Law Lore & Practice

PTMG Pharmaceutical Trade Marks Group

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Editorial: Thank you for the music ©

Sound has been part of human lives since we have been human. There is evidence of musical instruments 40,000 years old, and of the nine Greek muses Euterpe presides over this art, such is its power to transmit joy, hope and love. Progressing from single notes to complex and structured patterns as the centuries have passed, musical evolution often follows historical moments calling for more or less order. Arnold Schönberg developed his 12-tone scale known as dodecaphony during the 20th century, seen by some as a response to the destruction caused by war, while the recent funeral of Pope Francis reminds us of the healing power of music within faith and liturgy.

The EUIPO recently published on LinkedIn its very own playlist to celebrate World IP Day on 26 April – and a very amusing list it is too. But behind the fun sits the serious side of musical creation and performance. Raising awareness as to the importance of copyright protection within the music industry remains a tall order, as its scope is still misunderstood. Every year, my students look askance when I carry out a class poll, only to then inform them that they are all in fact regularly committing acts of IP piracy!

In these times where culture in its broadest meaning is under attack from all sides, legislators could and should strengthen those IP laws that seek to protect an industry providing so much employment and revenue. Defending the copyright which adds value to the various mediums through which products are sold under the trade marks that we trust, is a vital part of an IP lawyer's practice today. Music will soon take over the British summer with the arrival of the Festival season; copyright protection will occupy pharmaceutical companies throughout the whole year.

Vanessa

US Update

Kathryn M. Eyster, Tepper & Eyster, PLLC

The Trademark Trial and Appeal Board (TTAB) recently clarified its position on the importance of a house mark and reminded us of the power of a brand name. In re Sorrentino - 28 February 2025 was a non-precedential decision involving an appeal from a final refusal to register the mark CLEANFACE for beauty serums in Class 3.

The refusal was based on a likelihood of confusion with the registered mark DR.BELMEUR CLEAN FACE with 'clean' and 'face' disclaimed, for goods in Class 3 including, inter alia, 'non-medicated toiletry preparations;' 'beauty masks; functional cosmetics being non-medicated skin care preparations,' and 'non-medicated cosmetic body care preparations; hair care preparations.'

The Board reversed the refusal to register, finding that the marks were sufficiently dissimilar to co-exist even in the same channels of trade for similar goods. What is interesting about the finding is that all the factors customarily employed by the TTAB in a likelihood of confusion analysis (often referred to as the 'DuPont factors') seemed to weigh in favor of a likelihood of confusion except for the similarity of the marks. Again, the marks only differed in that the mark in the Cited Registration had a space between the words 'clean' and 'face' and began with a house mark.

The Board began by finding that the goods at issue were similar. Despite the Applicant's position to the contrary, the Board found that 'beauty serums' are related to 'beauty masks' as well as to hair serums/hair masks/ hair care preparations. The Examining Attorney provided evidence that many companies sell facial serums and masks under the same marks and that beauty serums are broad enough to cover hair serums and masks. Because neither the Application nor the Cited Registration provided limitations on channels of trade or customers, the Board found that this factor also weighed in favor of confusion. Although the Applicant tried to explain a difference in the channels of trade used, the Board refused to look outside the services as filed and those services had no limitations. Finally, the Board gave no weight to the lack of evidence of actual confusion because there was no evidence in the record to show whether the marks had any meaningful opportunity to co-exist. Things were not looking good for the Applicant.

The evidence did establish that the term 'Clean Face' is conceptually weak – 'Clean Face' was disclaimed in the Cited Registration, other registrations also used disclaimers - so the Cited Registration was entitled to a 'slightly less than normal scope of protection.' Things really started improving for the Applicant when the Board compared the marks themselves. The Board dismissed the Applicant's argument that the space between the words 'CLEAN FACE' in the Cited Registration differentiated it from the Applicant's unitary term .

'CLEANFACE.' However, the addition of what all admitted was a house mark was the game changer.

The Board cited In re Christian Dior, S.A., 225 USPQ 533 (TTAB 1985) to note that a house mark can either increase or decrease a likelihood of confusion. Adding a house mark to a mark does not generally differentiate the marks. However, if the marks involved are 'highly suggestive or merely descriptive or play upon commonly used or registered terms,' a house mark can be enough to sufficiently differentiate the marks. The Board found that, in light of the disclaimer in the Cited Registration, the highly suggestive nature of

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Words from the Chair

As the winter chill began to fade, Edinburgh surprised us with the historic cobblestone streets basking in the golden sunlight creating a picturesque scene. From the Sheraton Grand Hotel, where the conference was held, attendees were treated to stunning views of Edinburgh Castle. The castle, perched atop its rocky hill, looked even more magnificent under the clear blue sky, providing a breathtaking backdrop for another excellent conference.

The conference united experts to discuss key industry challenges and share insights on a wide range of trade mark topics such as the advantages of the Scottish interdict, similarity of goods and services in an evolving pharma industry as well as updates from Brazil and WIPO to name just a few.

One of the highlights of the conference was the Gala Dinner held at the stunning Hopetoun House. The evening was a perfect blend of elegance and camaraderie, with attendees enjoying a wonderful evening including haggis and pipers in full ceremonial dress. The historic and picturesque location added a touch of grandeur to the event, making it a truly memorable experience.

There is no doubt that the industry faces uncertain times, but the PTMG conference provides a platform for meaningful discussions and valuable networking opportunities. The quality of the speakers and the depth of the topics covered are a testament to the dedication and expertise of our committee and members. As we look forward to future conferences, we remain committed to fostering an inclusive, supportive and dynamic community that continues to thrive amidst the ever-changing landscape of our industry.

We are now preparing for the PTMG Autumn Conference and looking forward to returning to Budapest which in the last 30 years has transformed into a modern, vibrant city famous for its heritage landmarks, a popular mix of baroque, Renaissance, Gothic and Romanesque architecture and of course its thermal baths. We have another excellent set of speakers on a wide range of interesting and relevant topics lined up. Registration for the conference will open in June. Until then I wish you a wonderful spring and summer and I look forward to seeing many of you in Budapest in October.

Jo

US Update continued

the Applicant's Mark, and the prominent placement of the house mark in the Cited Registration, the house mark was sufficient to differentiate the marks at issue.

While the marks at issue in this case were not typical pharmaceutical trade marks, or even marks for OTC health preparations, the case does give guidance in the use of house marks. This case is unique in that the Board based its decision primarily on only one of the many DuPont likelihood of confusion factors. The fact that this one factor was the dissimilarity of the marks, and that it is based on the inclusion of a house mark, is notable. When a business wants to register a highly suggestive mark, as marketing departments are prone to do, but someone has already registered that suggestive mark, the use of a house mark may be an option to keep the business happy. It is important, however, not to overdo reliance on this practice. Adding a house mark is certainly not a panacea and, as the Board noted, can increase the likelihood of confusion under different fact patterns. Proceed with caution but this case reminds us that the degree to which the proposed mark is otherwise highly suggestive or descriptive is a very important piece of the house mark puzzle.

Medical devices as 3D trade marks

Suzanne Power, Venner Shipley LLP

A February 2025 decision from the High Court of England and Wales has highlighted some of the inherent difficulties in establishing the validity of and enforcing 3D trade marks in the UK.

Background

In December 2022, Abbott Diabetes Care Inc. (Abbott) secured a UK trade mark registration corresponding to the shape of a wearable medical device – more specifically, the on-body unit of a continuous glucose monitoring (CGM) system.

Abbott subsequently brought trade mark infringement and passing off proceedings against three defendants (together, Sinocare) who started selling their own CGM system in the UK in January 2024.

Sinocare counterclaimed that Abbott's trade mark registration was invalid on the grounds that the mark: (a) was devoid of distinctive character; and (b) consisted exclusively of the shape or another characteristic necessary to obtain a technical result.

The parties' arguments

The submissions and evidence put forward by both parties focused heavily on the validity of Abbott's registration.

Abbott's position was that their mark was validly registered and had been infringed by Sinocare's use of an on-body device with a very close visual resemblance.

Abbott originally claimed that their mark was validly registered on the grounds that it was inherently distinctive; however, by the time the matter reached trial Abbott pursued the alternative claim that the mark had acquired distinctive character as a consequence of the use of the mark in the UK. Evidence filed in support of this claim included a survey allegedly showing that UK consumers widely recognised the on-body unit as denoting Abbot's CGM system.

Sinocare in turn argued that Abbott's evidence did not support that the mark had acquired distinctive character – in particular, the survey did not support that consumers realised the shape of the mark was exclusive to Abbott.

The court's findings

The court found in Sinocare's favour and held that Abbott's registration was invalid and therefore not infringed. The judge held that all of the essential features of the mark performed an exclusively technical function, and the evidence did not support that the mark had acquired distinctive character through use.

On the latter point, the judge remarked that 'Although Abbott's marketing and advertising activities were extensive, when it came to educating consumers that the circular shape of the [on-body unit] 'means Abbott', these fell well short'.

Given the findings regarding the lack of distinctiveness of the mark, Abbott's alternative claim to passing off also failed.

Conclusions

Shapes remain a challenging category of trade mark for brand owners to exploit. Unless the shape is very unusual, then evidence of acquired distinctive character is likely to be needed to secure a registration in the first place. However, this case shows that demonstrating the validity of the mark from acquired distinctiveness is not a simple matter of proving its widespread use or economic success; consumers need to have been properly educated that the shape of the mark is exclusive to one particular provider, and this must be borne out by the evidence.

Obituary John Anderson

PTMG was saddened to learn of the passing of John Anderson, former Director General of The UK Anti-Counterfeiting Group (ACG), in January 2025. The IP world has lost one of its major influencers and guiding lights in the area of Brand Protection Public Policy. John was a long-time friend of PTMG, together with his wife Antonina Pakharenko-Anderson, the Founder and Managing Partner of Pakharenko Partners (Ukraine) since 1994. Antonina is a veteran of PTMG and a regular delegate at our conferences, which she has attended occasionally with John too, when he had the time.

John's most recent role was as Chairman of GACG (Global Anti-Counterfeiting Group) founded in 2004, which is an international network of national and regional IP protection, anti-counterfeiting and enforcement organisations. Its primary concern is to co-ordinate members' international activities, share best practices and information, and to participate in appropriate joint activities to solve international IPR enforcement and illicit trade challenges. In so doing GACG helps to shape the future of anti-counterfeiting and brand protection across the world.

Perhaps John's most well-known role however, was Director General and latterly Director of External Affairs at ACG - The Anti-Counterfeiting Group from 1997 to 2003. Following this, John founded GACG and was Chair until 2024.

Prior to joining ACG, John served as Manager of Government Affairs and Consumer Policy for the The AA (The Automobile Association) in the UK, where he became their lead in public affairs. Before that he had followed a distinguished career in the HM Diplomatic Service as a Head of Section at the Foreign, Commonwealth and Development Office, before becoming the UK's Economic Attaché in Lagos, Nigeria where he re-negotiated the UK Benin Technical Assistance Agreement. He later became Vice Consul at the British Consulate General Team in Rio de Janeiro, Brazil, where he was individually commended for his assistance in winning a multi-million-pound offshore oil rig contract.

With the founding of ICC/BASCAP (the International Chamber of Commerce – Business Action to Stop Counterfeiting & Piracy) in 2004 came the inauguration of the WCO/Interpol/WIPO Global Congress on Counterfeiting & Piracy (GC) and John was often involved with both the Public and Private Sector GC leadership in helping to craft the programme for the seven Congresses that followed over the next decade or so. He was very well-known amongst the NGOs and IGOs both at Global and Regional Levels including WIPO, WTO, WHO , WCO, Interpol, and The European Commission, especially DG TRADE, DG TAXUD and DG MARKT (as it then was). He was a regular figure to be seen in General assemblies, or Special Committees negotiating with Members of Parliament (MPs & MEPs), Senior Civil Servants & National Government Ministries, Police & Customs Agencies principally in Europe, such as Europol but also in Asia, especially China Customs as well as equivalent bodies in Africa and Latin America. In North America he worked closely with the International Anti-counterfeiting Coalition (IACC) to influence Senators & Congressmen in Washington for the United States and the National Anti-Counterfeiting Bureau and the Royal Canadian Mounted Police Forensic Service (RCMPFS) in Ottawa. At home he worked closely with Law Enforcement Agencies such as the Home Office, City of London Police, HMRC (His Majesty's Revenue & Customs) and Trading Standards in the UK.

John's negotiation skills were consummate and proved to set a standard in achieving international partnerships in the fight against transnational counterfeiting. As a result, he achieved an enduring international reputation for his influence in drawing partners together from across the world to foster excellent enforcement strategies.

John's reliance on evidence-based methodologies and tactics was evident in his drive to accurately estimate the global economic and social impacts of counterfeiting and piracy. His abilities in the two key threads of 'Capacity Building' and 'Public Awareness Raising' were second to none and it was this knowledge and experience that led to some of the earliest established reports on the emerging threat and scale of the problem. For example, he played a key role in advising and contributing to the OECD Trade and Agriculture Committee and the UNICRI (United Nations Interregional Crime and Justice Research Institute) in 2008.

John's absence from all of these fora will be a huge loss to the world of Brand Protection (Anti-counterfeiting & Piracy) but his legacy will live on and remains a crucial foundation for the continuous fight against this menacing form of illicit trade. I will remember him as a friend and colleague, with a tremendous sense of humour and a labyrinthine knowledge of Public Sector Technocracy with an innate ability to find his way around all aspects of Government Public Policy in Brand Protection. I am grateful to have known him.

Our thoughts and condolences remain with his wife Antonina and their family, and all his colleagues at Pakharenko Partners, his legacy will not be forgotten.

