

Law Lore & Practice

PTMG



Pharmaceutical
Trade Marks Group

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Editorial: In praise of women

As the sixty-fifth world health assembly gets underway in Geneva, one of the key topics for discussion will be adolescent pregnancy. The World Health Organisation has released statistics on its website showing that worldwide, one in five girls gives birth by the age of 18.

About 16 million girls aged 15 to 19 and two million girls under the age of 15 give birth every year. Worldwide, one in five girls has given birth by the age of 18. In the poorest regions of the world, this figure rises to over one in three girls. Almost all adolescent births – about 95% – occur in low- and middle-income countries. Within countries, adolescent births are more likely to occur among poor, less educated and rural populations.

Whatever the social, cultural or religious reasons behind such data, as a woman born and educated in the western world, it is hard not to respond. Surely, it is to be hoped that every girl is offered a broader, more complete, education before they embark on the path of the difficult, albeit fulfilling path of motherhood.

Reading the life story of Eleanor of Aquitaine to my 12 year old daughter is also a reminder that 900 years ago girls were mere

pawns in a political and religious game played out by men. Women like Eleanor broke the mould and struggled against the life plan others had laid out for her although not always with the happiest of conclusions. It is significant that it is the scandalous histories of female British monarchs which are remembered in the greatest detail. As Britain prepares to celebrate the Diamond Jubilee, it is tempting to wonder how future historians will remember Queen Elizabeth II's reign.

Female political figures are also top talking points, whether they are first ladies or presidential candidates, past or present. It is refreshing to watch the young, female ministers of the new French government breathe a breath of fresh air around sometimes stale institutions. Around the globe, women are slowly but surely reaching the highest positions in office and continuing to bring their unique approach to decision making.

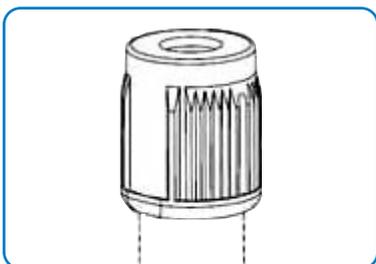
It is sometimes easy to forget how extraordinary the global trade mark profession is in its natural representation of parity (no quotas for us!) but as we look forward to our next gathering in Barcelona, I am sure that all readers, whatever their sex, will join me in wishing “Long may it last”. Happy holidays to you all.

Vanessa

US Law Update

James Thomas, Thomas Trademarks and Copyright Legal Services, North Carolina

In an appeal from a ruling by the Trademark Trial and Appeal Board, the U.S. Court of Appeals for the Federal Circuit recently agreed with the Board that a closure cap for blood collection tubes (pictured below) could not be registered as a trade mark because its



design was functional.

In so holding, the court applied the four-factor test from *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1331 (CCPA 1982), there is: (1) disclosure of utilitarian advantages of the design in a utility patent, (2) utilitarian claims

in advertising, (3) whether the design results from a comparatively simple or inexpensive method of manufacture, and (4) availability of alternative designs. Two significant features of the cap design, the hole in the top for the needle and the ribs for gripping, were disclosed in a prior utility patent and therefore weighed in favor of functionality, but the applicant claimed that separate design patents for similar designs were persuasive of non-functionality as a whole. The court, however, explained that design patents alone do not render a design non-functional and the design patents involved did not reflect the specific design in the trade mark application. The court also rejected the applicant's argument that its advertising touting utilitarian features of certain prominent elements constituted “look for” advertising. This decision provides additional useful explanations

of the Morton-Norwich four-factor test for determining functionality of a design. (*In re Becton, Dickinson & Co.*, 2012 U.S. App. LEXIS 7685 (Fed. Cir. 12 Apr 2012))

In a proceeding under the UDRP, the panel considered a complaint by the owner of the LUNESTA mark involving the domain name *lunexor.com*. LUNESTA is a mark used for a prescription sleep aid. The panel noted that the owner of the domain name had previously used it to sell an over-the-counter sleep aid under the mark LUNEXOR. Therefore, unless such use was obviously intended to play off the fame of the complainant's mark, the domain name owner would ordinarily have a right or legitimate interest in the domain name absent. The owner

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of the LUNESTA mark alleged, however, that domain name was chosen only to sell an infringing product. An action for infringement was pending in a separate court action, but no finding of infringement had yet been reached. As a result, the panel concluded that a UDRP proceeding, with its limited procedural nature, was not the place to resolve the question of infringement and denied the complaint. The panel also held, however, that the owner of the LUNESTA mark could refile its complaint if and when it obtained a finding of infringement. *Sunovion Pharm. v. Gadd Formulas, LLC* (WIPO, 28 Mar 2012)

In a recent practice tip published on its website, the US Patent and Trademark Office set out steps to take when another party incorrectly records an assignment against your trade mark. See www.uspto.gov/trademarks/notices/assignment_steps.jsp. The Office also recently published a warning regarding non-USPTO solicitations that may resemble official USPTO communications. See www.uspto.gov/trademarks/solicitation_warnings.jsp.

