

Law Lore & Practice

PTMG



Pharmaceutical
Trade Marks Group

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Editorial: The wonder of plants

After a scorching summer in Europe, with repeated raging fires, it is uplifting to see that many plants have survived, digging deep and activating their resistance responses. Indeed, the species most gardeners dismiss as mere weeds seem to have thrived in these drought conditions. Perhaps it is time for humans to uproot their view of the plant world.

At the height of the summer, the UK's National Institute for Health and Care Research announced the first successful trial of a 'fridge-free' tetanus-diphtheria vaccine on 60 volunteer patients. The dry powder formulation can be kept for a year at room temperature, before it is mixed with water and injected into patients to effectively protect them from these diseases. This new technology – with exponential worldwide potential – is inspired by resurrection plants, which dry out and appear dead during a drought, before springing back to life when it rains. In these

record-breaking temperatures, such a feat is certainly inspiring, in medicine and beyond.

Meanwhile, the WHO's most recent data for the DTP immunization coverage underscores the need for a concerted ongoing catch-up, recovery and system-strengthening vaccine programme post pandemic. Hopefully, all governments will continue to support such leading research with this aim in mind. Not least as the benefits of room-temperature and thus electricity-free storage would positively impact climate change, which affects us all in so many devastating ways, as recently shown in Nepal.

As the seasons turn around the globe, let us take a moment to appreciate the wonders of the natural world, and celebrate the joy that plants can bring to us all.

Vanessa

US Update: Trade Dress for Medical Devices

Kathryn Eyster, Tepper & Eyster, PLLC

Medical-device companies recently received guidance on how trade dress can differentiate a product even though that device has a utility patent. The medical device at issue was a wristband that tracks heart rate, sleep habits, blood pressure and other health metrics. Whoop, Inc. has been selling these health tracker bands for over a decade, all with a similar design – a 'faceless' fabric band that wraps over the bracelet and leaves thin metal accents on the sides (the WHOOP wearable). User metrics are viewed via subscription-based mobile application instead of on the wearable itself. Whoop objected to a wearable sold on Amazon by Shenzhen Lexqi Electronic Technology Co., Ltd. (Lexqi), claiming unfair competition and infringement of trade dress rights.

while the case was being decided. *WHOOP, Inc. v Shenzhen Lexqi Electronic Technology Co., Ltd.*, Case No. 25-12690-FSS (D. Mass.). A preliminary injunction is only issued if a court finds that the plaintiff is likely to succeed on the merits of the case. Although the case is ongoing, the court's analysis of the trade dress claim gives insight into the subject of trade dress for useful medical devices.

US law provides a cause of action where another party's use of a similar mark or a similar 'symbol or device' is likely to cause confusion, 15 U.S.C. § 1114. Trade dress protection originally included only a product's packaging but has been expanded to include a product's 'total image and overall appearance', such as its shape, color, texture and configuration. *Two Pesos, Inc. v Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1, 23 USPQ2d 1081, 1082 (1992). The party claiming trade dress rights must demonstrate that the claimed features are distinctive and not functional.

The court found that Whoop would likely establish distinctiveness for the WHOOP wearable trade dress. The US Supreme Court has held that product design, unlike product packaging, cannot be inherently

distinctive. See *Wal-Mart Stores, Inc. v Samara Bros.*, 529 U.S. 205, 209-10, 54 USPQ2d 1065, 1065-66 (2000). However, it can develop secondary meaning as a brand-identifier through extensive and continuous use. Secondary meaning can be established directly through consumer surveys and testimony, or indirectly through evidence of use: promoting the trade dress as a source-identifier, sales volume and market position, unsolicited media coverage and evidence of intentional copying. *Converse, Inc. v International Trade Commission*, 909 F.3d 1110 (Fed. Cir. 2018). Whoop provided evidence of ten years of use of the WHOOP wearable trade dress, extensive advertising, celebrity endorsements and social media use.

Although Lexqi argued that consumers relied on the W logo instead of any trade dress to identify the product, the court found that the labeling was much harder to see and that trade dress was more likely the distinguishing factor. The court also rejected the argument that Whoop shared the market with other wearables because the cited products were either visually distinct or had been discontinued.



The dispute landed in federal court in Massachusetts, where Whoop sought a preliminary injunction to stop Lexqi's sales

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There is always a particular energy to the arrival of Autumn. The sense of returning refreshed, looking ahead and reconnecting with colleagues after the sweltering summer months. This year, that anticipation feels especially strong as we prepare for the 108th PTMG Conference in Prague. This will also be a very welcome return to Prague after our 2011 conference. I am sure that those who attended will have their own memories of that occasion, while for many others this will be a first opportunity to experience Prague with PTMG. Our theme, Trade Mark Buddies on a Bohemian Rhapsody, brings a suitably playful note to a city with such a rich history and character.

The programme reflects both the enduring challenges of our practice and the incredible speed at which the world around us is changing. At a recent presentation, I was struck by the thought that, such is the extraordinary speed at which AI is developing and reshaping the world around us, we may be the last generation of professionals to work only with human colleagues - a thought that brings home just how profoundly AI is changing the way we all work.

Of course, the programme is only part of what makes a PTMG conference special. Our meetings give us space not only to learn, but also to exchange experiences openly, continue conversations over dinner and renew the friendships that have developed across countries, companies and private practice. Those less formal moments are often just as valuable as the sessions themselves. For me, one of the pleasures of being Chair is seeing the conference room fill with familiar faces while also welcoming those attending for the first time. That combination of continuity and new perspectives keeps PTMG lively and most importantly relevant. Whatever our different roles or jurisdictions, we come together with a shared interest in pharmaceutical trade marks and a willingness to learn from one another. So, whether you are returning to Prague with fond memories of 2011 or discovering the city with PTMG for the first time, I hope you will enjoy the conference. I am very much looking forward to seeing you there, to the discussions ahead and, above all, to spending time together once again.

Best wishes

Joanne

US Update Cont

The court also found that the claimed trade dress for the WHOOP wearable was not functional. A product feature is deemed functional if 'it is essential to the use or purpose of the article or if it affects the cost or quality of the article' such that competitors would be at a significant disadvantage without it because alternate designs are impractical. *Qualitex Co. v Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995). Relevant considerations include whether there is a utility patent demonstrating its utilitarian advantages, and whether advertising emphasizes these utilitarian advantages. *CeramTec GmbH v Coorstek Bioceramics LLC*, 124 F.4th 1358, 1363 (Fed. Cir. 2025). *Lexqi* argued that Whoop's design was functional because Whoop owns a utility patent with claims related to the clasp and the elastic band. The court disagreed.

The ornamental or incidental aspects of a product can be the subject of trade dress protection, even when that product is the subject of patent claims, if the feature is not a 'useful part of the invention'. *Traffix Devices, Inc. v Marketing Displays, Inc.*, 532 U.S. 23, 34 (2001). Here, the court found that the claimed advancement in Whoop's utility patent was the specialized buckle on the strap while the trade dress consists of the ornamental elements.

Whoop provided evidence of extensive marketing of the product's unique and recognizable design as opposed to the utilitarian benefits of the design. Also, Whoop provided examples of other 'faceless' wearables that did not look like its own, and there was no evidence that the Whoop trade dress is easier or cheaper to make than any other. The court concluded that Whoop was likely to prove non-functionality.

After determining that the claimed trade dress was likely to be found protectable, the court found that Whoop was likely to be able to show a likelihood of confusion between the WHOOP wearable and Lexqi's wearable. Given the demonstrated strength of Whoop's trade dress, the similarity of that trade dress in Lexqi's wearable, the similarity of the product use and that both were sold on Amazon to similar purchasers, the court found a likelihood of success despite a price difference in the products and that no evidence of Lexqi's bad faith intent was submitted.

What is the lesson when introducing a new medical device? Establish trade dress protection by identifying all the unique, nonfunctional, brand-identifying elements of that device and specifically focus advertising efforts on those. Patents protect the functional elements of a device, but trade dress protects the ornamental elements that make the device memorable and identifiable. Put yourself in the position to claim both.

Members News

Moves and Mergers

There have been a few moves since our last edition.

Baris Kalayci has left Gün+Partners to join NSN Law Firm in Istanbul, Turkey. Baris can be contacted at baris.kalayci@nsn-law.com

Agnieszka Matusik-Niedzialek has left Kulikowska & Kulikowski to join SDP D.Sierżant K. Dudziński Sp. kom. in Warsaw, Poland. Agnieszka can now be contacted at agnieszka.matusik-niedzialek@sdp.legal

Alexander Hallingstad has left Acapo Onsagers AS and is now with Aurex IP Advokat AS in Oslo, Norway. Alexander can be contacted at alexander@aurex.no

Following the merger, in certain countries, of Taylor Wessing with the US firm, Winston & Strawn, to form Winston Taylor, **Timothy Pinto** can now be contacted at timothy.pinto@winstontaylor.com

Khushboo Butail Karol has left ANM Global to join White & Brief in Mumbai, India. Khushboo can now be contacted at Khushboo.butail@whiteandbrief.com

Sarah Jeffery is now with Aspeya Switzerland SA in London, UK. Sarah can be contacted at sarah.jeffery@pmi.com

Lisa Tittlemore has left Sunstein LLP to join Merchant & Gould P.C. in Boston, USA. Lisa can now be contacted at ltittlemore@merchantgould.com

Ryan Hickey has left Corsearch and is now with SMD – Group, based in the UK. Ryan can be contacted at hickey@smd-group.info

Please remember to let us know of any changes to your contact details. You can notify me either via the PTMG website www.ptmg.org or directly to Lesley@ptmg.org or by writing to me at Tillingbourne House, 115 Gregories Road, Beaconsfield, Bucks, HP9 1HZ

Lesley Edwards
PTMG Secretary

UK Website-Blocking Injunctions Enter the Pharmaceutical Sector: The Novo Nordisk Judgments

Rachel Alexander, John Colbourn, Sara Ashby, Wiggin LLP, UK

Background

Website-blocking injunctions are court orders requiring internet service providers (ISPs) to impede access by their customers to specified websites. Although no liability claims are asserted against the ISPs themselves, courts can compel them to act because they are intermediaries (or service providers) whose services are being used by third parties to infringe the applicant's rights.

