Law Lore & Practice

PTMG Pharmaceutical Trade Marks Group

Dec 2025

Editorial: Borders

This December marks the fortieth anniversary of my gap year, during which I visited Japan and Indonesia en route for Australia. Passport, visas, clarinets, friends old and new welcoming me with open arms, and 'the world's mine oyster', so wrote the Bard. I discovered the intrinsic power of the English language but also the pitfalls of being 'Lost in Translation'. A life lesson indeed.

Since then, my personal and professional lives have been spent crossing borders – back and forth to the UK of course, but also multiple US trips, more adventures Down Under and all those PTMG conferences. When Geneva and Brussels dominated my weekly routine, I roamed throughout the Schengen Area, crossing borders without a thought.

However, the history of Europe is littered with wars over the lines on a map, which have altered the course of so many human destinies. Our October conference in Budapest was the catalyst for my discovery of Central Europe's history, where incessant border squabbles drove religious, cultural and political divides that persist to today. The ongoing conflict to the East of our continent underscores the conundrum contained in borders.

The only answer I have ever found was written by Tim Rice in the 1985 musical 'Chess'. The rousing Anthem culminates with 'Let man's petty nations tear themselves apart, My land's only borders lie around my heart'. Thankfully, our PTMG community continues to thrive in a world without borders, seeking only to enhance understanding within our global membership.

Wherever you are, I wish you and your families the very best of the season.

Vanessa

US Update: Don't Go Breaking My Mark

Kathryn Eyster, Tepper & Eyster

The Trademark Trial and Appeal Board (TTAB) recently provided helpful insights for companies seeking to register only the stylized portion of a mark in the United States. In re Verrica Pharmaceuticals Inc. is a non-precedential decision involving a company's attempt to register only the stylized V from its house mark. The Board's refusal to allow the registration of only this part of the mark outlines the test for whether a mark can be registered even if it differs from the mark as actually used.

Verrica Pharmaceuticals sought to register the mark in Classes 5 and 35. To demonstrate its use of the mark, Verrica submitted an image of one of its medication boxes where the house mark appeared on the box in this format for Class 5, and a screen shot of the owner's web-site in this format for Class 35. The Examining Attorney refused registration because Verrica had not shown use of the proposed mark in commerce. Specifically, the Examining Attorney found that the mark as shown on each Specimen of Use was not the same as the mark sought to be registered.

The TTAB affirmed the Examining Attorney's refusal to register, finding that the proposed mark was not a 'substantially exact representation' of the mark as actually used. The Board found that the stylized V was not the complete mark but was instead a mutilation of the full mark, meaning that essential and integral matter was missing from the proposed mark. Further, the Board noted that the V alone did not present a separate and distinct commercial impression or perform a trade mark function apart from its appearance in the full house mark.

The Board conceded that the requirement is only that the mark as filed and the mark as used should be 'substantially' exact, and therefore there is some allowance for minor, inconsequential variations. The Board clarified, however, that the primary consideration is whether the mark sought to be registered functions as a distinct trade mark on its own. A party may choose to register any portion of a composite mark, but it may only do so if that portion performs its own trade mark function. Although Verrica argued that its stylized V stood out with different font, shading, and colour and because of the 3 circles shown above the letter, the Board was not persuaded that it served a trade mark function standing alone.

In rejecting Verrica's argument, the Board provided relevant considerations for whether a portion of a composite mark can serve as a trade mark. First, a mark is unlikely to be regarded as a separable element worthy of trade mark protection where the proposed mark is part of, and integral to, a larger word. This is particularly true where, as here, there is not even a space between the stylized first letter of the house mark and the rest of the word. Parties seeking to register only part of a word should have that letter stand apart from the word, and be able to show that the letter is used standing alone. We all know, for example, a company that owns a registration for the stylized letter M for restaurant services. However, that company has evidence of use of the letter standing alone as a source identifier.

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Words from the Chair

As we reflect on the success of our Autumn Conference in Budapest, I want to extend my heartfelt thanks to everyone who contributed to making it such a memorable event. The energy, collaboration, and insights shared truly showcased the strength of our community.

One of the many standout moments for me was the final presentation delivered by our committee member, Bruce Longbottom. Bruce's contribution over the years to PTMG has been invaluable, and his farewell presentation was a fitting tribute to his remarkable career. We look forward to being able to say farewell to Bruce at a future conference but we wish Bruce all the very best in his retirement and thank him for everything he has done for the PTMG committee.

Looking ahead, we're already planning for our Spring Conference in Munich in 2026. This will be another opportunity to come together, share knowledge and tackle the challenges and opportunities that lie ahead.
As we all embrace using AI in our professional and personal lives, I took the opportunity to ask Copilot to summarise what it thought of 2025. It gave the following response: '2025 stood at a critical crossroads: geopolitical fragmentation, rising authoritarianism, economic stress, and climate emergency coexisted with technological breakthroughs and regulatory catch-up. It was a year where society, institutions, and systems were recalibrated - promping profound change and uncertainty.' I was hoping it might come up with a slightly more cheerful response but I am sure that we have all been touched by elements of this during 2025.

For trade mark practitioners, 2025 was not just about adapting to the external pressures and uncertainty, it was about leveraging AI tools and ensuring that legal advice keeps up with this rapidly evolving environment.

So, as we approach the holiday season after this exhausting year, I hope you all take time to rest, recharge, and enjoy time with friends and family. Thank you for your continued commitment to PTMG.

Wishing you a joyful festive season and a successful year ahead.

Best wishes

Joanne

In memory of Richard Gilbey (1952–2025)

It is with deep sadness that we share the news of the passing of Richard Gilbey on 29 September 2025. Born in Madagascar, Richard made his home in France with his wife Geneviève, where they spent most of their life with their family.

Richard was a highly professional and exceptionally talented intellectual property lawyer, recognised across Europe and beyond for his expertise in trade mark law. Qualified both in the UK and France, Richard was admired for his sharp legal mind, his pragmatic approach, and his unwavering professionalism.

Early in his career, Richard served in senior positions within the French pharmaceutical industry at Synthélabo and then Sanofi. These experiences established him as a trusted adviser to many in the pharmaceutical sector and helped to forge enduring connections with PTMG. It made us proud that our organisation remained close to his heart throughout his life.

Following his time in-house, Richard co-founded in 1992 the Paris-based law firm Gilbey de Haas with Charles de Haas. The firm later became Gilbey Legal in 2007. Richard formally stepped down in 2019, though his professional legacy and friendships continued long after.

Guillaume Marchais, a colleague from the French profession, and PTMG member writes 'I knew Richard since the 90's, we regularly met at conferences in France and abroad and had many discussions and worked together on some files. I admired his subtlety and intelligence but above all he was a very kind and caring person. His law firm was successful, but he always remained modest. And of course, a typically British sense of humour. He passed away with his usual discretion. We will deeply miss him'.

A long-standing and much-loved member of the PTMG community, Richard was a regular attendee at PTMG Conferences. He attended his first one in Harrogate in 1985 and spoke to conference in Paris in 2002. Many regular participants will have fond memories of Richard's warmth, humour, and ever-generous spirit, genuinely interested in others. He had a gift for connecting with people. His passing leaves a bitter sadness among those who were fortunate enough to know him. The Editor Vanessa Parker writes 'our mutual connection ran deep - as Brits living long-term in France, we had much to share. After retirement, Richard went on to teach English to higher education students and without doubt motivated his students with his unique brand of enthusiasm and professionalism'.

I had the privilege of knowing Richard for more than 30 years, and I remember his warmth and generosity vividly. When I told him in 2008 that I was leaving France to move to the UK, he was wonderfully supportive and encouraging. Later, during my time at GSK, he was always keen to help, offering generous and insightful feedback on our new initiatives.

One of my most cherished memories of Richard was at the October 2012 PTMG Conference in Barcelona, the first PTMG Conference I chaired. He was very supportive, and at the close of the event, he took the time to say some kind and touching words to thank me as Chair, a gesture that truly moved me and captured his thoughtful nature.

As Chris McLeod, a PTMG contemporary, put it so nicely: 'I will remember Richard as a constant and very amicable presence at PTMG Conferences. He always made time to speak to other attendees and was an integral part of what makes PTMG such a welcoming organisation. I will also remember him for always taking the opportunity to ensure that, after the Chair had thanked the speakers, organisers and sponsors, the Chair received a round of applause from attendees as each conference drew a close.'

He will be deeply missed.

Sophie Bodet
UnitedLex
Past PTMG Chair

Members News

New Members

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

Steven Lustig from Panitch Schwarze Belisario & Nadel LLP, Philadelphia, USA slustig@panitchlaw.com

Timothy Maier from Maier & Maier, Alexandria, Virginia, USA tjm@maierandmaier.com

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Elyana Faisal from JAH Intellectual Property, Doha, Qatar international@jahcoip.com

Moves and Mergers

Following the rebranding of Leaderboard Branding to Fingerpaint Branding **Daniel Hunt** can now be contacted at dan.hunt@fingerpaint.com

Abida Chaudri has left Norton Rose Fulbright LLP to join Arcacious IP in London, UK. Abida can be contacted at abida@arcacious-ip.com

Emily Sullivan has left Mewburn Ellis LLP to join BASF SE in Limburgerhof, Germany. Emily can be contacted at Emily.sullivan@basf.com

Robert O'Connell has left Orrick, Herrington & Sutcliffe LLP to join Nutter McClennen & Fish LLP in Boston, USA. Robert can now be contacted at roconnell@nutter.com

Lesley Edwards
PTMG Secretary

US Update Continued

Second, the Board noted that Verrica argued that its use of the colours purple and blue made the V stand apart, but that it had not claimed colour in its application. This provides a helpful reminder that applicants should be sure to claim colour if the colour of the mark is consistently used and is part of the mark's distinctiveness.

