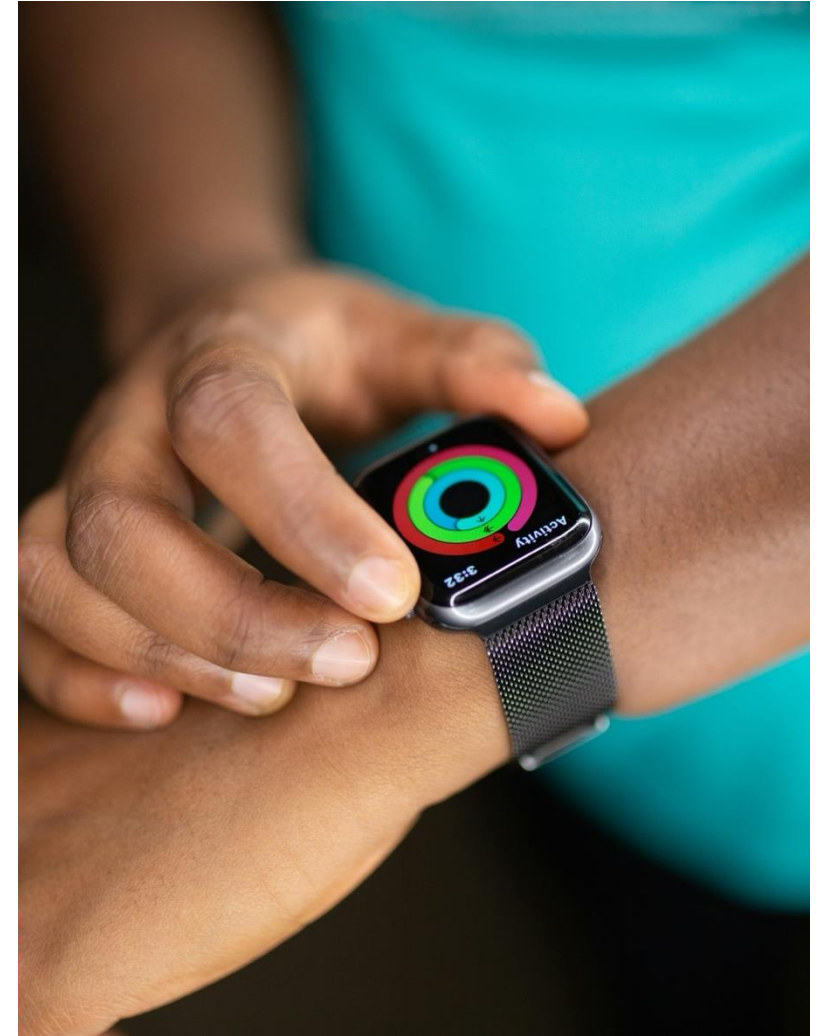
# Telemedicine

- Remote clinical services in non-emergency situations
- Driven by rising incidence of chronic diseases, cost-saving in healthcare, smartphones.
- Remote consultations (e.g. Teladoc); remote patient monitoring to enhance chronic disease management; psychotherapeutic counseling (e.g. Better Help)
- Infrastructure and software for practices/hospitals, telemedicine platforms
- Expected global market ~ USD 100 billion 2023 to ~ USD 500 billion 2032; EU ~ USD 20 billion 2022 to ~ USD 100 billion 2032



# Wearables / IoT in pharma / digital products

- Remote patient monitoring devices e.g. connected blood pressure monitors, thermometers, ECG or glucose monitoring devices and corresponding digital products (e.g. Omron Connect)
- Digital therapeutics (DTx) to treat certain disorders (e.g. Pear Therapeutics reSET to treat substance abuse or EndeavorRx, FDA-approved video game for children with ADHD)
- OTC digital products (e.g. Headspace or Woebot Health, Software as a Medical Device (SaMD))
- “Lifestyle” products to monitor/improve health e.g. smart watches, fitness trackers and corresponding digital products (e. g. Ōura Ring)