Case Comment

ROCHECARE

Chris McLeod,

Squire Sanders (UK) LLP, UK

In case O/467/11 *F. Hoffmann-La Roche AG v Rochecare Ltd*, 22 December 2011, the United Kingdom Intellectual Property Office has refused the latter's application for ROCHECARE in respect of care home and related services in class 44, following an opposition by F. Hoffmann-La Roche AG based on earlier CTM and WIPO registrations of its familiar logo comprising Roche in a lozenge, covering goods and services in various classes, including class 44, and on UK common law rights in the same mark.

The applicant's defence centred on the ROCHE element of its mark being a

reference to the Roch element of Rochdale, an area in North West England, to the river Roche in that area and on its use of the mark since 1999.

The hearing officer held that the marks were moderately similar visually, phonetically similar to a good degree and had no conceptual similarity. She also considered only the respective class 44 services and not the common law position, because she did not need to. The applicant's argument of concurrent use was dismissed on the basis that there was no evidence to show that the public distinguished between the services. Having found the services identical, she inevitably found a likelihood of confusion and refused the application in its entirety.

However, this dispute may rumble on, as the applicant has now filed a UK application for "rochcare" which is no more likely to be palatable to Hoffmann-La Roche.

International Update

Australia

Court criticises patent attorneys under new requirements to take genuine steps to settle disputes

The first highly critical decision under the new Australian Civil Dispute Resolution Act 2011 (CDR Act) has issued in a patent attorney costs dispute. The new CDR Act requires parties to take genuine steps to resolve a dispute before proceedings are commenced in any federal court. The purpose is to facilitate the early and efficient resolution of disputes. The CDR Act provides guidance as to the kinds of steps which will satisfy the obligations including:

- notifying a prospective defendant(s) and offering to discuss a resolution;
- responding appropriately to such a notification;
- attempting to negotiate with the other party with a view to resolving some or all the issues in dispute; and
- providing documentation to another party to help inform them or facilitate a resolution.

In *Superior IP International Pty Ltd v Ahearn Fox Patent and Trade Mark Attorneys* ([2012] FCA 282 23 March 2012) the Court was highly critical of the parties and their lawyers for their flagrant disregard of their statutory obligations. This decision serves as a reminder to all

potential litigants, defendants and lawyers to take heed of the obligation to take "genuine steps" to settle a dispute, or risk an effect on costs should the matter ultimately proceed to litigation.

Georgina Hey, Norton Rose Australia

European Union

ZIMBUS knocks out ZYDUS at the General Court

Novartis' opposition to Cadila's CTM application for ZYDUS has succeeded before the European Union General Court on the basis of Novartis' earlier mark for ZIMBUS. Both marks covered "pharmaceutical preparations" and similar goods.

The General Court reiterated the now settled position that in oppositions concerning pharmaceuticals (i) the relevant public is both healthcare professionals and the general public and (ii) that the relevant public's level of attention is relatively high. It also made it clear that the relatively high level of attention equally applies to over the counter pharmaceutical products, since those goods still relate to a consumer's health.

The General Court found that the goods in issue were identical or highly similar and that the signs had a strong phonetic similarity and a certain degree of visual

similarity. It also concluded that in oppositions concerning pharmaceuticals, equal weight should be given to the level of visual and phonetic similarity, as the relevant public will perceive the marks both visually and phonetically. Accordingly, despite the relevant public's relatively high level of attention, the General Court found that there would be a likelihood of confusion.

Robert Guthrie, SJ Berwin LLP

India

Publication of list of International Nonproprietary Names by Trade Marks Registry

The Controller General of Patents, Designs and Trade Marks has recently published the list of International Nonproprietary Names (INNs) as declared by the World Health Organization (WHO).

Initiated in 1950, the INN system facilitates the identification of pharmaceutical substances or active pharmaceutical ingredients thereby reducing confusion in drug nomenclature, which is an essential element of drug safety.

The Indian Trade Marks Act prohibits the registration of names of chemical elements or INNs declared by WHO and notified in the prescribed manner by the Registrar from time to time, as well as

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deceptively similar names (Section 13). According to the annual report of the Intellectual Property Office India for 2009-2010, about 16% of the total trade mark applications filed were in Class 5 which covers medicinal and pharmaceutical preparations etc.