Finally, the Board compared Verrica's case to other cases where a portion of a mark was allowed registration. Those cases involved a mark that was only followed by model numbers, a house mark, or additional descriptive wording and found that the mark was not 'intricately inter-twined' with the rest of the wording. For example, TINEL-LOCK was allowed registration based on a specimen showing the mark in a catalog as SETRO4AI – TINEL-LOCK-RING # CZ3652-000. In re Raychem Corp., 12 USPQ2d 1399, 1400 (TTAB 1989). Similarly, the Board allowed registration of this school logo despite the fact that the specimen of use showed an additional word on the shirt and an additional letter on the hat . In re Univ. of Miami, 123 USPQ2d 1075, 1079 (TTAB 2017).

As the Board noted, and has noted before, the issue of whether the mark you are seeking to register is a mutilation of a larger mark is essentially a judgment call. Knowing the factors at play helps companies better prepare their filings.

*As a side note, rest assured that Verrica does have some protection for the stylized V because it has registered.

VERRICA

Slim claims: How GLP-1 marketing is testing the boundaries of the Lanham Act

Michele S. Katz, Advitam IP, LLC

Over the past couple of years, Americans in particular have watched the GLP-1 drug boom take over not only the pharmaceutical market, but the general consumer market as well. Brands like OZEMPIC, WEGOVY, and MOUNJARO have landed their name in any conversation about weight loss, even if these particular brands did not intend to do so. The demand for GLP-1 drugs has far outpaced the supply available, which has created opportunities for telehealth startups, compounders, and wellness brands to capitalize on consumer fascination. Amid this rush, the truth in advertising has begun to stretch to its limits, especially since the commercial speech around weight-loss drugs borrows credibility from well-known brand names or FDA-approved drugs. As marketing around GLP-1s has skyrocketed, practitioners are turning to the Lanham Act's false advertising and false association provisions, forcing courts and regulators to adapt old doctrines to new digital behaviors.

Section 43(a) of the Lanham Act prohibits false or misleading representations in commercial advertising that misrepresent the nature, characteristics, qualities, or origin of goods or services. Traditionally, Section 43(a) disputes have taken the stage when competitors sue over product performance or claims. Recently, companies have used the Lanham Act because GLP-1 advertising is so tied into regulatory categories, such as pharmaceuticals, compounded drugs, and wellness services. Here, the traditional FDA policing does not fully reach these marketing efforts. For example, Novo Nordisk, the pharmaceutical company responsible for manufacturing OZEMPIC and WEGOVY, filed numerous lawsuits since 2023, specifically targeting medical spas and clinics based on the Lanham Act.

What has been seen to cross the line of the Lanham Act when it comes to GLP-1 advertising are statements like 'Same as Ozempic®' or 'FDA-Approved Equivalent'. These marketing terms have been most commonly seen in compounding pharmacies and telehealth ads. This type of advertising misleads consumers into believing compounded semaglutide (often salt forms) are identical to well-known GLP-1 weight loss drugs. This type of advertising directly violates the Lanham Act by falsely implying equivalence and approval status. Further, marketing terms like 'clinically proven weight loss without the prescription' may constitute false or unsubstantiated claims under the Lanham Act because it extends clinical results from approved GLP-1 drugs to unapproved, compounded, or supplement versions.

The Lanham Act plays a unique role in the landscape of regulatory actions. The FDA oversees labeling and promotion for approved drugs. The FTC polices advertising claims for over-the-counter and health related services. The Lanham Act fills the enforcement gap when competitors, not agencies, are harmed by misleading marketing. Competitors, however, have started to run into unique issues when using the Lanham Act to enforce their intellectual property against compounders or telehealth rivals. It is sometimes difficult to prove commercial advertising or promotion in the new influencer-driven environment where speech is semi-commercial and not as easy to decipher as traditional marketing and advertising speech. Further, it is difficult to establish consumer deception since many consumers are reaching these drugs through algorithmic ad placements. Lastly, it is challenging to balance private enforcement under the Lanham Act while pursuing claims under FDA/FTC regulations because this may result in preemption.

The marketing around GLP-1 drugs has created a turning point for how truth in advertising is defined in a digital, consumer-driven healthcare market. Many consumers are turning to influencers, celebrities, and Instagram posts to learn about drugs that were traditionally marketed under the guise of the FTC. The Lanham Act, a statute meant to protect competition, has now become a tool for consumers to put their trust in the right brand. As the line blurs between FDA-approved drugs and commercial wellness supplements, false advertising enforcement will determine not only who wins the market, but who keeps credibility among consumers.

PTMG 106th Conference – October 8-11, 2025 - Crossing Branding Hurdles by the Chain Bridge Budapest, Hungary

Cynthia Johnson Walden, Fish & Richardson P.C.

The 106th Annual PTMG Meeting was held this year from October 8-11 at the Intercontinental in the stunningly beautiful capital city of Hungary with a front-row view of the majestic Chain Bridge, which was constructed in 1849 to form a vital link between the Buda and Pest sides of Budapest. Attendees were treated to glimpses of this beautiful and icon bridge almost at every turn – from the hotel lobby, breakfast and lunch room, reception areas and, for some lucky ones, right from their rooms. Symbolically and visually the Chain Bridge was an excellent backdrop for a conference where many of the speakers spoke of the evolution of pharmaceutical trade marks, the pharmaceutical marketplace and the changes to trade mark and regulatory issues over time.

There were 420 attendees from 60 countries who were welcomed to the city on a gorgeous day with blue sky and sunshine sparkling on the Danube. While the warmer temperatures and sunshine unfortunately did not last throughout the entire conference, it certainly was an auspicious start for an excellent conference. Covering everything from the invention of Vitamin C, to a journey through FondueLand with the real Oliver Watson, to a fascinating overview of the history of the Egis Pharmaceuticals and Roche trade marks, the challenges of navigating new developments in pharmaceutical regulation in the EU and US, a multi-jurisdictional perspective on comparative advertising, to AI and the 'skinny' on trade mark issues for obesity drugs, the 106th Annual PTMG Meeting was filled with engaging speakers, interesting topics and was quite possibly the best one yet!

The conference commenced on Wednesday evening with a Welcome Reception in the Intercontinental Ballroom, which was filled with smiling faces and lively conversations amongst old friends and new acquaintances alike. Many attendees then moved on in smaller groups to explore and enjoy the delicious food and lively nightlife in the city.

On Thursday morning, the Conference Chairperson, Joanne Green, set the stage for an engaging conference with her warm and welcoming Opening Remarks.

Starting with a solemn note, Jo paid tribute to Richard Gilbey, a well-known and beloved member of PTMG who passed away recently. Richard's long-standing involvement in PTMG and his many contributions over the years will always be remembered.

Kicking things off in style with a twinkle in her eye, Orsolya Szentesi, Head of the Trademark Department of local Hungarian pharmaceutical company Egis Pharmaceutical, got the conference going with a fun pop quiz to teach attendees some fun facts about Hungary. As it turns out, we have Hungarians to thank not only for inventing goulash and perfecting the modern day thermal spa, but also for inventing the ballpoint pen, Vitamin C and needle-free high-pressure automatic injection devices (e.g., for insulin). And of course the Rubik ®'s cube is one of Hungary's most well-known inventions, a patent which issued to Ernesto Rubik in 1975. Orsolya also challenged non-native speakers to learn the Hungarian term for pharmaceutical trade mark: gyógyszervédjegy. With our interest piqued, Orsolya then gave an excellent presentation on the pharmaceutical and IP landscape in Hungary, starting with the interesting history and evolution of her company which dates back to Gedeon Richter and Eagle Pharmacy in 1901. Always a top filer and brand owner amongst Hungarian pharmaceutical companies, the current Egis trade mark portfolio includes a whopping 18,518 registered marks. Orsolya explained that the large number of filings directly relates in part to the unique challenges to clearing and registering pharmaceutical trade marks in Hungary in view of the EU decentralized procedure (DCP) and the fact that there is no uniform assessment and the need for harmonizing reform. Keeping true to the conference theme, Orsolya then talked about how the modern-day in-house trade mark pharmaceutical lawyer is not 'just a lawyer' and must bridge the gap between effectively navigating trade mark and regulatory issues, being an IP ambassador and strategic business partner and brand steward with the business.