Richard Heath

PTMG
Group Treasurer
Richard Heath (IP) Associates Ltd.
20 January 2025

Members News

New Members

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

Adèle Maier from Bouchara & Avocats, Paris, France info@cabinetbouchara.com

Maria Abdo from Saba & Co Intellectual Property, Bieurt, Lebanon mabdo@sabaip.com

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Michael Ellis from Ellis IP Ltd., Edinburgh, UK michael@ellis-ip.co.uk

Erik Rouk from Taylor Wessing LLP, Liverpool, UK e.rouk@taylorwessing.com

Moves and Mergers

Following the merger of UK firms AA Thornton IP and Venner Shipley, **Ian Gill**, **Lucy Pope** and **Suzanne Power** can now be contacted at their respective addresses; igill@vennershipley.co.uk, lpope@vennershipley.co.uk and spower@vennershipley.co.uk

Jade MacIntyre has left Deloitte LLP to join Lewis Silkin LLP. Jade can be contacted at jade.macintyre@lewissilkin.com

Jan Peter Heidenreich is now with Bonabry Partnerschaft von Rechtsanwälten in Hamburg, Germany and can be contacted at heidenreich@bonabry.de

Salvador Ferrandis is now with AC&G Asesores 1998 in Madrid, Spain and can be contacted at sferrandis@acglaw.es

Felix Reimers is now with Advokatfirmaet Glittertind AS in Oslo, Norway and can be contacted at felix.reimers@glittertind.no

Sarah McMullen (formerly Power) has left Pinsent Masons (Ireland) LLP to join Bird & Bird (Ireland) LLP in Dublin, Ireland. Sarah can be contacted at sarah.mcmullen@twobirds.com

Thomas Ryhl has left Njord Law Firm to join Lund Elmer Sandager Law Firm in Copenhagen, Denmark. Thomas can be contacted at try@les.dk

Andreas Gerling has left Corsearch and is now with SMD Group in Ahrensburg, Germany. Andreas can be contacted at gerling@smd-group.info

Oscar Benito has left Gavi and is now with BioNTech in the UK and can be contacted at Oscar.benito@biontech.co.uk

David Stone and **Karla Hughes** have both left A&O Shearman LLP, to join White & Case LLP in London, UK. David can be contacted at david.stone@white-case.com and Karla at karla.hughes@whitecase.com

Mathilda Davidson has left Gowling WLG to join Osborne Clarke in Bristol, UK. Mathilda can be contacted at Mathilda.davidson@osborneclarke.com

Please remember to let us know of any changes to your contact details. You can notify me either via the PTMG website www.ptmg.org 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

106th PTMG Conference

Budapest October 8-10 2025

Booking opens in June

E-Commerce Accountability and Legal Challenges The Delhi High Court's Verdict on Amazon

Mohandas Konnanath and Ranjan Narula, RNA

As technology and e-commerce continue to evolve, e-pharmacies are reshaping the pharmaceutical industry, making healthcare more accessible, efficient, and patient-focused. The e-pharmacies act as intermediary while selling medicines, however, they have higher due diligence requirements in terms of verifying prescriptions before dispensing medications. The e-pharmacies must also ensure checks and balances to safeguard customer health data and last but not the least ensure the authenticity of medicines.

A recent ruling by the Delhi High Court against Amazon Technologies Inc. underscores the legal responsibilities of e-commerce platforms. It serves as a clear warning that merely claiming to be an intermediary does not exempt them from liability, reinforcing the need for strict compliance and accountability in the digital space that extends to e-pharmacies as well.

Lifestyle Equity CV & Anr v Amazon Technologies Inc & Ors

The Delhi High Court has delivered a significant verdict, ordering Amazon Technologies Inc. to pay ₹339.25 crore (approximately USD $38.78 million) in damages to Lifestyle Equities C.V. and Lifestyle Licensing B.V. The ruling comes after the plaintiffs, who claim ownership of the 'Beverly Hills Polo Club' (BHPC) brand filed a trade mark infringement suit and the court ruled decisively in their favour.

Background

The plaintiffs initiated legal proceedings against Amazon Technologies Inc. and its associated entities, Cloudtail India Pvt. Ltd. and Amazon Seller Services Pvt. Ltd., alleging trade mark infringement, damages, etc. The dispute revolved around Amazon's private label, 'Symbol,' which featured a horse device mark closely resembling the BHPC logo, allegedly causing severe financial and reputational harm to the plaintiffs.

Despite multiple Court orders, the defendants failed to appear, and the Court proceeded ex-parte against them. The plaintiffs presented substantial oral and documentary evidence to support their claims including recording testimonies of industry experts and a chartered accountant.

E-Commerce and Intermediary Liability

In the instant case the High Court carefully analysed the growing complexities of e-commerce and the accountability of online platforms in trade mark infringement cases which often obscure the identification of responsible parties.

The Court emphasized that e-commerce platforms, while claiming to be mere intermediaries, must be held accountable when they facilitate the unauthorized sale of counterfeit or infringing products. The ruling underlined the importance of establishing clear legal frameworks to effectively address online trade mark violations.

The Court observed that Amazon Technologies Inc., Cloudtail India Pvt. Ltd., and Amazon Seller Services Pvt. Ltd. (Defendants 1 to 3) were interconnected entities that sought to present themselves as separate in an effort to avoid liability. The Court held that this deliberate structuring was aimed at 'diffusing and dissipating the consequences of infringement'.

Court's findings

- The Court held that the defendants acted in bad faith, emphasizing their intentional concealment of vital information. Their wilful and deliberate actions, termed as 'e-infringement,' were deemed enough to establish liability.
- The plaintiffs examined five witnesses, the founder of the company, their licensee, a chartered accountant, an independent expert, and a branded fashion business expert to establish the financial impact of the infringement.
- The Court assessed damages by relying on the Trademark License Agreement (TLA) between the plaintiffs and their Indian licensee. This agreement provided a basis for calculating lost royalties, fixed at 7.5% of gross sales. The final damages were determined using the minimum sales requirements and business plan projections specified in the TLA.

Assessment of Damages

The court considered multiple factors in determining compensatory damages, including:

- Lost profits suffered by the Plaintiffs.
- Quantum of income which the Plaintiffs may have earned through royalties/license fees, had the use of the subject IPR been duly authorized.
- The duration of the infringement.
- The degree of intention or neglect underlying the infringement.

The court after analysing the documentary evidence and oral testimony awarded compensatory damages as follows:

a. USD $33.78 million for lost royalties, calculated based on projected business plan sales.

b. USD $5 million for additional advertising and promotional expenses.

c. Total Compensation: USD $38.78 million (approximately ₹339.25 crore).

Our Comment

This ruling marks a significant change in how e-commerce platforms are viewed, reinforcing their accountability in unauthorized sales. It also underscores the growing need for strong legal frameworks that can keep pace with the evolving digital marketplace, ensuring better protection of intellectual property rights.

First-to-File v First-to-Use: How Arab Trade Mark Laws Impact Pharma

Zeina Salameh, Saba & Co.

Introduction

Trade mark protection is a fundamental aspect of intellectual property rights, particularly in the pharmaceutical industry, where brand identity, market exclusivity and consumer trust are paramount. Globally, trade mark registration systems generally adhere to one of two principles: first-to-file or first-to-use.

In the Arab world, the legal framework for trade mark protection predominantly follows the first-to-file system. This has profound implications for pharmaceutical companies, both local and international, when it comes to securing trade mark protection. However, the distinction between first-to-file and first-to-use is not always as straightforward as it sounds. While most Arab jurisdictions adhere to a first-to-file regime, unregistered trade mark rights may still arise through use, albeit with limitations that vary by country. Similar to the European Union, many Arab nations recognize certain unregistered rights, often through unfair competition laws. However, such rights are typically difficult to enforce and proving them in court can be challenging. In nearly all cases, securing a registered trade mark provides stronger, more enforceable, rights than relying solely on common law protections.

Understanding the nuances between these two systems and their implications for pharmaceutical trade marks in the Arab world is critical for companies seeking to safeguard their intellectual property, mitigate legal risks and navigate regulatory frameworks effectively.

Why is proving bad faith difficult?

In many first-to-file jurisdictions, the legal burden falls squarely on the brand owner to establish that a trade mark was registered in bad faith. This presents a significant hurdle, as bad faith is neither presumed nor easily inferred - it must be proven with concrete and compelling evidence. A mere assertion of prior use is generally insufficient to meet the legal threshold required to invalidate a registration on bad faith grounds.

The core challenge lies in the inherently subjective nature of bad faith. Courts typically demand clear evidence that the applicant had actual or constructive knowledge of the brand owner's rights and nonetheless proceeded with the filing in a dishonest or opportunistic manner. Common indicators of bad faith may include a history of similar filings, a prior business relationship between the parties, or conduct aimed at obstructing the brand owner's market entry or extracting a commercial advantage. Assembling such evidence, particularly in jurisdictions with limited discovery mechanisms, can be both time-consuming and costly.

Compounding this issue is the lack of a uniform or codified definition of bad faith in several jurisdictions, which often results in inconsistent decisions and unpredictable outcomes. This legal uncertainty makes it even more challenging for pharmaceutical companies to recover marks registered by third parties acting in bad faith.

Why does timely registration matter for enforcement?

Beyond the difficulties in opposing bad-faith filings, pharmaceutical companies must also consider the broader implications of not securing trade mark protection in a timely manner. In many countries, holding a valid trade mark registration is a prerequisite for enforcing rights through administrative or criminal actions. This is particularly relevant in jurisdictions where administrative enforcement is available, including Bahrain, Egypt, the Kurdistan Region of Iraq, Jordan, Kuwait, Oman, Qatar, Saudi Arabia, Tunisia and the United Arab Emirates.

Moreover, courts in several of these jurisdictions are unlikely to grant preliminary injunctions or other urgent relief measures without a valid registration in place - an essential tool for pharmaceutical companies seeking to prevent the circulation of counterfeit or infringing products.

Trade mark registration also plays a critical role in customs enforcement. In countries such as Algeria, Cyprus, Jordan, Morocco, Sudan, Tunisia, and the UAE, registration is required for customs recordal or for taking legal action to intercept and prevent the importation of counterfeit goods. Without this legal foundation, the ability to halt infringing shipments at the border is significantly compromised.

Why is opposing a trade mark registration challenging in first-to-file jurisdictions?

Opposing a trade mark registration in first-to-file jurisdictions presents several legal and practical challenges for brand owners, particularly those who have not yet secured local trade mark protection.

In first-to-file systems, trade mark rights are granted to the party that files for registration first, regardless of whether that party is the actual originator or first user of the mark. This approach stands in contrast to first-to-use systems, where priority of use can confer enforceable rights. As a result, even brand owners with long-standing international use of a mark may find themselves in a weaker position if they failed to file in time within a first-to-file jurisdiction.

While it is sometimes possible to oppose a registration based on the reputation or well-known status of a mark, the burden of proof in such cases is significantly higher. The opponent must typically demonstrate extensive recognition of the mark in the local market prior to the filing date - often requiring comprehensive evidence such as market studies, media coverage, advertising records and sales data. This process is not only resource-intensive but also subject to the discretion of the examining authority, which may apply a strict evidentiary threshold.

Moreover, relying solely on prior use as a ground for opposition is particularly ineffective in many Arab jurisdictions. In countries such as Morocco, Iraq, and Egypt, prior use is rarely afforded significant weight unless it is accompanied by clear and compelling evidence of bad faith or the well-known status of the mark. In practice, this significantly reduces the likelihood of success for brand owners who have not filed for trade mark protection proactively.

Additionally, using copyright ownership as a basis for opposition is either unavailable or unrecognized in most jurisdictions in the region, with Morocco being one of the very few exceptions where such a strategy might be considered.

Strategic Trade Mark Filing in the Arab Region: A Proactive Approach for Pharmaceutical Brands

Given the legal and regulatory frameworks across the Arab region, pharmaceutical companies are strongly advised to adopt a proactive and strategic trade mark filing approach to safeguard their brands and minimize exposure to legal and commercial risks.

1. File early and file smart: Balancing strategy with cost

A well-structured filing strategy begins with early action and a thoughtful assessment of where, what and how to file. While it may not be practical or cost-effective to file broadly in every jurisdiction, delaying registration can leave brands exposed to bad-faith filings, enforcement barriers and limited recourse in high-risk jurisdictions. When crafting a filing strategy, several key factors must be considered:

- The strategic value of the mark: How critical is the mark to the company's current operations and future growth in a specific country?
- Budget constraints: What level of investment is the company willing to make in brand protection and how should it be allocated?

Continued

- Risk tolerance: What legal or commercial risks is the business willing to accept in jurisdictions where protection is not secured?

2. Conduct pre-filing searches including records of Ministry of Health

Before filing a pharmaceutical trade mark, it is always advisable to conduct a comprehensive clearance search to ensure that no identical or confusingly similar marks are already registered. With trade mark rights in Arab countries granted on a first-to-file basis, a search of the national trade mark offices records is generally sufficient to provide an indication of a mark's availability for registration.

However, in the pharmaceutical sector, an additional layer of diligence is recommended. Specifically, it may be worthwhile to search the records of the national Food and Drug Authority or equivalent regulatory bodies in countries where such databases are publicly accessible. This step is crucial because marketing approval is often granted independently of trade mark status. Regulatory authorities do not typically coordinate with trade mark offices to verify the trade mark rights associated with a proposed drug name.

This lack of coordination creates the potential for third parties to obtain marketing authorization for a pharmaceutical product under a name that may infringe an existing trade mark. To mitigate this risk, it is prudent to regularly monitor Food and Drug Authority records - particularly in jurisdictions where such information is publicly available, including Saudi Arabia, Kuwait, Oman, Bahrain, Jordan and Lebanon. In countries where records are not accessible online, the necessary data can typically be obtained by submitting a formal request. As a final point, it is important to note that there is no pan-Arab equivalent to the European Marketing Authorization system. Each country in the region maintains its own independent regulatory framework for pharmaceutical approvals.

Conclusion

The first-to-file trade mark system in the Arab world presents both opportunities and risks for pharmaceutical companies. While it ensures clarity in trade mark ownership, it also demands early action and vigilance to prevent disputes, counter trade mark squatting and secure market exclusivity. By prioritizing early registration, conducting due diligence, and actively monitoring the market, pharma brands can successfully navigate the Arab trade mark landscape and protect their trade marks in a region with growing healthcare and pharmaceutical markets.

AI or nay: Navigating trade mark challenges of generative AI in healthcare

Michele S. Katz, Advitam IP, LLC

Artificial intelligence has crept into nearly every sector of the healthcare industry - from diagnostics and clinical decision- making to patient engagement and administrative workflows. In more recent applications, generative AI is being used to streamline brand development, naming strategies and marketing content for pharmaceuticals, medical devices and digital health platforms. While this promises increased efficiency and reduced costs, it also raises critical legal and ethical concerns, particularly in the realm of trade mark law.

Consider the situation where a healthcare startup uses generative AI to create a product name for a new telehealth app or wearable device. The AI may generate a name that is innovative, catchy, and seemingly available. However, without appropriate legal vetting, that name might already be registered as a trade mark in a relevant jurisdiction - or worse, resemble the name of an existing medication, increasing the risk of patient confusion or even medical error.

These concerns mirror those seen in the legal field. In June 2023, a US district court sanctioned two attorneys for filing a legal brief that included six fictitious case citations created by ChatGPT. This incident served as a stark reminder of the dangers of relying on generative AI without proper oversight. If legal professionals are not immune to these risks, neither are healthcare entities navigating complex regulatory and trade mark landscapes.

In healthcare, the stakes are especially high. A misstep in product naming is not just a branding issue - it could lead to regulatory scrutiny, loss of exclusivity, or even patient harm. For example, a name that is too similar to an existing drug may trigger safety concerns, particularly if it leads to confusion in prescribing or dispensing medication. Similarly, a brand that inadvertently infringes on an existing trade mark could result in costly litigation, rebranding, or withdrawal from market launch, all of which can significantly delay time-to-market and erode stakeholder trust.

There are additional complications when generative AI is used without regard for cross-border trade mark protections. A name that clears US trade mark databases may still be problematic in other jurisdictions, where trade mark law differs. AI tools often lack access to comprehensive, jurisdiction-specific trade mark data, making them unreliable as standalone naming resources in a globalized market.

Another issue is the potential for unintentional disclosure of confidential information. If healthcare companies use publicly available AI tools to brainstorm names or conduct preliminary trade mark searches, they may inadvertently expose sensitive information such as pipeline products, therapeutic targets or strategic branding directions. This could result in a loss of regulatory exclusivity or provide competitors with insight into a company's next move.