# Do you own a wearable with health features?

0



Yes

0



No

0



Don't know



# Personalized medicine

- Individual approach to patient and illness on a molecular level
- New technologies/AI empowering personalized medicine via new and faster ways for genomic sequencing & analysis of vast amounts of patient data
- Personalized medicines mostly used in oncology, e.g. cell therapies like CAR T-cell therapy or new neoantigen vaccines
- 286 personalized medicines available in the U.S. in 2020; 38% of all new drugs approved by U.S. FDA in 2023 are personalized medicines
- Adjustment of legislation and intensive research funding in the EU
- Expected global market ~ USD 530 billion 2023 to over USD 1 trillion 2033



# Theranostics

- Theranostics (therapy+diagnostic) - the same product used as an imaging agent as well as the therapy
- Innovative approach to personalized cancer care
- Radioligand therapy: the ligand binds to a specific marker on a cancer cell; it transports a radioisotope
- Can be used to diagnose: radioligand imaging “sees” the cancer allows the correct therapeutic approach for the patient to be selected
- Also used to treat the cancer, as it delivers the radiation treatment directly to the cancer cells



# Big Data and AI

- Integration of Big Data and AI to expedite drug development by new and faster methods to analyse large amounts of data for example from in silico models or existing chemical/biological databases
- Use of AI to predict and optimize processes of CRISPR systems, further improving gene editing technology
- AI in diagnostics: to compare symptoms and medical history with possible diagnoses; image recognition procedures to analyze CT scans and X-rays and detect abnormalities
- FDA approved over 900 AI/ML-powered medical devices until mid 2024, a large portion of them in the last few years
- Expected global AI in life science market growth from ~ USD 2 billion 2024 to over USD 13 billion 2034



# Intersection of Big Data, AI & Personalized medicine - Digital Twins

- Digital twin technologies model real life entities (cells, an organ, an entire patient) on the basis on large amounts of data (medical history, scans, genomic data etc.)
- The twin not only replicates the entity but realistically simulates its behaviour and reactions. Allows for the testing of treatments in a digital environment
  - SIMULIA Living Heart Model used for testing of in silico organ drug interactions, to develop and refine cardiac device design, for procedure selection and much more
  - Philips HeartNavigator for planning and guidance for structural heart disease procedures
- Can also be used to simulate larger processes e.g. for hospital management design or care coordination





# Similarity of goods/services

# Recap of “traditional” related goods & services

## Cosmetics (class 3)

purpose of certain pharmaceuticals (e.g. skin/hair care preparations with medical properties) coincide with cosmetic creams/lotions; many points of sales where they may be sold together

## Medical devices, apparatus & instruments (class 10)

pharma companies can produce both pharmaceutical preparations and medical devices/diagnostic appliances; complementarity in use/purpose

## Medical & therapeutic services (class 44)

provision of services requires pharmaceutical goods; consultation & information on the same

## Nutritional supplements (class 5)

pursue the same general aim of preventing and treating disease and are directed at the same relevant public through the same distribution channels (pharmacies)

## R&D in pharma (class 42)

pharma companies promote and administer pharmaceutical studies for consumers and undertake research and development activities in cooperation with third parties

# What is required for similarity of goods/services?

Does the relevant public perceive the goods/services as having common commercial origin? Would they consider it normal that the goods/services are marketed under the same trade mark?

Relevant factors include:

- nature, purpose and method of use;
- whether they are in competition or complementary (i.e. that one is indispensable or important for the use of the other);
- distribution channels



Similarity or dissimilarity and nature of the goods or services (second *DuPont* factor). Comparison “considers whether the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services”.

Sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.



# Are pharmaceutical preparations similar to medical software?

0



Yes

0



No



# Apps/software and wearables (class 9)

“**Computer software relating to the medical field**” and “**pharmaceutical preparations**” are “**simply too far apart to be found similar**”. The enterprises involved in the production and sale of medical computer software do not, generally, overlap with the producers of pharmaceuticals...The Board is not aware, nor has it been proven, that it is common for the producers of the earlier goods, for instance pharmaceuticals...to also sell software or develop it for third parties. Therefore, they are **dissimilar**.”

[Laboratorios ERN / Lewvel Health, EUIPO (1<sup>st</sup> Board of Appeal), 29 August 2023, R 118/2023-1]



“Downloadable software applications for mobile phones; Smart watches; Body fat scales for household use” etc

**Dissimilar** to “dietary and nutritional supplements”

[Cheerful Star/Helo Corp, EUIPO Opposition Division, 19 August 2024, B 3 197 492]



“Computer software for maintaining a database of blood test results from blood glucose monitors”

**Similar to a low degree** to “Reagents for medical and diagnostic use, biological and chemical reagents for medical and diagnostic use, and reagents for in vitro diagnostic use...”