Orsolya Szentesi

Picking up on the theme of pharmaceutical reform, Stefano Marino, currently Senior Consultant to DLA Piper and prior to that having played the important role of representing the European Medicines Agency (EMA) on notable cases related to EU pharmaceutical law, gave an interesting and thorough overview of the current status of the key issues and on-going debate regarding EU pharmaceutical law reform. Stefano recapped the Commission's 2023 Proposed Reform, providing detail on the 6 key political objectives of the proposed legislation aimed to achieve these goals. After providing some interesting insight on the issues and politics at play, Stefano reported that Pharma Law Reform is expected in 2026 and is anticipated to involve a high level of administrative discretion and increased risk of judicial challenges. Before concluding Stefano also called out another legislative development: Amendment 188 of Article 67(7)(a), that poses specific risk to trade mark owners on the issue of repackaging parallel imports. This amendment, which was proposed by the Danes and approved by the European Parliament, 'could wipe out 30 years of case law' on repackaging of parallel imports as it provides that medicinal products imported or distributed in parallel shall be repackaged in new outer packaging, raising concerns about preserving the integrity of the originator's trade mark, altering safety features and reducing the possibility of identifying falsified medicines. Amendment 188 has yet to be endorsed by the Council, and per Stefano it is hard to see how this amendment aligns with the purpose of EU Pharma Law which should be to benefit patients.

Stefano Marino

Conference Report: continued

No legal conference these days would be complete without discussion of the newest and most challenging issue we all face - AI and how it is creating hurdles and uncharted territory for brand owners to navigate. Bravely taking up this topic in the Founder's Lecture, Nora Takacs, Copyright Specialist at Sanofi, gave a very interesting and informative presentation entitled 'AI Dilemma in the Healthcare Industry: Creation, Control and Compliance'. Nora's presentation provided a thorough overview of the questions created on copyright issues on the input and the output side when using generative AI. On the input side, Nora set the stage with reference to the Draft Generative AI Copyright Disclosure Act in the US and the recent USD $1.5B Anthropic settlement in the US. She then discussed the EU AI Act as well a pending Hungarian CJEU case in which a preliminary decision is expected in 2026/27. On the output side, Nora highlighted the standard requirements of originality and human authorship – and how cases in recent years have tested the boundaries of these core tenets. From the famous Monkey Selfie photo, to the first AI-generated portrait (The Portrait of Edmond de Belamy, created in 2018) to an image of a piece of American Cheese, she talked about the importance of human authorship and how the cases thus far have treated this issue by focusing on the number of prompts evidencing human contribution. Nora then provided some practical recommendations for compliant use of AI in connection with pharmaceutical advertising including

Nora Takacs and Jo Green
Founder's Presentation

strategies and best practices for avoiding copyright infringement by conducting clearance, being careful of the prompts used and the importance of using disclaimers regarding AI-generated images of patients.

While everyone's interest was piqued on how to think creatively about addressing branding challenges, Jeremy Blum of Bristows took the stage for a very engaging presentation entitled 'David v Goliath: PR considerations for both sides when taking legal action' in which he emphasized the need to consider all angles when navigating brand enforcement in the courts and marketplace of public opinion. Jeremy underscored the reality that public perception is not always based on fact and even if you have the upper hand as a legal matter, you must understand the critical importance of what your brand stands for and take actions that are consistent with this underlying philosophy. This is particularly true when you have a David v Goliath situation where there are perils to be avoided for Goliath if the action you take is not aligned with your underlying brand philosophy, and there are victories to be seized if you are David by tapping into the marketplace of public opinion to spin a legal challenge into a marketplace success if you approach the issues creatively. It seems not being afraid to take a more creative approach to demand letters (e.g., the Jack Daniel's nicest demand letter ever sent) and embracing humor and tapping into the powerful court of public opinion for a marketplace win with creative marketing (e.g., the Oatly v Glebe Farms case in which a cheeky advertising campaign embracing the role as David and growing market share with things like a billboard that said 'Oatly sued us. We won. Now help us pay off our lawyers.') can be elements of an overall winning strategy whichever side you are on. Jeremy's charismatic presentation included numerous gems of advice for seizing victory out of the jaws of defeat and vice versa, including 'don't justify based on facts, the public doesn't care' and 'let the public be outraged for you' as elements of the recipe for success in strategically bridging the gap between legal challenges and marketplace realities.

Jeremy Blum

After enjoying a delicious lunch with hotel restaurant views of the Danube, Buda Castle and Fisherman's Bastion, the conference turned to the big topic of the current status of US law and politics as they relate to the pharmaceutical industry. I think all would agree that David Bernstein, of Debevoise & Plimpton, struck the perfect tone with his overview of 'US Regulatory, Political and Case Law Developments'. His presentation was a master class on how to eloquently talk about difficult and politically charged issues in a straightforward way that focused on the facts, called a spade a spade but kept the focus on the reality of where things are and what may be to come. David walked attendees through US regulatory and political developments, noting the current US administration's efforts to try to get pharmaceutical companies to reduce their pricing, including sending letters sent to 17 pharma companies last July demanding most-favored nation pricing for Medicare patients through insurance models and direct-to-consumer pricing via Trump RX and talking about banning direct to consumer advertising in the US. David noted that while much of what the president is doing is plainly unlawful, it will take the courts too long to catch up with legal challenges that may be brought and it leaves pharmaceutical companies in the very challenging position of needing to pragmatically navigate these branding challenges. After touching on the issue of tariffs and domestic manufacturing, David then touched on the current status of affairs at the US Food & Drug Administration (FDA), noting the substantial cuts to staffing and budget and how this will likely lead to delays, and the interest in accelerating the approval process for rare diseases as a means to encourage companies to invest in the US. He also acknowledged the upheaval at the Center for Disease Control and Prevention (CDC) and the unusual choice of someone vocally opposed to vaccines being appointed as the US Secretary of Health and Human Services (HHS). The USPTO's return to the office requirement (including for examiners, some of whom have worked remotely for decades) will likely lead to a slow-down in the examination of applications but the USPTO is 'self-funded' which largely immunizes it from the impact of the administration's cost-cutting measures. Wrapping things up with an overview of the recent case Novartis brought for trade mark infringement of the ENTRESTO product against Novadoz and MSN Pharmaceuticals / Laboratories who was selling product with the same shape, size and color pills, David called out some practice pointers on how to best position your case holistically (e.g., focus on the fact it was a combination of 3 tablets in specific shapes and colors and noting many generic heart medicines are not shaped or packaged in a similar way) and the impact of persuasive expert reports.

David Bernstein

Conference Report: continued

Pivoting to another difficult hurdle challenge brand owners regularly face these days, Nemanja Miliĉević of MSA IP in Serbia, presented on 'How to Maximize Use of UDRP in Online Enforcement'. Nemanja talked about the high-stakes issues at play for pharmaceutical brand owners in the world of online brand protection, which include brand misuse and tarnishment but also include serious risks to patient safety and public health. Noting that health crises (such as the Covid-19 pandemic, where INTERPOL measured a 569% growth of malicious registrations, including malware and phishing) and medical breakthroughs alike will result in an uptick of activity from bad actors who are trying to capitalize on the moment, it is more important than ever to closely monitor and take strategic action to address domain name infringement issues. Both UDRP and URS actions can be cost-effective and time-efficient tools in addressing bad faith domain name registration. Nemanja noted that over 80 countries have adopted UDRP or similar procedures and the vast majority of cases result in transfer. The data-unmasking that filing a UDRP action affords can be a valuable tool, and filing complaints against multiple domain names in the same action, if under common control, can be an effective strategic approach. While it can often feel like a never-ending game of whack-a-mole, the serious risks created by bad faith domain name registrations by bad actors makes it imperative that the pharma industry remain vigilant in this area.

Nemanja Miliĉević

Wrapping up an engaging day of thought-provoking presentations about branding hurdles faced by pharmaceutical companies, Oliver Watson of the Novartis Legal Brand Protection team gave an interesting presentation on 'The IP Aspects of Exiting a Country'. While many practitioners have a general awareness that there are logistics to be handled when brands change hands, most are not in the weeds on wrangling the many issues that ensure the process runs smoothly and the impact on the brand is minimized. Oliver cleverly framed his presentation through the hypothetical of a company that has divested a brand in 'Fondueland' and walked us through the myriad of issues and concerns involved. These include the confidentiality surrounding these deals (including within the company who is divesting the brand), that patients are still receiving its pharmaceuticals under that brand in the country, the black-out period to allow for changeover of IT and regulatory software, the need to review exiting licenses to ensure there are no restrictions, and considerations on whether to license the new owner the use of the mark or to require a rebrand, and anti-diversion / anti-export issues. Whether to allow use of marks that incorporate or reference the company name and / or brand colours is another important issue to consider, one that Oliver analogized to a funny story about the numerous other people who have his same name (Oliver Watson) – noting that the distinctiveness ship has long-sailed for Oliver Watson.

Oliver Watson

After enjoying a tea break, the group met in the hotel lobby for a short walk down to the river to embark on a river boat for an unforgettable evening of cruising the Danube while enjoying drinks and dinner with fellow attendees surrounded on all sides by the spectacular views of Budapest at night, with the Parliament building, Chain bridge, Buda Castle and other gorgeous buildings lit up in all their glory. With a full moon making an appearance in the sky, it was magical - it is difficult to image a more picturesque way to spend the evening and enjoy our host city.