In response to these challenges, healthcare companies must develop thoughtful internal policies that regulate the use of generative AI for naming and branding purposes. Legal departments, particularly those with trade mark expertise, should be involved early in the process. Any AI-generated names should be subject to rigorous clearance procedures, including trade mark searches, linguistic reviews, and regulatory assessments, before adoption.

As in the legal profession, there is a growing need for regulatory and ethical standards tailored to the healthcare industry's use of generative AI. Just as attorneys are being called to disclose their use of AI in court documents and safeguard client confidentiality, healthcare professionals must take similar precautions to ensure AI-generated outputs do not compromise patient safety or brand integrity.

Generative AI can be a valuable tool in healthcare branding, offering speed, creative diversity and cost efficiencies. But its role must be carefully managed. When trade marks are involved, the implications extend far beyond marketing - they affect public trust, legal compliance, and, most importantly, patient safety.

As the healthcare industry continues to embrace AI-driven innovation, trade mark law cannot be left behind. What may appear to be an effective or compelling brand name on its surface may, in fact, carry legal and ethical complications beneath. In a field where miscommunication can have life-threatening consequences, relying on AI without review is not merely imprudent - it is a risk the industry cannot afford to take.

Weak or non-distinctive trade mark elements in Swiss opposition matters in the pharmaceutical, medical, and healthcare sectors

Olha Yampolska and Milana Pantelic, AWA Switzerland SA

In Switzerland, there is no examination as to prior rights by the IPO, but a post-registration opposition procedure. In Swiss trade mark opposition proceedings, the risk of confusion is assessed, among other factors, based on the trade mark's scope of protection, which depends on its distinctiveness. Weak trade marks, i.e., with common or descriptive key elements, have a more limited scope of protection. Also, the scope of protection of even strong trade marks does not extend to elements belonging to the public domain. The Swiss IPO does not provide for disclaimers of public domain elements, meaning that trade mark records do not specify which elements will be considered non-distinctive in the context of opposition proceedings. However, the IPO maintains an Examination assistance database designed to enhance the predictability and consistency of its decisions. Additional guidance is available in Swiss case law, where recent decisions illustrate the Swiss instances' current approach.

In the pharmaceutical, medical, and healthcare sectors, the database classifies the following terms as weak or non-distinctive: MED/MEDI and PHARM/PHARMA refer to a product's medical or therapeutic effect; DERM/DERMA (often a prefix or a suffix) refers to skin; ACTIF/ACTIVE, FORTE, or HYPER imply an action or a strong or reinforcing effect; LAB denotes a laboratory; PAEDI relates to children; TAB is short for 'tablet'; and VITAL is a laudatory term for pharmaceutical products. The term COMPANIONS is deemed descriptive for Class 44 medical services, as it is commonly used for services requiring close personal support or care.

The Examination assistance database also provides more nuanced examples. SANO/SANA is considered descriptive of 'feeling well' or 'being in good health', whereas SAN is seen as an indeterminate, non-descriptive abbreviation. VIT/VITA are interpreted as a reference to vitamins only when that meaning is obvious through accompanying elements (e.g. VIT C). Accordingly, a normal degree of distinctiveness was accepted in opposition proceedings for the trademark VITA in relation to 'materials for filling teeth' in Class 5, with the alternative interpretation of 'VITA' as the Italian word for 'life' also not being (directly) descriptive. Interestingly, GASTRO is listed in the database as referring to 'gastronomy' only, while in the context of Class 5 goods, an association with 'gastroenterology' is plausible, as acknowledged in the opposition decision involving the trade mark TYGASTRO.

The Swiss IPO denied similarity between the marks EZ-FILL SMART and IDFILL, reasoning that FILL is allusive for medical pumps and syringes used for administration of pharmaceuticals, as these goods are already filled or intended to be filled. A similar approach was taken regarding BIOTIC, which was considered descriptive for Class 5 goods in the sense of relating to life or living beings. The inclusion of IMPLANT in the trade mark was seen as evocative of the intended purpose of Class 10 goods such as surgical, medical, dental, and veterinary instruments, thereby diminishing the trade mark's distinctiveness.

In the opposition decision concerning the trade mark DAOSIN, the Swiss IPO determined that the suffix -SIN was common for pharmaceutical products, while the acronym DAO could be recognized as standing for diamine oxydase among at least specialized circles in the field of food intolerances, thus limiting the trade mark's scope of protection. Similarly, in the case of TRAUMEEL, the term TRAUMA was perceived by professional medical circles as a reference to traumatology. SALUS – meaning in Latin 'health, well-being' – was also considered descriptive, especially given that the relevant medical circles are typically fluent in Latin. Another example includes the acronym SMA – a common abbreviation for 'spinal muscle atrophy', which would be recognized as such in the trade marks IZKISMA and IQROSMA by the target public.

That being said, according to the Swiss trade mark practice, weak or public domain elements may, in certain instances, influence the overall impression conveyed by a mark and thus be considered in the assessment of trade mark similarity. To illustrate this approach, in the case of the trade marks SANALGIN and TAPHALGIN, the suffix ALGIN was deemed weak, as it is both a collective term for the polysaccharide constituents of brown algae and a short form for alginic acid – meanings that are well-known to at least specialized medical circles. Nonetheless, the identical placement of the term 'algin' and its prominence in comparison to the shorter prefixes of both trade marks were factored into the overall assessment, ultimately leading to a finding of likelihood of confusion.

Some signs might seem suggestive at first, but the Swiss IPO did not find them weakly distinctive. For instance, PSORIACALM is not listed as descriptive for Class 5 medicated skin preparations, as no meaning was found in 'psoria' (which could be loosely associated with psoriasis). Similarly, PSICOBRAIN (covering pharmaceutical products and food supplements for intestinal flora) and VAC (seen as an indirect reference to 'empty' rather than vaccines) were not found to be descriptive. OPTI was deemed sufficiently abbreviated to maintain distinctiveness for optical products and services. In the trade mark FEMARELLE, the Swiss IPO did not consider FEMA to refer to 'female', and therefore did not attribute weak distinctiveness to it in connection with herbal supplements for menopausal symptoms. Nitrile Skin², despite 'nitrile' referencing the product material and 'skin' alluding to 'gloves as a second skin,' was deemed to possess normal distinctiveness for medical gloves in Class 10. Likewise, SORB, while suggestive of the verb to absorb, did not weaken the distinctiveness of the trade mark MESORB.

Examples can also be found among device marks. Although the trademark was deemed reminiscent of a DNA double helix, it was not seen as directly describing the Class 5 goods or as a basic depiction of DNA, since it lacked the base pairs that connect the two DNA strands. The device mark may initially appear as a temperature or heart rate curve, but such diagrams typically include both vertical and horizontal axes. For Class 44 services, consumers are likely to interpret the mark, leading to the conclusion that it is of average distinctiveness, but not weak.

To sum up, under Swiss trade mark practice, certain terms are deemed clearly weak or descriptive, thus limiting the trade mark's scope of protection. Others are evaluated in a more nuanced manner, depending on the circumstances. While some terms may initially appear allusive in the medical or pharmaceutical sectors, they do not necessarily limit a trade mark's scope of protection as their overall distinctiveness is assessed in the broader context. In addition, each case requires careful consideration of weak or non-descriptive elements, as they may still play a role in assessing the risk of confusion.

Comparative advertising in India: How much is too much?

Lucy Rana and Shilpi Saurav Sharan, S.S. Rana & Co.

Introduction

In recent cases in the realm of comparative advertisement, the Courts have addressed the compelling issues surrounding promotional strategies used by brands. The Courts have emphasised that though an advertiser has freedom to speak about the good aspects of its product, in doing so it cannot showcase a product in the same category in a negative light. These decisions provide clarity on the limits of advertising practices when competing products are involved.

Herein, we dissect the facts and circumstances of some of the recent cases which involve consumable products, such as health supplements and discern the comparative advertisement landscape in India.

1. Hindustan Unilever Limited v Abbott Laboratories

Brief facts of the case:

The Plaintiff in the case alleged that the Defendants were circulating a commercial advertisement with respect to their product ENSURE DIABETES CARE and that the impugned advertisement disparaged and belittled Plaintiff's nutritional beverage Horlicks Diabetes as well as infringed its registered trade marks and copyright.

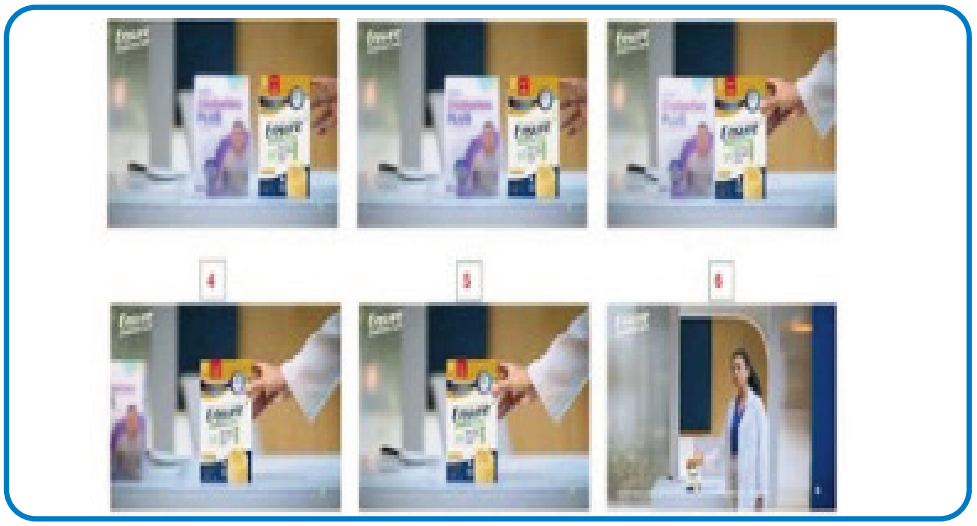
The Plaintiff also provided the Hon'ble Court details of its trade mark registration for the mark HORLICKS that dated back to the year 1943 in class 29. The Plaintiff also contended that its trade mark HORLICKS was recognized as a well-known trade mark by Delhi High Court .

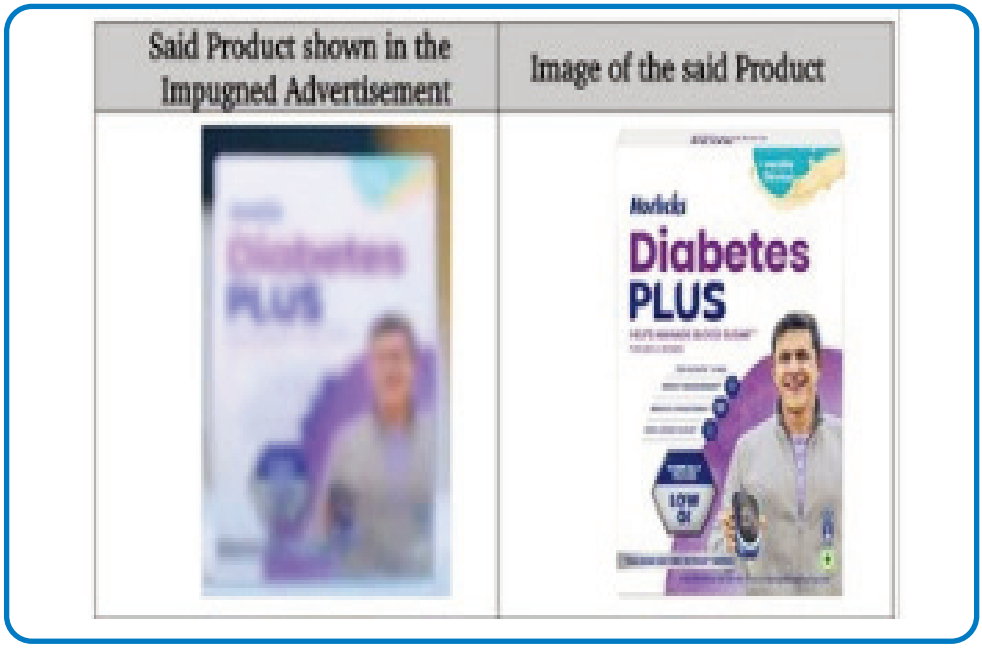
The Plaintiff claimed that its product that was shown in the impugned commercial advertisement - Horlicks Diabetes Plus - had been designed for blood sugar management and that the same had been classified as a 'high science' product.

Plaintiff's contentions

The Plaintiff stated that it came across the impugned advertisement in relation to Defendant's product on WhatsApp. The Plaintiff contended that the said product, although partially blurred, was clearly visible and identifiable as the Plaintiff's said product.

The Plaintiff alleged that the manner of impugned advertisement was such that the protagonist placed the Defendants' product and then pushes away the





Images from the Advertisement

Plaintiff's said product and places the Defendants' product, thereby taking the Plaintiff's product out of frame which showcased the Plaintiff's product in a negative light, which while giving a negative connotation to the viewer, conveyed that the Plaintiff's product was an inferior product and hence should be replaced by Defendants' product.

The Plaintiff further pleaded that the impugned advertisement made a clear suggestion that its product was not 'recommended' and did not have the nutrients that would effectively help in managing blood sugar.

Court's observation and holding

The Hon'ble High Court of Bombay, in view of the facts and circumstances of the case, made the following observations and order in the case:

a. That a tradesman is entitled to declare his goods to be the best in the world, however, while doing so he cannot directly or indirectly say that the goods of his competitors are bad or inferior;

b. That to decide the question of disparagement, the crucial factors are:

- Intent of commercial;
- Manner of commercial; and
- Storyline of commercial;

c. That if the manner of commercial is ridiculing or condemning the product of the competitor, it amounts to disparagement;

Continued on next page

How much is too much? Continued

d. Considering the manner of advertisement in the present case, the Court opined that the Plaintiff's product Horlicks Diabetes Plus could be easily seen and identified behind the blurring filter and on seeing the impugned advertisement, the Court was of the view that the basic premise of impugned advertisement was to denigrate the product of Plaintiff.

e. The Court, in view of facts and circumstances of the case, observed that the impugned advertisement was a deliberate attempt to show the Plaintiff's product in a negative light and not a mere coincidence.

f. Hence, the Court held that the Plaintiff had made out a strong prima facie case for the grant of injunction and the Court also restrained the Defendants from circulating, sharing or broadcasting the impugned advertisement in any manner with anyone including trade channels.

g. The Court also directed the Defendants, its members and affiliates to recall, delete and take down the impugned Advertisement from all platforms.

2. Marico Limited v Alpino Health Foods Pvt. Ltd.

In this case, Marico Limited, the market leader for Saffola Oats, took exception to a campaign by Alpino Health Foods Pvt Ltd. Alpino campaign for Alpine Super Oats utilizing disparaging language aimed at the entire oats category.