The English court's jurisdiction to grant these types of orders in relation to copyright infringement pursuant to section 97A of the Copyright, Designs and Patents Act 1988 (CDPA) was first confirmed in the *Newzbin 2* case (*Twentieth Century Fox v BT* (2011)), when the High Court ordered BT to block a site engaged in and facilitating large-scale copyright infringement of film and television content. A number of further cases followed and, by the mid-2010s, the grant of website-blocking orders founded on copyright infringement became an increasingly well-established practice.

A landmark extension to this jurisprudence came in *Cartier v Sky* (2014/2016/2018), where the English courts confirmed that website blocking orders could also be granted on the basis of trade mark infringement. In the *Cartier* cases, the targeted websites were advertising for sale and selling counterfeit products. Although there is no express statutory provision under UK law in relation to trade marks that is equivalent to section 97A CDPA, the courts found that such orders could be granted under the general power conferred by section 37(1) of the Senior Courts Act 1981, which enables the High Court to grant an injunction in all cases in which it appears to the court to be just and convenient to do so.

A number of cases have since built on the court's jurisdiction with respect to site-blocking applications following the principles established in the line of cases running from *Newzbin 2* and *Cartier*. Until recently, however, the remedy had not been used in the UK to address criminal regulatory wrongdoing as its core jurisdictional foundation.

The Novo Nordisk judgments

The main judgment

Novo Nordisk, manufacturer of the widely prescribed semaglutide-based medicines OZEMPIC, WEGOVY, and RYBELSUS (among others), applied for a website blocking order requiring the UK's six major ISPs to impede access to four websites selling counterfeit and unlicensed versions of its prescription-only medicines.

Novo Nordisk presented a number of reports to the court demonstrating significant evidence of harm caused by these websites, such as FDA data identifying falsified semaglutide products being linked to over 300 serious adverse events, 100 hospitalisations and 10 deaths in the US, and the WHO warning that up to one million deaths annually may be attributable to substandard counterfeit medicines sold online.

Novo Nordisk relied on three legal bases for the application: (a) trade mark infringement; (b) the law of passing off; and (c) criminal offences under the Human Medicines Regulations 2012, which prohibit the sale or supply of unauthorised or prescription-only medicines without proper authorisation.

Importantly, Novo Nordisk's application was brought with the full support and encouragement of the Medicines and

Healthcare Products Regulatory Agency (MHRA), which had itself tried and failed to take these sites down and had actively sought Novo Nordisk's assistance in doing so in the lead up to this case. This was a significant factor in the judge's decision that Novo Nordisk had standing to bring the application based on the criminal offences.

The judge granted the blocking injunction sought, confirming that the court's jurisdiction to make such orders is not limited to civil IP rights but can extend to any wrongdoing (whether civil or criminal) in which the ISP becomes mixed up as an intermediary, and that the granting of an injunction in this scenario was entirely proportionate given the serious and immediate risk to public health (aside from the IP infringements).

The supplemental judgment

In June 2026, Novo Nordisk returned to court seeking to vary and extend the original order. The application added seven further target websites and sought to add what the applicants referred to as a 'dynamic blocking' mechanism.

It is worth noting that all website-blocking orders granted by the English courts, including that granted in the initial *Newzbin 2* case, are dynamic in so far as new locations (i.e., URLs, domain names and/or IP addresses) used by the specified target websites can be notified to the ISPs for blocking without the applicants having to return to court. This is a very important aspect of the orders in terms of providing a practical and effective remedy.

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UK Website-Blocking Injunctions Continued

Under the mechanism proposed by Novo Nordisk, it would also be permitted to notify further websites (unconnected to those already the subject of the order) to the ISPs for blocking – without further judicial involvement - provided such websites are certified by Novo Nordisk as meeting certain designated criteria set out in a confidential schedule to the order. Novo Nordisk advocated for a large practical need for this, stating that it had identified over 130 further websites selling counterfeit products since the original judgment was granted, and wrongdoers were already registering alternative websites to circumvent the blocking mechanisms already in place. Whilst the judgment refers to this form of extended relief having previously been granted in the context of the broadcasting of football matches and other subscription broadcast content, it is relevant to note that this form of extended relief has previously been obtained by both the film and publishing industries in a series of orders granted since 2022, the most recent of which was granted on 6 May 2026.

The judge, though initially sceptical, was persuaded that the extended blocking mechanism was appropriate on the facts. He confirmed that the court's jurisdiction extends to criminal wrongdoing where the applicant is a 'victim' of that wrongdoing, even in the absence of a private civil law claim. The MHRA supported the variation sought, confirming that it welcomed industry-led initiatives to protect consumers.

Significance and future implications

The Novo Nordisk judgments are significant in at least three respects in the UK.

First, they extend the site blocking remedy in the UK into the pharmaceutical sector. Until now, UK blocking orders have been used to tackle piracy and

counterfeiting across various content industries, as well as the luxury goods and consumer electronics sectors. Their use to protect public health by targeting the sale of falsified medicines is significant. Secondly, the main judgment confirms that the English court's jurisdiction to grant blocking orders is not limited to civil intellectual property wrongs (and associated rights relating the circumvention of technological measures under the CDPA) but can extend to criminal wrongdoing, provided the applicant is able to demonstrate that it is a victim of the relevant offences. This broadens the potential scope of the remedy.

Thirdly, the supplemental judgment introduces the broader dynamic blocking mechanism described above into the pharmaceutical context. The mechanism enables rightsholders to obtain more effective relief by avoiding the delay and cost associated with having to make repeated court applications. As noted in an earlier decision of Mellor J in *Columbia Pictures v BT*, the court is open to making refinements to website-blocking orders to address the latest tactics of infringers and to ensure that the orders granted remain effective. In part, this approach is made possible by the responsible and proportionate manner in which the jurisdiction has been invoked by rightsholders to date. In doing so, the English courts have recognised the need for practical and adaptable remedies when parties are seeking to enforce their rights in the online environment.

The MHRA's active endorsement in the Novo Nordisk proceedings may encourage other regulators to adopt a similarly collaborative stance, particularly where criminal regulatory offences are relied on and particular considerations around a party's standing to seek blocking relief arise.

SPOTLIGHT

News updates from LL&P

July 2026

UK: 'Dynamic blocking' used for the first time to successfully tackle counterfeit medicines online

Pharmaceutical companies have a significant new weapon in the fight against counterfeit and unauthorised medicines in the UK, as two recent High Court decisions, *Novo Nordisk v. [redacted]* and *[redacted] v. [redacted]*, successfully obtained a website blocking order targeting websites involved in the online sale of falsified and counterfeit products.

The blocking order, as originally granted by the High Court, required various named internet service providers (ISPs) to block access to any website known to be involved in the sale of counterfeit and unauthorised medicines, including the websites of Novo Nordisk's competitors, and to remove any links to such websites from the OZEMIG and ELIQUIS trade marks. The court found that the website operators were engaged in extensive unlawful activity, not least trade mark infringement and passing off, together with multiple criminal offences under the Human Medicines Regulations 2012. The court also accepted that the High Court's jurisdiction to grant such orders was not limited to civil intellectual property rights.

The proceedings were remarkable from the outset. This was the first ever website blocking order targeting the sale of counterfeit and unauthorised prescription-only medicines and as such the boundaries of the High Court's jurisdiction in the area of civil or criminal wrongdoing. Here, both the criminal jurisdiction under the 2012 Regulations and the trade mark infringement were crucial in persuading the court to grant the order.

The High Court's willingness to grant a website blocking order addressed a longstanding enforcement challenge for pharmaceutical companies: rogue websites can be created rapidly, operated anonymously and based overseas, making them difficult to identify and shut down using traditional legal mechanisms. As a result, the online sale of counterfeit and unauthorised medicines has become a significant concern for both pharmaceutical companies and regulators.

Website blocking orders are also an especially attractive form of relief because of their practical effectiveness. Unlike orders in other areas of law, website blocking orders in the UK target blocking an entire website, rather than specific pages or content, which is often the case in other areas of law. Online counterfeiters routinely migrate between domains and quickly launch replacement websites when existing sites are disabled.

Recognising this reality, the High Court's decision is particularly significant in that it extends the High Court's jurisdiction to grant website blocking orders to criminal wrongdoing, where the applicant is a victim of that wrongdoing, even in the absence of a private civil law claim.

Although initially sceptical about the dynamic blocking mechanism, the judge was persuaded that the blocking mechanism was appropriate on the facts. He confirmed that the court's jurisdiction extends to criminal wrongdoing where the applicant is a 'victim' of that wrongdoing, even in the absence of a private civil law claim. The MHRA supported the variation sought, confirming that it welcomed industry-led initiatives to protect consumers.

First, as a matter of legal principle, the court's jurisdiction to grant such orders was not limited to civil intellectual property rights. The court found that the website operators were engaged in extensive unlawful activity, not least trade mark infringement and passing off, together with multiple criminal offences under the Human Medicines Regulations 2012. The court also accepted that the High Court's jurisdiction to grant such orders was not limited to civil intellectual property rights.

Second, that jurisdiction extends beyond civil wrongdoing to criminal conduct (as the applicant) is the victim, meaning the High Court's jurisdiction to grant such orders is not limited to civil intellectual property rights.

Third, the variation was justified on the facts. Enforcement action by the MHRA had met with only limited success. Novo Nordisk had demonstrated the extensive and persistent need to monitor websites effectively, and the MHRA expressly endorsed the proposed approach. Coupled with various other factors, the judge found that the blocking mechanism was a targeted and powerful way to disrupt the online sale of counterfeit and unauthorised medicines. The dynamic nature of these orders is particularly valuable, cutting through the constant churn of new websites by requiring information on counterfeiters and making enforcement more agile and cost effective. As a result, website blocking orders are likely to become a valuable component of protective pharmaceutical brand protection strategies.



Gill Dennis provides knowledge and innovation support to Patient Masons' IP practice across the UK and Europe with a focus on the protection and enforcement of brands. With almost 20 years of legal practice and professional support experience, Gill provides the team with up-to-the-minute information and training on IP developments and leads on the delivery of bespoke current awareness training for clients. She has written extensively for the main industry press and is regularly asked to comment on branding issues by the wider media.