The publication of the list of INNs is particularly relevant in India as it is expected to help agents and applicants in assessing their trade marks before applying for registration thus avoiding expensive litigation or disputes later on.

Sonal Madan, Ranjan Narula Associates

Macedonia

Customs Seize Fake Anti-Impotence Drugs

Macedonian customs inspectors discovered and seized large quantities of counterfeit drugs used for treating erectile dysfunction during two separate inspections conducted in the capital of Skopje and on the Skopje-Tetovo highway last April.

On 3 February 2012, during a regular customs control of a passenger motor vehicle with Macedonian license plates on the Skopje-Tetovo highway, the customs inspectors found 824 100-mg Viagra tablets, 384 20-mg Cialis tablets, 147 100-mg bags of Kamagra Oral Jelly gel and 168 20-mg Levitra tablets. The suspect

advertised the drugs online and in print and delivered them either by post or in person. Boxes containing four 100-mg Viagra tablets, four 20-mg Cialis tablets and four 20-mg Levitra tablets were sold for USD \$33 (EUR 25) each, while a box of seven bags of 100-mg Kamagra Oral Jelly was sold for USD \$30 (EUR 23), which indicates a profit of USD \$11,230 (EUR 8,480) for the entire quantity.

On 19 February 2012, customs inspectors discovered another large quantity of counterfeit medication in Skopje in the possession of a pharmacy student, a citizen of Serbia. The bag carried by the suspect contained 396 100-mg Viagra tablets, 400 20-mg Cialis tablets, 140 100-mg bags of Kamagra Oral Jelly gel and 80 Kamagra 100 Gold tablets. The suspect advertised the drugs online and shipped them by post. The suspect sold the Viagra 100-mg, Kamagra 100-Gold, and Cialis tablets for USD \$26 (EUR 20) per box, while a box of Kamagra Oral Jelly was sold for USD \$33 (EUR 25), which indicates a profit of USD \$6,326 (EUR 4,780).

The prices of the above-mentioned genuine drugs as recorded in Macedonia's official medicine register range between USD \$44 (EUR 33) and USD \$86 (EUR 65), and they are sold by prescription only.

Customs authorities will bring criminal

charges against the suspects after the investigation is completed and the necessary evidence collected.

PETOSEVIC

Tunisia

Launching of Arabic Domain Names

The Telecommunications National Authority (INT) in Tunisia announced the launch of the Naming Charter of the Arabic domain name "س.ت.نوت" pursuant to Decision No. 12/2012. Arabic domain names were officially launched on 1 March, 2012. The registration will consist of two phases:

- Sunrise Period: Sunrise Phase 1: (1 March to 31 May 2012) is open only to public institutions.
- Sunrise Phase 2: (1 June to 28 September 2012) is open to holders of trade marks registered in Tunisia. The request may be based on registrations of the corresponding mark in Latin.
- Landrush Period: The Landrush phase (which will begin on 1 October 2012) is open to any person or entity applying for the registration of domain names of high commercial value.

Tunisia will now join the ranks of Egypt, Jordan, Qatar, Saudi Arabia, Palestine and UAE as the only jurisdictions in the Middle East to allow for the registration of Arabic domain names.

Saba IP

Members News

New members

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

Annette Freeman of Freeman IP, London, UK annette@freeman-ip.com

Isabel Moniz-Pereira of Gastao da Cunha Ferreira Lda, Lisbon, Portugal isabel.pereira@gastao.eu

Tim Kleinevoss, of Meerbusch, Germany t.kleinevoss@gmx.de

Stephen Goldberg of Spoor & Fisher, Pretoria, South Africa s.goldberg@spoor.com

Elizabeth Atkins of Lathrop & Gage LLP, New York, USA eatkins@lathropgage.com

Catherine Jouguelet of Biofarma, Suresnes, Paris, France catherine.jouguelet@fr.netgrs.com

Isabelle Dini of Norgine Ltd., Uxbridge, UK idini@norgine.com

René Balibey of Sandoz International GmbH, Holzkirchen, Germany Rene.balibey@sandoz.com

Lena Shen of Beijing Sanyou Intellectual Property Agency Ltd., Beijing, China sanyou@san-you.com

Paul Van den Bulck of McGuireWoods LLP, Brussels, Belgium pvandenbulck@mcguirewoods.com

Ozge Atilgan Karakulak of Mehmet Gün & Partners, Istanbul, Turkey Ozge.Atilgan@gun.av.tr

Matthias Sonntag of Gleiss Lutz, Düsseldorf, Germany Matthias.Sonntag@gleisslutz.com