Background of the case

Marico, with a well-established brand Saffola Oats, argued that Alpino's advertisement - despite not naming Saffola Oats directly - engaged in a 'generic disparagement' by negatively portraying oats:

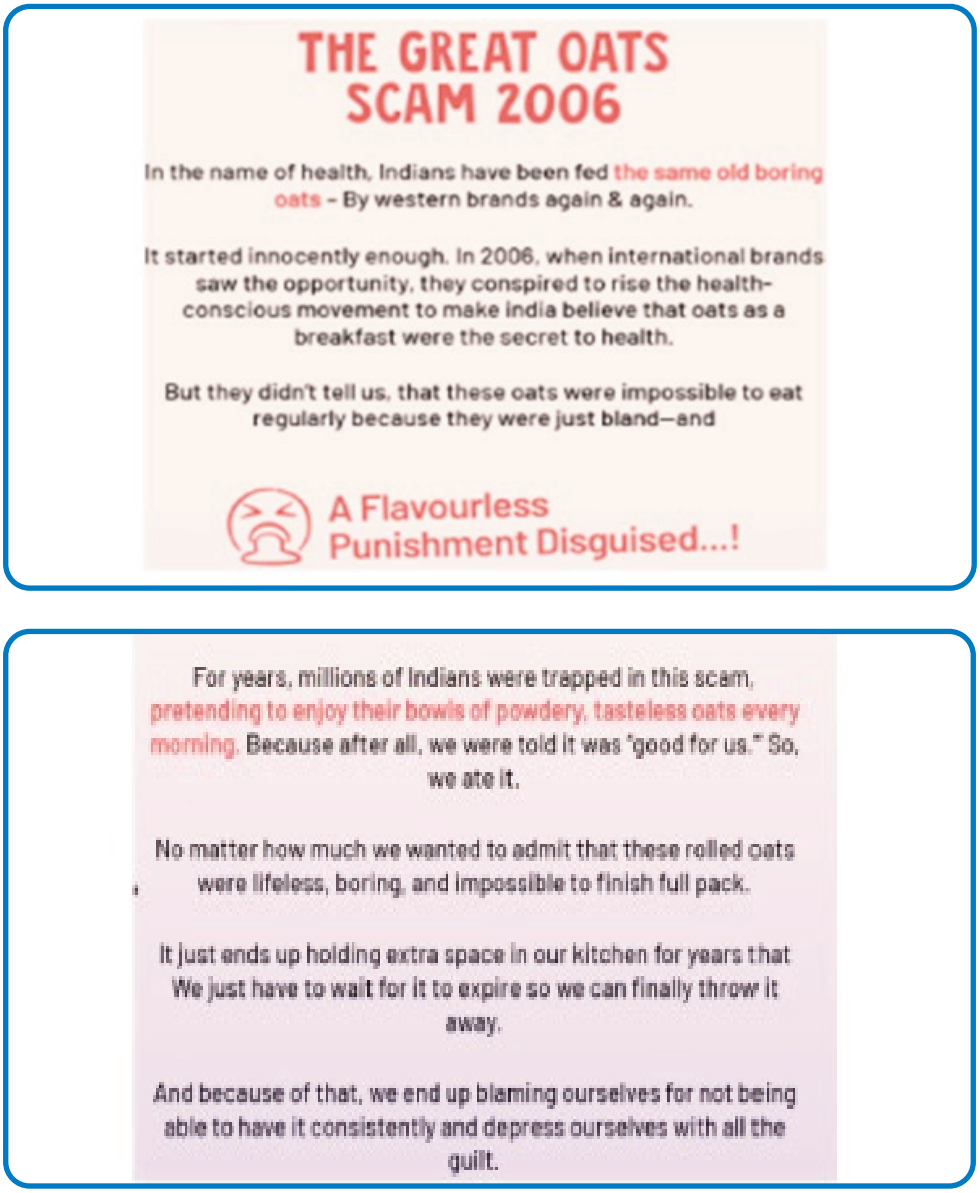
Images from the Advertisement

- The ad described oats with hyperbolic terms like 'bland' and 'flavourless'.
- It portrayed oats as a 'flavourless punishment' and even suggested they were a 'scam since 2006'.
- At one point, the advertisement dilatorily compared oats to 'choona' (lime powder), insinuating that oats could be used as construction material.

Allegations of Generic Disparagement

Marico contended that:

- Any campaign maligning the Oats category of food inherently damages its business due to its dominant market position.
- The exaggerated claims can mislead consumers about the overall quality of oats.



Images from the Advertisement

- Such depictions amounted to unfair trade practices and generic disparagement detrimental to its brand identity.

Court's Decision

When deciding whether an advertisement crosses from acceptable hyperbole to unlawful disparagement, the Courts rely on three key factors:

- Prima Facie case: there must be sufficient evidence showing potential harm to the plaintiff's product or trade.
- Irreparable loss: the plaintiff must demonstrate that the harm it causes cannot be remedied through monetary compensation.
- Balance of inconvenience: Whether granting an interim injunction would impose greater harm on the defendant than on the plaintiff.

In the case, the Delhi High Court found that the combined effect of Alpino's hyperbolic and disparaging portrayal of oats met these criteria.

While analysing these circumstances, the Hon'ble Delhi High Court was of the view that Marico has demonstrated a prima facie case for the grant of injunction and Alpino Health was restrained from publishing, sharing, forwarding, or communicating the impugned advertisement to the public either through social media platforms or in any other manner that would disparage oats as a category of foods.

Conclusion

These cases clear the ambiguity when it comes to distinguishing between the blurring lines of praising and promoting one's product and disparaging a product in the same category. These cases reiterate the critical factors that are to be looked into while determining a case of comparative advertising and cautions the advertiser to not cross the lines of comparison or disparagement while exercising its freedom to speak about the good aspects of its product.

105th PTMG Conference: Playing Trade Mark Notes With a Bonnie Bagpipe Twist

Catherine Wiseman, Barker Brettell

Joanne Green, Chairman of PTMG opened the conference by reflecting fondly on the last time the conference had been held there.

First up to the podium was Neeraj Thomas of CMS, who deftly guided us through how different the Scottish litigation system is to that of England.

Litigation takes place in the Court of Session, which has exclusive jurisdiction for IP matters, with experts in IP as judges. It can also be brought in the Sheriff Court, although this is not recommended. The Court of Sessions is very 'rights holder friendly' and trade mark savvy and it soon became clear that the process is much quicker, more streamlined and cost-effective than in England, or indeed many other jurisdictions.

Joanne Green

For starters, sending a Letter Before Action (LBA) is not necessary, and a trade mark owner would not be criticised for not doing so. Highly advantageous for those open and shut cases, or where you know that you will not get a reply to the LBA, as it means you can issue proceedings very quickly and it reduces the risk of a claim of unjustified threats.

Further efficiencies were revealed in the Scottish system, as there is no formal discovery/disclosure process, instead there is a shortened document recovery process, whereby a party can apply for a document or category of documents. This must be a specific framed request and cannot be a fishing expedition.

Other differences include no joint tortfeasors, so piercing the corporate veil is much more difficult than in England.

In terms of remedies, the main aim is always to stop the infringement and so unsurprisingly an injunction, known as an interdict under Scottish law would be the main remedy, along with damages/an account of profit

If it's damages that you are after, the Scottish system may not be the right forum for you, as if the infringement is incurring throughout the UK, damages are capped to the damage in Scotland and with a population of around six million in Scotland versus approximately sixty million in England, it makes sense that damages would be lower.

Neeraj Thomas

Delivery up is also possible, and Neeraj explained that publicity orders are common and can be placed in local, national and trade press, as well as online. The costs for these are borne by the infringer and can be very useful from a PR perspective, but Neeraj cautioned that they are not right for every case as sometimes they can result in an adverse social media backlash. The court fee in issuing proceedings is low (another advantage) at under GBP £400 and there is also no cap in damages or costs. Costs in the proceedings would generally be awarded to the successful party, with recovery of 50-60% of such costs typically being recovered.

Neeraj then outlined how a plaintiff can really get a tactical advantage in the Scottish courts, by applying for an interim interdict. This is a temporary order that can immediately stop the infringing behaviour. Although such injunctions are available in many jurisdictions, the advantage in Scotland is that such interdict can be granted ex parte. No cross undertaking for damages is required, should no infringement be found, but it is granted 'at risk' of such damages. It will be granted if there is a prima facia case and if the balance of convenience is in the applicant's favour, and delay is not as strictly interpreted as in England.

Neeraj highlighted that such application for interim interdict can be put to great use, as it comes like a bolt out of the blue to the defendant, especially if they are not based in Scotland. The defendant only needs to have business operations there. The net result is that the interdict may apply throughout the UK and so any infringing use must stop, putting the plaintiff in a real position of strength in terms of negotiating.

After detailing the 2021 look-alike case of William Grant and Sons v Lidl, Neeraj provided some other examples from his own experience, including dealing with online infringers, stating that in one case, within about three weeks of being instructed, the lawyers had secured a good settlement result due to applying for an interim interdict.

In summary, litigating in Scotland could result in real tactical advantages using the element of surprise in applying for an interim interdict and as it is not necessary to issue LBAs. There is no automatic discovery/disclosure process and there are streamlined case management rules, meaning a swifter, less burdensome and cost-efficient process. Well worth any pharmaceutical owner of IP exploring the Scottish legal system as a means of obtaining a quick result.

Isabella Cardozo

Next stop was Brazil, with Isabella Cardozo and Viviane Kunisawa of Daniel Law talking us through how to navigate Brazil's regulatory landscape, with each speaker taking turns to present either the trade mark or the health regulatory point of view.

Viviane Kunisawa

They opened with the background that Brazil has a large population of about 213 million, operating a dual healthcare system. It has the largest universal healthcare system in the world, providing free access to medicines and healthcare services. The private healthcare sector is also substantial, covering about 25% of the population. The pharmaceutical market in Brazil is valued at approximately USD $30 billion. Both public and private sectors play a crucial role in the distribution and access to medicines.

ANVISA (the Brazilian health regulatory agency) and the BPTO (the trade mark office) both perform an independent analysis with different purposes relating to the registrability of trade marks and medicine names.

Continued on next page

Conference Report: continued

The regulatory registration of a medicine name is mandatory for the placement of a medicine on the Brazilian market, whereas trade mark registration is highly advisable (but not mandatory). ANVISA's regulations regarding the naming of medicines aim to prevent potential health risks and to protect the consumer. The BPTO considers both absolute and relative grounds for refusal and its main purpose is to prevent consumer confusion and to protect the economic investment made in the creation and promotion of the marks.

Under ANVISA's regulations, the mark should preferably follow the criteria of being one single word, possible to pronounce in Portuguese and distinctive in relation to INN and other registered medicines. There are specific and different rules relating to, for example over-the-counter (OTC) drugs, families of medicines and the use of suffixes. ANVISA's analysis aims to prevent consumer confusion, just like the BPTO, but the focus is on preserving individual health and wellbeing, rather than protecting the economic investment. Detailed slides were provided containing the timings and the analysis of medicine names, but in summary it can take 18 months for straightforward trade mark registration and between 188 and 356 days for obtaining ANVISA regulatory approval depending on the type of medicine concerned.

In terms of OTC medicines, it is possible for them to evoke the main approved therapeutic indication, for example in the drug Cimegripe, 'gripe' means 'flu' in Portuguese.

Where a family of medicines is concerned e.g. Tylenol ® DC and Tylenol ® Sinus, products from the same company must have the same API to be grouped under a common name and only differentiated by complements. The use of complements in pharmaceutical trade marks is regulated for the purpose of registration, in that ANVISA will not consider the existence of exclusive rights over the name complement, which means that in principle the agency presumes that the name of complements cannot be appropriated. Using the same name complements with different meanings is prohibited. Suffixes may be used to distinguish the route of administration, pharmaceutical form, target population, absorption or other situations, but there must be a reasoned justification from the company.

Medicines with distinct release kinetics, pharmaceutical form or route of administration within the same family of medicines must adopt suffixes.

Isabella and Viviane then ran through various detailed prohibitions under the ANVISA regulatory framework which are designed to protect the consumers, before sharing some specific cases to further illustrate their points.

The talk then moved on to advertising regulations. Advertising of medicines in Brazil is regulated by both ANVISA and CONAR (National Council for Advertising Self-Regulation). Under ANVISA regulations, the advertising to the general public can only be OTC medicines (for prescription medicines it can only be to doctors), and there are various prohibitions, such as prohibition on promoting the indiscriminate use of medications, on featuring images of individuals using the medication and on 'language imperatives' that directly encourage medication consumption.

Under CONAR's rules, an advertisement can be challenged if it is not transparent or if it is deceptive or misleading. Any comparative advertising must be fair, and it must not violate any IP rights, and must indicate that it is an advertisement.

Interesting cases studies were provided to demonstrate the types of complaints. In the first one against Cellera Farmacêutica, a local influencer on TikTok advertised one of Cellera's prescription drugs. Although this was a violation and the influencer was ordered to take it down, Cellera was not liable as they had not authorised or contracted the advertising by the influencer.

In the second one, a laxative ad was considered to promote irresponsible behaviour as it encouraged the excessive consumption of food. Sanofi tried to argue that it was humorous, but CONAR did not agree and recommended that Sanofi should suspend its ad, and they complied.

The final one was about the use of other's trade marks. NEOSA and NEOSALDINA are registered trade marks of Hypera for headache tablets. Neosa is a woman's name and in an advert for ADVIL, the dialogue between two people was to call Neosa to ask for an Advil tablet, as 'even she knows that it's the best drug for headaches'! CONAR thought the use of the NEOSA trade mark was unnecessary and so the campaign was suspended.

Next came the International case round-up from Florencia Torresani from Clarke Modet. The round the world tour started with the UK and no conference update is complete without a mention of Sky v SkyKick, which concerned the use of broad specifications of goods and services by Sky. The upshot was that use of a broad trade mark specification can constitute bad faith if the applicant does not have a genuine intention to use the mark across all goods and services, and Florencia noted that from a pharma perspective, this could potentially include 'pharmaceuticals'. The key takeaways were that brand owners should draft specifications carefully to balance sufficient protection against the risk of bad faith challenges. Owners should document their rationale for trade mark filings and retain those records in case they are needed to defend against bad faith claims in the future. I would add that a practice note from the UKIPO regarding broad terms within specifications is expected imminently (and may even be issued by the time this publication is live).

Florencia Torresani

Next to India, to the PARAGON case, where Paragon Polymer sought to prevent a registration by Paragon Engineers for class 9 goods. Paragon Polymer's registration for PARAGON for footwear had been declared well-known by the Trade Mark Registry in 2017. Essentially, Paragon Polymer were seeking to enforce the well-known status against Paragon Engineers whose trade mark applications dated from before the declaration of well-known status. The Court confirmed that a trade mark's well-known status will apply only moving forward and it does not have retrospective effect. It was highlighted that a mark is not inherently well-known as it must gain recognition over time. The ruling supported honest concurrent use, ensuring that emerging businesses would not be unfairly restricted by a mark that is later declared to be well-known.

Florencia then gave a very interesting comparison between the US, Mexico and Australia as to what is required for well-known status recognition. The slides provided invaluable detail on the differences between the jurisdictions in terms of how to prove well-known status, the duration and any applicable costs. In terms of any pharmaceutical well-known trade marks, the US does not maintain an official list of well-known trade marks but in Mexico, there is one well-known pharma trade mark MERCK and in Australia, there are three defensive trade marks (the equivalent in Australia for well-known trade marks) of VIAGRA, ASPRO and NOVARTIS.