Friday morning, Conference Chair Jo Green warmly welcomed everyone back for another day filled with interesting presentations. The first session of the day was a very interesting, multi-jurisdictional discussion of 'Comparative Advertising in the Healthcare Sector' presented by Sarah Bailey (Simmons & Simmons, France), Paul Llewellyn (Arnold & Porter, US), and Lucy Rana (S.S. Rana & Co., India). Sarah started off with an overview of the legal framework for misleading and comparative advertising in the EU and UK, starting with the regulation on comparative advertising (EU Directive 2006/114/EC). She also referenced the Community Code on Medicinal Products (EU Directive 2001/83/ED) and the similar regulations under the UK Human Medicines Regulations 2012, which require that advertisements have a tone to encourage rational use of medicines, must not be misleading, must be consistent with the essential elements of the medicinal products, and which prohibit comparative advertising claims to the general public. Sarah identified EU member countries that have barriers to comparative advertising (France, Italy, Spain, Germany, Ireland) and those where comparative advertising is more prevalent (UK, Netherlands, Sweden, Denmark). Paul Llewellyn started by noting the US does permit direct to consumer advertising of pharmaceutical products in the US, and explained there are a number of regulatory bodies and related regulations in the US that govern pharmaceutical advertising, including: the Food & Drug Administration (FDA) which prohibits distribution of misbranded products and requires clinical studies to support efficacy claims; the

Sarah Bailey

Paul Llewellyn

Lucy Rana

Conference Report: continued

Federal Trade Commission (FTC) which requires advertising be truthful and non-misleading and requires substantiation for comparative claims; and Section 43(a) of the Lanham Act which prohibits false or misleading statements in advertising. He noted the big challenges are often proving if an advertisement is impliedly misleading, and that the US permits nominative fair use. Lucy then added the perspective from India, where there are a number of regulations related to comparative advertising of pharmaceutical products including the Drugs and Cosmetics Act of 1940, Consumer Protection Act, Food Safety Standards Act, Trademark Act, and the Freedom of Speech Act. She highlighted that there is also a recognition by the Ministry of traditional medicine systems (ayurveda, yoga and naturopathy, unani, siddha, homeopathy (AYUSH)) which adds an additional layer of complexity to comparative advertising issues in India. The panelists then talked about cases arising in their jurisdictions and discussed whether or how they might have been treated differently in the other jurisdictions. This panel provided an excellent perspective on the challenging hurdles faced by brand owners with global businesses when outcomes can vary depending on the nature of the claims and the jurisdictions involved.

Next up was the perennial favorite session, the International Case Round Up, presented by Philip Barengolts of Pattishall McAuliffe. Philip took us on a whirlwind tour of interesting and notable cases from around the world, including a couple of recent notable Federal Circuit cases involving colour for medical products in the US, cases from the EU and UK involving bad faith issues related to the filing and coverage of trade mark applications, cases from Germany dealing with the issue of first sales and parallel imports, and some cases from a number of Asian countries including a case involving 3D marks and Godzilla in Japan.

Philip Barengolts

A highlight of the conference was a captivating and enthusiastic presentation by Tapio Blanc of Hoffman La Roche on 'The Unshakeable House Mark.' With a signature walk-on song and characteristic flair, Tapio entertained and engaged attendees with a presentation filled with historical detail and interesting anecdotes, and I am sure all would agree that his thorough and thoughtful discussion of the evolution of the house mark did its title justice in every way. He impressively covered everything from the very interesting history of the 19th century origins of his company's house mark, the evolution of pharmaceutical branding and the interplay of house marks and brand names over the years, the critical importance of prioritizing defense of house marks, all the way through to future considerations and the unique issues in the digital marketplace. Included in his presentation was an interesting discussion of three different approaches to pharmaceutical branding: the use of the house mark in combination with a product mark; product marks that incorporate a portion of the house mark; and standalone product name marks that do not include any reference to the house mark. One example Tapio used to underscore the paramount importance of the unshakeable house mark was the example of how the global marketplace came to refer to Covid-19 vaccines, noting that the public simply referred to these products by the name of the company that manufactured the vaccines (Pfizer, Moderna, AstraZeneca) and not the specific product names. The challenge of vigorously protecting and preserving the strength of house marks is one that we all embrace and Tapio did an excellent job of reinforcing why we do so.

Tapio Blanc

An additional IP right that can be leveraged by brand owners are registered designs in the EU and Mali Rickards, Senior Counsel at Haleon, next gave an interesting presentation on protection of designs in the EU in light of the EU Design Regulation that came into effect earlier this year and is binding on all member states from the date of filing. Mali provided an overview of the regulation and changes, noting design protection can provide a valuable tool for protection and enforcement of rights where trade mark and patent may not. Registration is relatively cheap to obtain, protection lasts for 20 years from filing, and can cover the appearance of a product in whole or in part. There is no requirement to put a design to use, multiple variations can be filed for as being developed and then you can cherry-pick from them for enforcement purposes. Registered designs can also be registered with EU Customs and used as a tool to fight against counterfeits. Picking up on the theme of addressing new challenges and hurdles for brand owners, Mali noted the issues related to AI creating designs (citing the example of Cartelli chairs design by AI) and also emphasized that design registration prohibits use of the design whether embodied in a physical form, a graphical user interfaces or digital format and it gives the owner the exclusive right to create, download, store and distribute any means of manufacture by means of downloading, copyright or sharing of software which records that design. Design registration in the EU is a valuable tool to keep in mind when building a stable of rights to best address brand challenges.

Mali Rickards,

The naming of biosimilars is another area with unique branding challenges, and Larry Rickles of Moore & Van Allen (previously Chief Trademark Counsel at Teva and Johnson & Johnson) was the perfect person to address these issues given his perspective with extensive experience on both sides of this issue. Capturing the attention of attendees with his walk-on song 'Don't Stand so Close to Me' by the Police, which he aptly renamed 'Don't Name so Close to Me', Larry framed the issues with a helpful explanation of the differences between generics, biologics and biosimilars, and the requirements for naming requirements for biosimilars. Larry noted the FDA determined that in addition to different 4-letter suffixes and

Larry Rickles

Conference Report: continued

the generic name, proprietary names are required so healthcare providers can identify them, which helps with reporting of adverse events (but noting that FMA and Health Canada do not require suffixes). Larry walked through some interesting examples of the three different options for naming biosimilars: 1) adopting independent fanciful names; 2) adopting names that play off the INN or drug indications; and 3) adopting names that evoke the brand name. On this third approach, the big issue being how close you can get and there is no uniform standard for deciding this issue. Larry highlighted the concerns about medication errors, but also noted the counter-arguments that patient harm is unlikely in this situation given the biosimilar is intended to treat the same condition as the brand name product, and he also posited the argument that if the brand name encodes the INN or indication, why can't the biosimilar do the same thing?

Bruce Longbottom

The last presentation of the conference was given by esteemed and long-standing PTMG member Bruce Longbottom, in-house trade mark counsel at Eli Lilly, whose thoughtful and engaging presentations have enriched many PTMG meetings over the years. Bruce's presentation entitled 'Get the Skinny on Trade mark Issues for Obesity Drugs' was memorable for many reasons, not the least of which are that it was announced he is retiring at the end of the year, the adorable photos of his grandchildren and his enticing photos of delicious though perhaps not so healthy food. Bruce did an excellent job of walking everyone through the very hot topic of weight loss drugs, starting with an explanation of how obesity is a disease that impacts over 890 million adults and 160 million children globally, and that it is also linked to other health complications including diabetes, high blood pressure, high cholesterol, increased osteoarthritis, and mental health issues (including possibly Alzheimer's). He explained how GLP-1 weight loss drugs (Glucagon-like peptide 1 agonists) work and noted that these drugs are some of the top-selling pharmaceuticals globally in 2025. It is no surprise that the huge global demand for these drugs has given rise to a number of brand owner challenges, including the big issue of combatting 'compounding'. For those not familiar with this term, Bruce explained that compounding is the process of preparing of personalized medications (by combining, mixing, or altering ingredients) to meet the needs of an individual patient when there is no commercialized medicine to treat a specific patient's needs. Eli Lilly and Novo Nordisk are both actively pursuing cases against weight-loss drug compounders in an effort to combat this issue. The other big challenge is the use / mis-use of trade marks in media and popular culture. There is no end to the number and nature of Internet scams for weight loss drugs, but one of the straightforward things that Eli Lilly has done to try to combat this issue was to publish an Open Letter about compounding and emphasizing their founder Colonel Eli Lilly's statement when he affixed his signature as the logo for their medicines, which was: 'If it bears a red Lilly, it is right.' Lilly has also engaged in a public awareness campaign, advising the public that they never sell their weight loss drugs MOUNJARO or ZEPOUND on social medial or via illegal online pharmacies, that they can scan barcodes to check the validity of serial numbers – and highlighting that these are not cosmetic medicines or intended for cosmetic purposes only. Bruce's presentation was the perfect way to round out two full days of great content and dynamic presentations.

Jo Green

To conclude, Jo Green made some final comments and provided directions for attendees to walk the short distance to the Gala Dinner that night, which was held at the impressive Vigado of Pest venue. I think we would all agree that Jo truly did an impeccable job from start to finish keeping us on schedule, informed and excited for the next speaker with a twinkle in her eye and a gracious manner and it was a truly memorable conference all around.