Corina Post-Wolfert of Abcor B.V., Leiden, The Netherlands Wolfert@abcor.nl

Gustavo Bahuschewskyj Corrêa of Leão Intellectual Property, Porto Alegre, Brazil Gustavo@leao.adv.br

Claudia Maradan of Nestec SA, Vevey, Switzerland Claudia.maradan@nestle.com

Nola Pontes of Spoor & Fisher Jersey, St Helier, Jersey, UK n.pontes@spoor.co.uk

Oromena Ajakpovi of Abraham & Co, Lagos, Nigeria Mena.ajakpovi@abrahamandco.com

Karaliova Sviatlana of LexPatent LLC, Minsk, Republic of Belarus svetlana.koroliova@lexpatent.by

Nahum Gabrieli of Seligsohn Gabrieli & Co, Tel Aviv, Israel nahum@sgl.co.il

Yuri Bolotov of BMF Group LLP, Almaty, Republic of Kazakhstan ybolotov@bmflegal.com

Ignacio Serratti of Berkemeyer Attorneys & Counselors, Asuncion, Paraguay Ignacio.Serratti@berke.com.py

Steffen Schäffner of Merck KGaA, Darmstadt, Germany steffen.schaeffner@merckgroup.com

Sandra Bauwens of Arnold + Siedsma, Antwerp, Belgium sbauwens@arnold-siedsma.be

Aliki Charalambidou Arestis of Lelios P Demetriades Law Office LLC, Nicosia, Republic of Cyprus aliki@idlaw.com.cy

Oleksandr Bragarnyk of Legal Alliance Company, Kiev, Ukraine brgarnyk@l-a.com.ua

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Bitter pill to swallow

Viaguara S.A. v OHIM Case 332/10 25 January 2012, Chris McLeod, Squire Sanders (UK) LLP

In 2005, Viaguara S.A. applied to register VIAGUARA for beverages in classes 32 and 33. In 2007, Pfizer Inc., owner of an earlier Community trade mark registration of VIAGRA in class 5, opposed the application on the basis of Article 8(1) (b) and 8(5)CTMR. The Opposition Division rejected the opposition in 2009. Pfizer appealed.

In 2010, the First Board of Appeal overturned the decision. It agreed that the opposition under Article 8(1) (b) should fail, as there was no likelihood of confusion between the goods, but accepted the opposition under Article 8(5) because the marks were very similar. VIAGRA had a reputation as a drug for the treatment of impotence and there was a risk that the use of VIAGUARA would, without due cause, take unfair advantage of the distinctive character or repute of the VIAGRA trade mark.

Viaguara appealed to the General Court, alleging violation of Article 8(5), arguing that the Board of Appeal had relied solely on the similarity between the marks to reach its decision. Viaguara alleged that the goods were dissimilar and that the marks were not very similar, so the public would not assume that the marks were connected.

The General Court summarised the requirements of Article 8(5) in three parts: the marks had to be identical or similar; the earlier mark had to have a reputation; and there must be a risk that use of the later mark would, without due cause, be detrimental to, or take unfair advantage of, the distinctiveness or repute of the earlier mark.

The Court added that the public must perceive a commercial connection between the marks and that the level of similarity between the marks could help to establish such a connection, even if the public did not confuse them. The Court reiterated that all circumstances must be examined when considering similarity, including the type of goods, the level of proximity or difference between the goods, the extent of the earlier mark's reputation, its distinctiveness (whether inherent in the mark or acquired through use) and the likelihood of confusion. Finally, the Court noted

that, in order to oppose on the basis of Article 8(5), an earlier trade mark owner did not have to demonstrate that any detriment had been caused to the earlier mark, but that there was a real risk this might happen.

The Court stated that, to have a reputation, a mark must be known to a significant part of the relevant public. Unsurprisingly, it was not contested that VIAGRA had a considerable reputation as a drug for the treatment of impotence throughout the European Union, nor that it had a reputation with its users as well as the general public. Therefore, the Court held that the second condition of Article 8(5) was satisfied.

Taking the visual appearance of the marks first, and reflecting the Board of Appeal's analysis, the Court recognised that all the letters in VIAGRA were contained in VIAGUARA, the first four letters also being in the same order. The only difference between the marks was the extra 'u' and 'a' in VIAGUARA. The Court did not consider that this was significant, as a consumer would pay most attention to the first part of the mark, which in this case was identical. The applicant sought to challenge the Court by filing evidence of numerous other trade marks registered with the prefix 'via', but the Court held such evidence inadmissible.