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Conference Report: continued

Moving on, Florencia referred to a couple of very recent decisions from January from the EUIPO relating to bad faith. The first related to the mark Lab Companion and the second to the Eric Emanuel case. The key takeaways were that it is extremely difficult to prove bad faith so if you are planning to use a trade mark in a market, make sure you apply for it. In terms of the burden of proof, the good faith of the trade mark applicant is presumed until proven otherwise and the burden of proof of the existence of the bad faith lies with the invalidity applicant. Registration of an identical sign is not a clear indication of an abusive or fraudulent intention, however if the sign is identical, the burden of proof may shift to the applicant. Any claim of bad faith will be subject to an overall assessment taking account of all relevant circumstances.

Next, we darted to China for a very important decision. Novo Nordisk, the owner of a class 5 registration for RYBELSUS, and with a Chinese regulatory approval, sought to prevent a later identical mark applied for in classes 3, 5, 10, 29, 30, 32 and 35. It was speculated whether the Chinese trade mark authorities would support this opposition, considering that there was not much evidence of actual use in the Chinese market and the goods were not similar per the strict Chinese official criteria. It was therefore a victory when the PTO supported the oppositions, finding that the use of the opposed mark on goods such as food and drinks would be deceptive as to the raw materials or the function of the goods. On previous occasions, oppositions that had been filed against copies of drug names had not succeeded as they were not approved with the regulatory body, but in this case, the fact that the RYBELSUS mark was approved meant that the opposition succeeded.

We zoomed back across the world to the US to the case of Dewberry Group, Inc. v Dewberry Engineers Inc., which related to the recovery of the defendant's profits by a successful plaintiff in a trade mark infringement case. Under general corporate law principles, separately incorporated affiliates cannot be treated as a single entity for liability purposes, unless a legal basis, such as piercing the corporate veil can be established. At first instance, the Court allowed the plaintiff to recover the profits of the group as a whole, stating that this was the economic reality. However, the Supreme Court rejected this approach, stating that it violated corporate law principles and therefore, the damages went from USD $43 million to zero. Something pharmaceutical companies should bear in mind when considering their own veil of incorporation but also when filing a lawsuit!

Next to Argentina, where Florencia highlighted a long-running dispute between Pierre Fabre Medicament and Craveri SA which began in 2008, with a final ruling only being rendered in 2025. The key takeaway was that litigation in certain South American territories can take a very long time and so it pays to be patient.

That concluded the afternoon's sessions, and we were then treated to a wonderful evening reception at Hopetoun House, a stunning example of 18th century architecture and interiors in a glorious setting a short journey from Edinburgh. No Scottish cultural evening would be complete without bagpipes, kilts and an 'Address to the Haggis', the Robert Burns poem. This was recited by the charismatic speaker of the House, wielding a ceremonial knife before cutting into the haggis, which is to symbolise the start of the meal.

Frank Meixner

Day Two began with the announcement that Joanne Green had unfortunately been taken ill. Frank Meixner, in his capacity as Past Chairman, kindly stood in for her, expertly delivering his usual flair as Acting Chairman for the whole of the second day. Bright-eyed and bushy tailed delegates were treated to a captivating and highly visual talk from Maximilian Kammler of Boehringer Ingelheim, who took us through the concept of trade dress/packaging from his own in-house perspective. He highlighted that there is no real definition for trade dress in Germany and the EU, 'Aufmachung/get-up' being the commonly used term. Wikipedia defines trade dress as 'the characteristics of the visual appearance of a product or its packaging… that signify the source of the product to consumers'.

In terms of pharmaceutical packaging, European directive of 2001/83 defines immediate packaging as 'container or other form of packaging immediately in contact with the medicinal product' e.g. bottles/blister packs/syringes/inhalers and outer packaging as 'the packaging into which is placed the immediate packaging'

Maximilian Kammler

e.g. the folding box/carton. Maximilian's view is that inhalers are not really packaging, but are devices, as usually the product is in a blister pack, or in a container.

To find inspiration, he went to his company's museum, and in a series of slides, he took us through a range of packaging from 1912 up to the current date, and revealed that in terms of packaging, things have not really changed. Back in 1912, the company had ampules/bottles, with white labels with text, including the brand on it, usually with two colours on it, and a folding box, and this has not really changed over the period of a century.

Maximilian then queried what kind of protection could be obtained for this? Trade Mark protection, of course, but the get-up must be inherently distinctive and capable of serving as an indicator of origin, so he questioned how is this possible when the packaging has existed essentially in the same format over a period of a century? Designs are also challenging, as they must be new and have individual character. To attract copyright protection, get up must be an artistic work, must be original and there must be an author. In terms of passing off/unfair promotion claims, that requires some unfair exploitation of reputation/protecting the goodwill against misrepresentation. All of these types of protection require distinctiveness, individuality or originality – which can be challenging when the packaging has existed for many years in the same format.

The other hurdle is functionality. For trade marks, the shape of the goods necessary to obtain technical results shall not be registered and designs cannot be solely dictated by technical function. Functionality and safety are obviously critical to pharmaceutical packaging.

Maximilian talked us through their TWISTPAK product where he was tempted to look at design protection for the immediate packaging. He showed us a short video, where the product involved aligning and engaging two bottles by twisting them together using their colours, but despite the symmetry in shapes, he concluded that the immediate packaging was functional (as the medicines

Continued on next page

Conference Report: continued

couldn't be stored together), so they decided instead to make a trade mark of the concept – hence TWISTPAK.

Looking at outer packaging, he talked us through their 'Tricolore' packaging, which has been around for decades. Essentially, the principle has been the same, in that they divide the packaging into thirds. One third is then divided into thirds again, and then they apply two colours to that one third. It's about the placement and proportion of these elements (no matter the size or shape of the outer packaging). They have a trade mark registration for this configuration (and have so far been successful in seeing off infringers using this registration, (even though it includes the Boehringer Ingelheim mark).

One problem with such packaging was that under Directive 2001/83 relating to medicinal products for human use, there was so much information that had to be included e.g. name, strength, form, active substances, method of administration, warnings and the list goes on. It must be legible and clearly comprehensible, so that was a lot to fit onto the outer packaging and still have room for some get up. This resulted in a new design of the packaging, where essentially the 'Tricolore' element became a lot smaller, but always with two colours, one defining the product and the second representing the dosage strength of the product – in this way they were able to maintain the Tricolore heritage and the look and feel of the older packaging, and they obtained a new trade mark registration for it. His view is that the new Tricolore packaging assists in product safety and differentiation to help to avoid medication errors.

Maximilian gave some examples where copyright protection might apply which will very much depend on the type of design on the packaging.

He concluded with his final thoughts that the main tension between pharmaceutical trade dress and IP protection is the clear information that legally must go on to pharmaceutical packaging and the sheer amount of information leads to a lack of distinctiveness and a certain uniformity in the outer packaging of all products– almost akin to plain packaging for tobacco, as it all ends up looking the same and not distinctive of origin.

The second speaker of the day was Marta Koremba from Bird & Bird (Poland), who gave us a detailed briefing on well-known trade marks. Marta began by walking us through the international framework and then she focussed on different

Marta Koremba

jurisdictions and their terminology, eligibility criteria and scope of protection. The Paris Convention requires member states to offer protection for well-known trade marks, even if the mark is not registered. The TRIPS Agreement extends protection to well-known services. It provides that assessment of recognition should consider the relevant sector of the public and that recognition can be acquired through promotion. It extends protection against use of the mark on non-similar goods or services for registered trade marks under specific conditions. WIPO's Joint Recommendation (1999) offers guidelines for determining whether a mark qualifies as well-known and how to apply this.

Countries fall into four categories; those that are members of both the Paris Convention and TRIPS, just TRIPS, just Paris Convention, and those that are parties of neither. The good news is that most are members of both, but the main challenge is that the way each country interprets the principles diverge somewhat! Most countries agree that a well-known mark is one that very widely recognised; modest recognition will not be enough. There is no single definition as each country has its own understanding of the term. Some apply it to only registered marks, others include unregistered. Consumer awareness is key, but who, how many and how to prove it varies. Some protect marks known to the general public, some protect marks that are known to the relevant trade. Some require the mark to be a household name. Commonly, most countries apply such protection to dissimilar goods/services, although this is not always the case for unregistered marks.

Marta provided some amazing slides comparing the definitions of a well-known trade mark in a number of territories – it is worth referring to them as they highlighted the different 'flavours'. Many European Union countries rely on the Paris Convention definition to protect well-known marks, but they also have the separate protection that is given to registered marks that have a reputation in the EU.

Looking then at the threshold of awareness, again this various quite extensively. Some countries maintain a 'register' of those marks that are deemed/declared to be well-known, e.g. India and Finland. In China, there is no public register, but if a decision recognises a mark as well-known, this will set a precedent for future proceedings. Other jurisdictions such as the US, EU and UK do not have such a mechanism, and so whether a mark is well known will be determined on the evidence in the course of proceedings.

No country sets a benchmark, but the laws use terms such as 'widely well-known' and 'well-known to the public', with only a few countries such as Germany and Italy quantifying in percentages levels what the awareness of the public should be. And who that public is also differs for example - the US talks about a mark being famous if it is 'widely recognized by the general consuming public of the United States' and China about the 'relevant public'. Again, another set of slides provided some valuable information.

The type of information that is required to prove that the mark is well known is very similar between countries – sales figures, market share, advertising and promotional expenditure and details, trade fairs and exhibitions, duration and extent of use, public opinion surveys, third party market research reports, trade press and media coverage, enforcement history/decisions, license and franchise agreements, brand ranking and awards eg Interbrand and Forbes, consumer engagement as such as social media engagement metrics. Some countries value certain types of information above others.

So, in what type of proceedings can a well-known mark be enforced? This will again depend on the country, but includes oppositions, invalidations, infringement claims and the available grounds will vary with some requiring confusion or a connection, and some not.

The key takeaways for pharmaceutical companies were always to register key brand names, monitor them with watching services, keep a good bank of evidence and tailor it for each jurisdiction of importance. Make sure you act quickly against dilution and use multiple prongs of attack to expedite resolution and get the decision you are hoping for. Beware of local nuances in law and practice and of course get advice!

Brian Beckham from WIPO then took to the stage to meander through 25 years of

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Conference Report: continued

Brian Beckham

the UDRP at WIPO. Before that, he gave us a brief update on developments at WIPO. On the Hague side, the design law treaty was successfully concluded, to streamline the global system for protecting designs and the 1960 Act was frozen in favour of the 1999 Act.

In terms of Madrid, there are new additions of Saudia Arabia and Qatar, and they are expecting quite a few in the next year or so – South Africa, Bangladesh, Papua New Guinea, Sri Lanka, Fiji, Tonga, Hong Kong and Malta. Multimedia marks are now available and there are proposals for Arabic, Chinese and Russian languages to be adopted. Reference was also made to the WIPO ADR service for Life Sciences, which really became popular because of Covid. It was designed to facilitate contract negotiations between parties or to help parties resolve disputes in the life sciences area.

On to the star of the show – the UDRP. It is now possible to file a complaint online (you can still do it by email) and WIPO are working hard to make it easier to file and easier for them to process, to help streamline the process, with the aim of being timely and achieve possible cost savings.

Brian then chatted through some statistics about UDRP cases over the last 25 years. For many years cases hovered at around 2000 per year, but in the past 5 years they have grown from over 4000 to over 6000. Back in the 1990s, there was no UDRP or no national laws that really helped brand owners. Networks Solutions (one of the main registrars) had its own dispute resolution policy, but this had problems with jurisdiction and priority claims. The US government and other WIPO members asked WIPO to come up with a solution that would work globally, and out of this the UDRP was born.

Since 1999 over 135,000 domain names have been reclaimed – most of those have been gTLDs, with about 10-15% being ccTLDs, with more countries joining the WIPO UDRP system all the time. For certain countries it's possible to consolidate a gTLD and ccTLD if they have the same registrant – Brian mentioned there's a webpage that will walk us through this.

Top filing parties in 2020-2024 have been the likes of Lego, Meta, Facebook, Sodexo, Virgin, and pharmaceutical company Sanofi. Top filings industries are banking and finance (13%), internet and IT (11%), biotech and pharma (11%), retail (9%), fashion (8%), food beverage and restaurants (7%).

Complainants and respondents of course come from all over the world, although it is getting increasingly difficult to know where someone might be based. The US has been the largest filer of complaints, with France and the UK following, with Germany and Switzerland after that. In terms of respondents, the US also topped this list, with China, UK, France and India following.

As to the type of complaint, whereas it was traditionally cybersquatting/extortion cases, the landscape has changed a lot since the start of the UDRP. Nowadays, there are a lot of copycat/lookalike websites, pay per click, as well as inactive and redirected domains, and a lot of fraud such as employment scams and phishing. ICANN regulates the domain name process and has made some changes, so that Registrars have positive obligations to address certain types of fraudulent activity such as phishing. The Registrars are also obliged to have their own complaints process when it comes to fraudulent activity and are obliged to respond within a very quick time frame. There's also a website that you can go to, netbeacon.org, where you can either go direct to the Registrar, or you can use this centralised portal, that will forward your complaint on to the Registrar which will hopefully get the domain name taken down more quickly. Many companies also still file a UDRP to make sure nobody else gets hold of the domain.

Turning to copycat websites, these often skim user details and are becoming more common, probably due to AI tools which make it very quick to set up a copycat website. These types of websites can often be identified by discrepancies in, for example, contact information, such as having a US post code but a Hong Kong phone number. Some of these respondents are also using AI such as ChatGPT to provide their responses to UDRP complaints, although these often contain incorrect information, such as incorrect case citations. If these are spotted, it will help to steer the case towards a successful outcome for the complainant.

Turning to outcomes in such cases, Brian compared the decisions of single member and 3 member panel cases. 3 member panel cases often relate to a descriptive/dictionary/made-up term and these are generally defended so tend to have a 50% success rate. For the single member cases, over 90% of cases have had the names transferred. There has also been an increase in default in UDRP cases. 18% of cases tend to settle– it is possible to suspend the proceedings and negotiate behind the scenes. This can be good news for the complainant as if it settles, they will get the USD $1500 fee back from WIPO.

Reverse domain name hijacking (RDNH) is where a rightful trade mark owner tries to secure a domain name by alleging cybersquatting, when in fact the complainant does not have the rights to support this claim e.g. where the registration of the domain predates any trade marks right of the complainant, which would result in a finding of RDNH. These cases are few and far between, probably as they can create some adverse PR for the complainant.

Brian spoke of the difficulties post GDPR in trying to find out who the registrant is. It is possible to ask the Registrar, although half of these are denied for lack of legitimate interest, or they will deem that the information is already publicly available (when this is not really the case as what the registrar means when they say this is that 'name redacted for privacy' means that it is publicly available information, something that brand owners see quite differently!). A topic of much consternation presently.