Florian Traub leads the trade mark and brand protection team at Patient Masons and has extensive experience in domestic and international filing, prosecution and portfolio management. He acts on behalf of clients before the EUIPO, WIPO and the national offices in the UK, Ireland and Germany. Florian has over twenty years' experience as a trade mark practitioner. He has also written and presented on many cross-jurisdictional trade mark topics and is currently a member of the Editorial Board of INTA's Bulletin Committee.

This decision was previously reviewed by Gill Dennis & Florian Traub from Pinsent Masons for our Spotlight feature on LinkedIn, which you can still see here:

<https://www.linkedin.com/feed/update/urn:li:activity:7483167700802797568/>

Or read on the PTMG website:

<https://ptmg.org/law-lore-practice/>

Law Lore & Practice

Pharmaceutical Trade Marks Group

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Look out for more discussion on the impact of these injunctions beyond the UK in our December edition which will carry the conference report covering the International case round-up presentation in Prague.

Prescription for (no) Confusion: the GC insists on high level of attention for healthcare products

Sergio Pérez & Verena Bomhard, Bomhard IP

By decision of 1 July 2026 (Case T-591/24 – Sandoz v EUIPO – ARYUNA), https://infocuria.curia.europa.eu/tabs/document/T/2024/T-0591-24-00000000PI-01-P-01/ARRET_NP/322888-EN-I.html the EU General Court (GC) confirmed once again that, in cases concerning trade marks relating to healthcare, the attention of the relevant public is considered high, whether the specific products were OTC or prescription drugs or even dietetic products, on the – somewhat simplistic – ground that they affect the consumer's health. The threshold for likelihood of confusion therefore remains higher than for other industries – and, in this case, resulted in the opposition based on ARMUNIA against ARYUNA for identical goods being unsuccessful.

Background of the case

On 30 September 2022, Be Healthy d.o.o. filed an EUTM application for ARYUNA in class 5, covering 'Tincture of iodine; tinctures for medical purposes; medicinal herbs; herbal medicine; decoctions of medicinal herb'.

Novartis (whose rights later passed to Sandoz) opposed the application invoking likelihood of confusion with two earlier ARMUNIA trade marks covering 'pharmaceutical preparations, namely oral contraceptives'; and 'pharmaceutical preparations for human use', respectively.

EUIPO rejected the opposition in first and second instance denying a likelihood of confusion, inter alia based on the presumed high level of attention of the relevant public.

Sandoz filed an action to the GC, arguing predominantly that the level of attention of the relevant public had been assessed incorrectly. MARQUES supported Sandoz's action.

GC Decision

The GC found no fault with the EUIPO's decision and dismissed the action. It upheld the findings that the signs were similar to a low degree and that this was insufficient to give rise to a likelihood of confusion, in particular given the high level of attention of the relevant public.

As in previous case law, the GC considered that the relevant public was

composed of both pharmaceutical professionals and the general public, and that their level of attention was high, even for products that could be purchased without a prescription. While the GC acknowledged that goods like tinctures and medicinal herbs were not medicines, it maintained that also for these goods, the attention level was high, because these goods are intended to improve the health. The reason for this was essentially that this has been firmly established in case law.

Discussion

Sandoz was obviously fully aware of the case law assuming a high level of attention, but made a brave attempt to question this. There were two main arguments: firstly, the goods at issue could not be put on a par with actual medicines, and secondly, the empirical finding that also in the healthcare field, confusion was not rare – and certainly not less likely than in many other consumer goods fields. In addition, in the healthcare field, confusion had a greater potential for putting public safety at risk.

The arguments were dismissed based on the 'settled case law' affirming a higher degree of attention for medicines (para. 39). This shows once again that it is incredibly difficult to argue against a factual assumption. As trade mark lawyers, we are confronted with such assumptions, dressed as general 'rules of experience', all the time. These are factual (or pseudo-empirical) statements that are first made in one context and then develop a life of their own, becoming 'consistent case law'.

Specifically, the assumption of the higher attention level for goods in class 5 seems to have been first mentioned by the GC in April 2005 with respect to healthcare professionals in T 260/03 (CELLTECH), para. 14. Already in April 2006, the rule was applied to average consumers of both 'pharmaceutical products' and 'herbal medicinal products' (T 202/04 (ECHINAID)). While in subsequent decisions, sometimes reference was still made to the seriousness of certain conditions such as respiratory illnesses – T 256/04 (RESPICUR), para. 47) when applying the rule to the general public. Over time, the GC referred simply to the fact that the products affected or were intended to improve the health (T 412/08 (TRUBION),

para. 28): irrelevant whether prescription drugs or OTC, or even dietetic products, citing its own previous cases.

Sandoz tried to challenge this assumption, submitting substantial evidence before the GC in an attempt to demonstrate that in numerous everyday situations, the level of attention of the relevant public is rather low, also when it comes to goods affecting health, particularly under stress, suffering, or in emergency situations. Also, imperfect recollection increases the likelihood of confusion with respect to trade marks for pharma products, which tend to be long made-up terms that are difficult to remember. Lowering the threshold for confusion therefore ultimately also supposes a risk for patient safety.

Alas, the new evidence was inadmissible as it had not been submitted during the proceedings before the EUIPO, and the GC only assesses whether the Board of Appeal's decision was correct based on the facts and evidence as they were before the Board. The GC therefore saw no reason to question the 'settled case law' relating to the level of attention. Moreover, the arguments referring to health risks and public safety were dismissed on the basis that these belonged to regulatory, not to trade mark law.

Neither did the GC accept that goods like medicinal herbs or tinctures could not be treated the same way as medicines to treat serious illnesses. It was not convinced by the argument that there are many other goods that also affect health – potentially at least as much as products like medicinal herbs – such as cosmetics or foodstuff, for which attention levels are generally assumed to be normal at most.

Conclusion

The high degree of attention of the relevant public and resulting higher threshold for likelihood of confusion in the area of healthcare trade marks seems to remain set in stone in EUIPO and GC case law. The next opponent who has the courage (and the pockets) for challenging this will have to submit convincing evidence to the contrary during the EUIPO proceedings. In the meantime, we continue to be confronted with a prescription for (no) confusion.

International Update

BOSNIA AND HERZEGOVINA

Gordana Pavlovic, Cabinet Pavlovic

The Bosnian Parliament passed a new Trade Mark Law on 14 May 2026. The Law was published on 12 June 2026, and entered into force on 20 June 2026. It will start applying one year later, on 20 June 2027. Trade marks granted under the 2010 law remain in force and will be subject to the new Law. Proceedings pending before 20 June 2027 will be completed under the 2010 law.

The reform was driven by Bosnia's EU accession obligations, with the stated aim of aligning Bosnian trade mark legislation with EU Directive 2004/48/EC on enforcement of intellectual property rights and EU Directive 2015/2436 on harmonisation of trade mark law.

Absolute and Relative Grounds

Trade marks continue to be examined ex officio on absolute grounds (as well as upon written observations of third parties), while relative grounds can only be raised in opposition proceedings.

Most absolute grounds remain unchanged - lack of distinctiveness, descriptiveness, deceptiveness, etc. - but two changes are worth noting. The explicit prohibition on registering a sign identical to an earlier mark covering identical goods has been removed from absolute grounds and shifted entirely to the relative grounds procedure. Additionally, the category of excluded signs has been extended beyond national and religious symbols to cover signs representing goods of general cultural significance or high symbolic value.

Two entirely new relative grounds have been introduced.

- First, a mark can be opposed if it conflicts with a company name registered earlier, where the mark covers goods or services that fall within that company's field of activity.
- Second, a mark filed by a trade mark agent or representative of the trade mark owner without the owner's consent is directly opposable.

Goods and Services Classification

A new provision codifies EUIPO and CJEU practice that was previously absent from Bosnian law: class headings cover only goods and services within their literal meaning. This is a practically significant clarification that brings Bosnia and Herzegovina into line with how classification is treated across the EU.

Observations, Oppositions and Invalidity Proceedings

Third parties may file observations regarding absolute grounds for refusal within 3 months after the publication of the mark. This does not prevent the IP Office from re-examining absolute grounds ex officio at any point before

registration.

A notable procedural change has been introduced to both opposition and invalidity proceedings. The parties may jointly request a suspension of up to 24 months to pursue amicable settlement, with a minimum suspension period of two months. Once proceedings resume, all previously running deadlines restart in full. The 2026 Law also mirrors this in invalidity proceedings. In the past, suspension was entirely at the discretion of the Examiner of the IP Office.

International Registration

Two new provisions on international registrations fill in gaps that existed in the 2010 law.

- Transformation rules - converting an international registration into a national application when the international registration is cancelled - have been introduced, with the national application retaining the date of the original international registration ;
- Further, at the request of a trade mark owner, a national registration can now be formally noted as replaced by an identical international registration, with the IP Office notifying WIPO accordingly.

Rights of Trade Mark Holders

The list of acts that trade mark holders may prohibit has been extended to include use of the mark in comparative advertising contrary to applicable regulations.

A new provision also allows holders to act against preparatory infringement, prohibiting the production or distribution of packaging, labels or security features bearing their mark before any infringing goods reach the market.

Non-use revocation

Trade mark use continues to be mandatory. The five-year period for non-use revocation now runs from the five years preceding the date of the revocation request, rather than from registration or last use. A revocation request cannot be filed until five years have elapsed from completion of registration, preventing premature attacks. Use by a licensee or with the owner's consent expressly counts as use by the owner.

The date on which the mark ceases has also changed: from the date of last use or registration under the 2010 law, to the date of the revocation request under the 2026 law.

Civil Protection

The 2026 Law specifies that not only the trade mark owner, but also a licensee can sue for trade mark infringement. A non-exclusive licensee may bring infringement proceedings only with the trade mark owner's consent. An exclusive licensee may intervene in proceedings brought by the owner to recover their own damages. Where a trade mark agent has registered

a mark without the owner's authorisation, the owner may both prohibit use and demand transfer.

Conclusion

Overall, the 2026 law represents a substantial modernisation of Bosnian trade mark legislation and a significant alignment with European practice.

CAPE VERDE

CWB

The new Industrial Property Code introduced by Legislative Decree No. 2/2025 came into effect in Cape Verde on 2 June 2026, bringing significant reforms to the country's intellectual property framework.

Trade Marks

One of the key changes is the abolition of Declarations of Intention to Use (DIUs). From 2 June 2026 onwards, the Intellectual Property Office no longer requires or accepts these filings. Trade mark registrations now remain valid for ten years calculated from the filing date of the application, rather than the registration date. The revised term applies to both pending and new applications, while marks registered before 2 June 2026 continue to follow the previous renewal system.