In keeping with PTMG tradition, the final event was a Gala Dinner, bringing us all together to celebrate a successful conference and enjoy an evening of drinks, dinner and dancing in a beautiful concert hall, complete with a grand central staircase lined with a crimson carpet and lit with beautiful chandeliers that set an elegant tone and showcased attendees as they arrived in their formal attire. The Gala Dinner provided a final opportunity to enjoy some delicious Hungarian food and wine, music and dancing and to connect with fellow attendees - friends both new and old. The clues about the location of the 2026 annual meeting left virtually everyone dumbfounded, but there was an enthusiastic reaction when it was finally revealed that the location of the next Autumn conference will be Muscat, Oman. It will be hard to beat the 2025 Conference in Budapest, but I suspect the choice of the new and exotic location for the Autumn meeting in Oman has piqued everyone's interest and will set the stage for exciting things to come in October 2026.

When in Budapest PTMG was happy to support the local charity Burattino Children's Home and School by donating excess food from our social events and stationery from our kind sponsors.

PTMG Audio article on LinkedIn :

Listen to Vanessa Parker, Editor LL&P and Kathryn Eyster, Tepper & Eyster, PLLC discuss personalised medicine during the PTMG conference in Budapest. Kathryn shares her US perspective on treatments, the impact on FDA practice and what this means for trade mark practitioners.

https://www.linkedin.com/feed/update/urn:li:activity:7387519329212452864/

Long-running Merck dispute culminates in GBP £5.67m damages award

Ben Buray and Gill Dennis, Pinsent Masons LLP, London

The long-running trade mark litigation between German-headquartered Merck KGaA (Merck) and US-headquartered Merck Sharp & Dohme LLC (MSD) recently concluded with a High Court judgment assessing the damages payable by MSD for its infringement of Merck's trade mark rights in the UK. Damages inquiries for trade mark infringement by the English courts are rare. In this judgment, the court considered whether trade mark damages can be treated in the same way as other intellectual property rights and what appropriate valuation methods could be utilised to assess the quantum for those trade mark infringements.

Background

The dispute centred on coexistence arrangements between two major global pharmaceutical companies, Merck and MSD. Merck has exclusive rights to use the MERCK mark globally, except in North America. MSD only has exclusive rights to use the MERCK mark in North America and uses the name MSD in other markets. Formal coexistence arrangements were established between Merck and MSD in 1955 and later renewed in 1970.
There is a long and complex procedural history. Despite proceedings having been commenced in 2013, the High Court judgment finding that MSD had infringed Merck's United Kingdom trade mark rights and breached the 1970 coexistence agreement was not delivered until 2020. MSD was held to have carried out various acts amounting to direct use of MERCK in the UK. This included US-branded merck.com webpages being accessible in the UK, webpages using MERCK rather than MSD name and logo, UK consumers being directed to contact MSD personnel with @merck.com email addresses and MSD staff corresponding with UK consumers by reference to 'Merck products'. There were also further acts which breached the 1970 coexistence agreement.

Key issues for the court

The court's damages inquiry focused on three key questions:

- Whether 'licence fee damages' were appropriate for trade mark cases;
- If so, whether there was a basis for Merck to rely on a 'comparables analysis' to value the damages that should be payable by MSD; and
- Alternatively, whether the damages assessment should be based on the 'economic benefits' obtained by MSD in using the trade mark.

Licence fee damages assessment

Licence fee damages (also known as 'negotiating damages') is a well-established approach to damages assessment for intellectual property infringements where there is no normal rate of profit or established licence royalty. However, it has been rarely considered in trade mark infringement cases. Most damages inquiries have been in patent or copyright infringement cases.

The assessment has the 'user principle' at its core: a hypothetical negotiation between a willing licensor and licensee to determine a notional licence fee for the level of damages. MSD contended that licence fee damages were inappropriate in the circumstances because Merck would never have realistically licensed its umbrella MERCK brand to a direct competitor. MSD also argued that, while the user principle was appropriate for patent infringement (essentially paying for the use of the invention), the same could not be said for trade mark cases, particularly where the mark concerned was not a mark 'available for hire'.

The Court rejected MSD's arguments and confirmed that trade marks are 'quintessential commercial property rights, for which a licence presents no inherent difficulty'. No distinction should be made around the availability of negotiating damages between the different intellectual property rights.

A comparables analysis

In a comparables analysis, valuation experts typically utilise comparable royalty rates in similar licences in the relevant market. In Merck's best-case scenario, it claimed damages of GDP £50.5 million. This was calculated using a 0.33% royalty rate from a 'comparable' intragroup brand licence as there were otherwise no direct comparables in the pharmaceuticals industry for umbrella corporate brand licences. The court was unwilling to accept brand licences in other sectors (including licences of consumer brands VIRGIN and easyGroup) as adequately comparable. The court was also unwilling to accept the intragroup brand licence as a reliable comparator, finding that there was insufficient reliability in the data underpinning the royalty rate of 0.33% to provide any 'meaningful assessment' for damages.
As Merck was not able to identify any reliable comparables for the licence fee damages assessment, the court had to consider the alternative 'economic benefits' approach.

The 'economic benefits' approach

The 'economic benefits' approach measures the infringing party's quantifiable benefits (the 'ceiling price') and balances that against the incremental loss of the rights holder from the notional licence (the 'floor price'). The assessment then considers the commercial context and bargaining position of the parties to identify the appropriate 'notional licence fee' between the ceiling price and the floor price. There was consensus between Merck and MSD that the notional licence fee should be set at the ceiling price.
It was therefore only necessary for the court to consider which benefits obtained by MSD were quantifiable for damages purposes. The court held that these included:

- Avoided website costs of approximately GDP £4.33 million: the benefit obtained by MSD from not having implemented geo-blocking measures for its North American web site or maintained mirrored MSD-branded pages of their website for the global market;
- Avoided social media costs of approximately GDP £780,000 on a similar basis as the avoided website costs; and
- Avoided marketing costs of approximately GDP £566,000. Despite this being an 'uncertain' exercise, evidence from Merck of a 2013 rebranding project provided a proxy to value MSD's avoided marketing costs.

Other potential benefits were discounted, such as avoided email migration costs, as those would be incurred by MSD in any event once the notional licence had expired.

On the economic benefits analysis, Merck was awarded GDP £5.67 million in damages prior to adjustments for inflation and discounting measures.

Significance of the decision

This case provides helpful clarification that a 'licence fee damages' assessment is appropriate for trade mark infringement cases, including in the pharmaceutical sector. However, brand owners should be ready and willing to adopt an economic benefits analysis when exploring brand value unless reliable licence fee comparables exist.

International Update

ALBANIA

CWB

Albania has recently adopted a new trade mark law and a new law on patents, utility models and supplementary protection certificates (SPCs), both of which entered into force on 16 August 2025.

While the new laws repeal previous regulations within the 2008 industrial property law, all procedures initiated prior to the entry into force of the new laws will be regulated by Law No. 9947 'On Industrial Property', which still remains in force for industrial designs, geographical indications, and designations of origin.

Trade mark law

The new law aligns with Regulation (EU) 2017/1001, Directive (EU) 2015/2436 and Directive 2004/48/EC, which marks a major step forward in Albania's EU integration process. Key updates include:

Substantive trade mark law changes

- The law prohibits the registration of traditional wine terms, names of protected plant varieties, and guaranteed traditional specialties.
- A trade mark registered by a representative or agent without the owner's consent will be assigned to the owner.
- Trade mark ownership can be assigned based on a merger, a court decision or inheritance.
- Only sub-licenses explicitly included in the master license agreement are recognised.
- The withdrawal of a registered trade mark for which a license has been recorded is not permitted without the licensee's written consent.
- An exclusive license grants the licensee the right to initiate legal actions under certain conditions.
- Parallel import is prohibited, allowing trade mark owners to initiate administrative procedures directly with Albanian Customs or the Internal Market Inspectorate. However, if the importer objects, the case is brought to court.

Procedural reforms

- The deadline to respond to formal office actions has been shortened from three to two months.
- The deadline to file an appeal with the IPO's Board of Appeal has been extended to 45 days.
- The deadline to respond to provisional refusals based on an opposition has been extended to four months.
- In opposition and invalidation proceedings, the opposed party may request proof of use of the earlier trade mark(s), provided that they have been registered for at least five years prior to the action. Failure to submit such proof results in rejection of the opposition or invalidation.
- Opposition proceedings may be suspended for up to 12 months upon joint request by the parties to reach an amicable resolution.
- Trade mark renewals can now be filed up to 12 months in advance, instead of six.
- Confidential information is now formally regulated in proceedings before the Albanian IPO.

International registrations

- International registrations designating Albania will undergo a formal examination of the specified goods and services.
- For international registrations designating Albania, owners of collective or certification marks must submit the corresponding regulations to the Albanian IPO in order for the registration to be effective.
- The revised legislation enables the replacement of national registrations with international registrations.

The Council of Ministers is expected to approve the relevant bylaws and regulations for the complete implementation of the new laws within nine months from their entry into force.

BULGARIA

CWB

In two recent decisions, the Bulgarian Supreme Administrative Court ruled to invalidate trade mark registrations for СИНЯ ЗОНА (BLUE ZONE) and ЧЕРВЕНА ЗОНА (RED ZONE), citing public policy and deceptiveness.