25 years on, WIPO has convened a project team to review the UDRP with the assistance of key industry stakeholders, which will feed into ICANN's processes so watch this space!

There are new gTLDs on the horizon, likely to launch summer 2026. In 2012 about 1200 went through and they are expecting similar number this time– so watch out for more domains that need monitoring.

Finally, Brian concluded with a reference to Web 3.0. For those not tech savvy – web 3.0 is a new iteration of the internet that harnesses blockchain to 'decentralise' management thus reducing the control of big corporations, such as Google or Meta, and making it more democratic. It is defined by open-source software, it doesn't require the support of a trusted intermediary and it has no governing body. UDRP in connection with Web 3.0 domains is likely to be challenging and at the moment there are more questions than answers.

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Conference Report: continued

Mark Kramer

The pre-lunch slot was filled by Mark Kramer of Potter Clarkson, who walked us through the UK's approach to IP post Brexit and what it could mean for us, and whether at any stage there had been a 'new dawn'. He started by taking us through the relevant dates. Firstly, the surprising referendum result in 2016, after which nothing changed other than political wrangling and posturing. By the end of 2019, a withdrawal agreement with the EU had been reached and this then took us to 'exit day' on 31st January 2020. Nothing changed – all the UK did was to leave but the UK was still regarded as a member state subject to EU law. Then came 'IP Day' on 31st December 2020, at which point the EU Withdrawal Act kicked in. Still nothing really changed in the UK in terms of law and precedent, as EU case law continued to apply and EU law with direct effect was still retained. The only slight change is that appeal courts were given the right to depart from EU retained case law. Mark highlighted what happened to the principle of exhaustion, as the UK decided to continue to apply the principle of EU /EEA wide exhaustion, but the EU decided not to reciprocate. The UK did this as it was concerned about the shortage of goods, particularly pharmaceuticals.

There was then a lot of political talk about ripping up all EU retained law, but clearly this wasn't possible as there wouldn't be enough law left! Not a practical solution and so the next key date was 1st January 2024 'Assimilation Day' when the Retained EU Law (Revocation and Reform) Act 2023 (REULA) came into effect. UK government departments were given more time to make changes to retained EU law, and we now call it 'assimilated law' rather than retained EU law. The UK ended EU law supremacy (the principle whereby EU member states have to interpret national law such that it is compatible with EU law), abolished general principles of EU law such as proportionality, legal certainty and equal treatment, gave government department powers to review, revoke and restate law, and senior UK courts were given greater freedom to depart from retained EU case law.

So, what impact has this had on IP? Mark took us through some cases, starting with E-Accounting Solutions t/a Advancetrack v Global Infosys from 2023. The judge decided the case pre-REULA but explored whether this finding of infringement would be the same post-REULA. The Trade Marks Act 1994 was introduced to give effect to the EU Directive, and so he decided that this could be used as an external aid to reach the same conclusion. The specific provision in question was section 10 (1) (infringement of identical mark for identical goods/services). There is nothing in the provision about the essential function of a trade mark, so the judge considered whether UK parliament intended to give that provision this 'gloss', and decided that it did. So again, this did not result in any real change, despite REULA's purpose to enable re-interpretation, restatement, replacement or updating of EU retained law.

Next was Industrial Cleaning Equipment v Intelligent Cleaning Equipment again from 2023, in which the Court of Appeal cautiously diverged from the CJEU's interpretation in the EU's Budvar case. It ruled that the five-year period begins when the earlier mark or right owner becomes aware of the later registered trade mark's use, rather than its registration. The court felt able to do that as it found the CJEU's approach inconsistent with the General Court and EUIPO's approach, so decided to make its own decision.

In Thatchers v Aldi from earlier this year, Aldi invited the Court of Appeal to depart from L'Oreal v Bellure. This was rejected by the judge as departing from this would create considerable legal uncertainty. Another case from 2023 related to the test of originality in copyright law in THJ v Sheridan related. The Defendants appealed against the declaration of copyright subsistence in GUIs. Arnold LJ ruled that the High Court judge failed to use the correct test from the EU case law, choosing instead the UK's obsolete 'skill and labour' test. The correct test was confirmed to be the same test as the EU test, namely 'author's own intellectual creation' as per Infopaq and Cofemel. The opportunity to diverge was not taken.

Finally, in WaterRower v Liking from 2024, the issue was whether copyright subsists in a rowing machine. Under EU law, for a work to qualify for copyright protection, the only requirement is that it satisfies the originality test. UK copyright legislation however contains a closed list of works that can attract copyright, which includes 'works of artistic craftsmanship'. The UK court decided it was a work of craftsmanship and although it satisfied the EU test for originality it was not a work of artistic craftsmanship, so no copyright subsisted. Tensions have however always existed between the UK and EU law in respect of copyright law, and that is likely to continue to grow.

So where are we now and what happens next? Although UK courts must interpret UK statute based on domestic principles, without the direct influence of EU law, recent case law demonstrates the likelihood of divergence only in limited circumstances. That said, as CJEU and UK courts continue to interpret trade mark law independently, further divergence from EU law seems inevitable, with resulting uncertainty for brand owners in the UK.

Michael Hawkins

The post lunch slot on the similarity of goods and services in an evolving pharma industry was occupied by Michael Hawkins from Noerr. As a trade mark attorney whospends a lot of time searching, prosecuting and opposing, this was the most interesting and practical talk for me as a practitioner. The pharma industry is evolving with a lot of technological change and in the modes of delivery of pharmaceuticals, which will have an impact on the similarity of goods and services in the industry.

Michael began with some audience participation, asking which classes we search in other than class 5 when clearing a pharma mark – 1, 3, 10, 42 and 44 were the key ones that popped up.

One of the areas where we are seeing change is in the delivery of pharmaceuticals e.g. via online pharmacies like Amazon, Pharmacy (U.S.), DocMorris or Redcare Pharmacy (EU), and through other channels such as Uber Eats. This has been facilitated by innovation such as digital prescriptions, but it comes with safety concerns as where are the safeguards as there no pharmacists delivering advice? Although this isn't the norm in all countries, it is likely to become so.

Another area is telemedicine, namely the provision of remote services in non-emergency situations. This has increased due to many factors including the rising number of chronic disease, the increased

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use of smartphones, the rising need for mental health counselling/therapy and the drive for governments to save costs in healthcare.

Tech has had a big impact in terms of remote patient monitoring devices such as blood pressure and glucose monitors, digital therapeutics (DTx)/software to treat some disorders e.g. EndeavorRx, an FDA-approved video game for children with ADHD, and apps such as Headspace and smart watches/fitness trackers.

A further area of evolution has been in personalised medicine, in respect of which pharma companies are investing heavily such as in AI for faster ways of genomic sequencing and in oncology with personalised cell therapies or new vaccines.

Big data and AI is expediting drug development, improving gene editing technology and diagnostic technology. Digital twin technologies that model real life entities (like an organ, cells and a patient) can be used to test treatments in a digital environment, and to simulate processes such as the coordination of care.

So, what do these developments mean for the similarity of goods/services? To recap, the traditional similar goods/services to pharmaceuticals, at least in Europe have been cosmetics in class 3, medical apparatus in class 10, medical and therapeutic services in class 44, nutritional supplements in class 5 and R&D in pharma in class 42. Most search tools will pick these classes up when searching.

Michael then ran through what is required for similarity of goods and services. In the EU, this will include factors such as the nature, purpose and method of use, whether they are in competition or complementary, and distribution channels. In the US, it comes down to the relatedness of the goods or services.

With a bit more audience participation, Michael asked us whether pharmaceuticals are similar to medical software. The audience was pretty much divided equally, with the 'yes' vote edging forward a little. In the EU, the answer for the time being is 'no', although the door does seem to be open if evidence to the contrary can be adduced. The EUIPO in Laboratorios ERN v Levvel Health, EUIPO said that medical software and pharmaceuticals were 'simply too far apart to be found similar', as there is generally no overlap with the producers of each, nor had it been proven that there was an overlap. In Cheerful Star v Helo Corp, the EUIPO Opposition Division decided that apps, smart watches and body fat scales were found not similar to dietary and nutritional supplements. However, in Tcoag Ireland v Trividia Health, the 5th Board of Appeal decided that 'computer software for maintaining a database of blood test results from blood glucose monitors' was similar to a low degree to 'reagents for medical and diagnostic use, etc.', as there was evidence that they were marketed together.

Turning to the US, the position has been the same. In Scientific Solutions, Inc. v Scientific Solutions, LLC, it was held that software and dietary and nutritional supplements were wholly unrelated and vastly different products, yet in a much later case Oura Health v Nectr Energy, ŌURA / OURA devices and instruments to be placed on the human body and related software were found to be closely related to dietary supplements, due to common manufacturers, producers and trade channels.

Michael then went on to look at trade channels. In the EU there is case law that says the retailing of pharmaceuticals is 'lowly similar' to the goods themselves, and also that there is an 'average degree of similarity'. So for example an online pharmacy such as Amazon could be similar to pharmaceuticals.

In terms of providing platforms and portals in class 38 e.g. telemedicine, case law in the EU says they are not similar as there is no evidence they are provided by the same companies in the market. This particular decision related to non-personal information on healthcare – but if it had been a personalised medicine service the outcome might have been different. In the UK, a hearing officer found the transmission of information relating to pharmaceuticals and medicine to be similar to a medium degree to pharmaceuticals, but found the providing of user access to internet platforms, in particular in connection with patient support programmes, to be dissimilar. Case law is conflicting so it will turn on the evidence.

In terms of data and clinical trials/PaaS in classes 35 and 34, generally class 35 data services seem to be found not similar to pharmaceuticals, but research and testing in class 42 will generally be found to be similar.

What about personalised medicine in class 40? Case law will generally find these services to be similar to pharmaceuticals.

In terms of what this means for searching and filing strategies, some goods and services in adjacent classes and for emerging technologies are likely to be considered to be similar/related to pharmaceuticals. Case law is unsettled, but is likely to develop and change as the market continues to evolve with pharma companies e.g. acquiring health tech companies. Searching and filing strategies may need to take account of these broader classes and new types of competitors, particularly where house marks are concerned.

Raising a question from the floor, Richard Heath asked if it is worth making sure that protection is not too specific; referring to re-purposing VIAGRA and using AMBROXAL as another example which may be registered as a remedy for coughs and respiratory conditions, but is now on trial as a potential medication for slowing, treating or reversing the progression of Parkinson's. He also raised the issue of tablet format where many pills are so similar they are sometimes hard to tell the difference, such as APIXIBAN which is virtually identical to Half-Sinamet (Co-careldopa/Levodopa) Sustained Release – another Parkinson's staple. Michael agreed with him and Maury Tepper seconded my reaction having experienced similar situations with insulin.

Barbara Metz

The final talk 'Unlocking bad faith fears' was delivered by Barbara Metz of Novartis. Barbara gave a summary of the position on bad faith filings under EU law explaining the different facets of bad faith. There is no definition in EU trade mark law as to what constitutes bad faith, and so understanding has evolved through case law and the Common Practice note (CP13). Case law has decided that dishonest intention of the applicant is a mandatory factor and that the type of activities that could qualify as bad faith filings are : registering a very similar trade mark to a well-known brand to confuse consumers, registering a famous person's name without their permission, and filing a trade mark to prevent a competitor from using a similar mark, with no intention to use the trade mark. What is clear is that a finding of bad faith will very much turn on the individual facts of the case.

Barbara explained that bad faith in the EU can be divided into two types, firstly a dishonest intention to misappropriate the rights of a third party e.g. parasitic behaviour or registering a trade mark after the end of a contractual relationship and secondly a dishonest intention

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regarding the abuse of the trade mark system, e.g. defensive registrations, speculative filings to extort money and re-filing to avoid the 5 year non-use period.

There is a presumption that the applicant has filed in good faith and so the burden of proof is on the claimant to prove bad faith. The tribunal must consider the point in time when assessing bad faith, and must consider the applicant and their potential legitimate interest in filing the trade mark.

Barbara then looked at three cases that have framed the understanding of bad faith filings in the EU - 2009 Lindt & Sprüngli, 2012 Pelikan and 2021 Monopoly. Mention was also made of the recent UK Supreme court ruling in Sky v Skykick, in which the court was asked whether there is bad faith if a trade mark is filed for broad goods and services with no intention to use on all of them. The court ruled that if those goods and services were not within the owner's commercial activity, then the trade mark registration could be invalidated at least partially on the grounds of bad faith.

Looking more closely at bad faith in the re-filing of trade mark applications, it is clear that re-filing is not prohibited per se. As per the Pelikan case, a proprietor can have a legitimate interest in re-filing a trade mark application and this must be taken into account. There is a presumption of good faith and each case must be considered on a case by case basis. The applicant must have a dishonest intention, re-filing will generally be acceptable where the marks are not entirely identical, and the refiling of identical marks may be acceptable if a plausible explanation is given e.g. the list of goods is narrowed or updated, or there have been changes in consumer demands or marketing strategy.

What does this mean for brand owners? Almost certainly the end of 'evergreening' (the re-filing of the same trade mark for the same goods). Brand owners should keep evidence of their motives for re-filing and they should be selective when deciding which marks to use against third parties to avoid any counterclaims for bad faith.

Barbara then went on to consider the consequences for the pharma industry of this EU case law. In general, the naming process for pharma products starts about 4 years from creation to the launch of the product, taking account of the time needed for brainstorming the name, screening, legal and regulatory checks, market and safety testing and submission of the names to regulatory bodies and to trade mark offices. During this naming process, there can be uncertainty surrounding whether legally free to use marks are acceptable to the regulatory bodies, as they could for instance be rejected, or the compound rejected. There could be internal delays, or a project could be terminated, which means that pharma companies often end up with a number of names that are available and legally ready to use.

Given the difficulties in finding usable names, many pharma companies look to maintain these 'ready to use' marks. But can these trade marks be re-filed after the grace period to allow for potential future use? Care should be taken as repeat applications could be regarded as bad faith filings. However, thankfully usually such names are still within a few years of being registered and so are not vulnerable to non-use, but where they are vulnerable, it is too much of a risk for pharma companies not to re-file as otherwise they would lose all the investment that they have made in the name.

Barbara then had a quick look at the position in the US and China. The current legal framework varies across jurisdictions, and in many re-filings are not regarded as bad faith. In the US, although the owner must have a bona fide intention to use the mark, re-filing does not qualify as a bad faith act as it is generally accepted that R&D, clinical trials and regulatory issues can cause delays in product launches. In China, re-filing is also allowed and an intention to use is not required.

Barbara concluded that pharmaceutical companies maintain legally ready to use trade marks due to the complexity, uncertainty and difficulty in obtaining one globally approved brand, and that they do re-file trade marks based on a case by case assessment, whilst respecting the rulings and guidance of the ECJ/CJEU.

And with that, the conference drew to a close. It really was a conference packed with insightful and informative talks and engaging speakers.

PTMG gives back to the community

The Editor would like to thank all those who joined her in Edinburgh at the Venchie Children and Young People's Project. Blessed with glorious Spring sunshine, we merrily gave two hours of our time to help tidy up the outside gardens and children's play area. 'Such a great way to meet new people'; 'It feels so good to have done something meaningful' – this Monday morning activity is indeed a great way for 1st timers to join the PTMG family.