The grace period allowed for late renewal has increased from 60 days to six months. In addition, the Code removes the obligation for trade marks to be graphically represented, allowing protection to a broader range of non-traditional marks, provided they are clearly and accurately defined.

Trade mark prosecution procedures have been streamlined through enhanced digitalisation and simplified administrative processes.

Industrial Designs

For the first time, the revised legislation introduces protection for unregistered industrial designs. Qualifying designs now receive automatic protection for three years from the date they are first made available to the public.

Furthermore, the provisions governing registered designs have been updated to align with international standards and practices, while design application procedures have also been streamlined through greater use of electronic filing systems.

Additional developments

The new Code also enhances protection for confidential business information and trade secrets, acknowledges and protects plant varieties and traditional knowledge. It also strengthens measures aimed at combating unfair competition, and improves the mechanisms available for enforcing intellectual property rights.

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International Update continued

EUROPEAN UNION

Thomas Tresper, Tresper IP

Two recent decisions of the EU General Court, both handed down on 15 April 2026, highlight the importance of the initial elements when assessing the similarity of word marks.

Case T-410/25 (Ibumax-Lysin v ibum)

The EUTM application for Ibumax-Lysin, covering ibuprofen for use as an oral analgesic, was opposed on the basis of a Polish registration for ibum, covering pharmaceuticals. The opponent proved genuine use and a high degree of recognition of the earlier mark for analgesics. The EUIPO upheld the opposition.

The General Court found the signs to be visually and phonetically similar to a low degree. Consumers generally pay greater attention to the beginning of a mark than to its end. The element 'ibu' alluded to ibuprofen but was more distinctive than the descriptive elements 'max' and 'lysin'. In view of the identity of the goods and the high degree of distinctiveness of the earlier mark, there was a likelihood of confusion, despite the low degree of similarity between the signs and the high level of attention of the relevant public.

Case T-476/25 (Serosan v CLENOSAN)

The EUTM application for Serosan, covering goods in Class 5, was opposed on the basis of a Spanish registration for CLENOSAN, covering soaps and cosmetics in Class 3. The EUIPO rejected the opposition, even on the assumption that the goods were identical.

The General Court held that the Office, in finding a below-average degree of similarity between the signs, had not unduly overemphasised the differences in their initial parts. The visual and aural contrast between the initial letters was particularly prominent and immediately noticeable. In view of the below-average degree of similarity between the signs and the average degree of distinctiveness of the earlier mark, there was no likelihood of confusion, despite the assumed identity of the goods.

Comment

The decision in Ibumax-Lysin v ibum reaffirms the importance of the initial parts in the comparison of trade marks. It is also an example of how the principle of

interdependence of the relevant factors is applied when assessing likelihood of confusion. Although ibum was fully included at the beginning of the contested mark, the signs were found to be similar only to a low degree because of the allusive character of the element 'ibu'. However, the earlier mark had acquired enhanced distinctiveness in Poland. Therefore, an overall assessment led to a finding of likelihood of confusion.

The mark CLENOSAN from the second decision may ring a bell. In the EUIPO Guidelines, the case ALEOSAN v CLENOSAN (R 1669/2010-2) serves as an example of marks considered to be phonetically dissimilar, mainly because of the different number of syllables. By contrast, Serosan and CLENOSAN have the same number of syllables, so it is not inconsistent to find a certain degree of aural similarity. In this case, the below-average degree of similarity between the signs could not be offset by a higher-than-average distinctiveness of the earlier mark, but the result becomes even more convincing if one considers that goods in Class 3 and Class 5 are in fact not identical.

INDIA

Ranjan Narula & Mohandas Konnanath, RNA India

In *Laboratoires Griffon Private Limited & Anr. v Psychotropics India Limited*, the Bombay High Court granted an interim injunction restraining the use of PIL-LINCTUS. The Court reaffirmed that a descriptive element within competing pharmaceutical trade marks does not diminish protection when the marks, considered as a whole, are deceptively similar and likely to cause confusion.

Case background

The Plaintiffs, proprietors of the registered trade mark GRILINCTUS for cough syrups since the early 1970s, sued the Defendant for trade mark infringement and passing off following its adoption of PIL-LINCTUS. Before filing the suit, the Plaintiffs had opposed two trade mark applications filed by the Defendant for PIL-LINCTUS; the first application was subsequently abandoned.

Arguments advanced by the parties

The Plaintiffs argued that GRILINCTUS and PIL-LINCTUS were deceptively similar and used for identical pharmaceutical products. They further contended that the Defendant had knowingly adopted the impugned mark despite being aware of the

Plaintiffs' prior rights, relying on the Defendant's admissions before the Trade Marks Registry and its earlier abandoned application for the similar mark BRILINCTUS.

The Defendant contended that LINCTUS is a descriptive and common-to-trade term for cough preparations, making the prefixes GRI and PIL the distinctive elements of the rival marks. It also relied on third-party LINCTUS registrations and raised defences of prior use, acquiescence, delay and absence of likelihood of confusion.

Court's analysis and findings

1. Marks compared as a whole: Deceptive similarity must be assessed by considering the rival marks in their entirety, not by dissecting them into individual components.

2. Overall similarity: GRILINCTUS and PIL-LINCTUS were prima facie structurally, phonetically and aurally similar. The different prefixes and hyphen did not remove the likelihood of confusion, particularly because both marks covered identical medicinal products.

3. Composite mark protection: Even if LINCTUS were descriptive, the Plaintiffs claimed protection for the registered composite mark GRILINCTUS, not exclusivity over LINCTUS alone. Having applied to register PIL-LINCTUS, the Defendant could not simultaneously contend that LINCTUS was incapable of functioning as a trade mark.

4. Third-party registrations and conduct: Register entries alone did not prove that LINCTUS was common to the trade; evidence of substantial actual use was required and was not produced. The Court also rejected acquiescence because the Plaintiffs had consistently opposed the Defendant's applications, and it drew an adverse inference from the Defendant's inconsistent use claims and abandoned applications.

Decision and interim relief

The Court held that the Plaintiffs had established a strong prima facie case of infringement and passing off based on their prior registration, continuous use and goodwill. Finding that the balance of convenience favoured the Plaintiffs and that confusion in relation to pharmaceutical products could have serious consequences, it restrained the Defendant from using PIL-LINCTUS or any deceptively similar mark pending disposal of the suit.

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International Update continued

Key takeaways

- In pharmaceutical trade mark disputes, courts apply a heightened standard because confusion may have serious consequences for patient safety.
- Third-party registrations, without evidence of substantial commercial use, do not establish that an element is common to the trade.
- A party that seeks registration of a composite mark cannot simultaneously contend that the disputed element is incapable of functioning as a trade mark.
- In pharmaceutical trade mark cases, even a remote possibility of confusion may justify interim injunctive relief because the consequences for patient safety can be serious.

INDIA

Bisman Kaur & Sonal Goel, Remfry & Sagar

The Supreme Court of India in *Sun Pharma Laboratories Limited v Intas Pharmaceuticals Limited* [arising out of SLP(C) No. 23851/2026] has refused to interfere with a Delhi High Court Division Bench judgment dismissing Sun Pharma's trade mark infringement action over BEVETEX and BEVATAS.

Sun Pharma sued in 2017, alleging deceptive similarity between BEVETEX, used for Paclitaxel, and BEVATAS, used for Bevacizumab. Intas said BEVATAS was coined from BEVA (Becavizumab) and TAS (Intas). At the interim stage, a Single Judge granted an injunction on phonetic similarity, but the Division Bench reversed it and the Supreme Court declined interference. After trial, the Single Judge again ruled for Sun Pharma; the Division Bench again reversed, and on 27 July 2026 the Supreme Court declined to interfere.

Beyond similarity

While assessing similarity, the Division Bench noted that the prefixes BEV and BEVA are publici juris syllables specifically for anti-cancer drugs and, in the pharmaceutical industry, it is common practice for relevant persons to ignore the publici juris syllables and focus on the uncommon syllables for distinguishing between two pharmaceutical goods.

Also, the marks had to be assessed in their market context. Although both are anti-cancer preparations, they differ in composition, therapeutic purpose, dosage and administration; are non-interchangeable; and are Schedule H drugs prescribed by oncologists and administered by trained personnel. They

are also expensive; their packaging, trade dress and labelling differ, with active ingredients displayed prominently.

Phonetic resemblance alone could therefore not establish likelihood of confusion. This reasoning did not dilute the heightened caution required for medicinal products under *Cadila* (2001); rather, it reinforced *Cadila*'s requirement to consider the nature of the drugs, class of purchasers and circumstances of sale.

Evidence, not assumption

The post-trial evidence proved decisive. Sun Pharma produced no oncologist, chemist, nurse or other relevant professional involved in prescribing, dispensing or administering the drugs. Its sole witness was a Sales Manager, whom the Court found incompetent to speak for medical professionals or purchasers. He also admitted that there were no recorded instances of confusion despite the products co-existing from 2016 to 2026.

Per the Court, after trial, confusion had to be established through evidence reflecting actual market circumstances.

Plead the case you intend to prove

The Court also criticised Sun Pharma for reframing its commercial lawsuit into a 'public interest' issue. Sun Pharma initially claimed commercial injury but dropped its monetary demands during trial, arguing that the similarity risked public confusion. The Court rejected this shift because Sun Pharma knew the underlying facts from the start. A generic 2011 news report on pharmacist negligence was deemed irrelevant, and arguments about illegible prescriptions were dismissed as outside the formal pleadings. The Court emphasised that the 'likelihood of confusion' test assumes a reasonably prudent purchaser, not reckless medical negligence.

The Bench further held that a plaintiff must identify the specific subsection of Section 29 of the Trade Marks Act, 1999 relied upon, so that statutory basis, pleadings and evidence regarding an infringement claim remain aligned.

The ruling establishes a significant, evidence-based precedent. It conveys that trade mark claims in pharmaceutical matters cannot rely on speculation or assumed negligence. Instead, deceptive similarity must be supported by evidence. It also serves as a warning for litigants to align their pleadings, evidence, and invoked statutory provisions carefully.