The Bulgarian Supreme Administrative Court ordered the invalidation of two trade mark registrations, overturning the lower instance decisions which had upheld the trade mark registrations for СИНЯ ЗОНА (BLUE ZONE) and ЧЕРВЕНА ЗОНА (RED ZONE), both stylised and registered by BASSMANIYA-1 EOOD for goods and services including clothing, transport, and hospitality (Nice Classes 25, 39, and 43).

The judgments were in cases No. 853/25 and No. 200/25 and were delivered on 3 July 2025.

The Supreme Court upheld the position of Sofia's municipal parking authority - Urban Mobility Center - which, joined by other public entities during the administrative phase, argued that the terms are integral to the regulatory framework governing municipal parking and should not be subject to private trade mark monopolisation. The Court based its decision on provisions prohibiting trade marks contrary to public policy and trade marks that are deceptive.

In Bulgaria and other European countries, colour-coded zones denote municipal parking regimes. But does mere overlap with such terms justify barring trade mark registration? While certain regulatory terms should indeed remain free in the public interest, the rationale behind that is far less convincing when parking-related terms are applied to goods and services like clothing and hospitality. It is difficult to see how granting exclusive rights in such unrelated product categories would undermine public order.

The same applies regarding deceptiveness: It is hard to believe that someone buying a jacket labeled RED ZONE or staying in a hotel named BLUE ZONE would think they are engaging with a municipal parking authority.

That said, what makes the unfolding of this series of cases particularly puzzling is that it seems driven by a reasonable concern about monopolising parking-related terms, but then fails to stop there. The earlier finding of descriptiveness and lack of distinctiveness by the Bulgarian Patent Office regarding 'rental of parking spaces' in Class 39 had already redressed that concern and struck a balance between private rights and the public domain - although one could reasonably argue that transport-related services in Class 39 should also have fallen under these objections. Resorting to public policy and deceptiveness, therefore, appears so unwarranted here, so excessive, that the cancellation regarding the broader goods and services, like clothing and hospitality, feels more like collateral damage than sound judgment.

As a result, a legal stretch like this may have put an end to trade marks like BLUE and RED ZONEs altogether, but it has also left a whole new gray zone in Bulgarian trade mark case law.

ETHIOPIA

Lena Karaminassian, Saba IP

Ethiopia has deposited its instrument of accession to the Paris Convention for the Protection of Industrial Property, with the agreement entering into force on 15 August 2025.

The Paris Convention provides protection across patents, trade marks, industrial designs, utility models, service marks, trade names, geographical indications, and addresses unfair competition.

This step reflects Ethiopia's ongoing efforts to modernize its IP regime and bring it in line with international practice. It also underscores the government's aim to encourage innovation and attract investment through a more transparent and harmonized IP system.

Continued on next page

International Update continued

LEBANON

Amal Abdallah, Saba IP

The Lebanese Trademarks Office has introduced an important simplification to its assignment procedure. Trade mark owners are no longer required to submit the original registration certificate when recording a transfer of ownership.

Under the new practice, a Power of Attorney and a Deed of Assignment will be sufficient for the Registrar to issue the confirmation of assignment.

This change reduces administrative formalities and facilitates a faster, more efficient process for trademark holders in Lebanon.

NEPAL

Denise Mirandah and Lin Lixa, mirandah Asia

Background

Sometime on or about 19 August 2025, Nepalese Trademarks Registry issued a notice requiring actions as follows:

For trade marks registered before 19 August 2025 and within 7-Year renewal period, all trade mark proprietors must submit evidence of use within 60 days from the date of publication.

For Pending Applications

- Applications which remain pending due to incomplete documentation, to furnish such outstanding documents by 16 November 2025, failing which applications which have been pending for more than seven (7) years will be automatically cancelled by the Registry without further notice;
- Outstanding registration fees for applications which have been published for more than seven (7) years but remain unregistered due to non-payment of the same, should be made by 16 November 2025.

The sudden and ambiguous notice created quite a stir among international trade mark owners with interest in Nepal.

Just as quickly, on or about 24 September 2025, the Nepalese Trademarks Registry issued a further notice, suspending their earlier directive of 19 August 2025, due to unrelated nation-wide acts of disruption including arson, looting, etc., which resulted in the loss and destruction of records at the Registry.

New Notice

On 1 December 2025, the Nepalese Trademarks Registry issued their latest notice mandating as follows:

For Pending Applications

- Trade mark applicants with applications pending for more than seven (7) years due to incomplete documentation should file a request with the complete documentation within 90 days from said notice, ie., by 28 February 2026, failing which the application will be deemed abandoned and removed from the register without further notice;
- This new directive will apply to all trade mark applications henceforth, namely, any applications which remain pending for more than seven (7) years due to non-submission of complete documentation will be deemed abandoned and removed from the register without further notice;
- Trade mark applicants whose applications are published before 1 December 2025 and which pass through the publication window period without any oppositions must submit a request for the issuance of Registration Certificate, together with the requisite fees and/or documents, within six (6) months from the date of this notice, i.e., by 31 May 2026, failing which the application will be cancelled.

The new notice has not addressed registered trade marks or evidence of use, unlike previous. Please continue to watch this space for updates.

QATAR

Sami Nusair, Saba IP

The Investment and Trade Court in Qatar has signed a cooperation agreement with the WIPO Arbitration and Mediation Center. The partnership aims to enhance the Court's ability to manage IP-related disputes and ensure alignment with global best practices.

This development supports Qatar's objective to provide a reliable forum for resolving commercial disputes, including those in regulated sectors such as life sciences.

SAUDI ARABIA

Ahmad Khateeb, Saba IP, Saudi Arabia

The Saudi Authority for Intellectual Property (SAIP) has joined WIPO's Digital Access Service (DAS), becoming the first IP office in the Middle East to do so. SAIP is now operating as an Accessing Office, allowing priority documents to be retrieved electronically through the DAS platform.

For companies managing pharmaceutical filings across the GCC, this shift removes the need to submit physical priority documents locally and reduces administrative steps during prosecution. The change supports more efficient coordination of parallel filings, especially where timing and documentation requirements are critical.

SAUDI ARABIA

Odai Kallab, Saba IP, Saudi Arabia

The Saudi Courts have reaffirmed the protection of well-known trade marks, even when such marks are not locally registered.

In a recent opposition case that reached the Court of Appeals, the opposing party successfully argued that the contested mark:

- Bore a high degree of visual and phonetic similarity to their long-standing mark;
- Created a likelihood of consumer confusion due to overlapping market segments; and
- Infringed upon the superior rights of the earlier mark, which enjoys recognition and registration outside Saudi Arabia.

The Court relied on the principles enshrined in Articles 3(13) and 4 of the GCC Trademark Law, as well as Article 6bis of the Paris Convention, which together safeguard well-known trade marks against imitation, regardless of local registration.

Both the Court of First Instance and the Court of Appeals agreed with these arguments, confirming that international reputation and public recognition are sufficient grounds to prevent misuse or imitation. The Court ruled that the opposed mark was confusingly similar to a well-known trade mark and ordered its cancellation ex tunc (from the outset).

This decision underscores Saudi Arabia's growing commitment to strengthening intellectual property protection and aligning judicial practice with international standards. It reinforces confidence among brand owners that well-known trade marks benefit from robust judicial protection, even in cases involving stylized or unregistered versions.

Continued on next page

International Update continued

TANZANIA

Serge Haddad, Saba IP

The Fair Competition Commission (FCC) has announced that, starting 1 December 2025, all trade marks covering goods imported into Mainland Tanzania must be recorded under the new Merchandise Marks (Recordation) Regulations, 2025.

Introduced by the Finance Act, 2025, which amended the Merchandise Marks Act, the recordation system aims to enhance anti-counterfeiting controls and support border enforcement. Both Tanzanian and foreign-registered trade marks are subject to recordation when the related goods are intended for import into Tanzania.

Each application must be filed on Form FCC 1 and submitted to the Chief Inspector of the FCC. It must include details of the trade mark owner, place of manufacture, a sample or image of the goods, licensee information, a certified registration certificate, and proof of fee payment. The FCC will issue its decision within 21 days.

Recordation is valid for one year and renewable annually. Trade mark owners may authorize agents to act on their behalf through a Power of Attorney, and changes such as ownership or name updates can also be recorded.

As implementation approaches, trade mark owners and importers are encouraged to prepare their documentation and designate local representatives early to ensure smooth transition and avoid clearance delays at Tanzanian ports.

TANZANIA

Serge Haddad, Saba IP

Tanzania's highest court has confirmed that ARIPO trade mark registrations designating Tanzania are not enforceable in the country. Although Tanzania is a signatory to the Banjul Protocol on Marks, the Protocol has not been ratified or incorporated into domestic legislation, which is required for international treaties to take effect locally.

Trade mark protection in Tanzania is therefore governed solely by national law, under which rights arise through direct filing with the local trade marks office. ARIPO designations that include Tanzania do not confer enforceable rights and are not recognized by Tanzanian authorities or courts.

The ruling reinforces Tanzania's commitment to the territorial and first-to-file principles, meaning protection exists only within the jurisdiction of registration and belongs to the first applicant under national procedures.

Rights holders with ARIPO designations covering Tanzania should review their portfolios and ensure that essential trade marks are filed directly at the national level. Direct local registration remains the only way to secure valid and enforceable protection in Tanzania.