It then examined the phonetic similarity between the marks. It acknowledged that VIAGRA would be pronounced 'via – gra' or 'vi-a-gra' and that VIAGUARA would be pronounced 'via-gua-ra', 'vi-a-gua-ra' or 'vi-a-gu-a-ra' in most European languages. Therefore, the first syllable or first two syllables and the last two letters would be identical. As the consumer would pay most attention to the beginning of the words, which sounded identical, the minor difference created by the 'ua' in VIAGUARA did not prevent the marks from being very similar phonetically.

On conceptual similarity, it agreed with the Board of Appeal that whilst 'via' meant road in Spanish and 'by' or 'through' in other European languages, neither of the marks had any meaning in any European language so they could not be compared conceptually.

Viaguara claimed that the 'guara' part of the applicant mark would make the public think of the plant guarana, an ingredient used in its drinks. The Court rejected this, particularly as the 'guara' part was only part of the name of that plant.

The Court confirmed that the greater the similarity between the marks, the more likely it was that the public would perceive a commercial connection. Whilst Article 8(5) did not require identical or similar goods, the type of goods and their similarity would form part of the global appreciation of whether there was a commercial connection. The Court acknowledged that the Board of Appeal had held that there was a commercial connection between the marks due to their high degree of similarity and other factors, including proceedings in the UK High Court, which had held that VIAGRA was inherently distinctive; that it had acquired a reputation in a short space of time; and that it was rare that a trade mark for a pharmaceutical product would enter into common parlance in such a short time. The Court also held that the Board of Appeal had considered the nature of the goods, their properties and the image projected by the VIAGRA mark and had not therefore failed to conduct a global consideration of the marks.

The Court concluded that the high degree of similarity between the marks and VIAGRA's substantial reputation would create a commercial connection in the minds of the public even if the goods were dissimilar. Accordingly, the first condition of Article 8(5) was satisfied.

The Board of Appeal had concluded that there was a risk that the use of VIAGUARA mark would take unfair advantage of the reputation of the VIAGRA mark. The Court noted that a well-known mark would be valuable and project images such as luxury, exclusivity, adventure or youth and that this image might be projected onto the applicant's mark which would mean that sales of its goods would increase due to their association with the positive qualities of the VIAGRA mark.

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The Board of Appeal had relied on an injunction granted by the UK High Court in respect of VIAGRENE, which was intended for use in relation to drinks containing plant extracts and conveyed messages of pleasure, vitality, power and youth. The applicant said that the Court should not have relied on a national decision, but this was rejected on the basis that the national decision illustrated the facts.

The Board of Appeal had also commented that, whilst the suffix 'guara' alone might be legitimate, as guarana was an ingredient in Viaguara's drinks, the addition of 'via' linked it to VIAGRA. Further, Viaguara had promoted the stimulating and aphrodisiac qualities of its drinks. Even if the drinks would not treat impotence, the consumer would be inclined to purchase them on the assumption that they would have similar qualities, due to the positive association with VIAGRA. In respect of its alcoholic drinks, Viaguara had admitted that the drinks contained guarana, which has a fortifying and stimulating effect on the mind and the

body, similar to the effects of a drug.

Viaguara alleged that images of pleasure, vitality, power and youth projected by VIAGRA were incompatible with a prescription drug sold to treat a serious illness. The Court disagreed: VIAGRA projected an image of vitality and power rather than of the treatment of a serious illness, because it had recreational users. Viaguara also challenged the Board of Appeal's reliance on the promotional materials as it felt that the Board should have considered the properties of the goods. The Court disagreed.

In support of its submissions, Pfizer produced a website extract in which Viaguara had described the qualities and effects of 'guarana' in its alcoholic drinks. The extract claimed that Viaguara's drinks had beneficial effects on health and also aphrodisiac effects. This showed that the drinks were marketed as improving sexual performance, one of the qualities of VIAGRA.

Pfizer also produced photos of packaging which showed nude

masculine forms. Whilst Viaguara claimed that nude images were an example of primitive art, the Court disagreed; it was a clear attempt to link Viaguara to the qualities associated with VIAGRA.

Therefore, the Court held that the Board of Appeal had been correct to decide that the use of VIAGUARA would unfairly exploit the attraction, reputation and prestige of the VIAGRA mark by using Pfizer's marketing investment to promote its own goods and the consumer would be inclined to buy Viaguara's goods believing that they would have a similar effect to those of VIAGRA. As Viaguara could not demonstrate any fair use of the mark based on its previously unsuccessful 'guarana' argument, the appeal failed.

This case is a clear example of taking advantage of a well-known mark. Meanwhile, Viaguara continues to use the VIAGUARA mark on its website at www.viaguara.com/pl/viaguar and Pfizer has also opposed a 2010 CTM application for VIAGUARANA, so the dispute continues.