IRAQ

Mohcine Fettah, JAH Intellectual Property, LLC

The Iraqi Trademark Office has revised its formalities specifically for class 5 pharmaceutical, medicinal, and veterinary products. Under these strict new guidelines, trade mark filings now mandate the submission of a home registration certificate either at the time of filing or within six months of the application submission date. The TM office's logic behind this is that class 5 remains arguably the most critical classification within the Nice Classification because it directly intersects with public health and citizens' safety. Substandard, unapproved, or counterfeit pharmaceuticals carry severe risks, making heightened regulatory scrutiny essential. By necessitating a home registration certificate, the Iraqi authorities are enforcing a rigorous verification mechanism. This requirement ensures that the underlying pharmaceutical products have successfully navigated the complexities and legal standards of their country of origin before being granted brand protection in Iraq. Securing trade mark rights in the brand's home country is no longer merely a domestic priority but an absolute prerequisite for expansion into the Iraqi market.

KAZAKHSTAN

CWB

Effective 10 February 2026, Kazakhstan enacted new Rules on the recognition of trade marks as well-known by Order of the Minister of Justice No. 97 dated 28 January 2026. Adopted in accordance with Kazakhstan's Law on Trade Marks, Service Marks and Appellations of Origin of Goods, the Rules establish a more structured and evidence-based framework for obtaining well-known trade mark status.

The Rules apply to both registered trade marks and unregistered designations that have acquired widespread recognition in Kazakhstan. Applications must be filed with the Ministry of Justice for a single mark, specifying, among other things, the claimed date from which the mark became well-known and the relevant goods or services matter and issues a decision on recognition or refusal. The Rules also clarify and expand the grounds for refusal, denying recognition if the designation lacks distinctiveness or is false, misleading, or likely to deceive consumers. This aligns the recognition process with fundamental principles of trade mark protection under Kazakh law.

International Update continued

A key development is the formalization and expansion of evidentiary requirements. Applicants must now provide comprehensive documentation proving the mark's recognition among consumers. In addition to traditional commercial and financial documents (such as contracts, invoices, and sales data), the Rules expressly recognize a wider range of supporting evidence. This includes advertising and marketing materials, accompanied by records of advertising expenditures, media publications, and analytical reports.

The Rules now explicitly allow the use of digital and market-based indicators, such as website traffic and social media engagement statistics, search engine query data (including Google Trends and Yandex Wordstat), and sales and popularity data from online marketplaces. While consumer recognition surveys remain a central element of proof, further supporting materials may include information on industry awards and rankings, certificates of participation in exhibitions and competitions, letters from business partners and distributors, and expert opinions.

Under the Rules, applications must be published and are subject to a three-month opposition period during which third parties may file objections, in which case a designated commission reviews the matter and issues a decision on recognition or refusal. The Rules also clarify and expand the grounds for refusal, denying recognition if the designation lacks distinctiveness or is false, misleading, or likely to deceive consumers. This aligns the recognition process with fundamental principles of trade mark protection under Kazakh law.

Amendments to the opposition procedure under the Trade Mark Law introduce an important clarification. Starting February 2026, once an opposition against a published trade mark application has been considered and a decision issued, the applicant who filed the objection must be notified by the expert organisation within five working days. Previously, objections filed were not formally acknowledged, and the status of the challenged trade mark applications had to be monitored independently.

The new framework raises the evidentiary threshold while improving procedural

transparency. Brand owners should be prepared to submit robust, multi-source evidence and to navigate the enhanced opposition and notification mechanisms.

SAUDI ARABIA

Jehad Ali E Hasan, JAH Intellectual Property, LLC

The Saudi Authority for Intellectual Property (SAIP) has initiated the pilot launch of Tahaqqaq - a centralized digital platform modernizing trade mark enforcement at Saudi borders. For pharmaceutical brand owners, onboarding is operationally mandatory to maintain an active border watch. Without electronically registering trade marks on Tahaqqaq per mark and per class, rights holders will not receive automated customs alerts when suspected counterfeit medications are intercepted at Saudi borders. This customs recordation requires a copy of the Trade Mark Registration Certificate and a legalized or apostilled Power of Attorney.

In fact, Tahaqqaq introduces an accelerated workflow for suspected counterfeit shipments. Instead of physically detaining a shipment at the port, Customs will allow the importer to take conditional possession of the goods after signing a strict legal undertaking promising not to sell, distribute, or alter the shipment pending investigation. Meanwhile, Customs retains physical samples at the port and uploads high-resolution photographs alongside shipping documents directly to the platform. The brand owner's registered local agent receives an automated alert to review this digital evidence remotely.

Once the brand owner confirms an infringement, they must select one of two enforcement routes, which dictates their level of ongoing visibility. Under the Public Prosecution route, if the brand owner selects not to file a civil lawsuit, the case is referred directly to public prosecutors as a criminal matter handled independently by SAIP and Customs. The brand owner has no ongoing involvement, legal standing, or updates regarding the proceedings. Conversely, under the Parallel Litigation route, if the brand owner initiates a civil claim against the importer, SAIP launches parallel criminal proceedings. This route grants the brand owner and their legal counsel full procedural visibility to track the case, access key information, and actively monitor the enforcement outcome.

UNITED KINGDOM

Laura Rhodes, Lewis Silkin LLP

On 1 July 2025, KP Pharma Health Ltd (the Applicant) applied to register the figurative mark shown below in classes 3, 5, 9, 10 and 44 covering goods such as 'anti-aging moisturisers used as cosmetics' and 'sun care lotions [for cosmetic use]' at the UKIPO. On publication, HN Merchants Limited (the Opponent) opposed the application under the fast track opposition procedure. The opposition was directed at the class 3 goods covered by the application, on the basis of double identity and a likelihood of confusion with the Opponent's UK trade mark registration for the mark pharmahealth relying on goods in class 3 such as 'anti-aging creams' and 'skin hydrators being injectable dermal fillers'. The Hearing Officer dismissed the double identity grounds of opposition given that the respective marks were not identical but proceeded with the likelihood of confusion grounds of opposition.



On the comparison of the goods, the Hearing Officer found that the respective class 3 goods were identical or similar. The average consumer was defined as members of the general public who would pay a medium degree of attention when purchasing most of the goods at issue, rising to medium-high for injectable dermal fillers due to their more invasive nature.

The Hearing Officer held that the word elements pharma and health had a limited degree of distinctiveness in relation to the class 3 goods at issue. Specifically, the word pharma in relation to the class 3 cosmetic goods was held to allude to the goods having a formulation based on science (such as dermatological science). In particular, the Hearing Officer provided the example of cosmetics concerned with skin care or anti-aging being marketed as having ingredients with a scientific or pharmaceutical basis (such as vitamins or certain acids) which enhanced the appearance of the user. In relation to the word health, it was held that it alluded to the goods having health or wellbeing benefits.

Continued on next page

International Update continued

The Hearing Officer held that the letters kp and the background device element played the greatest role in the overall impression of the Applicant's mark, due to their size and position. Visually, the marks were considered to be similar between a medium and low degree because the size and position of the kp element, the differences in presentation and the device elements reduced the degree of similarity notwithstanding that both marks include the words pharma and health.

Phonetically, the marks were held to be similar between a medium and low degree because the letters kp, found at the beginning of the Applicant's mark were not present in the Opponent's mark, and consumers tend to pay more attention to the beginning of the marks.

Conceptually, the Hearing Officer held that the kp element conveyed no specific conceptual message. There was conceptual identity among the shared word elements pharma and health and the plus symbol in the Applicant's mark was considered to be reminiscent of a first aid cross, reinforcing the word health within the Applicant's mark. Overall, the marks were considered conceptually similar to a medium degree.

The distinctiveness of the respective marks and the elements within the marks played a key role in determining whether there was a likelihood of confusion. The Hearing Officer held that there would be no direct confusion between the marks, even for the identical goods, on the basis that the kp element in the Applicant's mark would not be overlooked, especially in view of its position at the beginning of the mark, and that it played a distinctive role within the overall impression of the mark.

Phonetically, the marks were held to be similar between a medium and low degree because the letters kp, found at the beginning of the Applicant's mark were not present in the Opponent's mark, and consumers tend to pay more attention to the beginning of the marks.

In relation to indirect confusion, the Hearing Officer did not consider that the conjoined words pharmahealth to be so strikingly distinctive that consumers would assume only one undertaking would use it in its mark, especially as the words pharma and health were allusive of the goods in issue. In addition, the kp element was not held to be a logical indicator of a sub-brand or brand extension of the Opponent's mark. Instead, the kp element in the Applicant's mark created the impression of a different undertaking, rather than a variant to the Opponent's mark.

The Hearing Officer concluded by stating that the average consumer would perceive the presence of the common element pharmahealth / pharma health in the respective marks as a coincidence rather than an economic connection between the undertakings. Therefore, no indirect confusion was found even in relation to identical goods.

The opposition was dismissed in its entirety, and the application proceeded to registration. This case highlights that applicants of trade mark applications containing allusive word elements in the healthcare and pharmaceutical sectors might be able to successfully defend against oppositions provided the mark as a whole contains additional elements which applicants can argue create a different overall impression.

UZBEKISTAN

CWB

On 7 May 2026, the President of the Republic of Uzbekistan signed Law no. LRU-1144 introducing significant reforms to intellectual property regulations, concerning licensing rules, official patent fees and trade mark termination procedures. The Law entered into force on 8 August 2026.

Licensing agreements do not automatically constitute trade mark use

A key amendment concerns the definition of trade mark use, removing from Uzbekistan's Civil Code the provision that previously allowed licensing agreements to automatically constitute 'actual use' of a trade mark.

This amendment is of particular significance for brand owners, as under Uzbek law, a trade mark that has not been continuously used for three years without legitimate excuse may be subject to cancellation proceedings initiated by third parties. With the removal of the licensing provision, trade mark owners can no longer rely solely on licensing agreements to satisfy the use requirement - they must now demonstrate genuine commercial use of their marks in the marketplace.

Early termination of trade mark registrations

The legislative amendment introduces early termination of trade mark registrations. Under the updated rules, a trade mark may be terminated by court decision if the legal entity owning the mark is liquidated, or if the individual owner dies without legal or testamentary heirs, upon the request of a third party.

This amendment simplifies the procedural path, since previously early termination action could be brought either before the court or with the Board of Appeal under the Ministry of Justice, which created procedural uncertainty. Under the current framework, such appeals are to be filed directly with the court.