Look out for information on the next Giving Back to the Community initiative when you receive your invitation letter to the Spring 2026 conference, taking place in Munich.

International Update

BAHAMAS

Patrick Hely, Caribbean IP

In late February, The Bahamian IPO (BIPO) made an unanticipated announcement that new laws concerning trade marks, patents, and copyrights were retroactively effective on 1 February 2025. While aspects of the Trade Marks Act, 2024 are welcome changes to a long-antiquated system, the roll out of the new law has been marked by confusion and a lack of clarity. That is primarily because the Act was implemented without accompanying subsidiary legislation (i.e., rules).

For historical context, the prior law was initially adopted in 1902 and had not been amended since 1987. Marks could only protect goods and classification was based on the pre-1938 UK system.

On the positive side, the new law introduces service marks and, presumably, Nice classification (the law refers to the Nice system in its definitions section, but leaves the actual adoption of a classification system to the subsidiary legislation). Presuming an adoption of the Nice system, one can expect significant improvements in the prosecution of marks. For example, Nice Class 5 will cover prior registrations from local classes 3 (chemical substances prepared for use in medicine and pharmacy), local class 4 (chemical substances used for . . . veterinary . . . purposes), and in some cases, local class 42 (substances used as food or as ingredients in food), and perhaps even the perennial catch-all, local class 50(10) (goods not included in the foregoing classes).

On the negative side, because the secondary legislation remains to be seen, owners and practitioners alike are left to guess about several key issues of the new system. Not only is the Nice system's use not assured yet, but the transitional provisions of the law leave the prior Trade Marks Rules in place in the interim, despite obvious disharmony with the Act.

The BIPO is not providing guidance on how goods or services should be classified on new applications. The former can, in theory, be applied for under the prior classification system. But that could lead to inefficiencies and amendments once the rules are put in place. Some may choose to assume the risk that Nice will be implemented and group goods together accordingly, but classify them (and therefore potentially misclassify some) according to the obsolete rules. The latter (services) is potentially more confusing, as one does not even have a current classification system to apply under and must place faith in Nice's adoption or prophesy some alternative.

Under the prior law (and retained rules), The Bahamas is a single-class jurisdiction. The question of whether it will accept multi-class applications moving forward will only be answered with the new subsidiary legislation. If retaining single-class marks is chosen, it could compound problems created by the current classification ambiguity and lead to considerable additional work for BIPO in addressing numerous office actions that could be avoided (or minimized) in a multi-class system.

One thing seems exceedingly likely from the little the BIPO has revealed, namely, official fees will increase with the new rules and the BIPO's position will undoubtedly be that they apply retroactively. So, despite filing applications at this time to preserve filing dates, owners should anticipate additional, unpredictable fees to maintain their applications in the coming months or years.

Until rules are passed, it appears BIPO will not examine applications made since 1 February 2025 (i.e., since the retroactive effective date). It is however accepting applications to accord filing dates, which will then be examined once the new regulations are in place. BIPO has been promising local agents that the regulations are 'coming soon,' but months after the official announcement that the Act was in effect, there remains no rules promulgated or a draft circulated to practitioners. Also, how BIPO is handling new and existing applications is subject to change at any time, so brand owners should be prepared for the unexpected.

Some other changes are unambiguously established by the existing legislation. For example, the Act reduces the term of marks from 14 to 10 years, including renewal terms of existing marks. This creates a point of caution when docketing, especially existing marks whose renewal term commenced on or after 1 February 2025. The Act also provides for certification and collective marks as well as non-traditional marks (the Act explicitly recognizes colors, three-dimensional shapes, holograms, motion marks, sounds, scents, and textures among the potential registerable marks). Finally, the Act incorporates provisions of the Paris Convention that previously operated without direct codification in the prior domestic law.

Despite the considerable challenges at this time, this author believes that the long-term benefits of the new law will be considerable. Brand owners should evaluate their long-term position in The Bahamas and evaluate the relative risks of applying to protect marks, especially service marks, during this transitional and vague period in Bahamian trade mark law.

CHINA

Flora Fang, Principal, Beijing, Rouse

After years of dedicated efforts, the China National Intellectual Property Administration (CNIPA) has significantly curbed malicious trade mark registration behaviours by implementing legislative measures and new practices.

CNIPA's efforts included releasing a Work Plan for the Systematic Governance of Malicious Trade Mark Registration and Promotion of High-Quality Development (2023–2025)(Work Plan) in April 2023. One of the measures of the Work Plan is to improve the monitoring and analysis of trade mark application behaviour data, enhance the early warning indicators and investigation of malicious trade mark registration activities to ensure effective prevention, timely detection, and targeted crackdown on such activities.

This update details the specific initiatives by the CNIPA to effectively implement this measure.

In December 2024, the China Government Procurement Network announced six successful bids to assist the CNIPA with identifying and investigating potential bad faith trademark registration behaviour with the intent to hoard and resell. The project spans diverse industries, such as home appliances, apparel, educational training services, telecommunications services, and also pharmaceuticals and medical devices.

For those in the pharmaceutical industry, this mainly includes:

1) Monitoring of Specific Platforms

Several active general online trade mark trading platforms, including Hao Biao (www.haotm.cn), Zhongxiruan Trade Mark Supermarket (www.gbicom.cn), Yuzhua (www.yuzhua.com), Pin Biao (www.mb.cc), Maihui (www.maihuiipr.com), and Chuangming (www.cmsbw.cn), etc., will be routinely monitored for a twelve-month period. The report will be reviewed by the China Trade Mark Office (CTMO). This monitoring, at a minimum of once a week, specifically targets potential hoarding and resale activities involving pharmaceutical product trade marks listed on these platforms.

2) Identification and Recording of Suspicious Trade Marks

For trade marks where hoarding and resale activities are suspected, a comprehensive list of indicators will be compiled. This will include all relevant details: the trade mark registration number, trade mark name, complete registrant information (name and address), associated trade mark agency (where applicable), along with captured screenshots of sales pages or other verifiable evidence demonstrating the sales behaviour. This evidence will be

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summarized every quarter to systematically keep track of potential hoarding and resale activities.

Using actual trade mark assignment data, the project will evaluate the registration behaviour of relevant trade mark owners and propose appropriate disposal recommendations for the registrants and their associated parties. Based on the provisions outlined in the Examination Operation Guidelines for Malicious Trade Mark Registration Applications without Intention to Use, the review procedure under Article 4 of the Trade Mark Law will be initiated. During the substantive examination, strict scrutiny will be applied to reviewing the submitted evidence of trade mark use or declarations of intended use. A quarterly report will be generated, encompassing the analytical findings, proposed disposal recommendations, and status update on the examinations.

What happens next?

Having followed established investigation protocols and applicable provisions, when a trade mark under investigation exhibits indications of hoarding or resale activities, CNIPA will formally issue an office action in accordance with Article 4 of the Trade Mark Law, requiring the applicant to provide evidence demonstrating either actual commercial use or intent to use the trade mark, or initiate an action to invalidate the registered mark in accordance with Article 44 of the Trade Mark Law. The evidentiary standards for establishing genuine use intent under such circumstances are particularly stringent, and failure to meet these requirements will lead to refusal of the trade mark application or invalidation of the registered mark. Additionally, any applications to assign or pledge marks of this kind will not be approved.

What impact will this have on pharmaceutical trade marks and what should pharmaceutical companies do?

This project demonstrates the CNIPA's continued dedication to combating bad faith trade mark registrations. We anticipate that this twelve-month project will yield meaningful outcomes. Of particular significance, brand owners operating in specialized fields including the pharmaceutical sector will stand to benefit from this project.

For entities considering trade mark acquisitions, conducting comprehensive due diligence is particularly crucial. This step is essential to preempt potential issues arising from the original owner's malicious acts. For instance, such malicious conduct could lead to the CTMO disapproving of the assignment. Even if the assignment is approved, the trade mark may still be at risk of invalidation due to the original owner's improper conduct.

ETHIOPIA

JAH Intellectual Property

Effective March 26, 2025, the Ethiopian Intellectual Property Authority (EIPA) has started publishing accepted trademarks in the Ethiopian Intellectual Property Authority (EIPA) website. This marks a shift from the previous practice of publishing trademarks via the Ethiopian Press Agency, which is currently still applicable and acceptable.

We further wish to inform you that, at present, the EIPA has not established a formal fee structure for online publication. Therefore, this service is currently being provided at no cost, though it is anticipated that fees may be introduced in the future.

GEORGIA

CWB

The National Intellectual Property Center of Georgia (Sakpatenti) recently announced on its website that the Georgian Parliament approved the ratification of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications on 18 March 2025. Georgia is expected to deposit its instrument of accession to the Geneva Act with the World Intellectual Property Organization (WIPO) in the near future.

The accession will allow Georgian applicants to protect their regional brands abroad as appellations of origin or geographical indications through a single application and upon payment of one set of fees. The scope of protection will be extended to cover 23 contracting states and two intergovernmental organizations that are parties to the Geneva Act – the European Union and the African Intellectual Property Organization.

The accession to the Geneva Act was preceded by a reform that Sakpatenti implemented with the support of the European Union, within the Twinning Project Establishing Efficient Protection and Control System of Geographical Indications (GIs) in Georgia aimed at the harmonization of local regulations with the Geneva Act.

At present, 39 appellations of origin and 31 geographical indications are registered in Georgia.

IRAQ

Zeina Salameh, Saba & Co.

The Iraqi Trademark Office (TMO) has officially eliminated its local subclassification system, which previously assigned alphabetical numbering to class headings. This update follows Iraq's adoption of the 11th edition of the Nice Classification, effective 19 January 2025.

Under the new system, applicants must specify the basic (serial) number corresponding to pre-approved goods or services as outlined in the 11th edition. The TMO will not allow claims for class headings or custom-written specifications.

For renewals and recordals, applications must include a reclassification request to transition from the 7th edition to the 11th edition. The TMO has also confirmed that renewal certificates will not be issued for trade marks previously published unless a reclassification request is submitted.

This update modernizes Iraq's trade mark registration process, bringing it in line with international classification practices.

SAUDI ARABIA

CWB

Saudi Arabia Cabinet Decision No. 237/1446 on the Approval of the Commercial Register and Trade Name Laws, which was published on 4 October 2024, took effect in January 2025. The new Saudi trade name law establishes clearer rules for the registration and protection of trade names, which are critical for distinguishing businesses in the marketplace.

Registration and Composition of Trade Names

Under the new framework, businesses must register their trade names with the Ministry of Commerce through the Commercial Register. The law also allows for temporary reservations of trade names, providing flexibility for businesses in the early stages of their operations.

Trade names can be composed of:

- The business owner's name;
- A distinctive name; or
- A combination of the above.

Names can include Arabic words, transliterated Arabic elements, letters, numbers, or even foreign language terms, provided they comply with specific rules set by the Saudi Ministry of Commerce. However, names that mislead the public or conflict with public order, morality, or existing legal provisions are prohibited.

Protection of Trade Names

Registered trade names are shielded against unauthorised use. Subject to other applicable legislation, the Trade Name Law grants exclusive rights to the owner, including the ability to seek compensation before the local courts. Importantly, the law prohibits the registration of names that are identical or similar to famous trade marks and trade names and registered trade marks or trade names to minimise consumer confusion.

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Administrative Measures and Enforcement

Applications for trade name registration are reviewed within ten days, subject to extensions, ensuring a swift and transparent process. Application rejections must include detailed reasons, and applicants have the right to appeal the decision before the Ministry within 60 days, with the possibility of further appeal before the court within 30 days.

The law also introduces stringent penalties for violations. Businesses found guilty of misusing trade names or failing to adhere to the new regulations may face fines of up to USD $13,300. Repeat offenders may incur double penalties. The Ministry is authorised to appoint inspectors to enforce compliance and address violations effectively.

Amendments, Transfers, and Display Requirements

The law allows for amendments to registered trade names, provided that prior obligations and rights are respected. Trade names can also be transferred independently of the business, subject to proper registration and notification. Businesses must prominently display their registered trade names at their premises and on, 'documents, correspondence and publications'.

Broader Impact

As the implementation date approaches, businesses are advised to familiarise themselves with the law's provisions to ensure compliance and capitalise on the opportunities the new law provides. The Ministry of Commerce will release additional guidelines to clarify specific procedures and address practical considerations.

This new law represents a significant step forward in Saudi Arabia's broader economic reforms, fostering a competitive and transparent marketplace for local and international businesses alike

SAUDI ARABIA

CWB

On 7 January 2025, Saudi Arabia deposited its instrument of accession to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs with the World Intellectual Property Organization (WIPO). This latest accession brings the total number of countries covered by the Hague System to 99.

On 7 April 2025, when the Geneva Act of the Hague Agreement enters into force in Saudi Arabia, designers or business owners in Saudi Arabia will be able to seek protection in any of the 99 countries covered by the Hague System, by filing just one international application. In parallel, non-residents seeking design protection in Saudi Arabia will be able to designate the newest contracting state in their international applications.

TURKEY

Simge Şahin, NSN Law Firm

International non-proprietary names (INNs) identify pharmaceutical substances or active pharmaceutical ingredients and are assigned by the World Health Organisation (WHO). As a result of the INN system, each substance can be recognised by a unique and globally available name which helps the clear identification, safe prescription and dispensing of medicines. It also makes easier the communication and exchange of information among health professionals. INNs can be used freely since they are public property.

More than 8.000 INNs have been published at the cumulative list of INNs of WHO until now and more are added each year. With the growing number of INNs, the possibility of conflicts between the trade marks and INNs has increased in recent years.

In accordance with the aim of INNs, when creating a pharmaceutical trade mark, the pharmaceutical companies should refrain from choosing a sign that may be confused with an INN. However, in practice, it is very common for the pharmaceutical companies to choose a sign that is derived from or similar to an INN.

There is no special regulation for the examination of pharmaceutical trade marks against INNs in Turkish IP Law. The Turkish Patent and Trademark Office makes ex-officio examination for pharmaceutical trade marks on the basis of absolute grounds e.g. distinctiveness, descriptiveness, delusiveness and being identical or indistinguishably similar to an earlier trade mark. In addition to the ordinary examination, the TURKISHPATENT also evaluates whether the applied sign is identical with or confusingly similar to an INN. However, the TURKISHPATENT's evaluation on the similarity to an INN is very strict. The Office seeks for almost identity since the targeted consumers of pharmaceuticals are considered to be professionals (i.e., doctors and pharmacists) who have a medical education and have a high level of attention. Although there is no established practice and it is evaluated case-by-case, IP Court and the Regional Court of Justice applied a broader approach in their recent decisions.

In an important case shedding light on the approach of Turkish authorizations to the similarity of pharmaceutical trade marks and INNs, the TURKISHPATENT rejectedthe opposition filed against VORTEXIN trade mark application on the basis of the similarity with VORTIOXETINE INN. In this case, apart from the similarity between the trade mark application and VORTIOXETINE INN, the similarity between the VORTEXIN phrase and the stem of the subject INN, which is '-oxetine', was also high to create likelihood of confusion. Seeking for almost identity, the TURKISHPATENT concluded that VORTEXIN trade mark application is not identical with or highly similar to VORTIOXETINE INN or its stem.