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Cam Gatta of D Young & Co LLP, London, UK cxg@dyoung.co.uk

Mohammed Badamchi of Raysan Patent & Trademark Agents, Tehran, Iran info@irantm.com and info@raysanip.com

Céline Bey of Herbert Smith Paris LLP, Paris, France celine.bey@herbertsmith.com

Edward Barker of Baker & McKenzie LLP, London, UK Edward.barker@bakermckenzie.com

Jean-Christophe Guerrini of Casalonga Avocats, Paris, France jc.guerrini@casalonga.com

Caspar Grote Caspar.Grote@basf.com and Katharina Mende katharina.mende@basf.com both of BASF SE, Ludwigshafen, Germany

Jacqueline Lemos Almeida of Brazilian Development Bank, Rio de Janeiro, Brazil jafel@bndes.gov.br

Jacob Bremer of BarentsKrans N.V., The Hague, The Netherlands bremers@barentskrans.nl

Vanessa Clabau of Thomson CompuMark, Antwerp, Belgium Vanessa.clabau@thomsonreuters.com

Benedikt Schmidt of Meisser & Partners, Klosters, Switzerland schmidt@swisstm.com

Craig Bailey of Corsearch, Diegem, Belgium cbailey@edital.com

Andrew Bellingall of Daniel Advogados, Rio de Janeiro, Brazil andrew.bellingall@daniel.adv.br

Robert Guthrie of S J Berwin LLP, London, UK robert.guthrie@sjberwin.com

Rudolf Böckenholt of Boehmert & Boehmert, Bremen, Germany boeckenholt@boehmert.de

Annie Tsoi of Deacons, Central, Hong Kong Annie.tsoi@deacons.com.hk

Clement Galluccio of Brandpersand LLC, New York, USA clement@brandpersand.com clement@brandpersand.com

Steven Garland of Smart & Biggar / Fetherstonhaugh, Ottawa, Ontario, Canada sbgarland@smart-biggar.ca

Rachel Cockburn Buhl of Ferring International Center SA, Saint-Prex, Switzerland rachel.cockburn-buhl@ferring.com

Moves and Mergers

Anna Carboni has left Powell Gilbert to join Redd in London, UK. Anna can now be contacted at Anna@redd.eu

Lorna Mbatia has left MMC Advocates to join CFL Advocates in Nairobi, Kenya. Lorna can be contacted at Lorna@cfllegal.com

Jette Sandel has returned to Plougmann & Vingtoft in Copenhagen, Denmark. Jette's new e-mail address is JES@pv.eu

Carly Mansell has left GSK in London to return to Australia where she has joined Davies Collison Cave in Melbourne. Carly can be contacted at cmansell@davies.com.au

Isabelle Leroux has left Bird & Bird AARPI and can now be found at SCP Salans & Associés in Paris, France. Isabelle's new e-mail address is ileroux@salans.com

Franziska Strebel Preiswerk has left KRSW Weinmann to join Schneider Feldmann AG in Zurich, Switzerland. Franziska can be contacted at franziska.strebel@schneiderfeldmann.ch

Katrina Burchell has left Unilever to take on the role of Group IP Director at PPR in Paris, France. Katrina can be contacted at kburchell@ppr.com

Frances Jagla has left Leydig, Voit & Mayer Ltd. to join Lane Powell PC in Seattle, Washington, USA. Fran can now be contacted at jaglaf@lanepowell.com

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

Lesley Edwards

PTMG Secretary

PTMG Spring Conference Report

Brussels, 19th and 20th March 2012

“Policy, Practice and Pitfalls – Pharmaceutical Trade Marks in Europe and Beyond”.

Gavan Ferguson, FR Kelly & Co.

Pre-Conference Dinner:

Although the conference officially kicked-off on the Monday, the early birds were treated to a wonderful Sunday reception and dinner at the Conrad Hotel.

Day 1:

As the conference was scheduled for an afternoon start, delegates had time to avail of the Brussels sunshine and to visit the



Sue Evans

many sights within steps of the conference hotel including dozens of chocolatiers scattered throughout the nearby streets.

In the afternoon, Sue Evans, Conference Chairman, officially welcomed everyone to the 84th PTMG Conference.



Richard Bergström

Richard Bergström (Director-General, EFPIA) delivered the Alan Cox Memorial Lecture by providing a reflection on Trade Marks and IP in general within the pharmaceutical industry today. Richard noted that there are many things we take for granted within the pharmaceutical industry, including whether the public actually understand who is responsible for the development and financing of new medicines. He reminded us that there are ongoing price cuts within industry and as a result, R & D is down within industry as a whole. Going forward, Richard commented on whether industry should

concentrate on a public/private partnership to finance new medicines. If it wishes to defend the right of the patient to stay on a branded product that it trusts, it may need to consider a co-payment model.