Amendments to official fees

The Law introduces significant updates to official fees for inventions, utility models, industrial designs, software, databases, and appeals filed before the Board of Appeal under the Ministry of Justice.

Official fees for deadline extensions to respond to Office Actions - primarily for patent, utility models, or industrial design applications are expected to be significantly reduced. The fees for appeals filed against decisions made during formal and substantive examinations are now harmonized, while previously appeals of formal examination decisions were subject to lower fees.

These reforms are particularly relevant for brand owners, technology companies, and foreign investors entering the Uzbek market, as they reflect Uzbekistan's ongoing efforts to modernize its intellectual property framework and improve the effectiveness and accessibility of trade mark protection mechanisms.

Last minute update

GAZA

JAH Intellectual Property, LLC

As the Trade Marks Office in Gaza is gradually resuming operations, the Palestinian Ministry of National Economy has issued a new administrative circular stipulating that any trade mark that became due for renewal during its non-operational period that extends from 7 October 2023 can still be renewed with the standard fees without incurring any additional late payment fees. However, starting 12 August 2026, this temporary waiver will officially end, and standard late fees will once again be calculated and collected in full. It is worth noting that under Palestinian trade marks law, rights owners typically have a one-month grace period to renew an expired mark by paying a late fee payment. In practice, however, a trade mark can usually still be renewed after this grace period provided the registrar has not officially issued a cancellation order. The Registrar only issues this order after delivering a mandatory notice of cancellation to the owner or agent on record and receiving no renewal request within one month of that notice.

Lost in Transliteration: Why Pharma Brands Clear in Latin Script and Collide in Arabic

Zeina Salameh, Saba IP

Across Arab countries, a clearance process, including knockout and full availability searches, may not always provide a complete picture. It is not uncommon for a pharmaceutical trade mark to clear comprehensively across the Gulf Cooperation Council, the Levant, and North Africa in Latin script, only to encounter unforeseen challenges when transliterated into Arabic.

These challenges rarely present themselves during the early stages of brand development. Instead, they tend to emerge during trade mark examination, in opposition proceedings, or, more problematically, after packaging has been approved and the product has been launched.

Arabic-script considerations should therefore not be viewed as a mere transliteration exercise to be addressed at the end of the process. Rather, they form an essential component of trade mark clearance and should be assessed from the outset as part of the overall brand availability and risk evaluation strategy.

Transliteration variants

Arabic-script does not lend itself to straightforward conversion from Latin-script. Several sounds commonly found in Latin languages, including P, V, and the hard G, have no direct equivalents in Arabic. As a result, a single Latin-script trade mark may give rise to multiple acceptable Arabic renderings, each carrying its own clearance considerations, conflict risks, and enforcement consequences.

Arabic script also introduces a visual dimension that is frequently underestimated. Minor orthographic differences, particularly the addition or omission of dots, can transform one letter into another. As a result, trade marks that appear distinct in Latin script may be perceived as confusingly similar when viewed in Arabic.

The commercial and legal implications are significant. A clearance strategy focused exclusively on the Latin-script version of a mark may fail to identify material risks that become apparent only when the mark is assessed in Arabic. Likewise, an enforcement strategy built solely around a Latin-script registration may prove inadequate if a third party secures rights in an Arabic transliteration that consumers associate with the same brand.

Clearance framework

The solution is not to undertake a comprehensive Arabic-language analysis for every proposed trade mark across every market. Such an approach is neither cost-effective nor sustainable, particularly during the early stages of brand development. A more practical strategy is

to adopt a tiered risk assessment framework, calibrated to both the maturity of the brand selection process and the commercial significance of the markets concerned.

At the shortlist stage, each candidate mark should be subjected to an initial Arabic screening exercise. This involves generating the most likely Arabic transliterations and assessing them for phonetic conflicts, visual similarities, and potentially adverse linguistic or cultural connotations. The purpose is not to achieve definitive clearance, but rather to identify and eliminate candidates that are likely to create problems later in the product lifecycle.

As the number of viable candidates narrows, the depth of analysis can be increased in those countries that are strategically important from an investment or enforcement perspective. In such markets, a more detailed assessment of existing third-party rights can provide a clearer understanding of the legal landscape and the associated risks.

Timing is critical. When conducted during the shortlist phase, Arabic screening is a relatively modest investment that helps eliminate problematic candidates while strategic adjustments remain easy and inexpensive. By contrast, postponing the exercise until after brand selection, regulatory filings, packaging approval, or product launch transforms a preventive measure into a remedial one, often at considerably greater cost and with far fewer options available.

Filing decision

Registering the Arabic transliteration of a pharmaceutical trade mark may not be necessary in every jurisdiction, but in the region's key pharmaceutical markets it should generally be treated as the default position. The rationale is both regulatory and strategic.

The first consideration is regulatory compliance. Across much of the Arab world, Arabic product names must appear on packaging, patient information leaflets, dosage instructions, and safety warnings as a condition of obtaining and maintaining market authorization. As a result, the Arabic rendition is not merely a marketing adaptation; it is a requirement and trade mark protection becomes necessary.

The second consideration is enforcement. None of the region's principal statutes (the GCC Unified Trade Mark Law, the UAE's Federal Decree-Law No. 36 of 2021, or Egypt's Law No. 82 of 2002) has an explicit transliteration provision; the cross-script argument rests on the general confusion test. Protecting only the Latin-script version of a mark often requires

brand owners to prove that the Arabic equivalent is confusingly similar, a process that can be complex and subjective. By contrast, ownership of the Arabic-script mark shifts the dispute from similarity to identity, making enforcement faster, straightforward, and generally more effective.

The key question, however, is not whether to register an Arabic transliteration, but which one to register. Given that a single Latin-script trade mark can generate multiple plausible Arabic renditions, careful selection is essential. The preferred Arabic version should be adopted consistently across trade mark filings, regulatory submissions, packaging, promotional materials, and commercial use. Alignment across these functions ensures that the brand is presented to the market in a coherent and defensible manner.

In higher-risk jurisdictions, brand owners may also consider securing defensive registrations for the most likely alternative transliterations, particularly where linguistic variations could facilitate third-party filings or create enforcement challenges. The appropriate approach will vary depending on the commercial importance of the market, the strength of the brand, and the level of enforcement risk involved.

Ultimately, effective Arabic-script protection is not about registering every conceivable variation in every jurisdiction. It is about identifying the Arabic forms that matter, securing them strategically, and integrating them into the broader trade mark protection framework. Knowing where to invest, and where to monitor instead, is often what distinguishes a resilient pharmaceutical trade mark portfolio from a vulnerable one.

Takeaway

Latin-script clearance remains an indispensable component of any pharmaceutical trade mark strategy, but it is no longer sufficient on its own. The best-protected brands are not necessarily those subjected to more extensive Latin-script searches; they are the brands whose owners recognize from the outset that, in the Arabic-speaking world, clearance must be approached as a dual-script exercise. For pharmaceutical companies, the stakes are particularly high. Trade marks are closely intertwined with regulatory approvals, market access, and patient recognition. At the same time, gaps between Latin and Arabic protection can create opportunities for third parties seeking to capitalise on brand recognition. In such an environment, Arabic-script clearance is no longer an optional enhancement to the trade mark process but a fundamental element of risk management and brand protection.

Vietnam Sharpens Pharmaceutical Counterfeit Enforcement as USTR Pressure Mounts

Nick Redfearn, Rouse

Vietnam's pharmaceutical and healthcare enforcement landscape is under heavy international scrutiny following the US Trade Representative's (USTR) 2026 Special 301 Report, released on 30 April 2026. It raised Vietnam to a 'Priority Foreign Country', the first use of that category in thirteen years, threatening trade sanctions. The designation reflects persistent concerns over trade mark infringement, online piracy and counterfeit goods, including products affecting health and safety.

Vietnam had been gradually upgrading its IP system, most recently through the amended Intellectual Property Law (Law No. 131/2025/QH15), which took effect on 1 April 2026. Then suddenly in May, Vietnam had to demonstrate a far more robust enforcement system. It began a nationwide anti-infringement campaign and a restructuring of its administrative IP enforcement framework. Recent police action against large counterfeit medicine and supplement operations shows pharmaceutical counterfeiting is now in focus as both an IP issue and a public health concern.

A national campaign and recent legal changes

The nationwide crackdown on IP infringement was launched under Official Dispatch No. 38/CD-TTg, signed by Deputy Prime Minister Ho Quoc Dung on 5 May 2026. Rather than relying on isolated raids or local administrative actions, the campaign appears intended to mobilise multiple agencies around priority sectors and repeat offenders. For pharmaceutical and healthcare companies, that matters because counterfeit medicines, supplements and medicated consumer products often fall between regulatory, criminal and IP enforcement channels. A centrally backed campaign increases the likelihood of joined-up action. By the end of the peak period on 30 May 2026, government media reported over 2,000 IP violations detected and 1,073 infringing websites blocked.

A second step was Decree No. 186/2026/ND-CP, issued on 26 May 2026, which revises Decree No. 99/2013/ND-CP and took effect on 15 July 2026. Most notably, IP Vietnam now assumes the principal administrative enforcement role previously held by the Ministry of Science and Technology Inspectorate. Directors of provincial Departments of Science and Technology are also empowered to act. In

parallel, police authority is clarified and expanded, including the role of cyber police in tackling online infringement. For pharmaceutical rights holders, these changes should streamline enforcement routes and improve the authorities' ability to address digital sales channels. One common IP complaint had been the slow bureaucratic pace of administrative bodies.

Decree 186 also introduces a potentially valuable new remedy for online enforcement. Telecoms operators can now be ordered to block access to domain names used for infringing activity within five days. Access must be restored within three days if a restoration decision is issued. For fake pharmacy websites and unauthorised online medicine sellers, this is a practical tool that did not previously exist in the same form. The decree also allows household businesses to be compelled to change infringing names.

The 2026 counterfeit medicine cases

These changes are now being tested against major counterfeit healthcare cases. A recurring feature is adulteration with undeclared pharmaceutical actives. In February 2026, Thanh Hoa police dismantled a nationwide fake traditional medicine operation trading as the Hoang Minh Duong clinic. Sales staff posed as doctors to market the products online. Investigators recorded nearly 87,000 orders between 2023 and 2025, generating more than VND 227 billion (USD \$8.7 million) in illicit profits.