UKRAINE

CWB

On 4 September 2025, the Antimonopoly Committee of Ukraine (AMCU) ruled that a Kharkiv-based pharmaceutical company Berkana+ LLC engaged in unfair competition practices by using the designation and packaging for their dietary supplements DetraMax which closely resemble the trade mark and packaging of the medicinal product DETRALEX®.

The DETRALEX® trade mark and packaging have long been used by the French pharmaceutical company Biopharma and Servier Ukraine LLC, both part of the Servier Group, one of the world's leading pharmaceutical companies. The companies filed a complaint with the AMCU, which determined that Berkana+'s unauthorised use of the DetraMax name and packaging could mislead consumers and allow Berkana+ to unfairly benefit from the established reputation of Biopharma and Servier Ukraine.

Specifically, the similarity could cause consumers to confuse DetraMax dietary supplements with DETRALEX® medicines—products that are subject to state registration, clinical trials, and rigorous quality control, and whose therapeutic efficacy is clinically proven. These conclusions were supported by consumer surveys conducted by the AMCU and an expert opinion in the field of intellectual property provided by the applicants.

As a result, the AMCU ruled that Berkana+ had violated Article 4 of Ukraine's Law 'On Protection Against Unfair Competition' and imposed a fine of 150,000 UAH (approximately EUR €3,100).

The AMCU further noted that Berkana+ acknowledged the violation and took corrective measures by withdrawing the infringing products from the market and arranging for their proper disposal.

UZBEKISTAN

CWB

On 13 May 2025, Uzbekistan adopted the Law 'On Amendments and Additions to Certain Legislative Acts' (ZRU-1080). IPR registration-related amendments entered into force on 9 August 2025, while the IP enforcement-related measures will enter into force on 10 November 2025.

The law aims to streamline IP registration through digitalisation, eliminate the need for official fee payment confirmation at filing, and strengthen enforcement mechanisms to protect IP rights, while fostering innovation. These changes align Uzbekistan's legislation with global IP standards, enhancing the country's appeal for investors and creators.

The new law, published via the National Database of Legislation (Lex.uz), amends the Criminal Code, Criminal Procedure Code, Administrative Liability Code, Civil Code, and the Law 'On Plant Variety.'

The key provisions include:

Streamlined IP registration procedures

- **Flexible grant fee payment terms:** Applicants can extend the three-month deadline for paying grant fees by up to six months with a 50% surcharge, easing financial planning for registering inventions, utility models, industrial designs, trade marks, plant varieties, and integrated circuit topographies (Article 10).
- **Revised plant variety registration rules:** Under the amended Law 'On Plant Variety', the requirement to submit a novelty declaration confirming that the plant variety has not been used, sold, or transferred, is no longer applicable, nor is the mandatory submission of testing material (Article 7). However, priority documents and powers of attorney remain required.
- **Proof of payment no longer required:** The requirement to submit official fee payment confirmation at filing was removed when filing for patents, utility models, industrial designs, trade marks, geographical indications, appellations of origin, and plant varieties / breeders' rights. Applications are now filed electronically via the Uzbekistan's Patent and Trademark Office's (PTO) digital platform, and are accepted after the automatically generated e-invoice is paid (Articles 2, 7, 9, 11).

Expedited compliance reviews: Software and database registration applications are reviewed for compliance with formal requirements within 10 business days by the Intellectual Property Center operating under the Ministry of Justice (Article 1).

Continued on next page

- **Digital certification:** Patents and certificates for IMP rights are issued electronically with unified QR codes for verification, supporting Uzbekistan's digitalisation efforts (Articles 1, 2, 7, 9, 11).
- **Automatic registry entry:** Upon approval and fee payment, IP rights are automatically recorded in the relevant state register (e.g. State Register of Inventions, Trade Marks, or Plant Varieties), (Articles 2, 7, 9, 11).
- **More authority to judicial bodies:** The Ministry of Justice is authorised to seize infringing goods, tools, and related documents during IP inspections, strengthening enforcement capabilities (Article 5).
- **Integration into criminal procedures:** IP-related offenses are explicitly included in the Criminal Procedure Code, granting judicial authorities jurisdiction over enforcement actions (Article 4).

Stricter administrative penalties

Unauthorised use or misuse of trade marks, service marks, geographical indications, appellations of origin, and firm names incurs:

- Fines of approx. USD $160–480 for individuals, and approx. USD $480–950 for officials (previously USD $130-300 for individuals and USD $300-600 for officials).
- Fines for repeat trade mark violations within one year of approx. USD $480–950 for individuals, and approx. USD $950–1,600 for officials, with mandatory confiscation of infringing items (previously USD $300-450 for individuals and USD $600-700 for officials)(Article 5).

Unauthorised use of inventions, utility models, industrial designs, topographies, and plant varieties incurs:

- Fines of approx. USD $60–320 for individuals and approx. USD $320–640 for officials (previously USD $90-150).
- Fines for repeat offenses within one year of approx. USD $320–640 for individuals, and approx. USD $640–950 for officials, with confiscation (Article 5).

Under Article 6, goods, packaging, and labels infringing trade mark rights must be seized and destroyed at the violator's expense.

New criminal liabilities for IP infringement

- Article 149 (author's non-property rights infringement) penalises false authorship or unauthorised IP disclosure with fines of USD $1,600–2400, up to 5 years of rights deprivation, 360 hours of community service, or 2 years of restricted liberty. Cases with aggravating factors incur fines of USD $2,400–3,200 or 2–3 years imprisonment, with exemptions for first-time offenders who compensate damages within 30 days.
- Article 149[1] (copyright and related rights infringement) penalises unauthorised use or distribution of copyrighted works causing significant damage with fines of approx. USD $1,600–3,200, or up to 2 years of correctional labor, restricted liberty, or imprisonment. Cases with aggravating factors, such as repeat violations or use of media/Internet, incur fines of approx. USD $3,200–4,800 or 2–3 years imprisonment, with exemptions for damage compensation.
- Article 149[2] (trade mark, geographical indication, appellation of origin and firm name infringement) penalises misuse of protection signs for trade marks, GIs, AOs, and firm names, incurring fines of USD $1,600–3,200 or up to 2 years imprisonment for significant damage. Cases with aggravating factors, such as repeat violations or group actions, face fines of USD $3,200–4,800 or 2–3 years imprisonment, with exemptions for compensation within 30 days.
- Article 149[3] (patent, design, topography, and plant variety infringement), penalises unauthorised use causing significant damage with fines of approx. USD $1,600–2,400, up to 360 hours of community service, or 2 years of restricted liberty. Cases with aggravating factors carry fines of approx. USD $2,400–3,200 or 2–3 years imprisonment, with exemptions for compensation within 30 days.

Recommended actions for businesses and IP rights holders

To ensure compliance with the law, rights holders should:

- Ensure marks like ® are used only for registered IP rights to avoid significant penalties for misuse, particularly under Article 149[2].
- Utilise the extended six-month window for paying grant fees and the streamlined filing process to optimize IP registrations.
- Anticipate increased inspections by the Ministry of Justice starting 10 November 2025, and ensure compliance with IP usage and licensing requirements to mitigate risks of penalties for violations causing significant damage.
- Consult legal professionals specialising in Uzbekistan's IP laws to navigate the updated regulations, particularly for electronic filings, plant variety registrations, and criminal liability risks under Article 149[2].
- Check current conversion rates and confirm exact amounts with local authorities, as fines are calculated in USD based on the estimated base calculation amount (BCA) of USD $32 and may vary due to currency fluctuations

YEMEN

Salah Samhouri, Saba IP

The Trademark Office in Yemen (Aden) has introduced a new procedure for trade mark applications in Class 5, covering pharmaceuticals and medical supplies.

All new applications in this class must now include a declaration stating that the mark is being registered for protection purposes only and will not be used in Yemen. This declaration must be issued by the Legal Department at the Ministry of Industry and Trade in Aden.

The declaration is a procedural formality and does not authorize product use. Any actual use of trade marks for pharmaceuticals or medical supplies in Yemen remains subject to prior approval from the Supreme Authority for Medicines and Medical Supplies.

Previously, Class 5 applications required a license from the Supreme Authority, though some flexibility was allowed. The Trade Mark Office is now enforcing this rule strictly, and applications without the required declaration will not proceed to examination.

ZANZIBAR

Serge Haddad, Saba IP

The Zanzibar Industrial Property Office (ZIPO), under the Zanzibar Business and Property Registration Agency, has implemented substantial increases to official fees for IP services. The revised schedule, published in the Zanzibar Government Gazette on 18 July 2025, entered into force on 11 August 2025.

Charges for trade marks, patents, industrial designs, and geographical indications have risen by 50% to 300%. The framework also introduced new items, including fees for association of marks and opposition hearings.

Applicants with pending cases have already been subject to the new schedule, as the increases apply retroactively.

Bad faith and Trade Mark Squatting – Law Practice in Asia

Flora Fang and Nick Redfearn, Rouse

Bad faith trade mark applications or trade mark squatting is a longstanding problem in Asia. Well-known brands, even less well-known ones can be copied in some markets by other traders, by filing applications early. The speed of commerce in the digital age, the wide availability of information on newly launched brands and the national nature of trade marks enable applications to be filed in some countries before a legitimate IP owner might get to it. This is made more challenging in the healthcare sector because pharma, and consumer products and medical devices may require regulatory approvals country by country. This sometimes leads to a slower registration process, and therefore potential gaps, which unscrupulous traders might try to fill.