Evidence that reagents for medical and diagnostic use are marketed together with automated analysers involving software which is meant for use in measuring, monitoring and management of results

[Tcoag Ireland / Trividia Health, EUIPO (5<sup>th</sup> Board of Appeal), 21 May 2019, R 923/2018-5]



# Apps/software and wearables (class 9)

“While petitioner’s [**computer hardware and software**] goods may be “embedded” in end products used by consumers, such as thermometers, they are clearly not the end products themselves. Furthermore, [no evidence consumers] would be aware of the trademark on petitioner’s “embedded” products, let alone that [the mark] would ever come to the attention of the same consumers who purchase respondent’s **dietary and nutritional supplements**”. **Wholly unrelated and vastly different products.**

[Scientific Solutions, Inc. v Scientific Solutions, LLC, USPTO TTAB, Request for Reconsideration, 15 August 2012, Cancellation 92051031]



“**Devices and instruments to be placed on the human body** ... for measuring and analysing the body's autonomic nervous system, physical parameters and other physiological data, bio-signals and bodily behaviour... [and **software related to the same**]” **closely related** to applicant’s “dietary supplements”. The same entity commonly manufactures, produces, or provides the relevant goods/sold or provided through the same trade channels, used by the same classes of consumers in the same fields of use or are similar or complementary in terms of purpose or function.

[Oura Health v Nectr Energy, ŌURA / OURA, USPTO office action following Letter of Protest, 8 January 2025]



# Trade channels (class 35)

“Retailing, in particular via the internet, of [pharmaceutical preparations]” is **lowly similar** to “pharmaceutical preparations”.

“Those goods are... complementary to the services in question, inasmuch as...they are indispensable or important for those services”

[SKINOREN / Skinovea, EU General Court, Second Chamber, Judgment of 2 March 2022, T-715/20]



The fact that the goods covered by the mark applied for [pharmaceutical preparations] are identical to those covered by the services covered by the earlier marks [retail and wholesale of pharmaceutical preparations] ... is a factor capable of leading to a finding that there is an **average degree of similarity** between those goods and services”

[apo-discounter / discount-apotheke.de, EU General Court, Sixth Chamber, Judgment of 20 January 2021, T-844/19]



Services related to **import and export of pharmaceuticals**, medical and veterinary preparations **similar to an average degree** to pharmaceuticals

“In the pharmaceutical field, [manufacturers] typically have a direct connection with wholesaler and hospitals and pharmacies. The direct supply chain ensures a streamlined flow of pharmaceutical goods ... this direct relationship emphasizes that import and export services are ... intrinsic to the entire supply chain.”

[ALTA / Altamedics, EUIPO (5<sup>th</sup> Board of Appeal), Decision of 19 April 2024]



# Providing platforms and portals (class 38)

These goods and services have a different nature (software, databases, publications, telecommunication services versus pharmaceuticals), purpose and method of use. The[ir] purpose is to provide general **(non-personal)** information on healthcare via different media, whereas the earlier goods serve to heal or cure. They are neither complementary, in the sense that one is indispensable for the other, nor in competition. Furthermore, they are not provided by the same companies and have different distribution channels.

[GALENPHARMA / g Galen, EUIPO (2<sup>nd</sup> Board of Appeal), 11 January 2022, R 486/2021-2]

(plus multiple first instance decisions)



“Transmission of information relating to pharmaceuticals, medicine” **similar to a medium degree** to “pharmaceutical preparations” - could reasonably be expected to be provided by the same businesses, overlap in user. Not in competition but complementary.

**BUT** “Providing of user access to internet platforms, in particular in connection with patient support programmes; Providing of internet forums” **dissimilar**. Although some overlap in user, no evidence that there would be any overlap in trade channels.

[Velinor AG v STADA, MOVICOL / MOVlcare, UKIPO (Hearing Officer), 17 February 2023]



**Telecommunications**, transmission of information by telematic means, services **providing access to databases, being intended for healthcare professionals and their suppliers similar to pharmaceuticals**, in that the former are intended to contribute to the process of prescribing and marketing pharma products, but the **degree of similarity is low**.