On 16 April 2026, Ho Chi Minh City police announced criminal proceedings against a counterfeit medicine ring led by Thai Chanh Kien. The ring mixed herbal ingredients with paracetamol and sold the pills as imported traditional medicines. Packaging falsely claimed origin in Malaysia and Hong Kong. Officers seized more than 4,000 boxes of finished product and around 790kg of pills and materials. The authorities treated the conduct as serious criminal activity rather than a routine product infringement matter.

Supplements follow the same pattern. On 26 April 2026, Ho Chi Minh City police arrested Tran Thi Nhu Hao and her husband Nguyen Trong Anh for mixing sibutramine, a banned weight-loss substance, into EMO'S branded functional foods. Police seized more than 5,200 finished packets and 639kg of raw powder, together with production machinery and printed packaging.

Doctor impersonation can also be the entire scheme. In May 2026, Hanoi police arrested 13 suspects led by Tran Van Hien for cold-calling fibroid and thyroid patients while posing as a doctor's staff. The group worked from patient records and sold purported cures such as THYROID GOLD MK at high prices. Police charged the group with fraud rather than counterfeiting. These cases blur the line between regulatory non-compliance, commercial fraud and IP infringement, and the risks to brand owners and consumers are correspondingly greater.

What this means for rights holders

The Vietnamese authorities are becoming more willing to pursue large and complex counterfeit healthcare operations through criminal channels. That is a positive signal for IP holders, particularly in a sector where administrative fines have long been seen as insufficient to deter repeat or commercial offenders. At the same time, the scale of these operations shows how entrenched and profitable counterfeit medicine and supplement activity can be.

This is where the USTR context becomes important. Vietnam's challenge is to show that enforcement is becoming systematic, consistent and better adapted to current infringement patterns, not a short burst of raids and penalties. The new US position seems to be driven by trade changes between China and Vietnam, Vietnam's US trade deficit and the tariff position, as much as pure IP issues. Vietnam's increasing importance in Asian supply chains has led to the US taking a more assertive stance.

Pharma enforcement strategies in Vietnam should now be reviewed against IP Vietnam's new role and the provincial authorities' expanded powers. Administrative options may become more effective where trade mark infringement is clear and rapid intervention is needed. Online enforcement belongs at the core of anti-counterfeiting strategy because e-commerce shops and websites are part of real-world counterfeit trade. Criminal enforcement should become easier on regulatory and IP grounds. For now, the direction of travel is clear: pharmaceutical counterfeit enforcement in Vietnam is becoming more active, more centralised and more consequential.

Beyond Counterfeits: Focus on India

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Pharmaceutical counterfeiting is no longer confined to fake medicines or copied packaging. Artificial intelligence (AI) can now be used to create convincing prescriptions, fabricated doctors and endorsements, cloned pharmacy pages, manipulated marketplace listings and copied packaging. Together, these elements can form a false but credible healthcare ecosystem that influences prescribing, dispensing, undermines product authentication, disrupts pharmacovigilance and, ultimately, puts patient safety at risk.

This article explains why pharmaceutical trade marks require heightened protection and examines the principal forms of AI-enabled abuse: fake prescriptions, deepfake medical authority, copied packs and online listings, and the circulation of counterfeit or unauthorised products through digital and physical supply chains. Drawing on Indian decisions, enforcement actions and regulatory developments, it also outlines how pharmaceutical companies can preserve evidence, linking online activity with the product supplied, coordinate legal and regulatory responses, and use AI responsibly to enhance detection, monitoring and enforcement.

Why do pharmaceutical trade marks require heightened protection?

Confusion involving medicines can cause consequences that do not arise with ordinary consumer goods. In *Cadila Healthcare Ltd v Cadila Pharmaceuticals Ltd*, (2001), the Supreme Court of India called for greater care where similar medicinal marks may lead to harmful consequences. The need for heightened protection is particularly pronounced in a country as linguistically diverse as India, where consumers may speak different languages, possess varying levels of literacy, and pronounce or recall medicinal names differently, thereby increasing the likelihood of confusion.

That principle remains equally relevant in the digital marketplace, where deception may influence not only what a patient purchases but also which medicine is ultimately selected, supplied or consumed.

The continued importance of this

heightened standard is reflected in recent decisions of the Delhi High Court. In *GlaxoSmithKline Pharmaceuticals Ltd v Zee Laboratories Ltd*, the Court considered PHEXIN, used for an antibiotic product, against FEXIT, FEXIT-B and FEXIT-M, used for pharmaceutical ointments. Similarly, in *Sun Pharmaceutical Industries Ltd v Artura Pharmaceuticals*, the dispute involved PEPFIZ and REVITAL against PEPFIX and NEOVITAL. An ex parte interim order restrained dealings under the challenged marks, including through chemists, distributors and e-commerce aggregators. Taken together, these decisions confirm that the threshold for tolerating confusion in the pharmaceutical sector remains necessarily low given the potential implications for public health.

AI-generated prescriptions: when digital deception becomes brand abuse

The rise of AI-generated prescriptions presents a new challenge at the intersection of healthcare regulation, counterfeiting and brand protection. Recent news reports have highlighted concerns that AI tools can generate highly convincing prescriptions bearing fabricated doctor, hospital or clinic details, potentially facilitating the unauthorised purchase of antibiotics, psychotropic drugs and other regulated medicines.

In February 2026, the All India Organisation of Chemists and Druggists reportedly warned that AI-generated prescriptions containing fabricated hospital details were allegedly being accepted by unregulated e-pharmacies, enabling the sale of restricted and prohibited medicines while bypassing verification safeguards. The reported concern extended to antibiotics, psychotropic drugs, opioids and Schedule H and X medicines.

The issue becomes a trade mark and brand protection concern when a forged prescription is used to obtain, dispense or substitute a branded medicine. While the generation of a fake prescription does not, by itself, amount to trade mark infringement, it may be used to divert demand towards a particular product, procure counterfeit versions of a branded medicine, or facilitate unauthorised

substitution. In such cases, the forged prescription becomes part of the mechanism through which brand abuse occurs.

The responsibility for verifying the authenticity of prescriptions rests primarily with pharmacists and dispensing platforms. However, once suspected misuse comes to light, pharmaceutical companies may need to investigate whether their products have been targeted as part of a diversion, substitution or counterfeiting scheme. From a brand protection perspective, companies should seek to obtain and preserve the prescription, order records, invoice, seller details, batch information and product samples. These materials may help establish whether the medicine supplied matched the product prescribed, whether the product was genuine, whether any unauthorised substitution occurred, and whether the prescription formed part of a broader pattern of misuse.

Deepfake doctors and fabricated medical authority

AI-generated endorsements can lend false credibility to counterfeit medicines. Recent reports have highlighted scams in which fraudsters used deepfake doctor videos, cloned voices, fake social media profiles and copied healthcare branding to market counterfeit or unsafe medicines through unregulated online channels, creating the false impression of medical approval.

Indian enforcement trends demonstrate the growing risks associated with fake medical authority. In 2025, the Delhi High Court intervened against AI-generated deepfake videos falsely portraying renowned cardiologist Dr. Naresh Trehan as endorsing healthcare products and remedies (*Global Health Limited & Anr v John Doe & Ors.*) Separately, law-enforcement authorities have recently reported cases involving individuals impersonating doctors, including a QR-code fraud at a government hospital in Madhya Pradesh and the arrest of multiple fake practitioners in Hyderabad.

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These incidents demonstrate how AI can manufacture an appearance of medical authority at scale. For pharmaceutical companies, the resulting harm extends beyond reputational damage. Deepfake endorsements can be used to promote counterfeit medicines, divert consumers to unauthorised sellers, exploit the goodwill of established brands and undermine trust in genuine healthcare professionals and institutions.

As AI-generated deception becomes increasingly convincing, brand protection can no longer be limited to traditional anti-counterfeiting measures. Effective risk management will require a combination of rapid takedowns, robust verification procedures and closer collaboration between pharmaceutical companies, healthcare institutions, platforms and regulators to preserve trust in legitimate medical advice.

From online deception to the physical supply chain

Indian enforcement actions show that online deception often extends into the physical supply chain, resulting in the distribution of counterfeit or unauthorised medicines. In December 2024, the Ministry of Health and Family Welfare reported a joint raid by the Central Drugs Standard Control Organisation (CDSCO) and the West Bengal authorities on a drug wholesaler in Kolkata. Anti-cancer, anti-diabetic and other drugs suspected to be spurious were seized, together with empty packaging material. The Ministry said the products lacked documents showing legitimate importation and that samples were sent for testing. The total market value of the drugs seized was estimated at approximately INR 6.60 Crore (around USD \$695,000).

In another real-world example, reporting on a 2024 Delhi investigation described empty vials of the cancer drug Keytruda allegedly being refilled and sold as genuine medicine. In August 2026, the International Consortium of Investigative Journalists (ICIJ) reported new Indian tracing requirements for cancer-drug packs, including a QR code or barcode showing their movement from factory to patient, with implementation required by July 2027. This shows how packaging, batch identity and traceability can become central to both patient safety and trade

mark enforcement.

The October 2024 Jan Aushadhi case offers a different example. A Delhi court restrained the use of Jan Aushadhi Sangh, ordered delivery of infringing material for destruction and awarded INR 10 lakh (approximately USD \$10,500) in damages. The Government linked the order to protecting the identity of authorised Jan Aushadhi Kendras and helping consumers obtain authentic medicines.

In August 2026, Karnataka authorities reportedly seized counterfeit and expired medicines worth nearly INR 5 crore (approximately USD \$526,000) from a facility near Bengaluru that allegedly repackaged and relabelled lower-cost drugs as products of reputed pharmaceutical companies. The case illustrates how supply-chain manipulation and false labelling can be used to introduce spurious medicines into the market.

Lessons from supply-chain and house-mark misuse cases

In a 2025 judgment in *Johnson & Johnson v Pritamdas Arora & Ors.*, the Delhi High Court addressed a sophisticated counterfeiting network dealing in SURGICEL, ETHICON and LIGACLIP surgical products. The defendants were alleged to have collected counterfeit and expired medical products, repackaged and relabelled them as genuine products, and circulated them through domestic and international distribution channels. Recognising the serious threat that such conduct posed to both trade mark rights and patient safety, the Court granted a permanent injunction and awarded approximately INR 3.34 crore (around USD \$352,000) in compensatory and exemplary damages. Although the case involved medical devices, its lessons equally apply to medicines: preserve test purchases and electronic records, trace cross-border suppliers, examine relabelling and expiry information, and explain the public-health risk.