This article will focus on the Asia Pacific region countries of concern. We can divide them into three groups:

A. No clear laws to prevent applications being filed in bad faith;

B. Clear laws on bad faith, but perhaps practice is not always clear;

C. The laws are perhaps insufficient to address the problem.

Before getting into specifics it is worth considering what IP owners seek. In an ideal world a national trade mark law should contain a provision which prohibits the registration of bad faith trade marks. This can typically be dealt with in 3 ways:

- At examination stage, examiners should be able to refuse applications they find to be in bad faith. This may be easy in the case of well-known marks, but harder for lesser known ones.
- In oppositions, opponents must be able to argue that an application is in bad faith, by providing supporting evidence.
- In invalidation proceedings, IP owners need to be able to argue that a mark applied for or registered is in bad faith, again providing supporting evidence.
- Lastly, in litigation, whether appeals from IPO decisions, or other proceedings similar to IPO proceedings, or as defences to infringement, ideally, but also in other lawsuits, parties should be able to argue a registration is in bad faith, providing supporting evidence.

The precise details for each may vary but that type of sequence enables the most cost efficient and speedy solutions to operate first, and then only complex disputed instances reach courts.

Let's start with countries without clear bad faith provisions in their laws. Thailand and Malaysia are examples. Their trade mark laws do not have specific provisions. However in Thailand while there is no prohibition at examination stage, in oppositions bad faith applications are commonly argued to be contrary to public policy, order or morality and therefore not registrable under Section 62 of the Trade mark law. In Malaysia invalidation cases can be brought based on either prior rights or fraud, which then refer indirectly to bad faith. This puts an obligation on IP owners to watch and oppose.

Countries which have bad faith provisions, although not yet in frequent use, include Indonesia and Vietnam. Indonesia has a very clear legal provision but examiners find it hard to examine and decide applications on that basis. Oppositions can use bad faith, but in practice examiners rarely decide cases on it. Partly this is an evidential issue, because oppositions only include cursory paper evidence so it can be challenging to provide clear evidence of bad faith by an applicant. It requires investigations to uncover some kind of documentary proof. Therefore several bad faith applications have been accepted, which must then be cancelled. This is only possible in court, making the process slow and expensive. But there are examples of healthcare products being cancelled due to bad faith. Two local pharma companies got into a dispute over PRIMOXONE v PROMOXONE, with the latter being cancelled on the basis of bad faith while sports shoe company Puma took action against a PUMA mark filed in class 5.

Vietnam amended its IP law in 2022. Article 96.1.a now refers to bad faith. However, it took another 18 months for Circular No. 23/2023/TT-BKHCN to introduce a detailed interpretation, referring to the motive behind the trade mark, taking advantage of the reputation or goodwill of the others' marks reselling and so on. As this is new, there are no decisions yet.

Of the third category of countries where laws have some but not a full degree of bad faith protection, China is a good example. Its Trade mark Law Article 4 allows rejection of marks in bad faith without intent to use. The additional intent to use element makes the proof of bad faith much harder.

China has made efforts to curb bad faith filings by issuing office opinions and requiring evidence of use, such efforts focus mainly on large-scale hoarding or cases causing negative social influence or public confusion. Malicious registrations without a wider impact are often allowed unless challenged by IP owners. In oppositions, establishing bad faith for minor filings is challenging for non-famous marks and proving malicious intent is hard. Invalidation actions, however, permit a broader assessment, where factors such as the fame of the prior mark and other factors of bad faith may be considered, even when only a few applications are involved. But they take longer.

China has a well-documented problem of trade mark squatting. It is the largest trade mark office by volume of applications globally, the second largest economy in the world and the 'world's factory', so the huge volume of goods and services there have led to a problem of bad faith squatting. The government has recognised this and taken steps to address it. IP owners argue there is still more to do. Some of the important steps include:

- Prohibiting agents from supporting squatting;
- Refusing large scale filing programmes that could look like squatting;
- The courts have interpreted trade mark squatting to be a form of unfair competition enabling litigation to address bad faith marks. In the healthcare sector, the landmark case Bayer v Li Qing led this pattern of cases.
- In practice many bad faith marks are removed by non-use invalidation actions, but these require time and work by IP owners to win.

In the Pharma sector, Novartis challenged a registration 诺欣妥 (Entresto in Chinese) filed in Class 10 for medical apparatus, as the registrant was found to have acted in bad faith in copying other famous brands.

Merz Pharma challenged CONTRACTUBEX in class 10 for medical devices, resulting in its cancellation based on the original registrant's history of filing over 120 trade mark applications that copied well-known pharmaceutical brands like 妈富隆 (Marvelon in Chinese) and 达克舒 (Dexasone in Chinese).

However, IP owners argue the costs and difficulty of preventing bad faith marks, especially given the fact the problem is relatively common due to the importance of China, means more work is needed. The common request made to China is to simplify the definition of bad faith to allow examiners to refuse obvious copies and opponents to provide arguments and evidence that will be more readily accepted.

The RCEP (Regional Comprehensive Economic Partnership Agreement) Free Trade Agreement signed by 15 Asia Pacific countries includes in Art 11.27 an obligation to regulate bad faith trade marks. Several countries still need to comply. Common interpretation and training will help bring about more consistent approaches to prevent squatting and bad faith applicants across the region.

PROFILE: Gretchen Stroud

Gretchen Stroud joined Gilead Sciences in 2008 as its first in-house trade mark attorney and now is head of a team which advises and trains the company on naming issues, trade marks, copyright and domain names worldwide. Prior to joining Gilead, Gretchen practiced at the Cooley law firm, where she represented software and internet companies. An active member of IP organizations, Gretchen has chaired the IPO's US Trademark Office Practice Committee as well as served on INTA committees. Gretchen obtained an A.B. in English from the University of Southern California and a J.D. from Stanford Law School.

Where were you brought up and educated?

I have lived in California all my life. I grew up in Orange County, halfway between the Pacific Ocean and Disneyland, and moved to downtown Los Angeles for college. After working a few years, I moved to Silicon Valley for law school.

How did you become involved in trade marks?

When I was a young law firm litigation associate with a toddler at home and a baby on the way, the firm's trade mark group leader educated me on both the fascinating elements of trade mark practice and how its pace better matched a working mother's life. She was so right.

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

In my alternate life, I worked for a studio after graduating college, became a TV writer and then a showrunner.

Which three words would you use to describe yourself?

Focused, hopeful, whimsical.

What do you do at weekends?

On my favourite weekends, my sons and their wives come over for Sunday dinner, and I play with my grandchildren.

What is the best thing about your job?

My team is amazing – knowledgeable hard-working professionals who support each other and are always learning and improving.

What did you want to be as a child?

A librarian, so I'd always be surrounded by books.

Complete the sentence: I'm no good at

Golf (not for the lack of trying).

What is the soundtrack to your life?

Birdsong at home, and airplanes at work. In my garden, I hear Anna's hummingbirds, mourning doves, lesser goldfinches, and Oregon juncos. A constant stream of jets on their way to land at SFO pass by my office window.

Who was your mentor or role model?

Anne Peck, who gave me my first trade mark job and is a creative lawyer and patient friend. She reminded me that a warm and friendly word is more likely to get positive results, and that pigs get fed, but hogs get slaughtered.

What car(s) do you drive?

Now, I drive a reliable compact SUV, but my first car was a 1971 powder blue Ford Pinto.

Which famous historical person would you like to have been and why?

Abigail Adams. Successful businesswoman, wife and mother, she kept her family financially afloat during the American Revolutionary War, advised her husband and advocated for women as he drafted the country's founding documents and reared four children – one a US president - to adulthood.

What is your favourite children's book?

From the Mixed-Up Files of Mrs. Basil E. Frankweiler by E.L. Konigsburg. Two siblings run away to stay in the Metropolitan Museum of Art in New York City and solve an art mystery.

Which book changed you?

There are so many! I loved This Is Happiness by Niall Williams, a meditation on asking for and giving forgiveness, as well as how to love your neighbour. And on a more practical level, Gâteau by Aleksandra Crapanzo. Her gluten-free coconut cake is both simple and delicious.

How do you relax?

Making something – perhaps a cake, a crochet project or a quilt.

Which sport do you play and/or enjoy?

Thanks to my youngest son, I enjoy watching rowing regattas and have become the primary user of our family erg machine.

What is your all-time favourite film?

Groundhog Day. A funny movie about finding meaning and joy anywhere.

What is comfort eating for you?

This time of year, a meat stew with mashed potatoes or polenta.

What is your most treasured possession?

The wooden toy trains my father played with as a boy.

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

Be sure to spend some time out of doors - hiking in redwood forests, whale watching in Monterey Bay or seeing elephant seals at Ano Nuevo Point.

What is your favourite building / piece of architecture and why?

The beautiful Golden Gate Bridge. I still catch my breath when I see it.

What do you like, even though it is not fashionable?

Baroque music and period orchestras. It's my version of time travel to listen to Vivaldi and Bach, the warm strings, the harpsichord and theorbo.

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