[PHARMABUS / PHARMABIS +, French Court of Appeal, 22 February 2011]



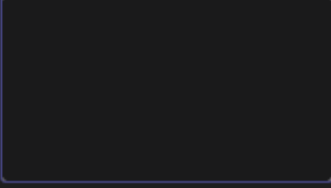
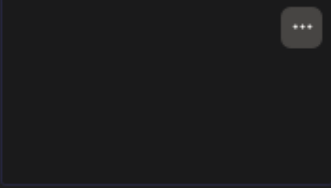
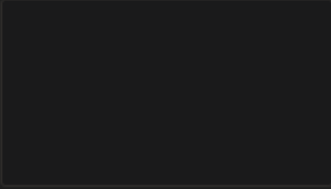
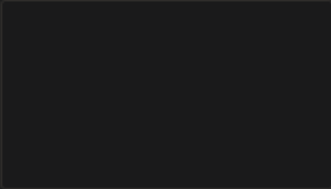


**Menti**

My first poll



Choose a slide to present



# (Big) Data and clinical trials/Platform as a Service (classes 35/42)

“Compiling, collecting of data for research purposes in the field of medical science, digital health and medical consultancy; compiling data for research purposes in the field of medical science and medical consultancy” (class 35) **dissimilar** to pharmaceutical preparations

“no evidence that there would be any overlap in trade channels...nature, method of use or purpose. Whilst there may be overlap in user, that is not sufficient on its own for a finding of similarity. They are neither in competition nor complementary”

[AVIVE / AVIVE, UK (High Court of England & Wales), judgment of 18 January 2022, upholding the UKIPO Hearing Officer’s finding]



Medical, bacteriology and chemical research and tests have **close links** with medical drugs and devices, in respect of their intended use, and complementary nature. They are **similar**.

[EMCURE, EU General Court, T-165/17, 14 June 2018]



[Citing with approval EMCURE] there will be complementarity – similar to a low degree. Also found “medical services” in class 44 to be similar to a medium degree to clinical trial services in class 42

[Avacare / avacare health, UKIPO Hearing Officer, 14 February 2022]



Pharmaceutical drug development services; designing clinical trial studies; platform as a service (PaaS) using AI for precision medicine, develop targeted treatments and therapies, big data analytics, simulations in clinical trials etc

**related** to “gastro-enteric [pharmaceutical] preparations”, pharma companies provide clinical trials; express reference to Roche providing software that uses AI to further pharma research and treatments

[CREON/CREYON, USPTO (office action), 12 May 2022]



# Personalization/customization (class 40)

“Custom manufacture of pharmaceuticals; pharmaceutical manufacturing for others” includes compounding by specialised licensed pharmacies to patients, combining, mixing or altering the ingredients of a drug to create a custom medication tailored to the needs of an individual patient

**coincide** with gastrointestinal preparations in their usual origin, distribution channels and relevant public. Moreover, they are in competition.

[I.C.E.-Therapie / ICE, EUIPO Opposition Division, 18 December 2023, B 3 175 267]



“Customized manufacture of medical preparations, nutritional preparations, dietary supplements and confectionery (wage production)” **dissimilar** to “natural remedies; medicinal oils; dietetic substances adapted for medical use”

Different nature and purpose. They target different clients as the contested services target the producers of the applicant’s goods. Moreover, they also differ in their distribution channels and methods of use.

[NORDIC OIL / NordicCan, EUIPO Cancellation Division, 29 January 2024, C 56 403]



“Custom synthesis and manufacturing of active pharmaceutical ingredients, intermediates thereof and finished dosage forms, especially for pharmaceutical use” **related** to pharmaceutical preparations

The same entity commonly manufactures applicant’s types of pharmaceuticals and provides registrant’s types of pharmaceutical manufacturing services and markets the goods and/or services under the same mark.