Thereon, the opponent filed a cancellation action against the TURKISHPATENT's decision and Ankara 2nd IP Court accepted the court action and decided the cancellation of the decision and the invalidation of the subject trade mark for the goods in class 5/1. The Court highlighted that the subject trade mark was created by removing some letters of VORTIOXETINE INN which means that it is derived from the root INN and since they mostly consist of the same letters, there is a considerable similarity between the trade mark and INN. The Court also added that the targeted consumers are very well-informed people and that it is allowed to create a trade mark based on INN or disease name provided that there is a distinguishing addition. Nevertheless, the Court did not find the differences enough to distinguish VORTEXIN trade mark from VORTIOXETINE INN.

Upon the appeal of the defendant, this time, the Regional Court of Justice (RCJ) reviewed the file and approved the First Instance Court's decision by rejecting the appeal. The RCJ stated that the ownership of words similar to INNs cannot be owned by any person or entity and considering the similarity level between the VORTEXIN trade mark and the VORTIOXETINE INN, the subject mark cannot be registered for class 5/1. The Court of Appeal uphold the decision and the decision became final and binding.

This decision sheds a light on the protection of INNs from a broader approach in future cases and also provides guidance to TURKISHPATENT for the evaluation of oppositions based on the similarity to an INN. Not allowing the registration of a pharmaceutical trade mark that is similar to an INN in its overall impression without seeking for almost identity serves the purposes of the INN system. In addition, pharmaceutical companies should be very sensitive when creating trade marks deriving from INNs or their stems in order not to face rejections or invalidations as a result of objections / actions of third parties.

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UKRAINE

Kateryna Oliinyk, Arzinger Law Office

Ruling of the Grand Chamber of the Supreme Court dated 17 April 2024

Facts of the case

The case related to the dispute based on the trade mark infringement claim between two Ukrainian pharmaceutical companies. The pharmaceutical company Darnytsia filed a lawsuit against the Ukrainian IP Office and Lubnyfarm JSC, seeking, inter alia, recognition of the designation Citramon as a well-known trade mark (TM) in Ukraine as of 1 January 1997 and invalidation of the TM registration in the name of Lubnyfarm JSC, which is confusingly similar to the TM Citramon.

The trial and appellate courts upheld the claim. However, the Grand Chamber of the Supreme Court dismissed the claim for recognition of the designation as a well-known TM in Ukraine. As for the other claims (invalidation of the trade mark certificate owned by Lubnyfarm JSC and obligation of UKRNOIVI to register changes in the State Register of Trade mark Certificates of Ukraine), it sent the case for a new trial.

Legal stance of the Grand Chamber of the Supreme Court

Recognition of a trade mark as well-known is only a condition for granting protection to a person, specifically by invalidating the TM registration (certificate) by another person, and is not an independent remedy.

The protection of a well-known trade mark does not automatically grant rights to it, and the recognition of such a mark by a court is intended to protect the rights of the owner. Such recognition is relevant only to the parties to a particular dispute and is not binding on persons who are not parties to the case. Therefore, the court is limited in establishing the circumstances that prove or disprove the trade mark's being well-known.

What it means for business

This decision changes the approach to the consideration of cases on protection of rights to well-known trade marks, according to which the recognition of well-known trade marks by a court decision was previously prejudicial in other disputes and did not require proof. Now the fact that a TM is 'well-known' must be established in court separately in each specific case. This significantly limits the possibility of referring to the already established status of a well-known TM in other court cases.

Further, the findings of the court give rise to the discussion how the parties may refer to the well-known status of a trade mark when such status has been granted by the Chamber of Appeals of the Ukrainian Patent Office.

UKRAINE

Kateryna Oliinyk, Arzinger Law Office

On 16 April 2025, the Verkhovna Rada of Ukraine adopted Law No. 4362-IX, which repeals the Law of Ukraine 'On the Protection of Interests of Persons in the Field of Intellectual Property during Martial Law Imposed Due to the Armed Aggression of the Russian Federation against Ukraine' (Law No. 2174-IX, dated 1 April 2022).

The repeal will enter into force 30 days after its official publication.

Key Takeaways:

1. Resumption of IP-related deadlines:

All deadlines for actions related to the protection of intellectual property rights and procedures for acquiring such rights, previously suspended under the wartime IP protection law, will resume from the date the new law enters into force. The calculation of these periods will account for time elapsed prior to suspension, and no deadline shall be shorter than 75 days from the date of reactivation.

2. Fee Payments Adjusted:

o Official fees under the laws on industrial designs, trade marks, semiconductor topographies, inventions, utility models, geographical indications, and plant varieties are to be paid in accordance with the extended deadlines.

o Annual maintenance fees for inventions, utility models, industrial designs, and plant varieties that became due during the suspension period are deemed timely paid if settled within 75 days from the date the new law enters into force.

o If such fees are not paid within the 75-day period, the relevant IP rights will be deemed terminated retroactively as of the original due date.

3. Trade mark Renewal Fees:

o Fees for renewal of trade marks due during the effectiveness of the repealed law will also be considered timely if paid within 75 days from the new law's effective date.

o Once paid, the trade mark certificate will be renewed for a full 10-year term, starting from the end of the previous validity period.

Implications for IP Right Holders:

IP owners, agents, and legal representatives should immediately assess the status of their IP portfolios and ensure:

- Timely completion of pending procedural actions.
- Payment of any fees that became due under the previously suspended regime.
- Adjustments to internal IP management systems to reflect resumed timelines.

Failure to act within the prescribed 75-day grace period may result in irreversible loss of IP rights.

YEMEN

CWB

The IPO based in Sanaa, Yemen has introduced a major update to its trade mark application policy, as outlined in Ministerial Decision No. 52/2024. The change eliminates the previous cap of 10 goods or services per application, allowing applicants to designate an unlimited number of items within a single filing. This reform reflects global trends to simplify and modernize trade mark registration processes.

While the prior restriction has been removed, any goods or services listed beyond the first 10 will be subject to additional publication fees, calculated at a rate of 5% of the standard publication fee for each additional item. This approach balances the flexibility of an unlimited number of items with the administrative costs of processing and publishing extended lists.

While Yemen has two IPOs, one operating in Sanaa and the other in Aden, each with its own jurisdiction and procedures, both offices have recently adopted the 12th edition of the Nice Classification of Goods and Services and are operating under a single-class protection principle.

By way of background, starting 22 October 2024, both offices raised the number of goods/services covered in a single trade mark application from 4 goods/services to 10. The Aden IPO still adheres to this policy, while the Sanaa IPO has now removed this prior 10 item restriction.

On 7 October 2024, the IPO in Sanaa introduced an online platform where users can access a range of trade mark services, including the filing and recordal of amendments, waivers, objections and responses. Deadlines for all procedures handled through the platform are now automatically calculated by the system, providing greater accuracy and reducing administrative burden. The Official Trade Mark Gazette is now exclusively available digitally on this platform.

Growing Importance of the 'Safe-Distance Rule' in Pharmaceutical IP Enforcement

Samta Mehra and Udayvir Rana, Remfry & Sagar, India

India's pharmaceutical market for FY 2023-24 is valued at USD $50 billion - considered the world's third largest by volume and 14th in terms of value of production. While this presents an attractive opportunity for pharmaceutical companies, the market is not without its challenges. Often small operators attempt to capitalize on the goodwill and reputation of world-renowned brands by adopting similar brand names for easy commercial gain. This not only dilutes famous brands but also poses potential health risks.

In a recent decision by the High Court of Bombay (Aventisub LLC & Anr. v Healing Pharma India Pvt. Ltd. & Ors.; Contempt Petition No. 21571/2022 in Commercial IP Suit No. 139/2021), the Court adjudicated on copyright infringement and the enforcement of trade dress in pharmaceutical packaging, relying on the application of the 'Safe Distance Rule,' a principle derived from U.S. jurisprudence.

Case Background

In October 2020, Aventis LLC, part of the Sanofi Group (Aventis) discovered that Healing Pharma India Pvt. Ltd. and D.M. Pharma (HPI) had applied for the trade mark Allergegra, nearly identical to Aventis' well-known antihistamine drug Allegra. HPI were selling antihistamines in the same variants as Allegra with similar packaging, colour scheme and trade dress. Aventis filed a lawsuit for trade mark and copyright infringement in the Bombay High Court (Aventisub LLC & Anr. v Healing Pharma India Pvt. Ltd. & Anr. - Commercial (IP) Suit (L) No. 6866 of 2020) and secured an ex parte injunction against HPI on 27 November 2020. Seizure operations yielded a high number of infringing products, and HPI agreed to a decree. On 1 March 2021, the court decreed the suit in favour of Aventis, with HPI agreeing to stop the sale of products using a packaging or trade dress that would infringe upon the marks of Aventis, as also using artistic work that would be identical or similar to the artistic work used by Aventis.

In 2022, Aventis LLC discovered that HPI were selling anti-allergy medication under the name ALGREAT, which they did not object to. However, the packaging closely resembled that of ALLEGRA, violating the 2021 court order. Aventis filed a contempt petition in the Bombay High Court.

Initially, HPI denied any infringement but later agreed to change the packaging, though only filing an affidavit in 2024. By then, in 2023, the court had already found them prima facie guilty of contempt and considered imposing costs. Meanwhile, Aventis found that the infringing products bearing similar packaging were still available online. In response, HPI claimed they had asked distributors to remove listings and that the expired products were no longer for sale. In 2025, they sought dismissal of the contempt petition. Aventis argued that despite recent compliance, HPI had violated court orders for years. Evidence showed the infringing products were manufactured as early as March 2022, with packaging dating back to 2021 - months after the initial ruling.

Application of the Safe Distance Rule and Court's Finding

The court ruled in favour of Aventis, stating that HPI had no justification for continuing to use the objectionable packaging despite their prior undertaking. It rejected the latter's initial claim of no infringement and noted that HPI acted with impunity and only took remedial steps when caught, merely to avoid prosecution under the contempt proceedings.

Further, the court referenced the Safe Distance Rule, a rule in trade mark law formulated by the United States Court of Appeals, Sixth Circuit, in Innovation Ventures, LLC v N2G Distributing, Inc., 763 F.3d 524 (6th Cir. 2014) and applied previously by the Bombay High Court in Pidilite Industries Limited v Raghunath Chemicals and Ors. This rule states that once an entity is found to be infringing, it must take sufficient steps to maintain a 'safe distance' from the protected mark or trade dress. Minor modifications that continue to create confusion do not absolve the infringer from liability.

The US Court of Appeals decision explains that the rule is 'a particularly useful tool in crafting and enforcing permanent injunctions. Once a party infringes on another's trademark or trade dress, the confusion sown is not magically remedied by de minimis fixes. Rather, the confusion lingers, creating the need for the infringer not only to secure a new non-infringing characteristic for his product but one so far removed from any characteristic of the plaintiff that it puts the public on notice that the two are not related'.

On the issue of contempt proceedings and fresh causes of action, the US Court of Appeals further noted: 'The rule relieves the reviewing court of the need to retry the entire range of issues that may be relevant in an infringement action for each small variation the defendant makes to the enjoined mark'.

Relying on the doctrine of contempt and the Safe Distance Rule, the Bombay High Court held:

'There is no escape for [HPI] from the fact that they willfully disobeyed the order of this Court, and solemn undertakings given to this Court were also breached with impunity'.

As a result, the court directed HPI to adopt a trade dress distinct from that of the petitioner. The High Court of Bombay further ordered HPI to pay approximately EUR €5,500 to Aventis. Failure to comply would result in the imprisonment of HPI's directors for a period of one month.

Conclusion

Trade dress in pharmaceutical products plays a key role in distinguishing medicines, particularly in cases where generic names form part of brand names. Deceptive tactics, such as minor modifications to packaging post an allegation of trade mark/ copyright infringement (as in this case), often force brand owners to initiate fresh litigation. However, the application of the Safe Distance Rule smoothens the path for brand owners and is sure to become a cornerstone of trade mark enforcement strategies in India.

PROFILE: Jenny Barker

Jenny, a UK qualified solicitor, currently leads GSK's Global Anti-counterfeiting Team, with AC experts based in Colombia, China and the UK. Jenny started her career in private practice at Simmons & Simmons LLP in London before moving to GSK in 2012. Jenny is Vice-chair of the AIM (European Brand Owners Association) Anti-counterfeiting Committee. She is also a member of PTMG and of EFPIA's Anti-counterfeiting and Security Network. She has spoken at various events, including ones held by the University College London Institute of Brand and Innovation Law, INTA, PTMG, IP Watchdog and at the CIIE IP Forum in Shanghai.

Where were you brought up and educated?

I grew up in Wokingham, England and studied law at Oxford University.

How did you become involved in trade marks?

I did a couple of internships as a student, including one in the IP team of a London law firm which I really enjoyed. It was far more interesting than tax and pensions.

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

I would probably have been lured into the corporate law department of the law firm where I trained.

Which three words would you use to describe yourself?

Adventurous, optimistic, thoughtful.

What was your worst experience in the world of work?

Attending an all-night completion meeting as a junior associate on a deal between two large tobacco manufacturers before indoor smoking was banned. The fug in my brain was almost as thick as the fug in the air by the end of it.

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

I was unexpectedly unable to access my laptop with all my slides and notes for a presentation to senior Chinese officials at the CIIE IP Forum in Beijing and had to give the whole presentation from memory. Learning – never assume the organisers will have your slides and make sure you have a hard copy set of notes!

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

Fantasy football competitions – I had to retire from the family competition on grounds of incompetence and lack of engagement.

What's the best thing about your job?

The people I work with – both in my direct team and in our various high risk markets for counterfeits - and the job satisfaction that comes from having a positive impact on patients.

What does all your money get spent on?

I have three children – enough said!

If you weren't completing this interview, what would you be doing right now?

Probably cycling around Richmond Park.

What's the toughest thing about your job?

Trying to influence government and enforcement authorities in challenging jurisdictions to take positive action against counterfeiters. Also, working across all time zones and with markets that operate on our weekends.

Which book or books are you currently reading?

'Demon Copperhead' by Barbara Kingsolver.

Which book changed you?

The Enforcement of Morals' by Patrick Devlin was the book that made me want to study Law at uni.

Which music recording would you take with you to a desert island?

Mahler's 4th Symphony.

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

'Where I'm Meant To Be' by Ezra Collective is currently my most-listened to album on Spotify.

Which sport do you play and/or enjoy?

I've recently taken up women's cricket which is fun. I'm pretty rubbish at it though!

What is your all-time favourite film?

'Little Miss Sunshine'. Stellar performances and an excellent portrait of family dynamics.

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

Simon Reeve. He has some amazing stories to tell about his travels.

Which is your favourite restaurant?

Hi Bangkok – our local Thai restaurant. There is invariably someone there we know and we can take our own wine.

If you could save only three things from your burning home, what would they be?

Once I've found and contained our neurotic cat I don't think there would be time to save anything else.

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