House-mark misuse can also make a false business look credible. In *Novartis AG v Novartis Pharma*, decided in February 2026, the Delhi High Court considered use of the NOVARTIS house mark and associated branding by a pharmaceutical

business. The case is a reminder that copying a company name or house mark may falsely suggest a genuine manufacturer, group company, licensee or authorised channel.

Using AI to strengthen pharmaceutical enforcement

AI can be a powerful enforcement tool. It can match carton and blister-pack images, detect deceptively similar medicine names, identify cloned pharmacy websites, uncover repeat sellers and analyse large volumes of online listings at scale. Yet AI should support, not replace, human judgment. Investigators must verify the evidence, quality and regulatory teams must assess patient-safety risks, and legal teams must determine the appropriate enforcement strategy.

The larger shift is that pharmaceutical enforcement can no longer focus on the trade mark alone. It must safeguard the integrity of the entire patient journey, from discovery and prescription to purchase and consumption. Effective response plans require coordinated action across legal, regulatory, quality, medical and cybersecurity teams, supported by systematic preservation of digital and product evidence.

In the AI era, the counterfeit may be the prescription, the doctor, the pharmacy, the advertisement or the medicine itself, and often several of them at once. Protecting a pharmaceutical trade mark therefore means more than protecting a brand. It means protecting the chain of trust that connects patients to genuine medicines.

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Mediation as a Strategic Tool for Intellectual Property Dispute Resolution in ASEAN Region

Denise Mirandah and Rudina Pescante, mirandah

In today's digital economy, intellectual property disputes frequently transcend borders, languages, and legal systems. Traditional litigation continues to play a vital role in dispute resolution, although it may involve greater costs, longer timelines, and a more adversarial process in some circumstances. Two recent mediation cases conducted under the WIPO-ASEAN Mediation Programme Plus (AMP+) illustrate how mediation is becoming a powerful alternative for resolving complex intellectual property disputes in Singapore and across the region. These are *The Beauty Nation Pte Ltd v Sin Seng Medical & Herbs Pte Ltd & The R.Co Pte Ltd (The Beauty Nation)* and *Moniba Ather v Singapore New Reading Technology Pte Ltd (Moniba Ather)*.

The Beauty Nation

The Beauty Nation concerned disputes over brand presentation, trade mark use, and alleged unauthorised online retail activities. Party A, a Singapore-based wellness company with substantial patent and trade mark portfolios, had long supplied products to Party B's traditional Chinese medical retail business. During the COVID-19 pandemic, Party B expanded into e-commerce and began listing Party A's products online, allegedly without proper authorisation, raising concerns over brand dilution and market positioning.

The mediation was shaped by several structural challenges. Party A was legally represented while Party B attended as unrepresented business owners, requiring the mediator to spend additional time ensuring Party B fully understood the mediation process and the implications of proposals. The parties also had very different expectations about a financial settlement, and because the mediation was conducted in two languages, careful communication was needed to make sure that meaning and intent were clearly understood by both sides.

Although the mediation did not ultimately result in settlement, it served an important function in clarifying positions, refining expectations, and supporting informed decision-making in a structured and respectful setting. From a broader perspective, *The Beauty Nation* illustrates that mediation can remain valuable even

without a settlement by helping to manage disputes arising from rapid digital changes, reduce misunderstandings between long-standing commercial partners, and provide a constructive forum for clarifying legal and commercial expectations.

Moniba Ather

In *Moniba Ather*, the dispute involved a Pakistani author and a Singapore-based digital publishing platform. The author had licensed her novel for online publication from 2020 to 2025. When the publisher later adapted the novel into a short-form digital drama and continued to make it available after the licence had expired, the author sought mediation through the WIPO Arbitration and Mediation Centre. The mediation was conducted fully online across different countries and time zones. Instead of focusing on lengthy legal arguments, the mediator guided the parties toward practical discussions on compensation, which allowed them to reach a settlement within three days. Language and trust were the main challenges, as the publisher preferred speaking Mandarin while the author did not. The mediator's bilingual skills and careful use of translation helped ensure clear communication, while upfront settlement terms addressed the parties' preference for a clean and final resolution.

By the third day, the parties had resolved all outstanding issues and signed a final settlement agreement. The case shows that cross-border intellectual property disputes, even those involving different cultures, languages, and legal systems can be effectively resolved through mediation. With the support of the AMP+ framework, mediation was able to provide a faster and more practical solution than what might otherwise have been a lengthy cross-border intellectual property dispute.

Bilingual Facilitation

A key similarity shared by the two mediations is the pivotal role of bilingual facilitation. In *The Beauty Nation*, the mediator conducted shuttle sessions in Mandarin and English to match each party's language comfort, reinforcing procedural fairness and party autonomy. In *Moniba Ather*, the mediator skilfully navigated Mandarin-English language barriers through careful translation and culturally sensitive communication,

ensuring that nuance and meaning were accurately conveyed.

These practices underscore an essential lesson for ASEAN dispute resolution: flexibility in the use of language during mediation is vital to effective IP mediation in a culturally diverse region.

Balancing Representation and Procedural Fairness

Both cases further highlight mediation's flexibility in engaging parties with different levels of legal knowledge and experience. In both cases, one party was unrepresented while the other party had legal representation. Mediators in both cases took deliberate steps to ensure procedural fairness, explaining legal implications, reality-testing best alternatives to negotiated agreements (BATNAs), and providing space for reflection before commitments were made.

AMP+ as a Regional Infrastructure for Mediations

Crucially, both mediation cases were supported by AMP+, which offers funding incentives, institutional support, and structured mediation procedures. AMP+ lowers financial and procedural barriers to justice, making mediation viable even for individuals and small-medium enterprises (SMEs) who might otherwise be priced out of formal intellectual property enforcement routes.

Conclusion

Together, these two mediation cases demonstrate that ASEAN is witnessing a paradigm shift in how intellectual property disputes are resolved. Mediation is no longer merely an alternative but is fast becoming the primary mode of dispute resolution for intellectual property conflicts.

As ASEAN's digital and creative economies continue to expand, mediation under AMP+ offers a future-ready framework: multilingual, cost-efficient, culturally sensitive, and commercially pragmatic. For rights holders, publishers, retailers, and technology platforms, mediation is no longer merely optional but has become a strategic necessity.

PROFILE: Lisa M. Dellamura

Lisa graduated from the University of Maryland and earned her J.D. from Seton Hall University School of Law. She began her legal career at Fitzpatrick, Cella, Harper & Scinto LLP (now Venable LLP) in New York City, where she counseled clients on trade mark and copyright matters and represented clients in patent litigations. Based in New Jersey, she joined MSD in 2019 and advises on all aspects of trade marks and copyrights, including counseling, clearance, prosecution, enforcement, and due diligence.



Where were you brought up and educated?

I grew up in central New Jersey, about an hour outside New York City. I attended the University of Maryland, located just outside Washington, D.C. While I loved my four years there, the experience reinforced my appreciation for the New York metropolitan area, and I returned to New Jersey to attend Seton Hall University School of Law.

How did you become involved in trade marks?

A random research assignment. I studied microbiology in college, went to law school intending to practice patent litigation, and joined Fitzpatrick, Cella, Harper & Scinto as a patent litigation associate. Early in my career, I was assigned a research project relating to a trade dress dispute. The partner on the matter was impressed with my work and offered me the opportunity to take over the firm's trade mark prosecution associate role. That unexpected opportunity led me down the career path I continue today.

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

I went to college thinking I would be a plastic surgeon, but when I realized how many years of training it would take, three years of law school seemed like the better path!

Which three words would you use to describe yourself?

Determined; Supportive; Candid.

Complete the sentence: I wish . . .

. . . I had learned more languages.

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

Science was my favorite subject throughout school, which is part of why I initially planned to pursue a career in medicine.

What was your worst experience in the world of work?

I was assigned to a patent litigation relating to fish finding sonar. I am not an electrical engineer, nor did I know anything about fishing or sonar.

What do you do at weekends?

I spend most weekends with my husband and two children, enjoying family time and whatever activities or adventures we have planned.

What is your biggest regret?

Moving out of New York City. I lived there for several years, and now that I am living in the suburbs, I miss living in a city – getting to walk everywhere, restaurants opened later, and anything you could want to do at your disposal generally at any time.

What is the soundtrack to your life?

Broadway musicals. Ever since I was about six years old, I've loved musical theater. Growing up just outside New York City gave me the opportunity to see several shows each year, and those experiences sparked a lifelong passion.

Who was your mentor or role model?

My mentor was a partner I worked with at FCHS, Ed Vassallo, who first gave me the opportunity to do trade mark work. He was supportive, encouraging, and generous with his guidance. Beyond being an exceptional lawyer with deep experience across all areas of intellectual property, he was someone whom everyone respected, both professionally and personally. I owe my career path to the opportunity he gave me.

Which book or books are you currently reading?

The Calamity Club by Kathryn Stockett.

What is your favourite children's book?

The Harry Potter Series.

How do you relax?

Working out or watching reality TV.

Which sport do you play and/or enjoy?

Running. I have completed 4 half marathons, including the New York City Half Marathon twice.

What is your favourite food dish?

Pizza. I never get tired of it.

What is your favourite drink?

Pellegrino sparkling water or Coke Zero.

What is your favourite holiday destination?

Florence, Italy – I have been lucky enough to travel there 3 times, and I love the city, the food, and the surrounding Tuscany.

What is your favourite item of jewellery?

My grandmother's engagement diamond, which I inherited and had made into a necklace. It is a special family heirloom, and I feel fortunate to have it.

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

New Jersey is very different from the stereotypes people often have. It lives up to its name as the Garden State, while also being conveniently located near both New York City and Philadelphia. Plus, there are countless beaches to visit along the shore.

What is your favourite mode of transport and why?

Walking. I lived in cities for most of my 20s and early 30s, and I loved being able to walk everywhere I needed. I also love walking through cities and finding new areas to explore when traveling.