Marcus Goldbach (Sandoz International) concluded the afternoon session with an International Case Round-up on online infringement and pharmaceutical developments. He outlined developments in US case law with regard to liability of “Internet intermediaries”, e.g. auction sites, search engines, and ISPs. He referred to *Tiffany (NJ) Inc v eBay Inc*, wherein eBay was found not liable for contributory liability because it possessed only general knowledge that counterfeit



Marcus Goldbach

Tiffany jewellery was being sold on its website. Also, eBay’s anti-counterfeiting measures (e.g. Verified Rights Owner Programme) were taken into account positively. Marcus shared an interesting case from Australia, *Solahart Industries v Solar Shop*, wherein it was held that the use of a deceptively similar and infringing trade mark as a domain name constitutes trade mark use if it is used to channel customers to another website and exploits the goodwill of the earlier trade mark.

Later that evening, the Gala Dinner took place at the famous Concert Noble, which was designed by Henri Beyaert in 1873 upon the instruction of Leopold II in order to serve the Belgian aristocracy. During the evening, Sue Evans teased out the details of next year’s Spring conference - - the location of a world famous football team and its unique architectural delights - Hambourg.

Day 2 - Tuesday:

At the start of day 2, we were treated to an overview of developments to the IP framework at the European Commission by Margo Fröhlinger (DG Markt, European Commission). Margo gave us an insight of the ongoing project to reform the Patent



Margo Fröhlinger

system, which could be in effect by 2014, although she noted that there is wrangling over the seat of the Court of First Instance. She also mentioned that we can expect updates to the Trade Mark Harmonization Directive, which will cater for consistency in practice and procedure between the Community Trade Mark and the National Trade Mark system. The streamlining will be addressed in legal texts and through greater cooperation between OHIM and the National Offices.

Sophie Bodet (GlaxoSmithKline) shared an industry perspective on trade marks in Europe. She outlined her proposals for “evolution, not revolution” and welcomed the review of the Trade Mark Regulation and Harmonization Directive. Sophie commented that GSK as an industry player requires consistency and certainty in a cost-effective manner. She noted the disparity in relation to multi-class filings between OHIM and the national offices. Although this may lead to clutter on the CTM Register, it also occurs nationally, as 10 national Registry Offices also cater for filings in up to 3 Classes. Sophie



Sophie Bodet

suggested that if the Registry Offices were to reduce class designations per filing, they should in turn reduce the filing fees per class. Sophie shared an industry perspective on the genuine use provisions, which if lowered from 5 to 3 years would have an impact upon the Pharma industry due to the length of time it generally takes to launch and get regulatory approval. Also, in relation to the listing of goods and



Shelley Duggan

services, she noted that the non-use of class headings would make clearance easier for all concerned and this needs harmonisation throughout the EU.

After a short break for coffee, treats and chat, Shelley Duggan (Procter & Gamble) set out her strategies for fighting counterfeits online. Shelly set out an interesting overview on how her company's online brand programme helped her remove various Internet myths, such as that the Internet is so anonymous that it is impossible to take any action, and that Internet companies do not want to help. Part of the strategy now is to select third party vendors to work with and educate them on strategy for dealing with counterfeits. Shelley also took us through a review of the Memorandum of Understanding (MOU) to fight against the sale of counterfeit goods over the Internet. The MOU has taken two long years to negotiate and they are now



Isabelle Moulon

beginning a journey to build trust and cooperation between right owners and Internet companies. She noted that this has led to an improvement in the relationship between right holders and Internet companies. The next challenge will be to implement MOUs with other stakeholders, such as shipping and credit card payment companies to enforce their own terms and conditions.

Ending the morning session, Isabelle Moulon (Head of Medical Information of the European Medicines Agency) discussed updates at the EMA Name Review Group (NRG). Isabelle took us through the process on how the NRG assess proposed names through assessing safety concerns, public health concerns, and similarity to INNs and INN stems. During the period



Jeremy Philips

from January 2009 to March 2012, 1,031 invented names have been accepted, with 284 names used for a new marketing authorisation and 747 remain unused. Isabelle concluded by noting that they intend to provide more guidance to industry by streamlining the procedure, including revising the guidance document. Isabelle encouraged industry to review the EMA website for the procedural guidelines.