[AZAD/AZED, USPTO (office action), 18 February 2022]



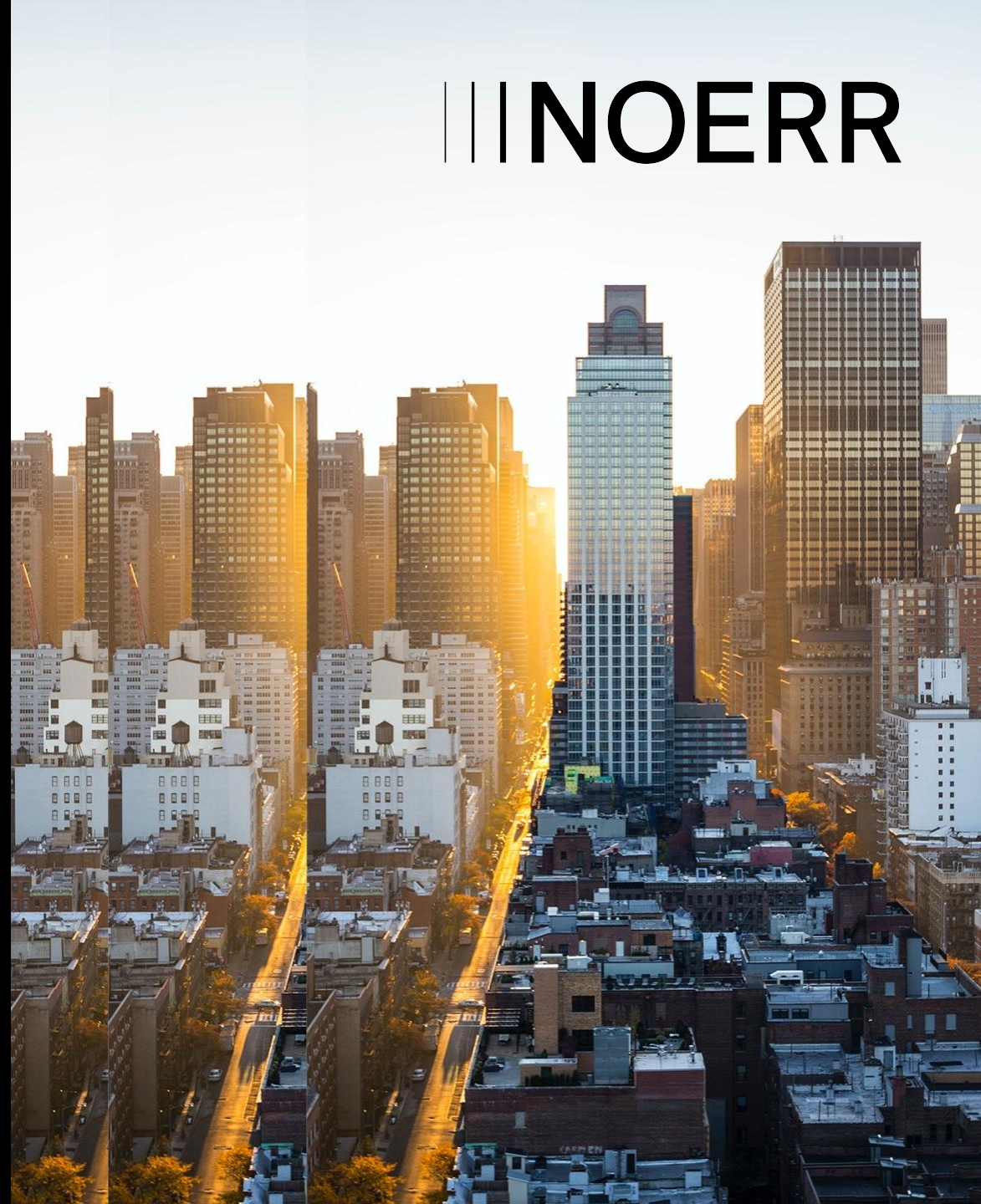
# Searching and filing strategies



- Some goods and services in adjacent classes and for emerging technologies likely to be considered similar/related to pharma
- Unsettled case law around the borders, likely to develop as the marketplace changes/consolidation happens
- Although similarity/relatedness may be low, could still give rise to issues, especially if signs are very similar
- Full searching may need to take into account broader class searching/new types of competitors
- Consider possible non-traditional filing classes to encompass technological developments, especially for house marks



||| NOERR



[alicante@noerr.com](mailto:alicante@noerr.com)  
[noerr.com](http://noerr.com)  
© Noerr Alicante IP, S.L.