Hubertus Craz

The afternoon session got off to a great start with Jeremy Philips (IPKat; Olswang, UK). Jeremy helped a captive audience canter through the EU legislative process from a private (non-legislative) law perspective. As an illustration of how much law is still in force, Jeremy noted that Open Europe counted 666,878 pages of Official Journal, which he equated to the weight of a rhinoceros. Of this, only 285 kg represents law still in force, which in turn equates to the weight of a baby elephant. Jeremy also shared his thoughts on the legislative system, which is noted as being highly complex and non-intuitive in that it reduces input from outsiders and makes stakeholder input difficult to achieve.

Following Jeremy, Hubertus Craz (Director General of the Association of European Self-Medication Industry, AESGP) led us through an update on umbrella branding of OTC medicines within the EU. Hubertus provided insight into AESGP's position with regard to umbrella branding and how to address the possibility for confusion. He noted that the risk of confusion was diminished by a number of features including form, basic pack design, colour, the use of prefixes, suffixes and sub-brands and labelling. This was further illustrated by reference to well-known

examples of umbrella branding within the marketplace. Hubertus concluded his presentation with a vision on the future of the self-care market in the EU, notably a market that is open so that new products can be launched without untimely delays and wherein the communication on self-care products is not unnecessarily restricted.



Dorothy Linvill-Neal

Dorothy Linvill-Neal (Janssen) closed the day by comparing and contrasting practice between the EMA and the FDA. Dorothy led us through a detailed overview of the two organisations. Notwithstanding notable differences in policy, it was noted that the organisations share a common goal to minimise medication errors. Dorothy also kindly provided us with her strategies for success in obtaining an approved name, notably to perform proper due diligence during name development, to establish a local network to assist with national product nomenclature review and investigation, to maintain an open and transparent dialog with health authorities, and to be responsive to enquires and to provide proper data and analysis to short appeals. Above all, she advised that we should abandon trade mark candidates that present a clear risk.

Sue Evans drew the conference to a close once again thanking all the speakers and noted that we will meet again in Barcelona in the autumn.

PTMG 85th Conference Barcelona

**October 3rd to 5th
2012**

**Registration on line at
www.ptmg.org**

PROFILE: Domenico De Simone

Domenico is admitted to the Bar in Italy and before the Italian Court Sections specialized in Industrial and Intellectual Property Law. He is an Italian and European Intellectual Property Attorney (trade marks, patents and designs), a professional representative before the Italian Patent & Trade Mark Office, the European Patent Office, the Office for the Harmonization in the Internal Market and has been practising Intellectual Property Law since 1972. He is also a member of AIPLA, AIPPI, AISCRIS, ECTA (Vice-President), EPI, FICPI, INDICAM (Vice-President), INTA, LES, PTMG and UNION.Bono programme and founding, along with others, the leading Israeli Human Rights Watch Organization.



Where were you brought up and educated?

I was studied for ten years at an Irish School in Rome, then at a college in Parma, then at a law University in Rome, then at a law University in Palermo. Then in Rome I took the examinations to qualify as an admitted (to the bar) lawyer.

How did you become involved in trade marks?

Intellectual Property was in the family's business and so in 1972, I started learning the job from late David J Lawson Esq., c/o Marks & Clerk in London. Then, as a student worker I started working in Rome and during that time carried out my national service.

Quite obviously thereafter it was much easier as I had only to work!

In my view trade marks had more to develop as opposed to patents and justified more legal resources, including mine.

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

I would have worked as an intellectual property producer.

Which three words would you use to describe yourself?

Made in Italy.

Complete the following sentence.

"I wish a sustainable serenity for everybody"

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

Mathematics and essays.

What was your worst experience in the world of work?

No very bad experience so far. However as a principle I find too much tolerance towards bad faith.

What do you do at weekends?

A few working hours, sports, family (including friends).

Complete the sentence: If I have time to myself ...

But I do have time to myself, if I had more I couldn't stand myself.

What did you want to be as a child?

A runner and a tennis player.

What does all your money get spent on?

I appeal to the Geneva Convention and won't confess.

What is your biggest regret?

Not to be able to do more.

What is your favourite work of art?

My daughter and son.

What is the soundtrack to your life?

The sound of people : their voices, their movements, their steps...

What do you dream of?

Luckily enough I dream of everything.

What do you wish more people would take notice of?

Of respect for differences.

What is a common misperception of you?

That I am good.

What is the most surprising thing that ever happened to you?

To have found an unbelievable wife.

What is the best age to be?

As yet I have not found what nowadays "age" is for individuals. So, it is not yet time for my answer.

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Editor: Vanessa Parker

Tel.: +33 679 316 860 email: vparkercordier@wanadoo.fr